

7-11-2022

## Reexamining The Reviewed: Challenging Patents Subject to Inter Partes Review Via Ex Parte Reexamination

Ellyar Y. Barazesh

Follow this and additional works at: <https://scholarship.kentlaw.iit.edu/ckjip>



Part of the [Intellectual Property Law Commons](#)

---

### Recommended Citation

Ellyar Y. Barazesh, *Reexamining The Reviewed: Challenging Patents Subject to Inter Partes Review Via Ex Parte Reexamination*, 21 Chi.-Kent J. Intell. Prop. 23 (2022).

Available at: <https://scholarship.kentlaw.iit.edu/ckjip/vol21/iss2/6>

This Article is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Chicago-Kent Journal of Intellectual Property by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact [jwenger@kentlaw.iit.edu](mailto:jwenger@kentlaw.iit.edu), [ebarney@kentlaw.iit.edu](mailto:ebarney@kentlaw.iit.edu).

REEXAMINING THE REVIEWED:  
CHALLENGING PATENTS SUBJECT TO  
*INTER PARTES* REVIEW VIA *EX PARTE*  
REEXAMINATION

BY ELLYAR Y. BARAZESH

---

INTRODUCTION .....	25
I. IN RE VIVINT, INC. ....	25
II. USING <i>EX PARTE</i> REEXAMINATION TO CHALLENGE PATENTS ALREADY SUBJECT TO <i>INTER PARTES</i> REVIEW .....	28
A. Filing a Reexamination Request Before Institution Decisions are Rendered.....	28
B. Filing a Reexamination Request After Institution Decisions are Rendered.....	30
III. SITUATIONS WHERE A SERIAL REEXAMINATION CHALLENGE MAY PROCEED DUE TO THE “PUBLIC INTEREST” .....	32
CONCLUSION .....	33

## INTRODUCTION

The Federal Circuit’s *In re Vivint* decision considered serial *inter partes* review (“IPR”) and *ex parte* reexamination filings, finding “the Patent Office, when applying § 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive.”<sup>1</sup> However, this case was explicitly “limited,” with the court acknowledging “there can be a *public* interest in reexamination that goes beyond the interests, or propriety of behavior, of a particular challenger.”<sup>2</sup> And after a relatively dormant period, *ex parte* reexamination has become an increasingly popular choice for challenging patentability, including against patents already subject to IPR.<sup>3</sup> Thus, in Parts One and Two, this Article examines *In re Vivint* and, in view of that decision, analyzes situations in which patent challengers may consider using *ex parte* reexamination to challenge patents already subject to IPR. Part Three of this Article reviews situations in which a serial reexamination challenge like that of *In re Vivint* may proceed due to the “public interest.”

### I. IN RE VIVINT, INC.

Vivint asserted four patents against Alarm.com in 2015.<sup>4</sup> As part of its defense, Alarm.com filed fourteen IPR petitions against the asserted patents, including three serially filed petitions challenging all claims of U.S. Patent 6,717,513.<sup>5</sup>

Alarm.com filed the first petition in September of 2015.<sup>6</sup> The Board denied institution of IPR on the merits.<sup>7</sup> Alarm.com filed the second petition in November of 2015, before the first petition had been denied, presenting grounds based on different references.<sup>8</sup> The Board again denied institution, this time because it found the primary reference relied on in all of the grounds did not qualify as prior art.<sup>9</sup> Alarm.com filed the third petition (the ‘091

---

1. *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021); 35 U.S.C. § 325(d) (Sept. 16, 2012) (stating “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office”).

2. *Vivint*, 14 F.4th at 1354 (emphasis in original).

3. *Reexamination Operational Statistics*, UNITED STATES PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/sites/default/files/documents/reexamination-op-stats-FY22Q1.pdf> [<https://perma.cc/NB3X-PQYM>] (showing an increase in *ex parte* reexamination request filings from 2019 to 2021); David Cavanaugh et al., *Potential Changes to PTAB Practice On Multiple IPR Petitions*, BLOOMBERG L. PROF. PERSP., Nov. 2019, at 5.

4. *Vivint*, 14 F.4th at 1346.

5. *Id.*

6. *Alarm.com Inc. v. Vivint, Inc.*, No. IPR2015-01997, Paper 1 (P.T.A.B. Sept. 28, 2015); *Alarm.com Inc. v. Vivint, Inc.*, No. IPR2015-01997, Paper 14 at 8–9 (P.T.A.B. April 7, 2016).

7. *Alarm.com Inc. v. Vivint, Inc.*, IPR2015-01997, Paper 14 at 29–31 (P.T.A.B. April 7, 2016).

8. *Alarm.com Inc. v. Vivint, Inc.*, No. IPR2016-00129, Paper 1 (P.T.A.B. Nov. 2, 2015); *Alarm.com Inc. v. Vivint, Inc.*, No. IPR2016-00129, Paper 13 at 9 (P.T.A.B. May 3, 2016).

9. *Alarm.com Inc. v. Vivint, Inc.*, No. IPR2016-00129, Paper 13 at 16–17 (P.T.A.B. May 3, 2016).

petition) in May of 2016, after the first two petitions had been denied, presenting grounds including combinations of references from the prior petitions.<sup>10</sup> Here, the Board exercised discretion under 35 U.S.C. § 314(a)<sup>11</sup> to deny institution of IPR, finding Alarm.com used the Board’s “decisions in the earlier cases as a roadmap for attempts to remedy deficiencies in its earlier petitions” and that the filing constituted “undesirable, incremental petitioning.”<sup>12</sup>

Alarm.com then requested *ex parte* reexamination of all claims in August of 2017, over a year after discretionary denial of the ‘091 petition, where Alarm.com raised four substantial new questions of patentability (“SNQs”), with two of the questions overlapping grounds in the ‘091 petition.<sup>13</sup> The United States Patent and Trademark Office (“USPTO”) ordered reexamination on all SNQs.<sup>14</sup> Vivint petitioned the Patent Office under 37 C.F.R. § 1.181 twice during the reexamination—first seeking dismissal under 35 U.S.C. § 325(d) by arguing the Patent Office “could not decline to institute IPR based on abusive filing practices, yet grant reexamination on essentially the same facts,” and after that petition was denied, petitioning again seeking reconsideration of the Section 325(d) issue.<sup>15</sup> But the Patent Office denied the second petition too, and a final rejection eventually issued rejecting all claims.<sup>16</sup> Vivint appealed the final rejection to the Patent Trial and Appeal Board (“PTAB”), which affirmed but did not address Section 325(d), and Vivint thereafter appealed to the Federal Circuit.<sup>17</sup>

On appeal, Vivint asserted Alarm.com’s *ex parte* reexamination request did not present any SNQs under 35 U.S.C. § 303(a) because the questions “‘had already been considered and rejected by the Board’ in the ‘091

---

10. Alarm.com Inc. v. Vivint, Inc., No. IPR2016-01091, Paper 1 (P.T.A.B. May 24, 2016); Alarm.com Inc. v. Vivint, Inc., IPR2016-01091, Paper 11 at 5 (P.T.A.B. Nov. 23, 2016).

11. 35 U.S.C. § 314(a) states “[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

12. Alarm.com Inc. v. Vivint, Inc., IPR2016-01091, Paper 11 at 10, 12, 14 (P.T.A.B. Nov. 23, 2016).

13. *Vivint*, 14 F.4th at 1346–48 (the court noted the request “repackaged the arguments raised in the ‘091 petition” that had been denied and “vast swaths of the *ex parte* reexamination request copied, almost word for word, the ‘091 petition”); *Ex Parte* Reexamination Control No. 90/020,115, Reexamination Request.

14. *Vivint*, 14 F.4th at 1346–48; *Ex Parte* Reexamination Control No. 90/020,115, Decision Granting Ex Parte Reexamination.

15. *Vivint*, 14 F.4th at 1347–48.

16. *Id.*; 37 C.F.R. § 1.181 (Sept. 16, 2012) (stating “(a) Petition may be taken to the Director: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title”); 35 U.S.C. § 325(d) (Sept. 16, 2012).

17. *Vivint*, 14 F.4th at 1347–48.

Decision.”<sup>18</sup> The court disagreed, noting only two questions raised by the request overlapped with grounds of the ‘091 petition.<sup>19</sup> The court further explained “a question of patentability is new until it has been considered and decided on the merits,” and in the ‘091 petition’s proceeding, the PTAB had not decided questions of patentability because it instead exercised discretion to deny institution based on “abusive filing practices.”<sup>20</sup>

Vivint also contended the USPTO “abused its discretion and acted arbitrarily and capriciously by ordering reexamination, and thereafter, refusing to terminate that proceeding”<sup>21</sup> in view of § 325(d). The court agreed, finding the USPTO’s Section 325(d) determination should be set aside.<sup>22</sup> The court further explained that while it would normally vacate the Patent Office’s decision in view of its findings, “it would be arbitrary and capricious for the Patent Office to do anything on remand other than terminate the reexamination.”<sup>23</sup> The ‘091 petition’s institution decision “focused on Alarm.com’s abusive filing practices” and how it was “undesirable, incremental petitioning,” and while the PTAB applied Section 314(a) to deny institution, “it actually relied on [Section] 325(d) considerations for its core analysis,” examining “whether the Petitioner’s current challenges present the same or substantially the same art or arguments as those previously presented to the Office.”<sup>24</sup> Thus, the reexamination request was an even “more egregious abuse than the ‘091 petition under the same considerations already analyzed by the Board” because it “was another, fourth iteration of Alarm.com’s abuse of process” that “copied, word-for-word, two grounds from the ‘091 petition—the very petition deemed a ‘case of undesirable, incremental petitioning,’” and the non-copied portions ““used prior Board decisions as a roadmap to correct past deficiencies.””<sup>25</sup> The court explained “the Patent Office, when applying Section 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive,” and “[w]e see no difference between the IPR and *ex*

---

18. *Id.* at 1348–50; *see* 35 U.S.C. § 303 (a) (stating “[w]ithin three months following the filing of a request for reexamination under the provisions of section 302, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications”).

19. *Vivint*, 14 F.4th at 1350.

20. *Id.* at 1347.

21. *Id.* at 1350.

22. *Id.* at 1350–52. The court explained it was “legal error” for the USPTO to narrowly interpret its authority to reconsider orders granting reexamination, and “arbitrary and capricious for it to order reexamination over § 325(d), or at a minimum, refuse to terminate reexamination once Vivint requested it do so.”

23. *Id.* at 1352; *see also id.* at 1353 (“it was unreasonable for the Patent Office to order reexamination, and once ordered, to refuse to terminate it”).

24. *Id.* at 1352–53.

25. *Id.* at 1353.

*parte* reexamination processes that would justify such conduct and nothing short of termination of the reexamination would be appropriate.”<sup>26</sup>

The court finally noted its ruling was “limited” because “there can be a *public* interest in reexamination that goes beyond the interests, or propriety of behavior, of a particular challenger,” which is reflected by the Director’s authority to launch an *ex parte* reexamination “[o]n his own initiative.”<sup>27</sup>

## II. USING *EX PARTE* REEXAMINATION TO CHALLENGE PATENTS ALREADY SUBJECT TO *INTER PARTES* REVIEW

After *In re Vivint*, patent challengers should consider whether *ex parte* reexamination is an appropriate option in view of Sections 303(a) and 325(d) if one or more IPRs have already been filed. 35 U.S.C. § 315(d) should also be considered since it addresses the Director’s options when multiple proceedings involving the same patent are pending before the Office.<sup>28</sup> This part of the Article reviews potential situations challengers may face and the analysis they should undertake to decide whether to file.

### A. Filing a Reexamination Request Before Institution Decisions are Rendered

If a reexamination request is filed when IPRs challenging the same patent are pending before institution, the PTAB has not yet considered the merits in the IPRs, so whether the same or different art and/or arguments are

---

26. *Id.* at 1354 (explaining “§ 325(d) applies to both IPR petitions and requests for *ex parte* reexamination”).

27. *Vivint*, 14 F.4th at 1354. (emphasis in original), citing 35 U.S.C. § 303(a) (Sept. 16, 2012) (which states “[o]n his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 or 302”) and 37 C.F.R. § 1.520 (which states “[t]he Director, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Director or which have been brought to the Director’s attention, even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913”). The court further explained “we are not holding that the Director may never launch a reexamination even when a particular challenger has engaged in improper serial filing.” *Vivint*, 14 F.4th at 1354.

28. 35 U.S.C. § 315(d) (Sept. 16, 2012) (stating “Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding”); see Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (listing several factors that are considered when deciding whether to stay a reexamination involving the same patent at issue in an IPR under § 315(d), including (1) 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, (2) whether the same grounds of unpatentability or the same prior art are at issue in both proceedings, (3) whether the concurrent parallel Office proceeding will duplicate efforts within the Office, (4) 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), (5) whether amending the claim scope in one proceeding would affect the claim scope in another proceeding, (6) the respective timeline and stage of each proceeding, (7) the statutory deadlines of the respective proceedings, and (8) whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot).

included in the request, the reexamination would still likely present SNQs under § 303(a) if the central reexamination unit reviews the request before the PTAB renders an institution decision.<sup>29</sup> Although the challenger could not be accused of using any PTAB decision as a “roadmap” due to a decision not yet being rendered, if art and/or arguments overlap between the request and IPRs, the reexamination may still be denied due to § 325(d); here, analyzing the *Becton, Dickenson* factors may be helpful.<sup>30</sup> In the present example, the “same or substantially the same prior art or arguments” would have already been “presented” to the office in the IPR. Under *Becton, Dickenson*, the similarity of art, cumulative nature of art, and/or overlap of arguments (factors (a), (b), and/or (d)) would likely cut against a requester even though the extent of the prior art analysis (factor (c)) would be inapplicable since an institution decision had not yet issued.<sup>31</sup> A challenger should also consider § 315(d) in this example because multiple proceedings would be “before the Office” and the Director would have the ability to terminate or stay one of them.<sup>32</sup>

The risk of denial may decrease if a reexamination request uses different, non-cumulative art and/or arguments because, in addition to the lack of a “roadmap” from the IPRs, factors (a), (b), and/or (d) would not be as relevant, and SNQs under § 303(a) would likely be found as the invalidity grounds would not have been considered yet by the PTAB.<sup>33</sup> However, the

---

29. *Vivint*, 14 F.4th at 1348–50.

30. *Id.* at 1353. When evaluating whether to institute an IPR in view of Section 325(d), the PTAB examines the non-exclusive *Becton, Dickenson* factors. *Becton, Dickenson & Co. v. B. Braun Melsungen AG*, No. IPR2017-01586, Paper 8 at 17–18 (P.T.A.B. Dec. 15, 2017) (precedential as to section III.C.5, first paragraph). The *Becton, Dickenson* factors include (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Id.*; see also *Advanced Bionics*, which explains “[t]he factors set forth in *Becton, Dickinson* should be read broadly, however, to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office during a proceeding pertaining to the challenged patent.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Ger. . .te GmbH*, No. IPR2019-01469, Paper 6 at 9–10 (P.T.A.B. Feb. 13, 2020) (precedential). In the reexamination context, the Trial Practice Guide explains that “the Office may not necessarily consider these factors” when deciding whether to order reexamination as “[a]n *ex parte* reexamination proceeding is not a trial proceeding, and the considerations with respect to issues involving 35 U.S.C. § 325(d) may differ due to the different nature of an *ex parte* reexamination proceeding.” *Patent Trial and Appeal Board Consolidated Trial Practice Guide* (Nov. 2019), UNITED STATES PATENT AND TRADEMARK OFFICE, 63, <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=https://perma.cc/BS34-WS4T>. But in view of *In re Vivint*’s focus on previously presented art and arguments under 325(d) in the reexamination context, analyzing the *Becton, Dickenson* factors may be a helpful exercise.

31. *Becton, Dickenson & Co. v. B. Braun Melsungen AG*, No. IPR2017-01586, Paper 8 at 17–18 (P.T.A.B. Dec. 15, 2017) (precedential as to section III.C.5, first paragraph).

32. 35 U.S.C. § 315(d).

33. See *supra* note 30; see *supra* note 18.



Director may still terminate or stay the later filed reexamination under § 315(d) due to the multiple pending proceedings.<sup>34</sup>

If all prior IPRs were terminated before institution—for example, due to settlement between the parties—and a subsequent reexamination request was filed against the patent, the risk of denial may also decrease. Regardless of whether the same or substantially the same art and/or arguments were presented in the reexamination relative to the IPRs, the PTAB would not be examining the merits of those arguments or otherwise have provided a “roadmap” for the subsequent challenger.<sup>35</sup> Thus, SNQs would likely be present and the risk of denial under § 325(d) for abusive filing practices may be limited because this would not be a case of “incremental” challenging that uses any prior decision as roadmap.<sup>36</sup> Under *Becton, Dickenson*, if art and/or arguments are the same between the IPRs and reexamination, factors (a), (b), and/or (d) may cut against a requester, but the extent of the prior art analysis (factor (c)) would be inapplicable.<sup>37</sup> Moreover, multiple proceedings would not be pending before the Office, eliminating the risk of termination or stay under § 315(d).<sup>38</sup>

#### B. Filing a Reexamination Request After Institution Decisions are Rendered

After institution decisions have issued, the risk of a subsequently filed reexamination request being denied under § 325(d) may increase because the decisions can be used as a “roadmap” for a requester.<sup>39</sup> Whether art and/or arguments of the reexamination request are new or overlap with that in the IPRs, reexamination may be denied because it could be considered incremental challenging.<sup>40</sup>

If art and/or arguments do overlap between filed IPRs and reexamination, and if institution was granted in the IPRs, an elevated risk of the reexamination being denied due to Sections 303(a) and 325(d) likely exists. In view of Section 303(a), the Office may find that SNQs do not exist because the art or arguments have already been considered by the PTAB at institution; in view of Section 325(d), the “same or substantially the same prior art or arguments” would have already been “presented” to the office in the IPR and analyzed by the PTAB, providing a roadmap, and under *Becton, Dickenson*, similarity of art, cumulative nature of art, and/or overlap of arguments (factors (a), (b), and/or (d)) would likely cut against a requester, as well as the extent of the prior art analysis (factor (c)) since an institution

---

34. *See supra* note 32.

35. *Vivint*, 14 F.4th at 1348–50, 1353.

36. *Id.*

37. *See supra* note 30.

38. *See supra* note 32.

39. *Vivint*, 14 F.4th at 1353.

40. *Id.*

decision issued.<sup>41</sup> Under § 315(d), multiple proceedings would be “before the Office” and the Director would have the ability to terminate or stay one of them under § 315(d), likely the reexamination due to the IPRs being at a more advanced, post-institution stage.<sup>42</sup>

If IPR(s) are terminated after institution—again, for example, due to settlement—and a reexamination request is subsequently filed, multiple proceedings would not be pending in parallel before the Office, removing § 315(d) issues.<sup>43</sup> But if the “same or substantially the same” art and/or arguments as the IPR is presented in the reexamination, a denial risk may exist under § 303(a), because the SNQs would have already been considered (albeit positively) by the PTAB, and under § 325(d) because the serially filed request could be seen as engaging in “harassment of patent owners and frustration of Congress’ intent in enacting the [AIA]” and under *Becton, Dickenson*, the same factors discussed in the previous post-institution example would apply.<sup>44</sup> However, the relevant § 325(d) analysis of *In re Vivant* rested on the “same petitioner” filing the serial reexamination.<sup>45</sup> An unrelated entity filing its first challenge against the patent via the reexamination request may not be subject to the § 325(d) issues of *In re Vivant* because they have not engaged in any serial or abusive filing practices. And the grounds of the petition would have been preliminarily approved by the PTAB because it instituted trial, indicating likely success before the central reexamination unit; if the reexamination request raised SNQs corresponding to the instituted IPR grounds, but explained how they were different, included additional explanation, or were enhanced in some way, the Patent Office may allow it to proceed under § 303(a).<sup>46</sup>

If a challenger’s IPR results in a final written decision, that same challenger would be estopped from filing an *ex parte* reexamination under § 315(e)(1) with respect to a claim on any ground the petitioner raised or reasonably could have raised in the IPR.<sup>47</sup> An unrelated entity would be free

---

41. See *supra* note 30; see *supra* note 18.

42. 35 U.S.C. § 315(d); see *supra* note 3.

43. *Id.*

44. *Vivant*, 14 F.4th at 1353 (quoting *Alarm.com*, No. IPR2016-01091, Paper 11 at 12); see *supra* note 30.

45. *Id.*

46. 35 U.S.C. § 314(a) (Sept. 16, 2012); see *supra*, note 18.

47. 35 U.S.C. § 315(e)(1) (Sept. 16, 2012); UNITED STATES PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2212 (9th ed. rev. Oct. 2019, June 2020) (explaining “[t]he only ‘person’ who is barred from filing a request for *ex parte* reexamination of a patent under 35 U.S.C. § 302 is one who is barred from doing so by the estoppel provisions of AIA, 35 U.S.C. [§] 315(e)(1) or 35 U.S.C. [§] 325(e)(1) based on *inter partes* review and post grant review, respectively, once the estoppel attaches”). Note that since a challenger does not participate in *ex parte* reexamination after it is ordered, the Section 315(e)(1) preclusion of a challenger “maintain[ing] a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review” does not apply to a pending reexamination that addresses the same claim(s) of a prior IPR that has an issued final written decision. 35 U.S.C. § 315(e)(1) (Sept. 16, 2012).

to challenge the patent via reexamination, but §§ 303(a), 315(d), and 325(d) as discussed above should be considered.

### III. SITUATIONS WHERE A SERIAL REEXAMINATION CHALLENGE MAY PROCEED DUE TO THE “PUBLIC INTEREST”

*In re Vivant* explains “there can be a *public interest* in reexamination that goes beyond the interests, or propriety of behavior, of a particular challenger,” which is “reflected most expressly in the statute’s grant to the Director of the authority to launch an *ex parte* reexamination “[o]n his own initiative.”<sup>48</sup> When Director initiated reexamination has occurred, it has been due to a “compelling reason” from the Office’s perspective, such as a significantly large damages award in district court litigation,<sup>49</sup> patent assertion implicating non-technical human behavior,<sup>50</sup> or questionable patent examination practices.<sup>51</sup> Thus, it follows that reexamination requests filed against patents that have been previously subject to IPRs may be allowed to proceed if the public interest is similarly impacted.

One exemplary situation where the public interest may compel a serially filed reexamination to proceed is when IPRs have been denied without an examination of the merits and a district court grants a substantial damages award in related litigation for the patent at issue.<sup>52</sup> This situation mirrors the Director initiated review of U.S. Patent 5,838,906, which had an

---

48. *Vivant*, 14 F.4th at 1354 (emphasis in original); 37 C.F.R. § 1.520 (Dec. 7, 2000). Director initiated reexamination is rare. See *Ex Parte Reexamination Filing Data – September 30, 2020*, UNITED STATES PATENT AND TRADEMARK OFFICE, [https://www.uspto.gov/sites/default/files/documents/ex\\_parte\\_historical\\_stats\\_roll\\_up\\_21Q1.pdf](https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_roll_up_21Q1.pdf) [<https://perma.cc/KF7M-CUCU>](showing that as of September 30, 2020, only 1.2% (175 total) of reexamination requests have been filed by the Director since July 1981).

49. See *Ex Parte Reexamination Control No. 90/006,831*, challenging U.S. Patent 5,838,906, Reexamination Request at 2. The ‘906 patent had an associated damages award of \$521 million in district court. See Amy L. Magas, *When Politics Interfere with Patent Reexamination*, 4 J. MARSHALL REV. INTELL. PROP. L. 160, 169–170 (2004).

50. See *Ex Parte Reexamination Control No. 90/006,868*, challenging U.S. Patent 6,567,790. In district court, Wealth Transfer Group, LLC asserted the ‘790 patent against Dr. John W. Rowe, the President and CEO of Aetna U.S. Healthcare, alleging Dr. Rowe’s advisors had funded two trusts with nonqualified stock options that infringed the patent. *Tax Strategies?* INSURANCE IP BULLETIN, Oct. 15, 2006, available at <http://www.bakosenterprises.com/IP/B-10152006/IPB-10152006.html> [<https://perma.cc/3XRE-43RL>].

51. See Director-initiated *Ex Parte Reexamination Control No. 90/006,289*, challenging U.S. Patent 6,368,227 titled “Method for Swinging on a Swing;” Director-initiated *Ex Parte Reexamination Control No. 90/006,068*, challenging U.S. Patent 6,022,219 titled “Painting Kit and Related Method” and reciting in claim 1 “[a] method of painting on a work surface using the posterior of an infant,” where the method included “stamping the posterior on said background media to create stamping prints.”

52. See, e.g., *Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00106, Paper 17 at 4–13 (P.T.A.B. May 5, 2020), *Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00158, Paper 16 at 4–14 (P.T.A.B. May 20, 2020), *Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00498, Paper 16 at 4–10 (P.T.A.B. Aug. 19, 2020) (denying institution due to discretionary factors without an examination of the merits, where the district court in related litigation awarded \$2.18 billion in damages associated with patents); Alan Cox, *The Damages Testimony in VLSI Technologies v. Intel*, PATENTLYO (Mar. 19, 2021), <https://patentlyo.com/patent/2021/03/damages-testimony-technologies.html> [<https://perma.cc/9QZ4-Y7SG>].

associated damages award of \$521 million.<sup>53</sup> The USPTO may deem that a serial challenge should not be terminated to ensure a significant damages award is not premised on invalid claims.<sup>54</sup>

Another exemplary situation in which the public interest may allow serially filed reexamination to proceed involves national security. Huawei, which has close ties to the Chinese state, is a leading patent holder in 5G technologies, but has been excluded from selling much of its smartphone and 5G infrastructure equipment in the U.S. due to cyber-security and IP theft concerns.<sup>55</sup> In response, Huawei resorted to patent assertion campaigns in the U.S. to create revenue streams that replaced lost equipment sales due to the exclusion.<sup>56</sup> This type of practice poses a national security threat because, in addition to circumventing the intended effect of the exclusion, it has the potential to flood U.S. courts with new patent cases and drain resources from targeted U.S. companies, stifling domestic innovation.<sup>57</sup> Thus, when patents are asserted against U.S. companies in this manner by such state-linked entities, and ensuing IPRs fail, the USPTO may consider allowing serially filed reexaminations to proceed to combat this threat.<sup>58</sup>

## CONCLUSION

After *In re Vivint*, when IPRs have already been filed but a further challenge is desirable, challengers should carefully consider whether *ex parte* reexamination is a viable option. Challengers should also consider whether the public interest would weigh in favor of reexamination.

---

53. See *supra* note 49.

54. See *supra* note 49; *supra* note 52.

55. Jonathan Stroud & Levi Lall, *Paper of Record: Modernizing Ownership Disclosures for U.S. Patents* (July 12, 2021) at 1, 3–7, 12–15, 19–23, W. VA. L. REV., forthcoming, available at SSRN: <https://ssrn.com/abstract=3885076> [<https://perma.cc/GLS5-XSMG>]; Tim Pohlmann, *Who is leading the 5G patent race? A patent landscape analysis on declared SEPs and standards contributions*, IAM (Feb. 17, 2021), <https://www.iam-media.com/who-leading-the-5g-patent-race-patent-landscape-analysis-declared-seps-and-standards-contributions> [<https://perma.cc/J8HW-RATD>].

56. *Id.*, 15, 21–23.

57. See *supra* note 55.

58. *Id.*