



IP: How reissue patents may help you sleep at night

REISSUE PATENTS KEEP COSTS LOW AND CAN PROVIDE A RESOLUTION TO SOME NIGHTMARE SCENARIOS

Imagine this scenario: You are in-house head IP counsel of an up-and-coming drug company. You have impressed the CEO by securing several issued US patents that provide protection *around* the company's lead drug candidate. And then it hits you — none of the claims in the issued patents exactly cover the lead drug candidate. If no patent applications are pending, is all hope lost for securing a patent claim that precisely covers the company's anticipated product?

Or, imagine this scenario: You are in-house head IP counsel of a software company. In pre-litigation diligence, you discover that the claims in the issued patent are potentially invalid in view of newly discovered prior art. If no patent applications are pending, is all hope lost for securing a patent claim that is valid in view of the new prior art?

Unfortunately, the above

scenarios may be all too familiar to companies of all sizes and industries. While this “whoops” moment may lead to sleepless nights and the unenviable task of breaking the bad news to the CEO, all hope is not lost.

Particularly now in view of the U.S. Patent Office's (USPTO) “first to file” system, the model in many companies across all industries is to file patent applications “early and often.” However, in industries such as biotech and pharma where the final commercial product can take many years to develop, patents will often issue before a product has even made it into the clinic for testing. As a result, many companies choose to file continuation applications in order to keep at least one application pending in the USPTO while the clinical testing proceeds. This article highlights the use of an alternative — a reissue patent — where the costs of filing

continuation application after continuation application are prohibitive and where companies need a solution to the first nightmare raising scenario described above. Although a reissue proceeding may likely be stayed if the original patent is involved in a concurrent litigation, a reissue patent may be a nice option for the second nightmare scenario as well.

Reissue proceedings — the basics

The Leahy-Smith America Invents Act (AIA), enacted in law Sept. 16, 2011 with various effective dates, introduced several new proceedings applicable to issued patents (*e.g.*, post-grant review, *inter partes* review, derivation proceedings and supplemental examination), modified some old proceedings (*e.g.*, reissue patents and *ex parte* reexamination), and got rid entirely of other proceedings (*e.g.*, *inter partes* reexamination

and interferences). Supplemental examination, which will not be discussed here, is a new (much more expensive) proceeding that patentees might also consider when they would like the USPTO to consider, reconsider, or correct information believed to be relevant to a patent.

Reissue patents can be used to correct errors such as failure to perfect claims for priority (e.g., failure to properly claim a priority filing date of an earlier filed foreign or U.S. patent application), defects in the drawings or specification, improper inventorship, and claiming more or less than what was proper to claim in the original patent. Returning to the nightmare scenarios above, note that additional claims may be filed in reissue proceedings. Indeed, in *In re Tanaka*, the Federal Circuit Court of Appeals opened the door to submitting nothing more than a single, narrowing, dependent claim in a reissue proceeding. Such a strategy enables a patentee to hedge against the possibility that other broader claims may be one day found invalid — a concern in both scenarios above.

Where additional broader claims are desired, the request for a reissue proceeding must be filed within two years of the grant of the patent for which reissue is sought. For all other “errors,” patent owners may request a reissue proceeding at any time

during the pendency of the patent. Reissue applications are examined much like the way regular patent applications are examined – a patent examiner, likely the same examiner from the original patent, will direct prosecution and the application will initially be examined on a priority basis.

Considerations to weigh before requesting a reissue proceeding

Before requesting a reissue proceeding at the USPTO, careful thought should be given to at least the following considerations:

- **Costs.** Where an application in a patent family is still pending, patentees must weigh the benefit of bulking up their patent portfolio against the costs of filing serial continuation applications. While some applicants prefer the “safety in numbers” approach, some smaller companies and universities may consider a reissue patent the better option. The prosecution costs of a single reissue patent will likely be similar to the cost of obtaining an original patent.
- **Prosecution history.** As with any proceeding at the USPTO, there is no guarantee that a reissue proceeding will result in a

favorable outcome for the patentee. The newly added/amended claims may be rejected by the examiner. Although the original patent will remain in force, any negative prosecution history is available to the public and would likely be a focus for competitors and opponents in litigation.

- **Recapture.** While it is permissible to file broadening claims within two years of grant of original patent if the broader claims are adequately supported by the original specification, it is *not* permissible to file such claims where the subject matter was surrendered during prosecution of the original patent.
- **Term.** In large patent portfolios that include a series of continuation patents, often the first patent will enjoy the longest patent term (i.e., the first patent is the most likely patent to benefit from patent term adjustment (PTA) due to prosecution delays at the USPTO). Any reissue patent based on such a first patent will also enjoy this extended term. That is to say, although the original patent is surrendered at the grant of the reissue patent,

patentees do not surrender the PTA of the original patent.

While the AIA introduced several new post-grant proceedings, reissue proceedings should still be considered as a possible remedy to nightmare scenarios, depending on the facts. Strategically, reissue patents should be considered at the outset by applicants looking to save costs and by applicants who are filing very early in the development of a potential commercial product. In this way, reissue patents can be considered “fixes” to resolve one or more shortcomings in the original prosecution and, more forward thinking, as “strategic fallbacks” should circumstances warrant additional or modified claim scope in the future.

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