

Insights: Alerts

USPTO Issues Guidance on Options to Amend through Reissue and Reexamination during AIA Trials

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On October 29, 2018, the US Patent & Trademark Office (USPTO or Office) issued a Notice requesting comments on proposed modifications to motion to amend (MTA) practice. The Office received a number of comments and questions concerning the interplay between reexamination and reissue proceedings during a co-pending AIA trial (inter partes review (IPR), post grant review (PGR) or covered business method (CBM) review). Today, the USPTO responded to those comments by publishing a Notice discussing the handling of requests to amend claims through reexamination and reissue proceedings during co-pending AIA trials. Notably, the Notice was intended to summarize rather than amend or alter existing practice.

The Office indicated that it will consider a reissue application or a request for reexamination any time before, but not after, either (1) the Office issues a trial certificate cancelling all claims in a patent, or (2) the Federal Circuit issues a mandate concerning a decision finding all claims invalid. The Office will issue trial certificates after either the period for filing a notice of appeal from an AIA trial decision has closed (63 days after (i) a final written decision (FWD) or (ii) a decision on a request for rehearing following a FWD)), or an appeal to the Federal Circuit has been finally resolved.

Additional important takeaways from the Notice include:

- Patent Owners (PO's) may avail themselves of reissue or reexamination before, during, or even after an AIA trial has concluded, so long as it is filed before the Office has issued a trial certificate, effectively providing PO's with an additional option to try and amend their claim.
- On motion or on its own, the Office will likely stay examination of a reissue application or reexamination pending a FWD in an AIA trial addressing the same patent. A showing of good cause is required. The Notice provides several factors that may be considered in deciding whether to stay or lift a stay of a co-pending reissue or reexamination proceeding. A motion to lift a stay after FWD will likely be granted if the PO has proposed amendments in that proceeding in a meaningful way not previously considered by Office, e.g., narrower claims than those previously considered in a related AIA trial.
- The one-year bar to filing an IPR/PGR under 35 USC 315(b) after service of a complaint does not apply to a reissued patent, which is considered a new patent. In contrast, the one-year bar does apply to

reexamined patents, which are not considered new patents, even if the reexamination certificate results in amended claims.

- Since reexamination requires raising a substantial new question of patentability (SNQ), a PO cannot raise a question in a ground already decided in a FWD. A SNQ may be based on such grounds, however, during an AIA trial. A SNQ cannot be based on denied amended claims in an AIA trial.
- The Office may deny institution of an AIA trial if a parallel Office proceeding is more advanced and involves overlapping issues.
- If a stay of a reissue application is lifted on PO's motion pending Federal Circuit appeal of a FWD, the USPTO will delay issuing any notice of allowance pending resolution of the appeal. But reexamination typically will continue to completion, notwithstanding a Federal Circuit appeal.

Today's USPTO Notice continues Director Iancu's push to provide meaningful mechanisms for permitting PO's to amend claims during AIA trials. Now, in addition to the recently-launched MTA pilot program, which provides PO's up to two opportunities to present amended claims, the Office has confirmed that PO's may file for reissue or reexamination, even after a negative FWD, effectively affording a third opportunity for PO's to amend their claims.

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