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Requesting Inter Partes Reexaminations Under AIA

Law360, New York (January 12, 2012, 12:30 PM ET) -- The Leahy-Smith America Invents Act replaces the prior "substantial new question of patentability" (SNQ) standard for granting requests for inter partes reexamination with the new "reasonable likelihood to prevail" (RLP) standard. The change took effect on Sept. 16, 2011, and is in place until Sept. 12, 2012. This article compares aspects of granted inter partes reexamination petitions under the RLP standard with reexaminations granted under the SNQ standard.

Under the AIA, a request for inter partes reexamination will not be granted unless the information presented in the request establishes that there is "a reasonable likelihood that the requester would prevail with respect to at least one of the claims challenged in the request." Requests for inter partes reexamination have been filed with the U.S. Patent and Trademark Office both on the eve of Sept. 16, 2011, and beyond, the decisions of which are now available on public Patent Application Information Retrieval. The decisions offer insight into the PTO's interpretation and implementation of the new RLP standard under the AIA.

One prominent observation lies in the correlation between the establishment of RLP on issues of patentability in ordering the reexamination and the adopted grounds for claim rejection in nonfinal PTO actions. Under the SNQ standard, the PTO accepted issues of patentability that raised SNQ for reexamination, and then decided separately whether or not to adopt the proposed SNQs as grounds to reject claims in PTO actions.

Under the RLP standard of the AIA, it appears that, as long as the PTO orders a reexamination, the PTO will, in its initial office action, reject claims subject to reexamination by substantially adopting the grounds proposed by the accepted portions of the petition. Such correlation appears to indicate that the RLP standard, compared with the SNQ, is indeed an elevated threshold with respect to granting reexamination orders.

Under the SNQ standard, upon grant of reexamination, the challenged claims might still end up being confirmed in the initial PTO action. On the contrary, under the RLP standard, it seems that as long as the PTO grants the request for reexamination, the claims under reexamination will be rejected in the initial office action. Therefore, the concurrently issued first office actions do not confirm claims upon which a RLP has been successfully established.

IP practitioners have approached the RLP standard with a variety of solutions in their inter partes reexamination requests: The request under Control No. 95/001,778 relied upon a combination of qualified new prior art and art previously presented before the PTO to establish RLP. The request under Control No. 95/001,776 succeeded on a combination of art that never came before the examiner.

As for reexamination under Control No. 95/001,777, one claim was confirmed because the PTO found the requestor failed to establish RLP regarding this particular claim, which was found not subject to reexamination. In this request, new prior art has been introduced to successfully establish RLP by anticipating or rendering obvious the challenged claims, both with and without a combination of art previously considered in the prosecution. Again, the concurrently issued office action rejected all the claims subjected to reexamination.

The three granted orders so far confirm that the RLP is a heightened standard compared with the SNQ in the sense that an order of reexamination does not result in confirmation of claims reexamined. Instead, as long as the PTO finds that the requestor has established the RLP with respect to a particular claim, only a claim rejection will ensue.

Since this study is based on only three orders of reexamination, it remains to be seen how the PTO interprets and implements the new RLP rule over the long term.

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