

# Debunking Conventional Wisdom—You CAN End *Inter Partes* Reexamination

Prominent lawyers have recently stated that once started, *inter partes* reexamination cannot be stopped. This conventional wisdom is wrong. The following debunks this common myth about *inter partes* reexamination.

## Conventional Wisdom

Most patent cases settle and stop. Conventional wisdom is, however, that if an *inter partes* reexamination has been started, it can't be stopped (whether related to a patent case or started on its own).

## Dislodging the Conventional Wisdom

Conventional wisdom is not true. *Inter partes* reexamination can be stopped. If a court order is entered in a patent case, and it meets some conditions, it can stop a related *inter partes* reexamination. It will cause the reexamination to be vacated and/or the original claims of a patent considered to be no longer subject to reexamination.

## How To Get This Result

Getting an *inter partes* reexamination stopped does not take a contested court order. It can be accomplished as a part of a settlement or mediation. It can be a court order by consent.

There are several precedents in the PTO stopping an *inter partes* reexamination in response to an order by consent. Three of the decisions can be viewed at [www.bannerwitcoff.com](http://www.bannerwitcoff.com) as in the specific address in the first endnote.<sup>1</sup>

The third decision is from a case that our firm handled. It is a case for a patent owner. We not only stopped *inter partes* reexamination of original claims—after they were rejected twice—but gained the allowance of many additional claims. A final court order we negotiated in mediation along with select pages of the PTO Right of Appeal decision that puts our final court order into effect are found at the specific address in the second endnote.<sup>2</sup> As a result of the court order, original claims 1 through 44 of the patent—which were rejected in both a first office action and an action closing prosecution—became no longer subject to reexamination, as shown on page 3 of the Right of Appeal Notice. Readers will also note that many additional claims were examined in reexamination and allowed. Reexamination will

continue as to the additional claims, and not as to the original claims. A reexamination certificate adding the additional claims is anticipated.

## Thoughts for Negotiation on Both Sides of This Situation

If you have litigation pending, and you are the patent owner, you could bargain for the needed final court order as part of a settlement. If you are the reexamination requester, you also could bargain to give the patent owner the needed order in exchange for things you want, like freedom to practice.

Indeed, even if you don't have litigation pending, as a patent owner or a requester, you could add litigation as a companion to an *inter partes* reexamination in contemplation of bargaining for a settlement that would include a court order by consent, on terms that would end the *inter partes* reexamination.

## Caveats

The order must state the requester has not sustained its burden of proving invalidity. It will bind the requester against re-raising prior art issues that the requester raised or could have raised at the time of the order. It will not bind the requester against other issues.

## Resources for More Information

See 35 U.S.C. 317, 37 CFR 1.907(b) and MPEP 2686.04 for more information. The link to the MPEP where you can find all three is at the address of the third endnote.<sup>3</sup>

Of course, the patent owner could throw in the towel, and that would end *inter partes* reexamination, but that is not under consideration here. Also, this article does not address *ex parte* reexamination, where the benefit of a final court order as discussed is not available.

## NOTES

1. [www.bannerwitcoff.com/\\_docs/library/articles/Client%20Alert%20Here%20First%20Link%20.pdf](http://www.bannerwitcoff.com/_docs/library/articles/Client%20Alert%20Here%20First%20Link%20.pdf)
2. [www.bannerwitcoff.com/\\_docs/library/articles/Client%20Alert%20Here%20Link%20Second%20Link.pdf](http://www.bannerwitcoff.com/_docs/library/articles/Client%20Alert%20Here%20Link%20Second%20Link.pdf)
3. [www.uspto.gov/web/offices/pac/mpep/documents/2600\\_2686\\_04.htm#sect2686.04](http://www.uspto.gov/web/offices/pac/mpep/documents/2600_2686_04.htm#sect2686.04)