

PTAB Strategies and Insights

July 2019



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The PTAB Strategies and Insights newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

This month, we cover reissue practice via an overview discussion and a review of two recent Federal Circuit opinions in recent reissue cases:

- Our overview article examines options to resurrect invalidated patents via reissue or ex parte reexamination by comparing the requirements for each and the speed of reissue examined as special applications to reexaminations and Track One applications.
- We also discuss two Federal Circuit cases explaining the requirements for reissue applications to comply with the original patent doctrine and what the Board needs to evaluate to determine if a reissue complies with the written description requirement.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

To view our past issues, as well as other firm newsletters, please click [here](#).

Best,

Jason Eisenberg

Editor & Author:

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ARE THE DMV SLOTHS FROM ZOOTOPIA REFLECTIVE OF THE PACE FOR REISSUE APPLICATIONS FROM FILING TO OFFICE ACTION?

By: [Jason D. Eisenberg](#)

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FEDERAL CIRCUIT FINDS ANOTHER REISSUE APPLICATION FAILS TO MEET THE "ORIGINAL PATENT" REQUIREMENTS

By: [Jason D. Eisenberg](#)

In [Forum v Flow Valve](#), decided June 17, 2019, the Federal Circuit held Flow Valve's reissue claims were invalid for failing to comply with 35 U.S.C. 251(a): "for broadening reissue claims, the specification of the original patent must do more than merely suggest or indicate the invention received in reissue claims: '[i]t must appear *from the face of the instrument* that what is covered by the reissue claims was intended to have been covered and secured by the original.'"

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UPDATED TRIAL PRACTICE GUIDE

A third version of the Trial Practice Guide issued this week as both a [Federal Register notice](#) and [updates](#). The USPTO/PTAB updated *ex parte* communications, protective orders, additional discovery, live testimony, claim construction, patent owner preliminary responses, considerations in instituting a review and the content of a Decision on Whether to Institute, various issues associated with motions to amend, other motions, final decisions, rehearing requests, and protective order guidelines. This third version follows last summer's [2018 update](#) to the TPG. The [full version](#) is also available on the USPTO website.

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This month, we focus on resurrecting invalidated patents that have no pending family members. This scenario limits options to a narrowing reissue or a patent owner-filed *ex parte* reexamination. Both can expose the patent to all avenues of unpatentability since amendments are being filed – §§ 101, 112, 102, 103, double patenting, etc. – but there are stark differences in what is required to file each, their advantages/disadvantages, and their speed.

In today's culture of immediate feedback and gratification, one approaches reissue practice by taking the United States Patent and Trademark Office (USPTO) at its word. The USPTO says reissues are not eligible for Track One.¹ The USPTO has explained that reissue applications cannot be on Track One because *all* reissues are prosecuted under special dispatch. For example, MPEP 1442: "Special Status: All reissue applications are taken up 'special,' and remain 'special.' All reissue applications...will be taken up for action ahead of other 'special' applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in litigation will be taken up for action in advance of other reissue applications."

But is this really true? Here is a comparison between reissue and track one pendency.

Reissue Applications Filed Since 2014

	Months to 1st OA	Months to Allowance	Months to Disposition
Reissue Applications Since 2014	13.5	22.5	25.8
Track One Applications FY19	3.0	6.7	8.0

Note: Data for reissue applications is compiled via Juristat, data for Track One applications is via the USPTO Patent Dashboard

It appears the USPTO's Central Reexamination Unit – who now handles all reissues – accepts one year from filing to first action and two years to disposition (appeal, abandonment, allowance) as meeting the required “special” speed. Our firm has even seen 18 months pass between first and final Office actions. Yet these one- and two-year time frames have caused much angst for patent owners relying on reissues to save their invalidated patents for subsequent enforcement when those patents are nearing their end of patent term.

Earlier this year, the USPTO asked AIA patent owners to consider using reissue and reexamination for amendments. The USPTO even published a presentation on its study of the interplay of reissue, reexamination, and AIA proceedings. But if a patent that is in danger of being held invalid or that has been invalidated by the PTAB or a Court is expiring – which cuts off all rights to amend – how can patent owners be expected to use reissue if application pendency is so lengthy?

Many have argued that the USPTO needs a better system of prioritizing reissue applications or needs to expand its group of examiners for reissues in order for patent owners to trust the USPTO to timely take up an end of term patent that is being enforced. These pendency statistics appear to support the patent bar's complaints about inadequacies of the current reissue system.

An alternative to amend claims in an invalidated patent is a patent owner-filed *ex parte* reexamination, which has required timelines to grant/denial of request for reexamination and to first office action – 3 months each. But the reexamination poses other issues. Namely, the patent owner cannot get a granted reexamination without finding new, non-cumulative prior art that raises a substantial new question of patentability. Then, the patent owner needs to prepare their own rejection of the claims under the new prior art. Finally, the patent owner needs to amend their claims around the prior art, and then explain why the claims are patentable.

Even after all this exposure of their patent, the examiner can deny the request for reexamination if the examiner finds that the new prior art does not pose a substantial new question. If denied, the only way to get the claims amended is to turn to a reissue application. Or, if the patent owner is willing to spend the additional time and money, it can file the reissue and reexamination at the same time, which raises other issues, such as merger of the proceedings and further delay.

A large deterrent of reexamination versus reissue is the lack of control for the patent owner – patent owners cannot withdraw their request for reexamination or stop prosecution before full appeal. And reexaminations lack the reissue application options of request for continued (re)examination, continuations/divisionals, and abandonment. So the speed advantages of a reexamination can be negated by these deficiencies when compared to reissue.

In the end, reissue is usually the most effective way to resurrect a patent, but at its relative sloth-like pace to first action and disposal can patent owners afford to use it?

¹ – **59052 Federal Register**/Vol. 76, No. 185/Friday, September 23, 2011/Rules and Regulations

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The patent claimed fixtures for holding pipe fittings during machining. The original patent disclosed only embodiments that used arbors to hold a pipe joint while it rotated. The reissue patent added claims that did not use arbors.

Flow Valve argued that a skilled artisan would have understood the disclosure to include embodiments without arbors. The Court disagreed, stating that even if a skilled artisan would have understood the newly claimed invention was possible, that "was insufficient to comply with th[is] standard."

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Global's patent claimed carpeted automotive vehicle load floors having sandwich-type composite panels with cellular cores. Global had filed a reissue application seeking to replace the term "thermoplastic" with "plastic" in independent claims.

The Court stated that the PTAB should consider "the predictability of substituting generic plastics for thermoplastics in the skins and cellular cores of vehicle load floors [because it] is relevant to the written description inquiry" and that "in some cases, the criticality or importance of the expressly disclosed species may be relevant to whether an inventor had possession of a claimed genus."

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