



---

## Choosing Between Inter Partes Reexamination & the New Inter Partes "Review"

The USPTO has issued new rules effective between Sept. 16, 2011 and Sept. 16, 2012 setting out the new "reasonable likelihood" standard for all requests for inter partes reexamination. It is important to immediately conform any new inter partes reexam requests to the new standard, otherwise they may be denied.

The notice also points out that inter partes reexamination will end as a procedure on Sept. 16, 2012, when it will be replaced with "petitions for inter partes review." Although the USPTO has not proposed any implementing rules for inter partes review yet, the new law provides some of the ways in which it will differ from inter partes reexam. Some of the differences are:

- Ability of USPTO to limit the number of inter partes review proceedings during the first 4 years if they exceed the number of inter partes reexams from the last fiscal year before implementation (if the quota is reached, a requester could be completely blocked from using inter partes review)
- Ability to file inter partes review against patents issued on applications filed before Nov. 29, 1999 (those not eligible for current inter partes reexam)
- Ability to settle and terminate if USPTO has not "decided the merits of the proceeding"
- Handled by Board in the first instance (no handling at examiner level)
- Limited right to depose expert declarants possible
- Estoppel as to ITC actions (in addition to litigation)

Whether to choose inter partes reexam before Sept. 16, 2012 or wait for inter partes review on or after Sept. 16, 2012 is a complex decision that involves many factors beyond the ones listed above. The fear that a quota may limit the number of inter partes reviews in the first 4 years may create a spike of inter partes reexam filings prior to Sept. 16, 2012 - which would actually make it easier to file inter partes reviews by increasing the quota limit, since it is based on the total number of inter partes reexams filed in the last fiscal year before implementation.

Requesters who decide they wish to wait for inter partes review should prepare early and be ready to file within the first few days to reduce the chance of being blocked by a quota limit that might be imposed by the USPTO.