



Procedural Quirk Prevents Amendment During Inter Partes Reexamination

Jan 20, 2016

Reading Time : **1 min**

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This is an unusual procedural case. In an *inter partes* reexamination, the examiner rejected all of the patent owner's claims, to which the patentholder responded by amending some of its claims. The examiner rejected these amended claims as well, and on appeal, the Board reversed the examiner's rejection. Unfortunately for the patentholder, by the time the Federal Circuit made its decision on the appeal from the Board, the patent had expired. This was bad news for the patentholder because the PTO cannot issue an *inter partes* reexamination certificate with amendments after the patent has expired. 37 CFR 1.530(j). Thus, no matter what the Federal Circuit's ruling would have been on the Board's decision, the amended claims could not become effective. Because of this, the Federal Circuit vacated the Board's decision and remanded the amended claims back to the PTO to determine the appropriate course of action.

Biomet Orthopedics, LLC v. Puget Bioventures, LLC, 2015-1468 (Fed. Cir. Jan. 14, 2016) [Moore, O'Malley, Taranto]

Categories

Federal Circuit

Inter Partes Review

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