

Filing a Reissue Application In Response to an IRP

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I. Introduction and Summary

There are reported instances where a patent owners attempted to reissue patents for patents subject to IPR proceedings. Filing a reissue application in response to an IPR challenge is a tactic. Whether that is a good tactic depends upon many factors, and is fact specific to the particular case. However, this article indicates anecdotally that such a strategy has a low probability of success.

II. Relevant Law

Whether the patent owner concedes unpatentability of a claim or loses on the issue of unpatentability after contesting unpatentability of the claim, the result and effect are the same. The PTAB enters a final decision indicating that claim to be unpatentable. 35 USC 318(a). This triggers the issuance by the USPTO of a certificate canceling the unpatentable claims, and this certificate redefines the patent as not including the canceled claims. 35 USC 318(b).

The statute also provides estoppel against the petitioner and its closely associated parties in certain circumstances, such that, if the petitioner loses the IPR, then the petitioner cannot take certain actions. 35 USC 315.

The statute does not speak to preclusion against the patent owner in case of lost claims. But the USPTO's implementing regulations do. Specifically, 37 CFR 42.73(d)(3), which states:

§42.73 Judgment. ... (d) Estoppel. ... (3) Patent applicant or owner. A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent: (I) A claim that is not patentably distinct from a finally refused or canceled claim; or (ii) An amendment of a specification or of a drawing that was denied during the trial proceeding, but this provision does not apply to an application or patent that has a different written description.

Rule 42.73(d)(3)'s "finally refused" refers to any proposed substitute claim presented in a motion to amend, which motion was denied.

Rule 42.73(d)(3)'s "canceled claim" refers to a claim identified in the certificate canceling the unpatentable claims, as a canceled claim.

Rule 42.73(d)(3)'s "patentably distinct ... from a claim" means not obvious in view of the claim and the prior art.

Rule 42.73(d)(3)'s "action inconsistent with the adverse judgment" means action that would be inconsistent with any finding of fact or conclusion of law of the PTAB relied upon for the adverse judgement in the IPR proceeding.

The net effect of 42.73(d)(3) on reissue applications is that this rule precludes a patent