

Patent Reexaminations: For Patent Owners

Reexams pose a critical problem to patent owners, even for battle hardened patents that have been successfully enforced in hard fought patent litigation. As a practical matter, the CRU does not show any significant deference to prior successful enforcements of the patent in reexam. There are different evidentiary standards, claim construction rules, ability to amend claims, possible loss of past damages and practical application of the *KSR* obviousness standard between the CRU and the courts in proceedings involving the same patent. In addition, there are rigid timelines in reexams and critical junctures for submission of non-obviousness evidence and arguments that require proactive handling of the proceeding to maximize the chance of success at the CRU and to create a full record for appeal to the BPAI and the Federal Circuit. Deep understanding of how the CRU handles reexams improves the chance of success and minimizes what are often fatal mistakes.

Patent owners should not be lulled into complacency if an *ex parte* reexam is filed against their patents because they assume that the one party nature of the proceeding and the ability to interview the CRU examiner team creates a significant advantage. In fact, *ex parte* reexams, especially in the “rolling *ex parte* reexam” scenario, can often pose as much of a threat to the patent as the more adversarial *inter partes* reexam process. The grant or denial of a stay in the parallel court proceeding can often create huge advantages or losses to the position of the patent owner in an enforcement program. Strict page limits are imposed on the responses that the patent owner can file in response to office actions, so the patent owner needs an optimized strategy to create a full record to support the patentability of the claims under reexam.

