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Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019)

A Notice by the Patent and Trademark Office on 04/22/2019

PUBLISHED CONTENT - DOCUMENT DETAILS

Agencies: Department of CommercePatent and Trademark Office
Agency/Docket Number: Docket No. PTO-P-2019-0008
Document Citation: 84 FR 16654
Document Number: 2019-08022
Document Type: Notice
Pages: 16654-16658 (5 pages)
Publication Date: 04/22/2019

PUBLISHED DOCUMENT: 2019-08022 (84 FR 16654)

DOCUMENT HEADINGS

Department of Commerce
Patent and Trademark Office
[Docket No. PTO-P-2019-0008]

AGENCY:

United States Patent and Trademark Office, Department of Commerce.

ACTION:

Notice.

SUMMARY:

The United States Patent and Trademark Office ("USPTO" or "Office") provides notice of information regarding existing Office practice as it pertains to reissue and reexamination procedures for amending claims available to patent owner during the pendency of a trial proceeding under the America Invents Act ("AIA") involving the same patent. On October 29, 2018, the Office published a notice requesting comments on proposed modifications to current motion to amend ("MTA") practice and procedures in AIA trial proceedings. In (🗋 print page 16655) response to that notice, the Office received a number of comments and questions requesting clarification regarding existing reissue and reexamination procedures at the Office available while an AIA trial proceeding, including any appeal, involving the same patent is pending. In response to those comments and questions, this notice provides a summary of current practice regarding reissue and reexamination options in which patent owners may amend claims before and after the Patent Trial and Appeal Board ("PTAB" or "Board") issues a final written decision in an AIA trial proceeding. This notice also provides summary information about factors the Office currently considers when determining whether to stay or suspend a reissue proceeding, or stay a reexamination, that involves a patent involved in an AIA proceeding, and also when and whether to lift such a stay or suspension.

FOR FURTHER INFORMATION CONTACT:

Rae Lynn P. Guest, Lead Administrative Patent Judge by telephone at (571) 272-9797 or Stephen Stein, Managing Quality Assurance Specialist, Central Reexamination Unit at (571) 272-1544.

SUPPLEMENTARY INFORMATION:

I. Background

On October 29, 2018, the Office published a request for comments ("RFC") on a proposed procedure for motions to amend filed in *inter partes* reviews, post-grant reviews, and covered business method patent reviews (collectively AIA trials) before the PTAB. *See* Request for Comments on MTA Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 FR 54319 (/citation/83-FR-54319) (Oct. 29, 2018) (hereinafter RFC or MTA RFC). The Office received 49 comments in response to this RFC as of December 21, 2018 (the closing date for comments). *See Comments on Motion to Amend Practice and Procedures in AIA Trials,* U.S. Patent & Trademark Office, *https://go.usa.gov/xEXS2 (https://go.usa.gov/xEXS2)* (comments received by December 21, 2018, in response to the RFC) (last visited Feb. 8, 2019) (hereinafter PTAB RFC Comments website). On March 15, 2019, the Office published a notice of a pilot program for MTA practice and procedures in AIA trial proceedings before the Board. *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 FR 9497 (/citation/84-FR-9497) (March 15, 2019). In addition to the comments addressed in the MTA program notice, the Office received a number of comments and questions relating to reissue or reexamination as an alternative vehicle for claim amendments. The comments included requests for clarification regarding existing reissue and reexamination procedures at the Office.

In response to those comments and questions, this notice provides a summary of various pertinent practices regarding existing Office procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of the same patent, after the Board institutes a trial, and after the Board issues a final written decision. This notice also provides summary information about factors the Office currently considers when determining whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding, and when and whether to lift such a stay or suspension.

AIA proceeding, and when and whether to lift such a stay or suspension.

This notice is only meant to summarize existing practice, and not to amend, supersede, or otherwise alter it. This notice should not be cited in papers submitted to the Office. Instead, applicants, parties, and the public should consult relevant statutes, regulations, case law, and the Office's Manual of Patent Examining Procedure (MPEP) for a full assessment of the issues, and for sources of citations in papers submitted to the Office.

II. Options for Amendments Through Reissue or Reexamination

The Office will consider a reissue application or a request for reexamination any time before, but not after, either: (1) The Office issues a certificate that cancels all claims of a patent, *e.g.,* a trial certificate in an AIA trial proceeding, or (2) the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") issues a mandate in relation to a decision that finds all claims of a patent are invalid or unpatentable. The Office will not issue a trial certificate relating to a patent at issue in an AIA proceeding until after either: (i) The deadline for the filing of a notice of appeal to the Federal Circuit under 35 U.S.C. 142 (https://www.govinfo.gov/link/uscode/35/142) has passed (*i.e.,* 63 days after the date of a final written decision or, if a request is timely filed, 63 days after the date of a decision on a request for rehearing relating to the final written decision) (37 CFR 90.3 (https://www.ecfr.gov/current/title-37/section-90.3)); or (ii) all decisions or determinations in relation to an appeal to the Federal Circuit regarding the patent are finally resolved.

Thus, patent owners may avail themselves of a reissue application or a request for reexamination before, during, or after an AIA trial proceeding results in a final written decision, as long as the application or request is timely filed as discussed above (*i.e.,* before the Office issues a certificate that cancels all relevant claims, or before the Federal Circuit issues a relevant mandate, as applicable).[1] For example, a patent owner may file a reissue application or a request for reexamination within 63 days of a final written decision regarding the patent at issue. Actions taken by the Office in response to such an application or request will depend on the timing of the filing and other relevant facts and issues, as explained in further detail below.

Reissue

Under the current statutory scheme, a patent owner may file a reissue application to

Under the current statutory scheme, a patent owner may file a reissue application to amend claims before, during, or after an AIA trial proceeding concludes with a final written decision, as discussed above. In particular, although 35 U.S.C. 251 (https://www.govinfo.gov/link/uscode/35/251) requires an "error," both the Office and the Federal Circuit have recognized that the error requirement is satisfied by the patent owner's failure to previously present narrower claims. *See In re Tanaka,* 640 F.3d 1246, 1251 (Fed. Cir. 2011); MPEP 1402(I). In other words, no admissions as to the patentability of original claims are required in a reissue application, and the oath accompanying a reissue application may include a statement about the error requirement related to the original patent's failure to earlier present narrower claims.[2] A reissue then proceeds through examination in much the same way as an application for a patent under original examination. 35 U.S.C. 251(c) (https://www.govinfo.gov/link/uscode/35/251).

As stated in 37 CFR 1.178(a) (https://www.ecfr.gov/current/title-37/section-1.178#p-1.178(a)), an "application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent." A patent owner may abandon a reissue application at any time before reissue of the patent, for example, after obtaining a favorable result in a final written decision in an AIA proceeding or on appeal. Before reissuance of a patent, the original patent is not surrendered and remains in effect.[3] As discussed (print page 16656) above, a reissue application must be filed before the issuance of a trial certificate that cancels all claims of a patent in an AIA trial proceeding or before the Federal Circuit issues a mandate in relation to a decision that determines or affirms that all claims of a patent are invalid or unpatentable. *See* MPEP 1449.01.

A reissue proceeding involves expedited prosecution. Under 37 CFR 1.176 (https://www.ecfr.gov/current/title-37/section-1.176), "[a]pplications for reissue will be acted on by the examiner in advance of other applications," and, as stated in MPEP 708.01, "[r]eissue applications, particularly those involved in stayed litigation, should be given priority." Further, under MPEP 1442, reissue applications have "special status" and "will be taken up for action ahead of other `special' applications." The Office may stay examination of a reissue application, however, pending a final written decision in an AIA trial proceeding addressing the same patent, as discussed in more detail below.

Office procedures provide for third party notice (by announcement of the reissue

application in the Official Gazette, *see* MPEP 1430) and a (limited) opportunity for a third party to be heard (by filing a protest, *see* MPEP 1441.01). In addition, any 35 U.S.C. 315(b) (https://www.govinfo.gov/link/uscode/35/315) bar triggered by service of a complaint alleging infringement of the original patent may not apply to the reissued patent. *See Eizo Corp.* v. *Barco N.V.,* Case IPR2014-00358, Paper 21 at 7-8 (PTAB July 14, 2015); *cf. Click-To-Call Techs., LP* v. *Ingenio, Inc.,* 899 F.3d 1321, 1336-37 (Fed. Cir. 2018) (rejecting petitioners' effort to deem a reexamined patent a "new patent" for the purposes of 35 U.S.C. 315(b) (https://www.govinfo.gov/link/uscode/35/315), noting that "`[u]nlike reissue, reexamination does not result in the surrender of the original patent and the issuance of a new patent'") (quoting *Aspex Eyewear, Inc.* v. *Marchon Eyewear, Inc.,* 672 F.3d 1335, 1341-42 (Fed. Cir. 2012)).

Ex Parte Reexamination

A patent owner also may seek to amend its claims by filing a request for *ex parte* reexamination before, during, or after an AIA trial proceeding concludes with a final written decision, as discussed above. Reexamination presents considerations, however, not present with regard to reissue applications. Of particular note, under 35 U.S.C. 303 (https://www.govinfo.gov/link/uscode/35/303), the Director is required to determine whether a request for reexamination raises "a substantial new question [SNQ] of patentability affecting any claim of the patent concerned."

An SNQ is not raised if the "question of patentability has already been . . . decided in an earlier concluded examination or review of the patent by the Office" (MPEP 2242(I)). Thus, an SNQ for reexamination cannot be a question raised in a ground already decided in a final written decision. *In re Swanson,* 540 F.3d 1368, 1377 (Fed. Cir. 2008) (quoting H.R. Rep. No. 96-1307(I), at 6466 (1980)) (the SNQ requirement bars "reconsideration of any argument already decided by the office, whether during the original examination or an earlier reexamination"); *accord id.* at 1380. Thus, after the Board issues a final written decision on the patent in an AIA proceeding, an SNQ in a later-filed request for reexamination on that patent must differ from any question raised in a ground addressed in a final written decision.

In addition, current Office interpretation requires that the "substantial new question of patentability [is] established for the existing claims in the patent in order to grant reexamination" (MPEP 2242(I)) and that the reexamination "request should be decided on the wording of the patent claims in effect at that time (without any proposed

on the wording of the patent claims in effect at that time (without any proposed amendments)" (MPEP 2221). Thus, an SNQ cannot be established based on new questions raised in relation to amended or new claims proposed during reexamination. *See also*35 U.S.C. 303 (https://www.govinfo.gov/link/uscode/35/303) (requiring the SNQ affect "any claim of the patent"). Once an SNQ has been established for the original claims in a reexamination proceeding, however, an SNQ is not required for examination of amended or new claims.

On the other hand, prior to the issuance of a final written decision, an SNQ may be established based on a question raised in a ground presented in an AIA petition. *See* MPEP 2242(I).[4] If the Central Reexamination Unit (CRU) grants a reexamination request, however, the Office may stay the reexamination pending a final written decision in an AIA trial proceeding addressing the same patent, as discussed in more detail below.

In contrast to reissue, a reexamination results in the issuance of a certificate in the original patent, rather than the issuance of a new patent. Therefore, the 35 U.S.C. 315(b) (https://www.govinfo.gov/link/uscode/35/315) bar triggered by service of a complaint alleging infringement of the original patent applies to a reexamined patent, even if the reexamination involves amended claims. *See Click-To-Call Techs.,* 899 F.3d at 1336-37 (rejecting petitioners' effort to deem a reexamined patent a "new patent" for the purposes of 35 U.S.C. 315(b) (https://www.govinfo.gov/link/uscode/35/315)); *BioDelivery Sciences Int'l, Inc.* v. *MonoSol Rx, LLC,* Case IPR2013-00315, Paper 31 at 3-5 (PTAB Nov. 13, 2013).

Also in contrast to a reissue proceeding, which may address all statutory requirements relating to patentability (*i.e.,*35 U.S.C. 101 (https://www.govinfo.gov/link/uscode/35/101), 102 (https://www.govinfo.gov/link/uscode/35/102), 103 (https://www.govinfo.gov/link/uscode/35/103), 112 (https://www.govinfo.gov/link/uscode/35/112)), a reexamination proceeding generally addresses only issues relating to 35 U.S.C. 102 (https://www.govinfo.gov/link/uscode/35/102) and 103 (https://www.govinfo.gov/link/uscode/35/103), and 35 U.S.C. 112 (https://www.govinfo.gov/link/uscode/35/112) under limited circumstances (*i.e.,* only as raised by newly added subject matter in an amendment). In addition, a reexamination proceeding must be based on prior art consisting of patents and printed publications (35 U.S.C. 301 (https://www.govinfo.gov/link/uscode/35/301), 302 (https://www.govinfo.gov/link/

uscode/35/302)). For example, a reexamination proceeding does not address issues involving public use or sale.

Considerations for When a Parallel Office Proceeding Will Be Stayed or Suspended

This notice provides additional information as to how the Office may handle the imposition of a stay or the lifting of a stay in a reissue or reexamination proceeding ("parallel Office proceeding") in view of a co-pending AIA proceeding involving the same patent. Any parallel Office proceeding, however, will be evaluated based on its particular facts and circumstances.

The Director has authority to determine the approach with regard to a possible stay of a reissue or *ex parte* reexamination proceeding. 35 U.S.C. 315(d) (https://www.govinfo.gov/link/uscode/35/315), 325(d) (https://www.govinfo.gov/link/uscode/35/325). The Director has previously authorized the Board to enter an order to effect a stay, transfer, consolidation, or termination of parallel Office proceedings involving the same patent during the pendency of an AIA trial proceeding. 37 CFR 42.3(a) (https://www.ecfr.gov/current/title-37/section-42.3#p-42.3(a)), 42.122(a) (https://www.ecfr.gov/current/title-37/section-42.122#p-42.122(a)), 42.222(a) (https://www.ecfr.gov/current/title-37/section-42.222#p-42.222(a)). Under that authority, the Board ordinarily will stay a parallel Office proceeding where good cause exists. Good cause for staying a case may exist if, for example, an on-going AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.

Parties to an AIA trial proceeding may request authorization to file motions to stay or motions to lift stays at any time (print page 16657) during the pendency of the AIA proceeding. The Board typically will consider motions to stay a concurrent Office proceeding (or may impose a stay *sua sponte*) any time after institution of an AIA trial proceeding and before the filing of a notice of appeal or the deadline for filing a notice of an appeal to the Federal Circuit under 35 U.S.C. 142 (https://www.govinfo.gov/link/uscode/35/142) has passed (*i.e.,* 63 days after the date of a final written decision or, if a request is timely filed, 63 days after the date of a decision on a request for rehearing relating to the final written decision). *See*37 CFR 42.3(a) (https://www.ecfr.gov/current/title-37/section-42.3#p-42.3(a)), 42.122(a) (https://www.ecfr.gov/current/title-37/section-42.122#p-42.122(a)), 42.222(a) (https://www.ecfr.gov/current/title-37/

section-42.222#p-42.222(a)), 90.3 (https://www.ecfr.gov/current/title-37/section-90.3).

In deciding whether to grant a stay of a parallel proceeding involving the same patent within the Office, the Office (typically the Board) may consider a number of factors, including, but not limited to:

- Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding;
- Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether the concurrent parallel Office proceeding will duplicate efforts within the Office;
- Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (*e.g.,* whether substantially similar issues are presented in the concurrent parallel Office proceeding);
- Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
- The respective timeline and stage of each proceeding;
- The statutory deadlines of the respective proceedings;
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

See, e.g., CBS Interactive Inc. v. *Helferich Patent Licensing, LLC.,* Case IPR2013-00033, Paper 15 (PTAB Nov. 6, 2012) (order to stay a concurrent reexamination); *Stride Rite Children's Group, LLC* v. *Shoes By Firebug LLC,* Case IPR2017-01810, Paper 23 (PTAB Jul. 12, 2018) (order to stay a concurrent reissue). *See also, e.g., Arctic Cat, Inc.* v. *Polaris Indus., Inc.,* Case IPR2015-01781, Paper 78 (PTAB Sept. 25, 2018) (denying stay because of meaningful distinctions between issues raised in a reexamination and an IPR); *Acrux DDS Pty, Ltd.* v. *Kaken Pharma. Co. Ltd.,* Case IPR2017-00190, Paper 11 (PTAB Mar. 1, 2017) (denying stay requested prior to trial institution); *Mastercard Int'l Inc.* v. *D'Agostino,* Case IPR2014-00543, Paper 14 (PTAB October 2, 2014) (denying stay because a Notice of Intent to Issue a Reexamination Certification already had been entered in the co-pending reexamination); *cf.Ultratec, Inc.* v. *Sorenson Comm'ns, Inc.,* No. 13-cv-346-bbc, 2013 WL 6044407, at *2-3 (W.D. Wisc. Nov. 14, 2013) (assessing some of the same factors in determining whether to stay district court litigation in light of pending *inter partes* review petitions).

of pending *inter partes* review petitions).

The Board also may deny institution under 35 U.S.C. 325(d) (https://www.govinfo.gov/link/uscode/35/325) of a requested AIA trial proceeding if a parallel Office proceeding, for example, is in a more advanced stage and involves overlapping issues with the proposed AIA trial proceeding.

The Patents Organization (which are the offices under the Commissioner for Patents, hereinafter "Patents") also may decide to suspend proceedings in a parallel reissue application either *sua sponte* or on request of the applicant under 37 CFR 1.103 (https://www.ecfr.gov/current/title-37/section-1.103). *See also* MPEP 1442.02. Patents typically will consider similar factors to those discussed above but will weigh them in view of relevant facts and circumstances at the time suspension is being considered.

For example, action in a reissue application typically will be suspended (either *sua sponte* or if requested by petition) when there is concurrent litigation or a pending trial before the PTAB. MPEP 1442.02. However, the Office may or may not suspend a reissue application, using its discretion based upon the facts of the situation, for example if it is evident to the CRU examiner, or the applicant indicates, that "the . . . trial before the PTAB has been terminated"; "there are no significant overlapping issues between the application and the litigation or pending trial before the PTAB"; or "it is applicant's desire that the application be examined at that time." *Id.*

Considerations for Lifting a Stay of Parallel Office Proceedings

In deciding whether to lift a stay of a parallel proceeding involving the same patent within the Office, the Board may consider a number of factors, including, but not limited to:

- Whether factors considered when ordering the stay (*i.e.,* factors indicating good cause) have changed from when the stay was ordered;
- Whether the patent owner has requested adverse judgment or canceled all claims at issue in the AIA trial proceeding;
- Whether the patent owner is requesting rehearing or appealing the final written decision in the AIA trial proceeding to the Federal Circuit;
- Whether the patent owner agrees to abide by the estoppel provisions set forth in37 CFR 42.73(d)(3) (https://www.ecfr.gov/current/title-37/section-42.73#p-42.73(d)(3)) (*i.e.,* not obtain a claim patentably indistinct from a claim cancelled or found

unpatentable during an AIA trial proceeding); and

- Whether lifting the stay would be in the interests of the efficient administration of the Office and integrity of the patent system (*cf.*35 U.S.C. 316(b) (https://www.govinfo.gov/link/uscode/35/316)).

See, e.g., Sienna Biopharmaceuticals, Inc. v. *William Marsh Rice Univ.,* Case IPR2017-00045, Paper 54 (PTAB Jun. 4, 2018) (lifting a stay of an *ex parte* reexamination); *see also, e.g., Unified Patents Inc.* v. *Heslop,* Case IPR2016-01464, Paper 14 (PTAB Feb. 23, 2017) (denying request to lift stay where similar, if not identical, issues in the *inter partes* review would needlessly duplicate efforts within the Office); *CBS Interactive Inc.* v. *Helferich Patent Licensing, LLC,* Case IPR2013-00033, Paper 19 (PTAB Dec. 20, 2012) (denying request to lift stay due to overlapping issues and the conduct of parallel proceedings would burden the Office and the parties). Patents may consider similar factors when determining whether to lift a suspension of a reissue proceeding.

When ordering the stay of a parallel Office proceeding, the Board generally indicates that the stay will remain in place "pending the termination or completion of the instant proceeding." Thus, absent a motion to lift the stay, a stay typically will remain in place until at least after the deadline for the filing of a notice of an appeal to the Federal Circuit under 35 U.S.C. 142 (https://www.govinfo.gov/link/uscode/35/142) has passed. The issuance of a trial certificate signifies the completion of a trial proceeding and the end of the Board's jurisdiction, and thus automatically lifts a stay entered with the language above.

If a patent owner files a motion to lift a stay of a parallel Office proceeding after the Board issues a final written decision (and after any requests for rehearing are resolved, if applicable), the Board typically will lift the stay, absent reasons not to do so, *e.g.,* in view of factors as discussed above. For example, the Board typically will lift the stay of a parallel Office proceeding if the patent owner proposes amendments in that proceeding in a meaningful way not previously considered by the Office. Meaningful amendments may include those that narrow the scope of claims considered in an AIA proceeding or otherwise attempt to resolve issues identified in the final written decision. (print page 16658)

Additional Considerations for Lifting a Suspension of a Reissue Proceeding

Non-exhaustive factors considered by the Office when determining whether the Board will lift a stay, or Patents will lift a suspension, of a parallel reissue application are discussed above. Further information specific to reissue proceedings are provided below.

After a final written decision issues in an AIA proceeding (and after any requests for rehearing are resolved, if applicable), if requested by the patent owner, Patents may lift a suspension of or otherwise decide to proceed with, *i.e.,* not suspend, a related reissue proceeding while an appeal to the Federal Circuit regarding the final written decision is pending. For example, Patents may lift a suspension if the reissue application attempts to (1) resolve issues with the original or proposed substitute claims identified in the final written decision (*e.g.,* amends the claims in a meaningful way not previously considered by the Office, also taking into account estoppel provisions set forth in 37 CFR 42.73(d)(3) (https://www.ecfr.gov/current/title-37/section-42.73#p-42.73(d)(3))), if applicable; or (2) correct an unrelated issue with the patent (*e.g.,* correction of a priority claim, inventorship, or a drawing). Otherwise, Patents generally will not lift a suspension or proceed with prosecution of a reissue application after the Board issues a final written decision and while a Federal Circuit appeal of that decision is ongoing.

If a Federal Circuit appeal of a final written decision in an AIA trial remains ongoing when allowable subject matter is identified in the reissue application, the Office typically will not pass that application to allowance until the Federal Circuit appeal concludes. In that situation, after an appeal to the Federal Circuit concludes, a patent owner may confer with the examiner and decide how to proceed with the reissue application (*e.g.,* proceed to issuance, file a request for continued examination ("RCE") for further amendments/prosecution, or abandon the reissue application). The examiner also may need to reevaluate the status of allowable subject matter in view of a decision by the Federal Circuit.

As long as patent owner files the reissue application in a timely manner as discussed above, and raises issues different than those already considered in the AIA proceeding (*e.g.,* amendments meaningfully different than those in a previously presented motion to amend), the Office typically will consider the reissue application (subject to possible considerations for suspension discussed above).

Additional Considerations for Lifting a Stay of an Ex Parte Reexamination

Non-exhaustive factors considered by the Board when determining whether to lift a stay of a parallel reexamination are discussed earlier. As noted previously, under certain circumstances, the Office will proceed with a reexamination after the Board issues a final written decision relating to the same patent.

Unlike reissue applications, patent owners do not have the option to abandon *ex parte* reexamination applications. Once started, reexaminations proceed with special dispatch to completion. *See*35 U.S.C. 305 (https://www.govinfo.gov/link/uscode/35/305). Thus, after the Office determines that it is appropriate to lift a stay, or that a stay is not appropriate, a reexamination typically will continue to completion, notwithstanding a Federal Circuit appeal of a final written decision on the same patent.

PUBLISHED DOCUMENT: 2019-08022 (84 FR 16654)