

Training Module for Chapter 26 of the MPEP

(Revised August 16 2018)

Summary

Chapter 26: Optional Inter Partes Reexamination

NOTE: Throughout this Chapter, there is a multiplicity of warnings that, based on changes introduced by the AIA, **no requests for *Inter Partes* re-examination may be filled on or after September 16, 2012.** This may make a student wonder if the practice of *Inter Partes* re-examination is coming to an end at the USPTO and, if so, why bother studying Chapter 26. In fact, *Inter Partes* re-examination has found a new life that is more fully described in the recent and second to the last chapter in the current MPEP, Chapter 28, covering the topic of Supplemental Examinations.

There you will find that a patent owner may now request a Supplemental Examination of his/her patent to review any matter, such as a questions of infringement, that might have come up since his/her patent was issued. The result of such a Supplemental Examination will be to either provide the owner with a current certificate indicating that the patent remains valid or to refer the case to an *Inter Partes* re-examination for a final determination. In effect, the new procedure for Supplemental Examination serves as a limiting gateway to reduce the total number of cases previously reaching *inter partes* re-examination at the USPTO. (Prior to this change, the percentage of applications granted *for inter partes* re-examination was in the range of 95% – causing somewhat of a log-jam at the USPTO.)

To further limit the number of cases reaching *inter partes* re-examination, more stringent acceptance criteria have been introduced by the AIA. A transition period began starting on September 16, 2011 and ended September 15, 2012, during which *inter partes* re-examinations were still accepted by the USPTO. But, the acceptance criteria was elevated from the old criteria of a Substantial New Question (SNQ) of patentability to a reasonable likelihood that the request will prevail with regards to at least one of the claims challenged in the request. After September 16, 2012, the USPTO no longer accepts requests for *inter partes* reexamination, but the acceptance criteria for such cases that arise from Supplemental Examinations remains elevated, corresponding to a reasonable likelihood of prevailing (RLP).

Section 2601 – Introduction

- Chapter 22 covered ex parte re-examination (where the third party may introduce material to the USPTO but may not participate in any continued proceedings. Here, Chapter 26 covers the alternative, inter parte re-examination, where the third party takes an active role in the proceedings.
- While there are obvious benefits to the active role provided by inter parte re-examination, THERE IS ALSO A SUBSTANTIAL RISK. Specifically, if the inter parte re-examination does not go to the advantage of the third party, his only recourse is to make an appeal of the USPTO Board's decision to the Court of Appeals for the Federal Circuit Court.

The estoppel provision also prevents the requestor from participation in any future inter-partes re-examinations of the patent in question.

In contrast, if an ex parte re-examination decision goes against the third party requestor, he may still assert invalidity of the patent in a civil action. [Whereas he would be prevented from doing so in an inter

parte re-examination by estoppel.]

- NOTE: Here, estoppel only applies to validity arguments based on prior art publications. But, not to other defenses such as invalidity based on public use or sale, erroneous inventorship, or inequitable conduct.
- A request for an inter parte re-examination is similar to a request for ex parte re-examination. However, it must also include:
 - (1) A certification by the third party requestor that a copy of the request has been served in its entirety on the patent owner at the address provided for. The name and address of the party served must be indicated. (If service was not possible, a duplicate copy of the request must be supplied to the USPTO.
 - (2) A Certification by the third party that the estoppel provisions do not prohibit the inter partes re-examination.
 - (3) A statement identifying the real party in interest to the extent necessary for a subsequent person also filing a inter partes re-examination to determine if that person is a privy (patent insider).

Selected Questions and Answers for Chapter 26 - NONE

In-Depth Review of Chapter 26

Chapter 26 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

[Chapter 26, MPEP](#)