

Patent Reexaminations: For Third Parties

Historically, third party requesters have shied away from using reexams as a defense to a charge of infringement regardless if there was a parallel patent litigation involving the patent. This ambivalence continued with the creation of *inter partes* reexams in 1999 because of a fear of estoppels involving the prior art patents and printed publications and a belief that the USPTO favored the patent owner. This has dramatically changed in the past few years due to important court decisions from the Federal Circuit and the creation of the CRU. Now, many third party requesters are requesting *inter partes* reexams on patents of others they are not in privity with even if there is no parallel patent litigation involving these patents.

Only a third party not in privity to the patent owner is entitled to request an *inter partes* reexam. Not all unexpired U.S. patents are eligible for possible *inter partes* reexam, only those having an application filing date on or after November 29, 1999. Once the *inter partes* reexam is instituted, the third party requester has equal standing to participate in the proceeding as does the patent owner, and this right to participate continues through appeals to the BPAI and the Federal Circuit. Because of this full participation right, many potential or accused infringers view *inter partes* reexams as a more favorable vehicle for challenging patents than the patent owner-centric *ex parte* reexam proceeding. However, present data indicates that on average it takes longer to complete an *inter partes* reexam than an *ex parte* reexam, so if a stay of the parallel court proceedings has not occurred, some third parties opt for an *ex parte* reexam instead.

