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The Federal Circuit Agrees to Consider En Banc Whether Intervening Rights Can Apply To Independent Claims Not Amended During Reexamination

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In September 2011, I wrote about how the Federal Circuit overturned a patentee's $29.4 million infringement verdict and held that cancelling dependent claims in a reexamination without changing the language of the independent claims narrowed the claim scope due to intervening rights. See our previous alert, *Marine Polymer v. Hemcom*. In sum, the Court held that the scope of the claims was changed due to the reexam patentee's arguments which, in turn, gave rise to intervening rights. I speculated then that the case might well lead to increased PTO post-grant proceedings in addition to or in lieu of district court proceedings since any accused infringer can contend that a patentability argument somehow changed the claim scope.

On Friday January 20, 2012, the Federal Circuit vacated the panel decision and agreed to rehear the case *en banc* on the basis of the original briefs and oral argument. The Federal Circuit order was a bit unusual in that unlike many of its other *en banc* orders the Court did not agree to accept amicus briefs or even suggest what questions will be addressed. Nonetheless it is quite likely that the main issue will be the one Judge Lourie focused on in his dissent, i.e., the patent statute provides for intervening rights only in the instances of an "amended or new claim" and not for patentability arguments alone. An Intellectual Ventures amicus brief in support of *en banc* rehearing argued the practical policy aspects and said that if the decision stood, then parties will "request even more re-examinations and to make such contentions routinely as a means to enjoy intervening rights and avoid liability for past infringement."

If the *Marine Polymer* case follows the trend of other *en banc* cases, then a decision may not be issued until the fourth quarter of 2012. Until then practitioners will be operating with uncertainty as to the effects of arguments without amendments. Accordingly, practitioners will need to continue to be vigilant and perceptive as they make patentability arguments during post-grant and other PTO proceedings so as to lessen the potential of intervening rights arising.

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