

America Invents Act and Reexamination

When President Obama signed the Leahy-Smith America Invents Act into law, one of the significant changes in our patent laws focused on the reexamination of patents by the U.S. Patent & Trademark Office after patents issue. As you learned at our presentation there are two types of reexamination, *ex parte* and *inter partes* reexamination. As of September 16, 2011, the standard for *inter partes* reexamination was raised. Now, the information presented in an *inter partes* reexamination must provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the patent claims challenged in the request. The standard for *ex parte* reexamination remains unchanged.

In addition, *inter partes* reexamination will no longer be available beginning September 16, 2012. Instead, beginning September 16, 2012, a new procedure called *inter partes* review will be allowed. *Inter partes* review will be available to a person who (a) is not the owner of the patent and (b) has not previously filed a civil action challenging the validity of a claim of the patent. Using the new standard, the petition must demonstrate a reasonable likelihood that the petitioner will prevail on at least one claim challenged. The petition cannot be filed until after the later of: 1) 9 months after the grant of a patent or issuance of a reissue of a patent, or 2) the date of termination of any post grant review of the patent.