

# Inter Partes **Reexamination**

David McCombs  
Haynes and Boone, LLP  
September 2009

## **Why More?**



Basics



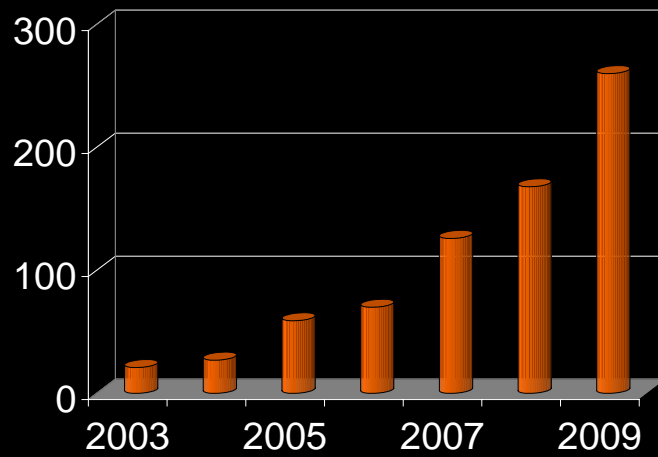
Litigation Strategy



Interplay Among Proceedings

## Why More?

### Inter Partes Filings



“A **key aspect** of patent reform,  
already in place.”

- Commissioner Dudas

## Why more?

- 1999: Creation of *Inter Partes*
- 2002: Amendments
- 2005: Central Reexam Unit
- 2007: *KSR v. Teleflex*
- Published Statistics

## Advantages . . .

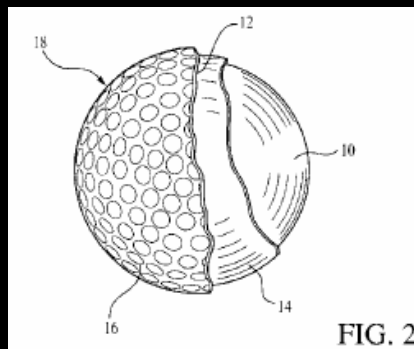
“The PTO may be in a  
**better position**  
to evaluate the prior art.”

- *Alza v. Wyeth*, (E.D. Texas, 2006, J. Clark)

## Advantages . . .

- Better forum for complex arts
- Intervening Rights
- Leverage

Giving evidence of reexamination to the jury would be “really confusing”



*Callaway Golf Co. v. Acushnet Co (D.Del., 2008, J. Robinson)*

## Disadvantages . . .

- Confirmed Claims
- Estoppel
- Pendency

Why More?



**Basics**



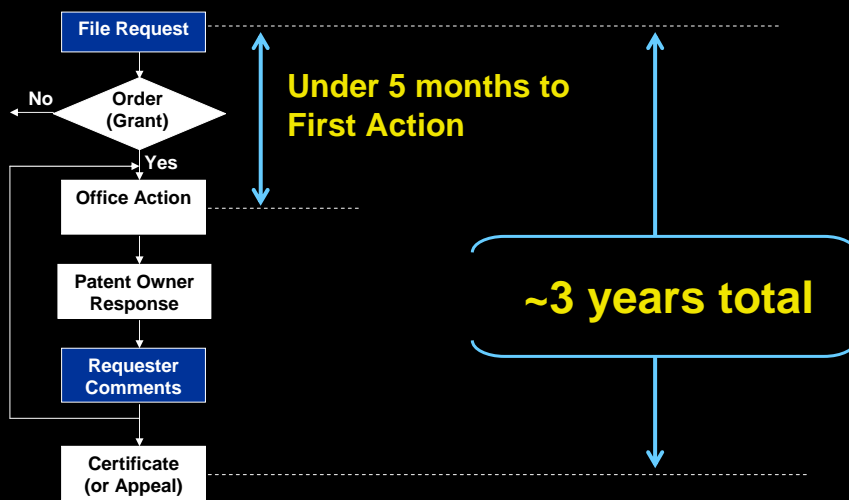
Litigation Strategy



Interplay Among Proceedings

- Procedure to correct a patent
- No presumption of validity
- “SNQ”
- Estoppel
- Cannot stop it

## Inter Partes Flow Chart



Why More?



Basics



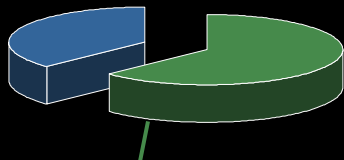
**Litigation Strategy**



Interplay Among Proceedings

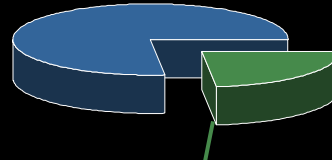
## Choosing **Inter Partes**

Inter Partes



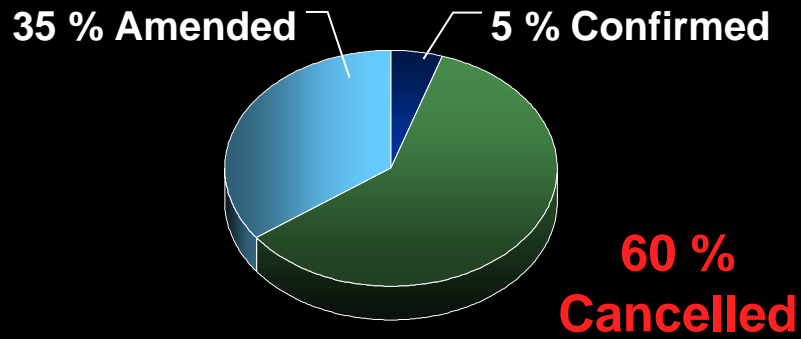
63% known to be  
in litigation

Ex Parte



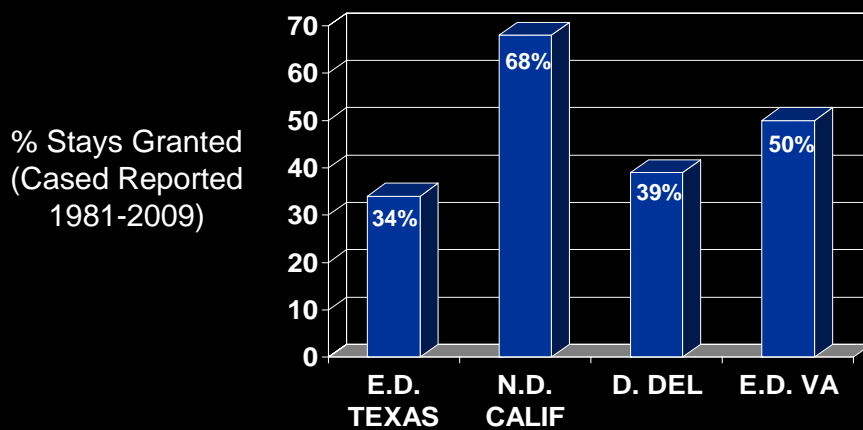
30% known to be  
in litigation

## Results



77 Inter Partes Certificates

## Litigation Stay: Venue Matters



\* Source: Interplay Between Litigation and Reexamination, Katherine D. Prescott, Fish & Richardson P.C.



## Special issues . . .

- Joint Defense Groups
- Prosecution counsel
  - protective orders
  - duty of disclosure v. candor

Why More?



Basics



Litigation Strategy



**Interplay Among Proceedings**

# Estoppel Effects

Inter Partes reexamination  
finds patent...

**Invalid** → **Case dismissed**

**“Valid”** → **Cannot use reexamined  
art in litigation**

**Note:** Estoppel applies only after all appeals are exhausted.

# Estoppel Effects

Litigation finds patent...

**Invalid** → **Reexam is vacated**

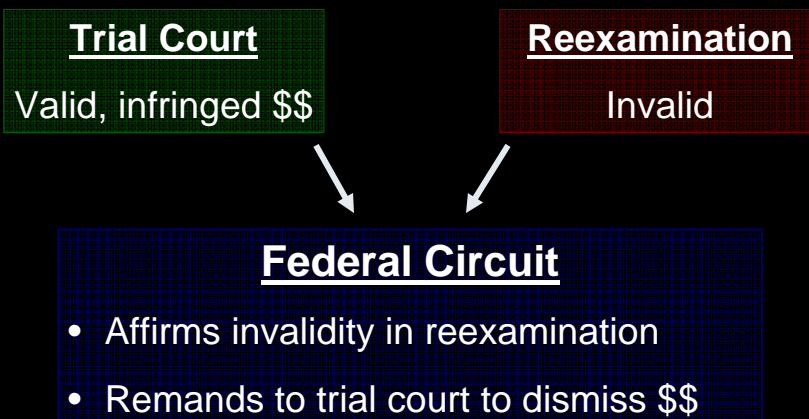
**“Valid”** → **Reexam is vacated  
(if requester is a litigant)**

**Note:** Estoppel applies only after all appeals are exhausted.

## *In re Swanson*

- Trial court finds patent “valid”
- Fed Cir. Affirms
- Reexam is filed and finds patent invalid (same prior art)
- “Court holding of validity is not binding on PTO”

## *In re Translogic Technology*



## Post-trial Stay

- Will court stay post-trial proceedings pending reexamination?
  - *No - MercExchange v. eBay*
  - *Yes - Standard Havens v. Gencor*

**Thank you.**

-David McCombs