

IP LAW ADVISORY

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**Reexamination Proceedings May Determine the Validity of
Priority Claims**

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The Federal Circuit has clarified that reexamination proceedings may include a determination of whether a patent is entitled to an earlier priority date. This decision allows patent examiners to challenge priority claims during reexamination and decide whether a priority document contains sufficient written description to support the claim.

On August 1, 2011, the Federal Circuit ruled in *In re NTP, Inc.* that a patent examiner in a reexamination proceeding is free to scrutinize a priority claim and, when appropriate, invalidate that priority claim. Invalidating a priority claim changes the priority date of the patent undergoing reexamination and broadens the pool of available prior art that may then be used to invalidate the claims of the patent.

To receive the benefit of a priority date under 35 U.S.C. § 120, the patent or application to which priority is claimed is generally required to describe the subject matter of the claimed invention in a way that conveys possession of the claimed subject matter to one of ordinary skill in the art.

In the *In re NTP* case, the patent examiner decided that the claims were not adequately described in the priority document. Having broken the priority chain, the examiner then used a patent, which only qualified as prior art if the priority chain was broken, to cancel all claims of the patent undergoing reexamination.

The patent owner, NTP, argued that this was beyond the examiner's authority, pointing out that the statutory basis for

reexamination proceedings, 35 U.S.C. §301, is intended to permit reexamination of an issued patent based on new information about preexisting technology that may have escaped review during the initial examination. NTP also noted that the scope of reexamination proceedings is limited to substantial new questions of patentability based on prior art patents or printed publications.

In short, NTP argued that reexamination proceedings should be limited to questions of novelty or obviousness, and that scrutiny of a priority claim is a question of written description or enablement that cannot be raised during a reexamination proceeding.

The Federal Circuit disagreed, stating that "when a patentee argues that its claims are entitled to the priority date of an earlier filed application, the examiner must undertake a priority analysis to determine if the patentee meets the requirements [for priority]. There is no statutory limitation during a reexamination proceeding prohibiting the examiner from conducting a priority analysis... Nothing in §§ 301, et seq. prohibits an examiner from determining whether or not a priority date was properly claimed during the original examination of the application."

In rejecting NTP's argument, the Federal Circuit noted that "a patent's claims are not entitled to an earlier priority date merely because the patentee claims priority... Rather, for a patent's claims to be entitled to an earlier priority date, the patentee must demonstrate that the claims meet the requirements of 35 U.S.C. § 120."

Thus, the patent examiner is not bound to accept as true the patentee's priority claim; instead, the examiner should determine the validity of a priority claim during reexamination. This necessarily requires scrutiny of the issued claims of the patent subject to reexamination as well as the written description of the priority document.

Interestingly, the written description of the priority document can be identical to the written description of the patent at issue. In this situation, a lack of written description support in the priority document would equate to a lack of written description support in the patent at issue. However, a request for reexamination cannot be based on a lack of support in the written description of the patent. The lack of written description support in the priority document is used only to invalidate the benefit of the earlier priority claim, and not directly to invalidate the claims of the issued patent. A document that qualifies as prior art as a result of the invalid priority claim may then be asserted in the reexamination to invalidate the claims of the patent due to a lack of novelty or obviousness over that prior art document.

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