

# To Patent or Not to Patent?

(in the age of post grant options)

## That is the Question

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The America Invents Act of 2011 significantly increased the opportunities for challenging or enhancing a patent *via* a PTO proceeding

Now...more like litigation, with opportunities for discovery, document requests, depositions and sanctions

**Pro-patent options**  
for strengthening an existing patent

*-supplemental examination (\$4,400; subsequent reexam \$12,100)*

PTO to consider, reconsider, or correct information believed to be relevant to the patent

*-patent reissue (\$960)*

correct errors in an issued patent; 'broadening' reissue (2 years); 'narrowing' reissue

**Anti-patent options**  
for challenging an existing patent:

*-post-grant review (\$30,000)*

w/in 9 months; 'more likely than not' standard  
(broad patentability challenges)

*-inter partes review (\$23,000.....\$250-350K)*

validity challenge; patents/printed pub only; standard:  
'reasonable likelihood of prevailing on at least one claim'  
(narrow patentability challenges; 102; 103)



## ***ex parte* reexamination (\$12,000)**

-Anyone can request reexamination at any time during the period of enforceability of the patent

-Only patentee and USPTO involved, not PTAB;

-‘substantial new question of patentability)

# Broadening Reissue

- “error without any deceptive intention”
- “wholly or partly inoperative or invalid”
- “by reason of a defective specification or drawing”, or
- “by reason of claiming more or less than had a right to claim in the patent”

# RESTRICTIONS

- No new matter
- No enlargement of the scope of the claims beyond two years from the grant of the original patent
- No 'recapture' of previously surrendered claim matter
- intervening rights as a *quid pro quo* for permitting correction in claim scope

## Understanding the Issues

- Reissue reopens prosecution and examination of all the claims, not merely those declared to be defective as being too broad or too narrow, or even where the error relates to something other than the claims
- There is no presumption of validity of the originally issued claims during a reissue examination
- Reissue requires an oath or declaration admitting to the existence of at least one defect



# Broadening Reissue

## Summary of Pros/Cons

### Pros:

- Where a claim of priority to an earlier filing date is likely to be necessary
- Where a category of invention, *e.g.*, a method, has been overlooked

## Cons:

- Where there is risk of claim construction arguments and/or the doctrine of
- Risk of recapture, intervening rights, or inequitable conduct issues
- Need to preserve the presumption of validity
- Need (if you sue an accused infringer) to establish invalidity by clear and convincing evidence
- Where defects in the disclosure and/or claims are trivial even if not merely typographical



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*Technologies:* Nanophotonics, CMOS, micro-/opto-fluidics, optics, advanced medical and computational imaging, lasers, solar PV, medical devices, software, business architecture, e-commerce.

Bill works with clients to develop patent strategies aligned to business goals; works with high-tech start-ups to secure foundation IP and freedom to operate; helps to identify people and resources for launching and funding new companies.

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