

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



**Patent Public Advisory Committee
Quarterly Meeting**

AIA trial/reexam/reissue parallel proceedings study

Jason Repko, Administrative Patent Judge, Patent Trial and Appeal Board
John Cottingham, Director, Central Reexamination Unit

May 2, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Purpose

- Explore the interaction between parallel proceedings at the USPTO (e.g., AIA proceedings, reexamination, and reissue) involving issued patents.
- Determine how many patents had overlapping proceedings, and if so, what was the timing between the proceedings.
- Attempt to identify trends in the use of the proceedings by the parties.

Methodology

- This study was conducted in collaboration with the Central Reexamination Unit (CRU).
- The statistics depict data from the start of AIA filings (September 16, 2012) through mid-year FY18 (March 31, 2018).
- The study covered any corresponding reissue or reexam filed through mid-year FY18 (March 31, 2018) for the challenged patents.
- We analyzed 5,056 patents challenged in the AIA proceedings and any corresponding reissue and reexam for those challenged patents.

Reissues and “reexams”

- **A reissue is an application to correct an error in an unexpired patent.**
 - The reissue applicant is the original patentee, or the current patent owner, if there has been an assignment.

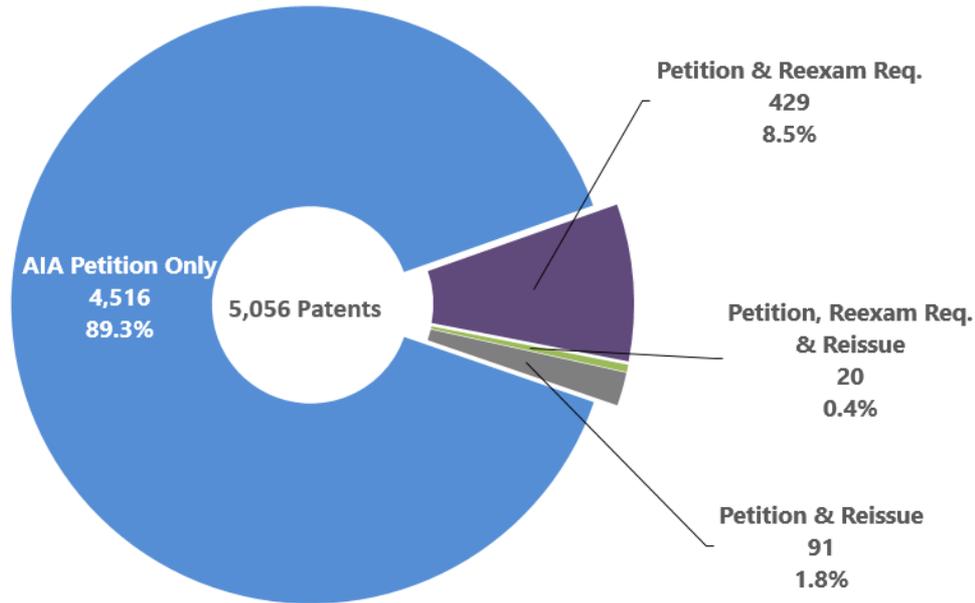
In this study, we refer to the following as “reexams”:

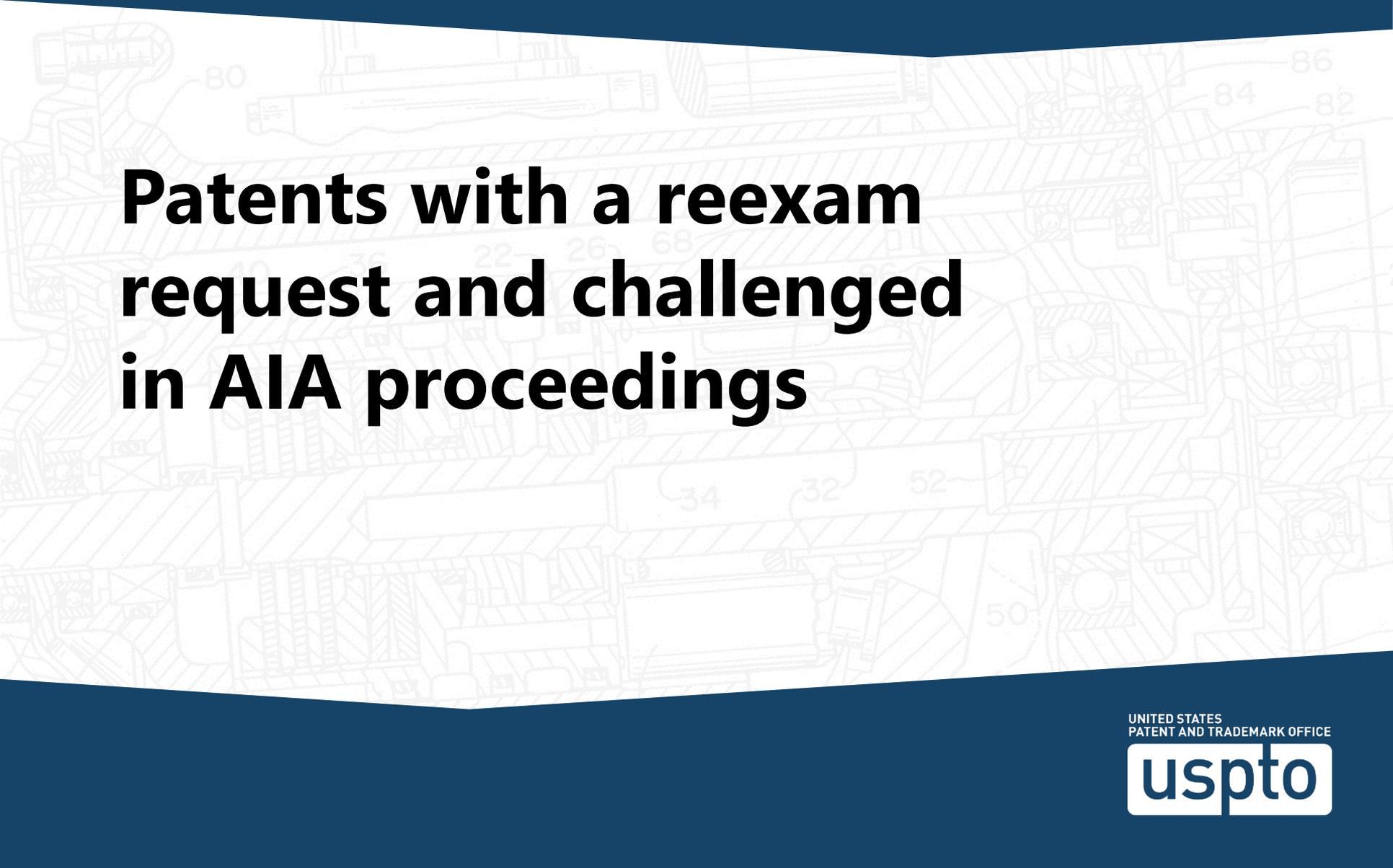
- **Ex parte reexaminations (“EP reexams”)**
 - Who can request an EP reexam? Anyone, including the patent owner, except those barred by estoppel provisions.
 - When can an EP reexam be filed? Any time during the patent’s period of enforceability.
- **Inter partes reexaminations (before September 16, 2012) (“IP reexams”)**
 - Who was able to request an IP reexam? Any third party requester.
 - When was an IP reexam able to be filed? Any time during the patent’s period of enforceability (for a patent issued from an original application filed on or after November 29, 1999).
- **Supplemental examinations (“SEs”)**
 - Who can request an SE? A patent owner.
 - When can an SE be filed? Any time during the patent’s period of enforceability.

Summary

- 89% of patents challenged in AIA proceedings have not had any associated reexams or reissues.
- Decrease from FY12 to mid-year FY18 in percentage of patents that have received both:
 - Reexam request and/or reissue application
 - AIA petition
- In 71.5% of all patents that had both a reexam request and an AIA petition, the reexam request was filed before the AIA petition.
- In 70.3% of all patents that had both reissue and an AIA petition, the reissue application was filed on or after the AIA petition.
- There were about four times as many patents that had an AIA petition and a reexam request as patents that had an AIA petition and a reissue.

Patents with a reexam request or reissue and challenged in AIA proceeding (As of mid-year FY18: Sept. 16, 2012 – Apr. 1, 2018)





Patents with a reexam request and challenged in AIA proceedings

UNITED STATES
PATENT AND TRADEMARK OFFICE



How has the percentage of patents challenged in an AIA proceeding also having corresponding reexam changed over time?

UNITED STATES
PATENT AND TRADEMARK OFFICE

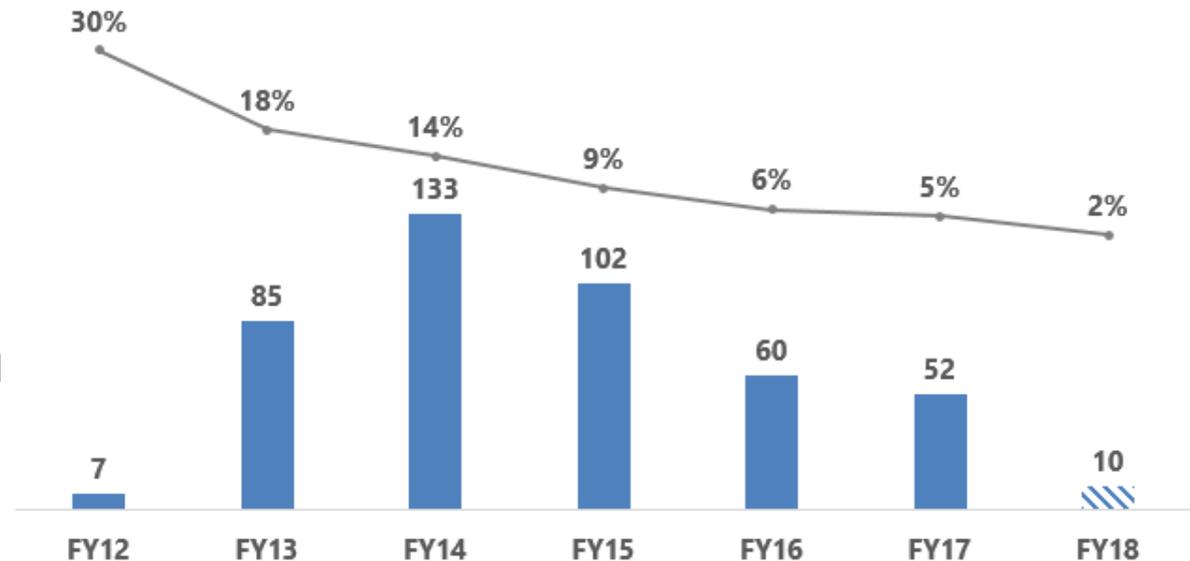


Patents with a reexam request and challenged in AIA proceeding

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

Percentage of All Patents Challenged in AIA Proceedings

Patents with a Reexam Request and Challenged in AIA Proceedings



**When was the reexam
filed in relation to the
AIA proceeding milestones?**

UNITED STATES
PATENT AND TRADEMARK OFFICE

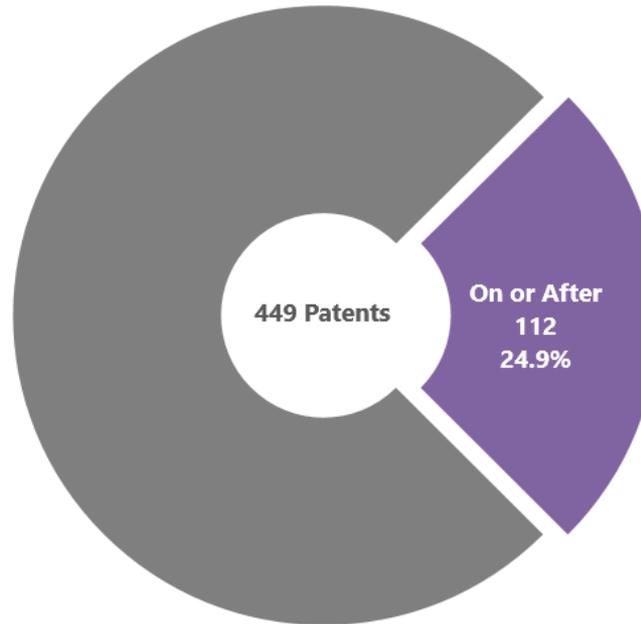
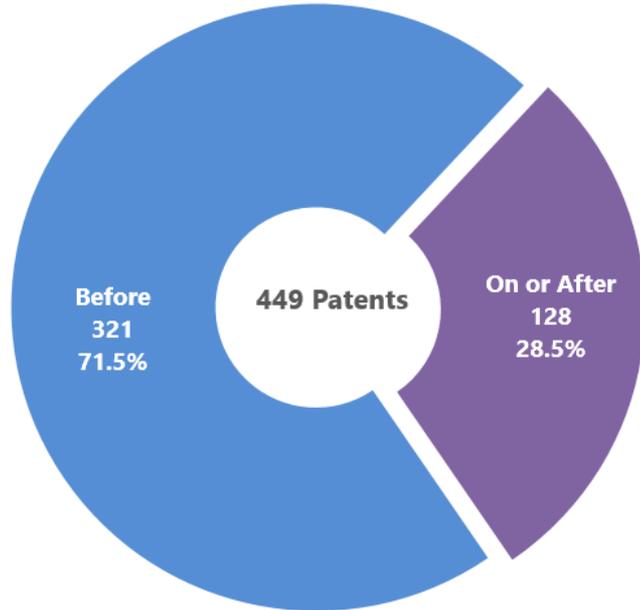
uspto

Was the first reexam filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the filing date of the first AIA petition?

...the date of the first decision on institution?



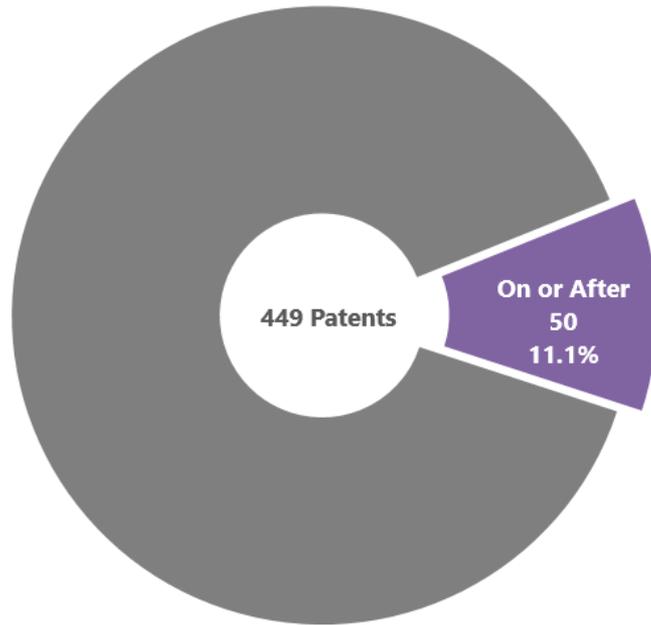
409 of the 449 patents have had at least one decision on institution in any AIA proceeding.

273 of the 449 patents have had at least one petition instituted.

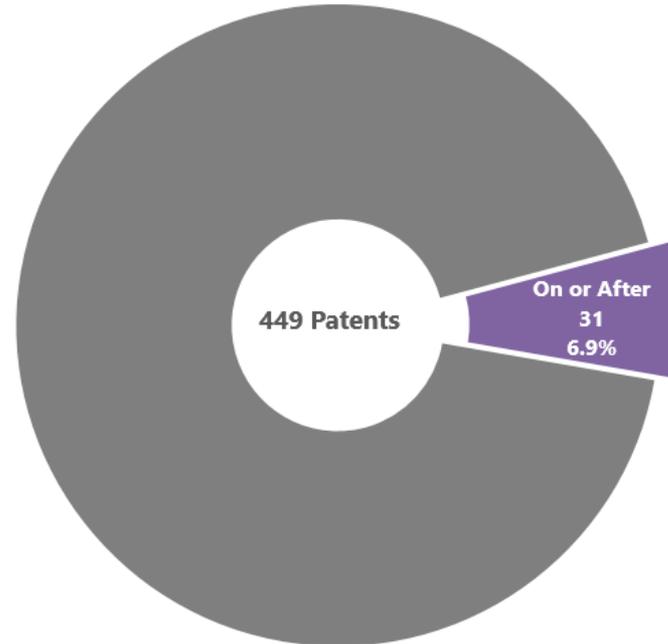
Was the first reexam filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the date that the first AIA proceeding terminated?

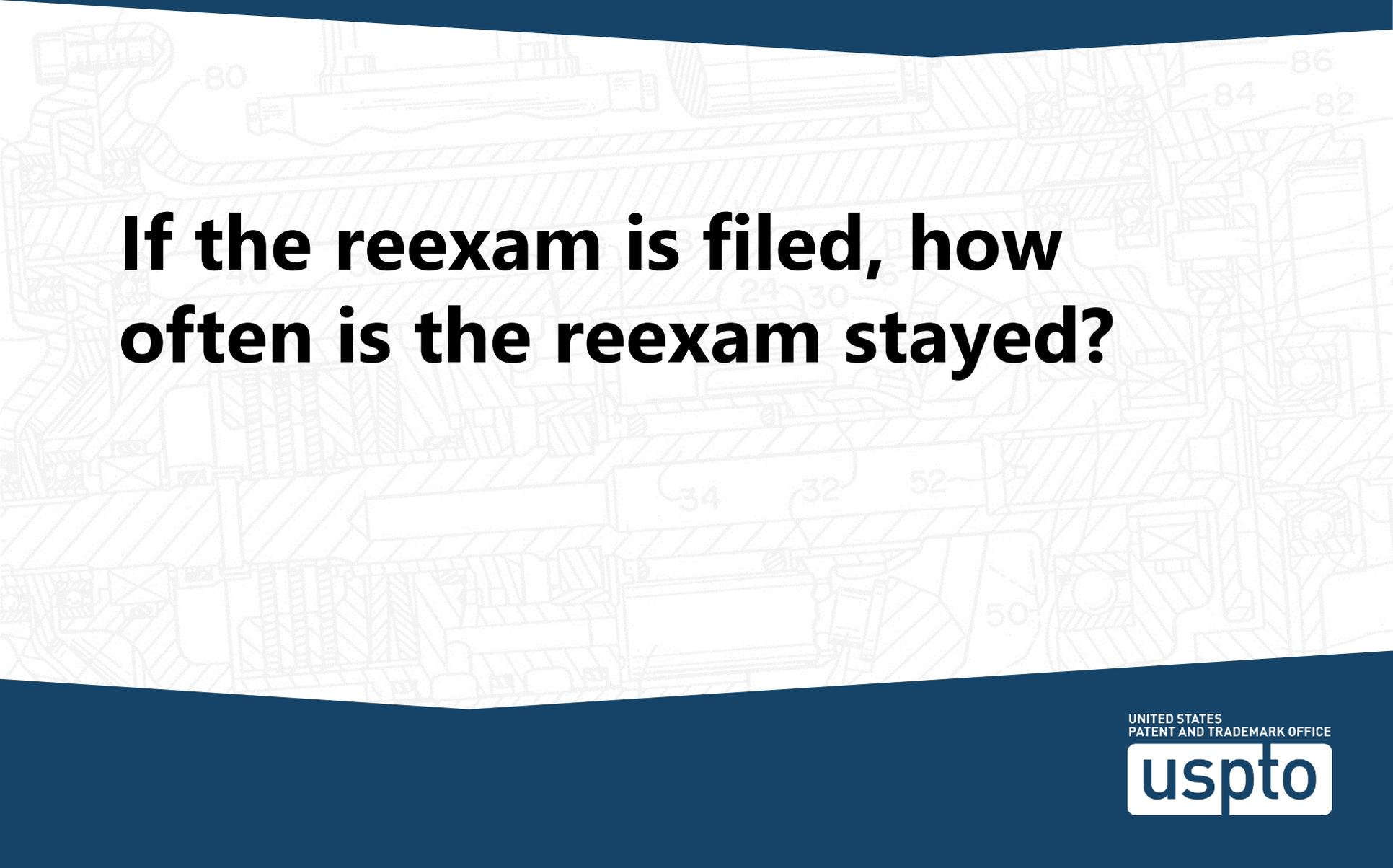


...the date of the first final written decision issued?



179 of the 449 patents have had a final written decision in any AIA proceeding.

Termination means that the proceeding concluded for any reason including request for adverse judgment, settlement, or final written decision.



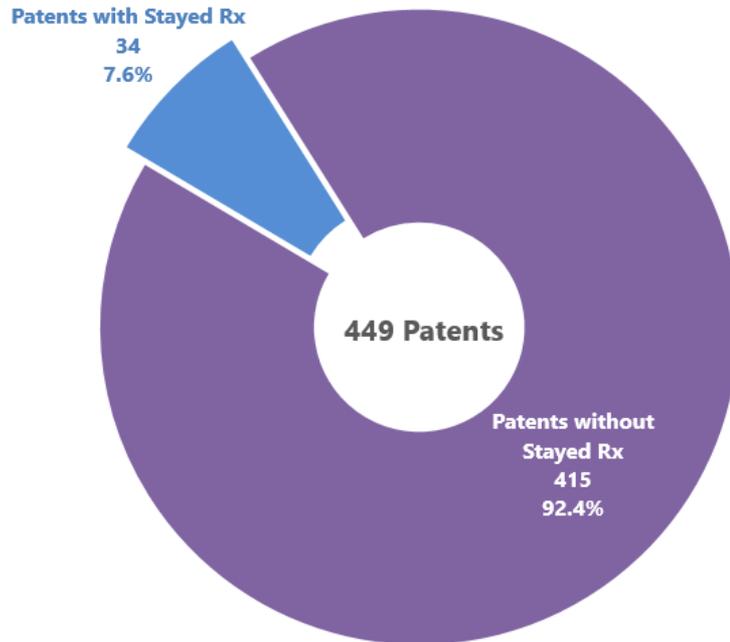
If the reexam is filed, how often is the reexam stayed?

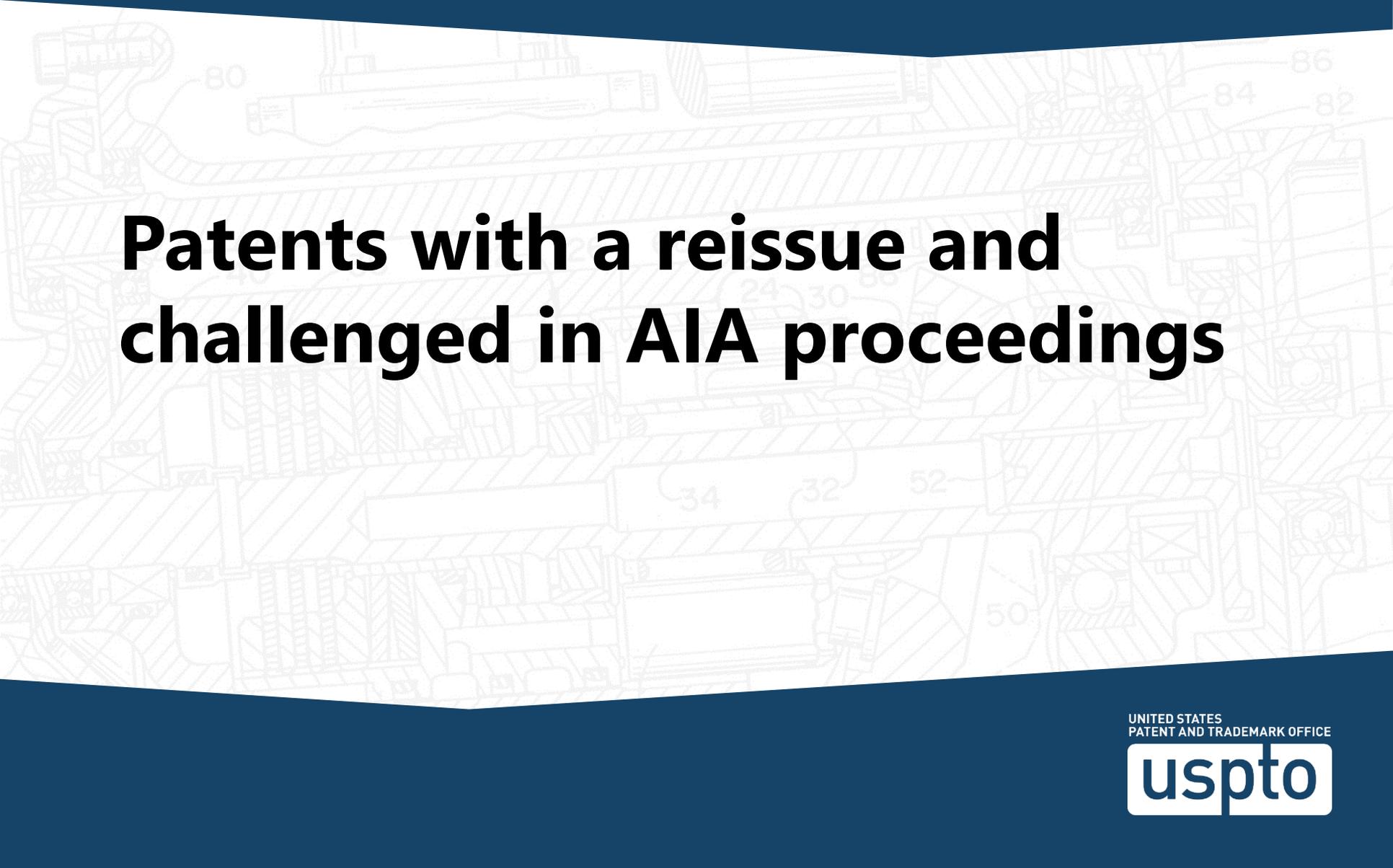
UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

Percentage of patents with reexams stayed

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)





Patents with a reissue and challenged in AIA proceedings

UNITED STATES
PATENT AND TRADEMARK OFFICE



How has the percentage of patents challenged in AIA proceeding also having a corresponding reissue changed over time?

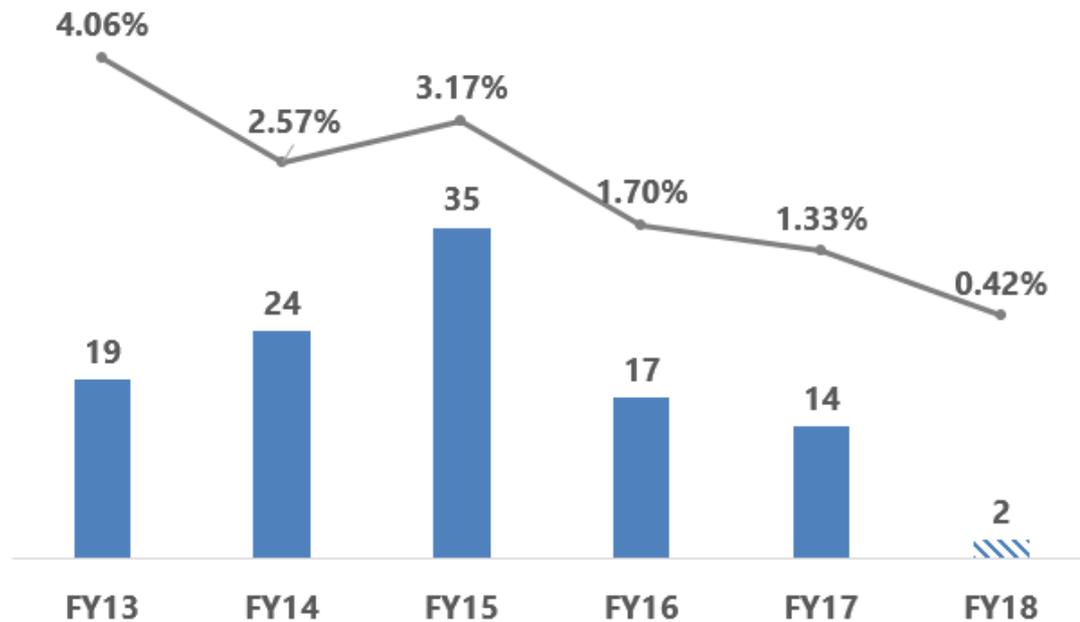
UNITED STATES
PATENT AND TRADEMARK OFFICE



Patents with a reissue and challenged in AIA proceedings

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

Percentage of all
patents
Challenged in
AIA proceedings



Patents with a
reissue and an
AIA petition

**When is the reissue
filed in relation to the
AIA proceeding milestones?**

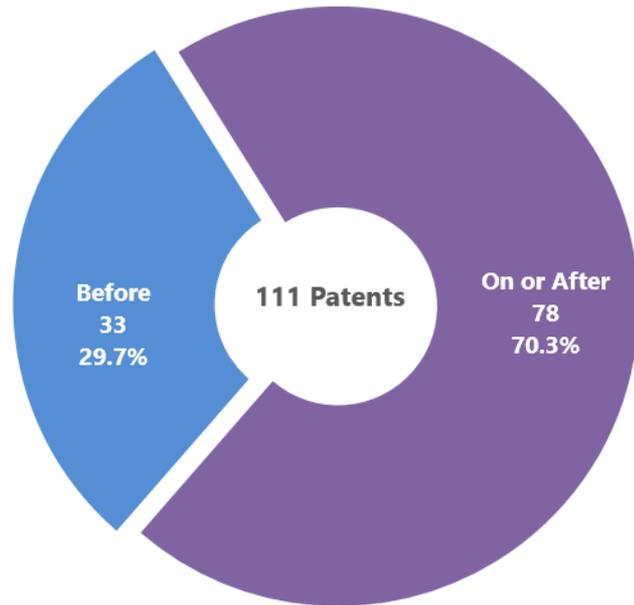
UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

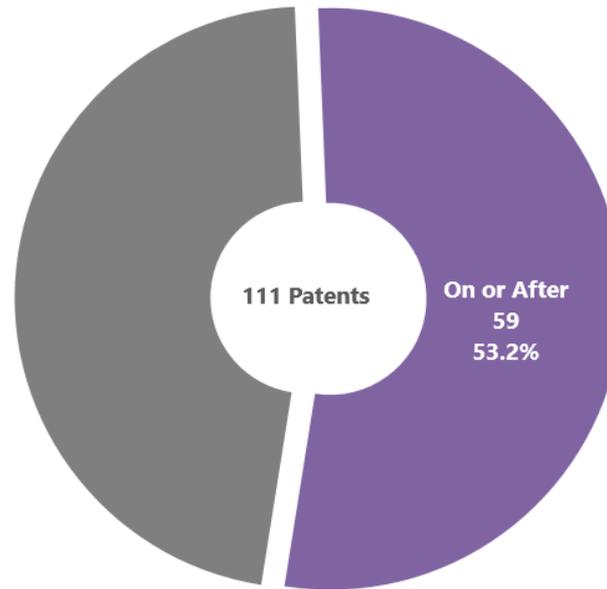
Was the reissue filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the filing date of the first AIA petition?



...the date of the first decision on institution?



101 of the 111 patents have had a decision on institution in any AIA proceeding.

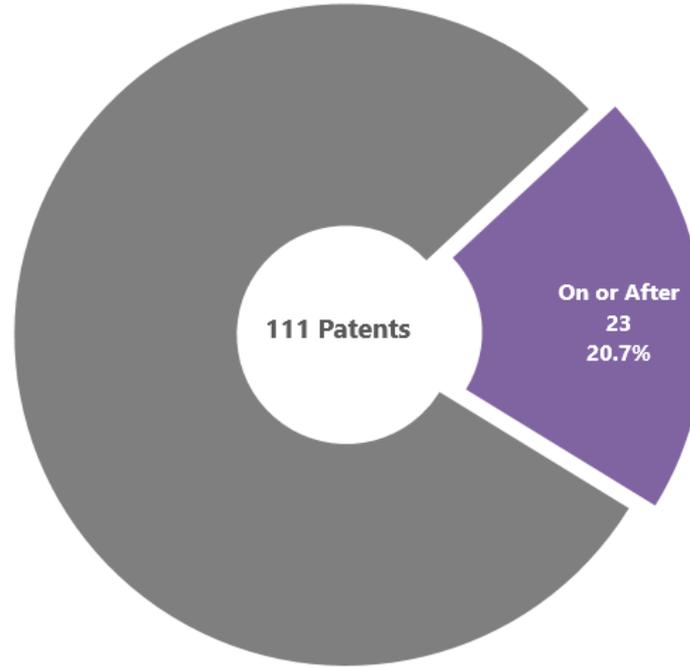
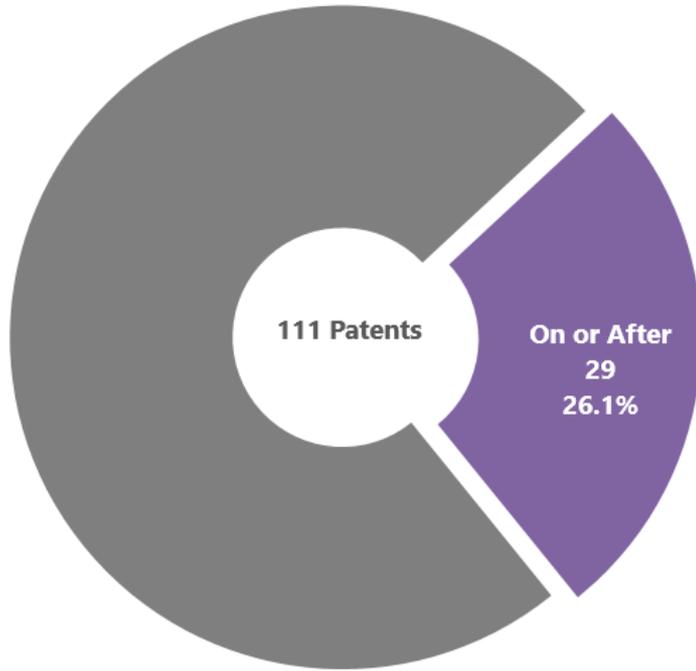
90 of the 111 patents have had at least one petition instituted.

Was the reissue filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

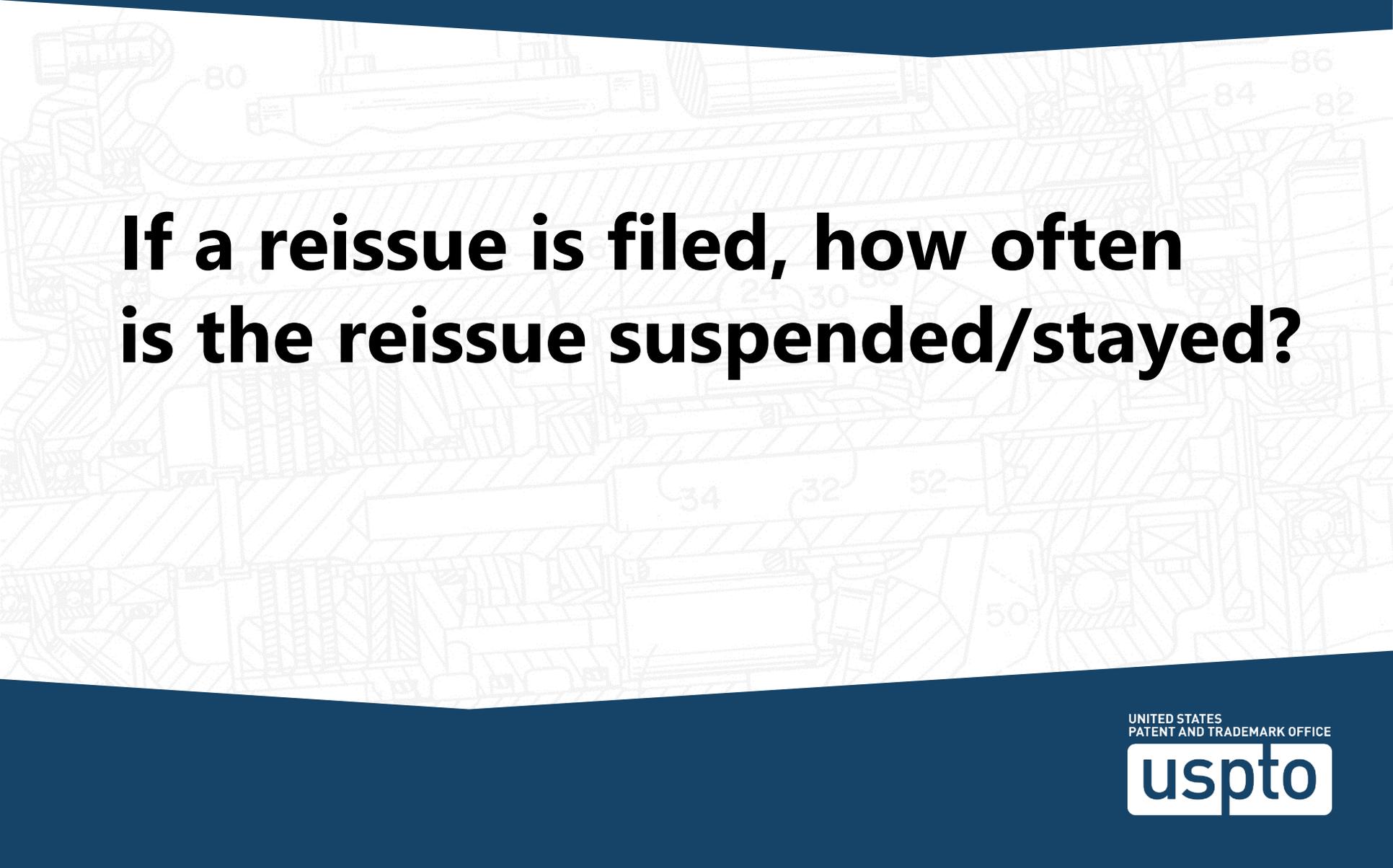
...the date that the first AIA proceeding terminated?

...the date of the first final written decision issued?



64 of the 111 patents have had a final written decision in any AIA proceeding.

Termination means that the proceeding concluded for any reason including request for adverse judgement, settlement, or final written decision.

The background of the slide is a light gray technical drawing of a mechanical assembly, possibly a piston or a similar component. It features various parts with hatching and is annotated with numerous numerical callouts such as 80, 84, 86, 82, 24, 30, 55, 34, 32, 52, 50, and 5. The drawing is oriented horizontally and occupies the upper and middle portions of the slide.

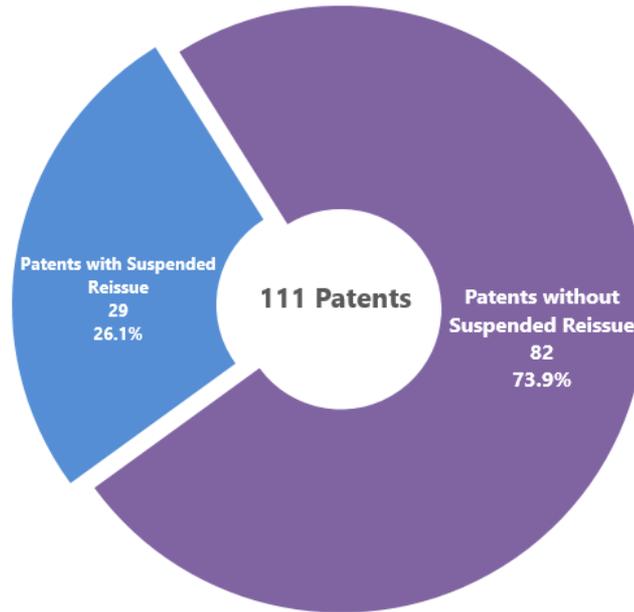
**If a reissue is filed, how often
is the reissue suspended/stayed?**

UNITED STATES
PATENT AND TRADEMARK OFFICE



Percentage of patents with reissues suspended/stayed

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)



These suspensions/stays can be instituted by either the examiner or PTAB.

Recap

- 89% of patents challenged in AIA proceedings have not had any associated reexams or reissues.
- Decrease from FY 12 to mid-year FY19 in percentage of challenged patents that have received both:
 - Reexam request and/or reissue application
 - AIA petition
- In 71.5% of all patents that had both a reexam request and an AIA petition, the reexam request was filed before the AIA petition.
- In 70.3% of all patents that had both reissue and an AIA petition, the reissue application was filed on or after the AIA petition.
- There were about four times as many patents that had an AIA petition and a reexam request as patents that had an AIA petition and a reissue.

Questions and comments

Jason Repko

Administrative Patent Judge, Patent Trial and Appeal Board

(571) 272-9797

jason.repko@uspto.gov

John Cottingham

Director, Central Reexamination Unit

(571) 272-7705

john.cottingham@uspto.gov

