



Reexamining Success Rates in *Inter Partes* Reexaminations

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An avenue of attack being used more frequently against patents than just a few years ago is *inter partes* reexamination. According to Patent Office statistics, requests for *inter partes* reexamination have grown from seventy (70) in 2006 to two hundred fifty eight (258) in 2009, and is currently on pace to total at least three hundred seventy eight (378) in 2010. A driving factor in the increase of requests for *inter partes* reexam is believed to be the “success” rate published by the Patent Office in obtaining certificates with “all claims canceled (or disclaimed).” According to Patent Office statistics, as recently as the period ending March 31, 2009, the success rate of “all claims” being knocked out in *inter partes* reexamination was 71%.

A review of more recent statistics shows that this success rate is plummeting. For the period ending June 30, 2010, the success rate of all claims being knocked out in *inter partes* reexamination was at 49%.

An independent study done by the author of this Alert for certificates issuing between September 8, 2009 and August 31, 2010 shows that the rate of all claims being knocked out in *inter partes* reexam was 33%, and that between March 2, 2010 and August 31, 2010, the rate has dropped to 24%.

A party who is considering whether to file a request for *inter partes* reexam needs to consider a number of factors. The fact that the knock out rate in *inter partes* reexam has recently dropped precipitously is a factor that should be considered. Further, about 70% of *inter partes* reexaminations are known to be in litigation. Thus, parties should be aware that more recent statistics can be used to help defeat a motion to stay litigation pending *inter partes* reexam by rebutting published Patent Office knock out rate numbers, which include all *inter partes* reexam certificates. Indeed, the author compiled recent statistics and used them to help defeat a motion to stay litigation pending *inter partes* reexamination in the Northern District of California, a court that historically has granted stays pending reexamination more often than not. The litigation settled shortly after the motion to stay was denied.

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