

Reexaminations

USPTO–Challenges and Opportunities

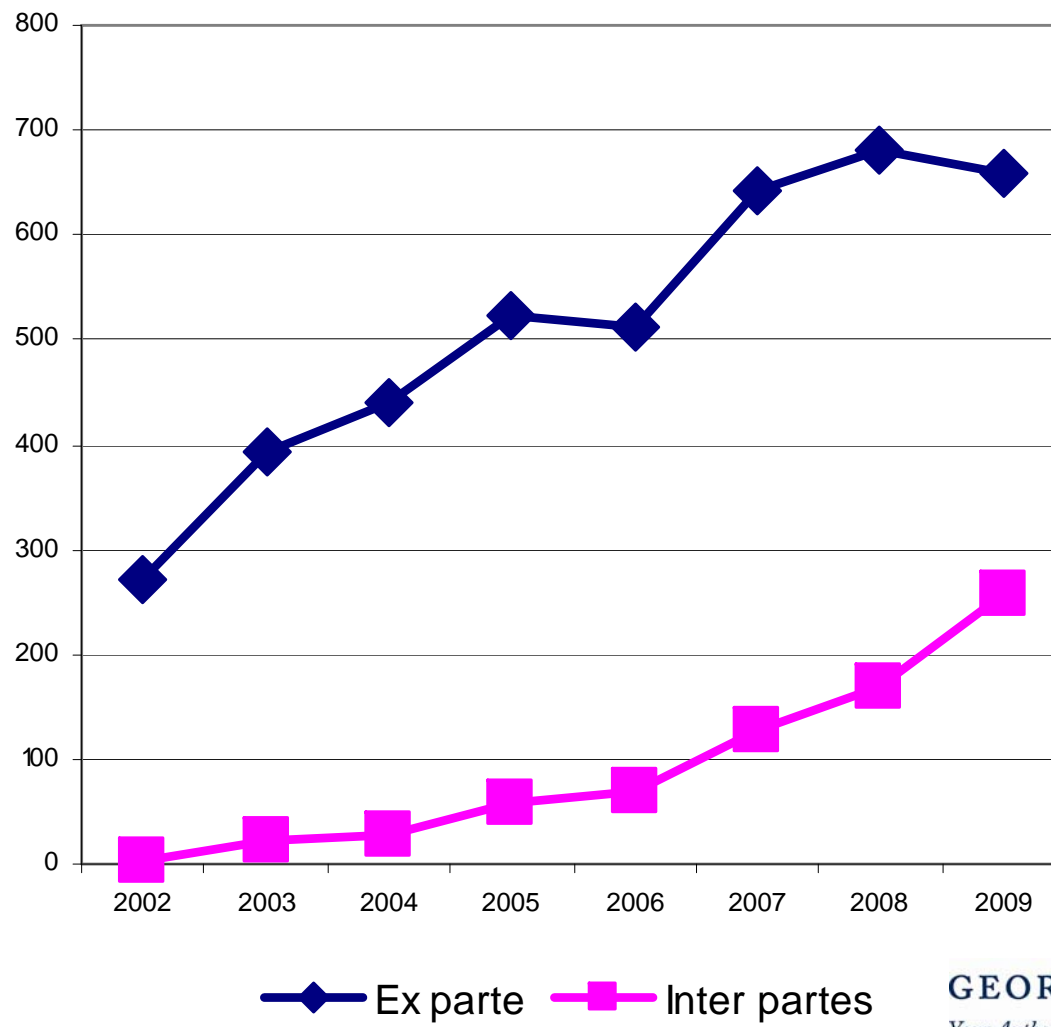
GEORGETOWN LAW CLE

Your Authoritative Legal Resource from the Nation's Capital

- Panel Members

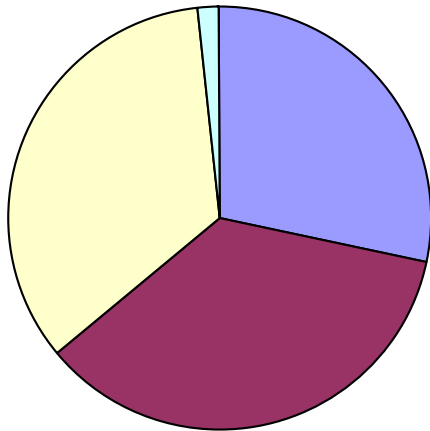
- Commissioner Robert L. Stoll–Commissioner of Patents, USPTO
- David L. Cavanaugh–Partner, WilmerHale
- Joseph P. Reagen–Counsel, Baxter Healthcare Corp.
- John M. Whealan–Associate Dean of Intellectual Property, GW University Law School

Reexamination Requests Filed 2002-2009



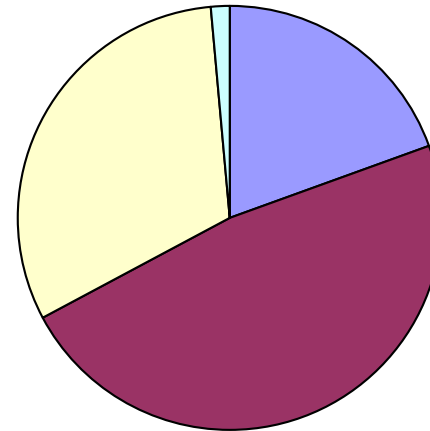
Reexamination Requests by Discipline

Ex parte, 1981-2009
(10,411 filings)



■ Chemical ■ Electrical ■ Mechanical ■ Design

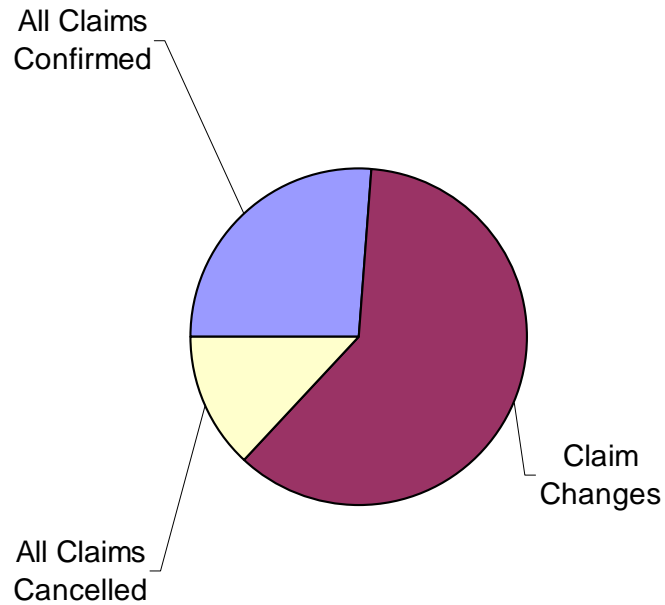
Inter partes, 1999-2009
(808 filings)



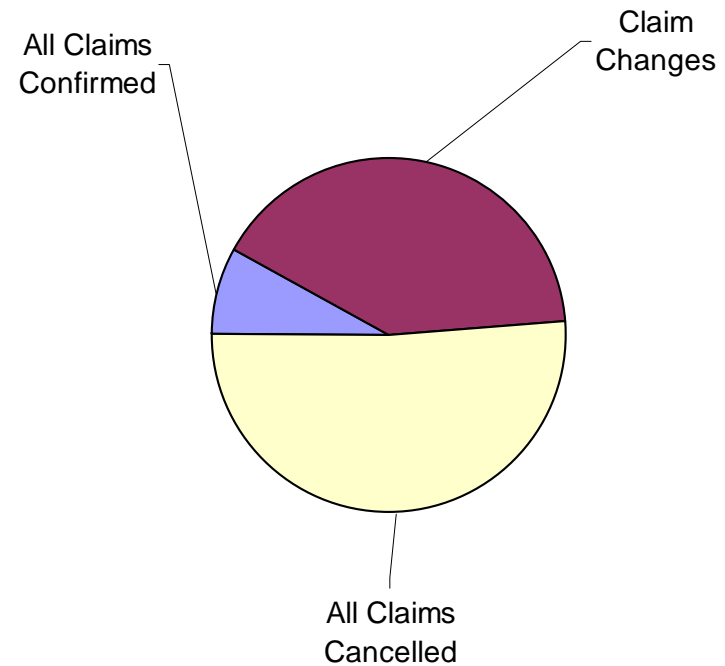
■ Chemical ■ Electrical ■ Mechanical ■ Design

Reexamination Outcomes

Ex parte - third party requested (4,274 certificates)



Inter partes (134 certificates)



• Process and Possible Changes

- Are current procedures satisfying objectives?
- What can be done to force narrowing of issues?
- Should interviews be permitted?
- How to explain the increase in non-compliant requests?
- How can activities/behaviors that delay *inter parte* reexaminations be curtailed?
- Should requests have a page limit?

- Policy

- Should substantial new question of patentability (SNQ) standard be changed?
- Should real party in interest remain anonymous?
- Should patent term extensions be granted?
- How does *KSR* affect the SNQ standard?
- Post grant proceedings?
- How can workload and timeliness issues be addressed?

- Interplay with Litigation

- How is reexamination different/similar to district court proceedings?
- Are “aggressive” litigation style tactics helpful?
- Should broadest reasonable interpretation be balanced against court’s claim construction?
- Should deference be given to district court findings of fact?

- Collateral Effects of Reexamination
 - Does market react to an SNQ finding?
 - How has reexamination changed strategy of in-house counsel?
 - Is it cost prohibitive for small entities to defend reexaminations?
 - Are high profile patents treated differently?

- Disclosure/Candor/Inequitable Conduct
 - How to balance duty of candor and compliance under MPEP 2686?
 - Does flooding PTO with material provide shield to inequitable conduct?
 - Is it necessary to submit information beyond that required by 37 CFR 1.555?



QUESTIONS

Georgetown University Law Center Conference

The Changing Patent Landscape

April 20, 2010

GEORGETOWN LAW **CLE**

Your Authoritative Legal Resource from the Nation's Capital