

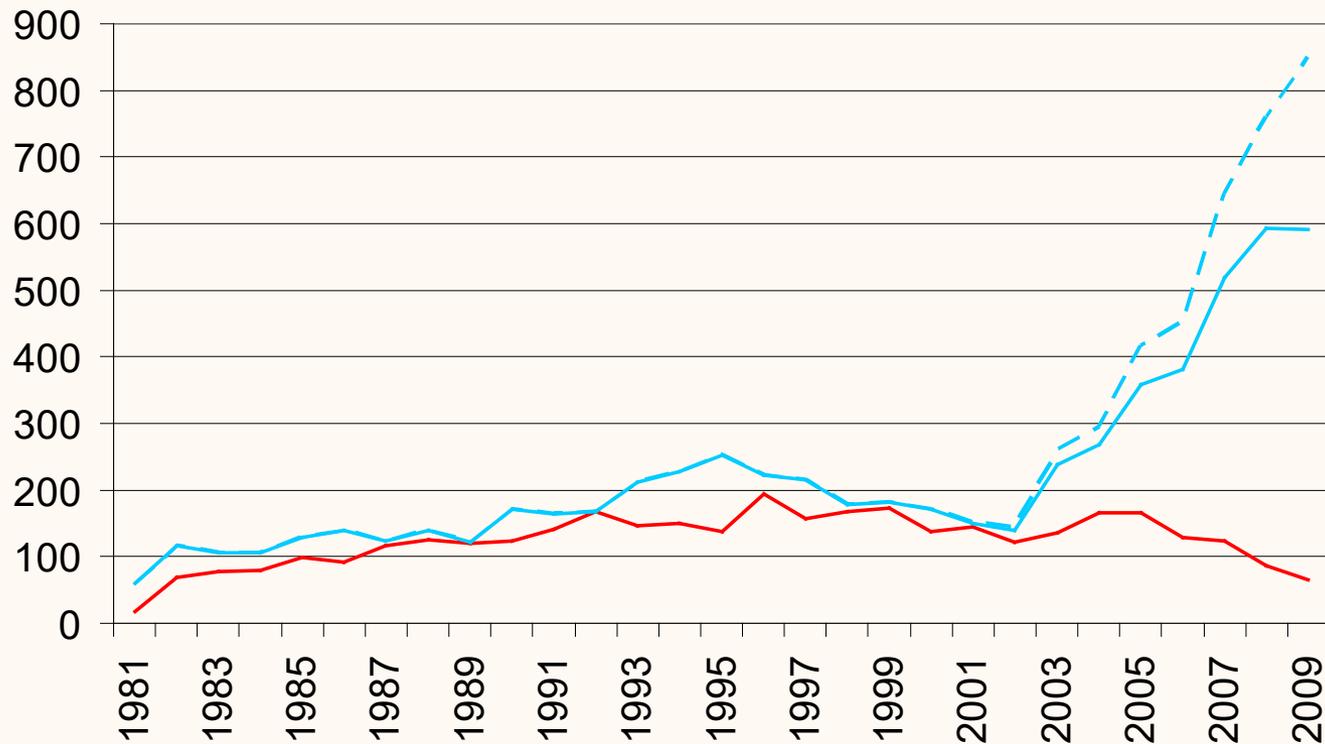
# Filing Compliant Reexam Requests

**Andy Kashnikow**  
**SPE, Central Reexamination Unit**



**June, 2010**

# Reexamination Filings

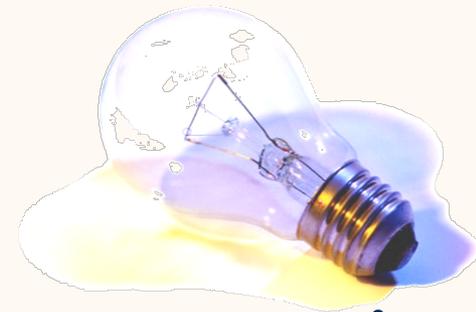


— Owner requested ex parte — Third Party ex parte - - Third Party ex + inter partes



# Filing Compliant Reexam Requests

- Statutory Requirements
- Regulatory Requirements
- Case Law: *In re Swanson*
- Common Defects
- Best Practices



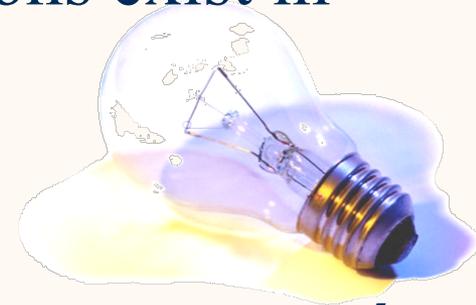
# Statutory Requirements

- The request must be in writing and must be accompanied by payment of a reexamination fee. 35 U.S.C. 302
- The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. 35 U.S.C. 302
- [T]he Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request. 35 U.S.C. 303



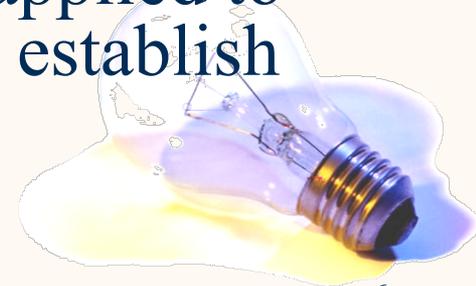
# Regulatory Requirements

- If the request does not include the fee for requesting *ex parte* reexamination required by 37 CFR 1.510 (a) and meet all the requirements of 37 CFR 1.510 (b), requester will be notified and generally given an opportunity to complete the request. If there is a failure to comply with the notice, the *ex parte* reexamination request will not be granted a filing date.
- See 37 CFR 1.510 (c) - (d). Parallel sections exist in 37 CFR 1.915 for *inter partes* requests.



# Content of Request

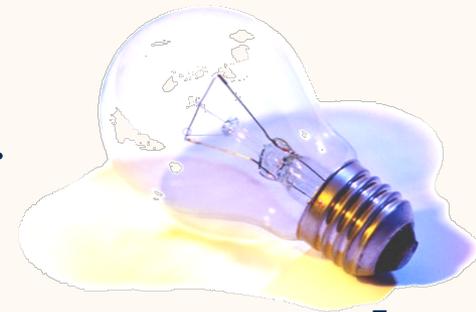
- 1) The complete reexamination fee
- 2) A statement pointing out each substantial new question of patentability (SNQ) based on the cited patents and publications
- 3) An identification of every claim for which reexamination is requested
- 4) A detailed explanation of how all of the cited documents are applied to the claims for which reexamination is requested. For each identified SNQ, the request must explain how all of the cited documents identified for that SNQ are applied to meet/teach the claim limitations to thus establish the identified SNQ



# Content of Request

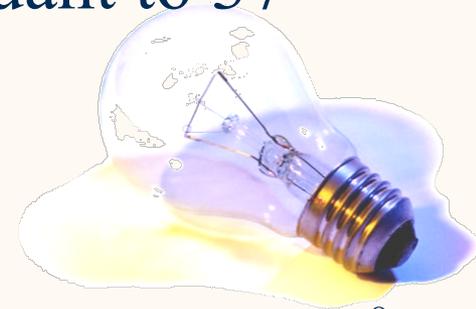
- 5) A copy\* of every patent or printed publication relied upon or referred to in the request
- 6) Some translation (at least of the necessary and pertinent portion(s)) of any non-English language patent or printed publication
- 7) A copy\* of the entire patent to be reexamined
- 8) A copy\* of any disclaimer, certificate of correction, or reexamination certificate issued for the patent

\*The copy must be legible. 37 CFR 1.52(a)(1)(iv).



# Content of Request

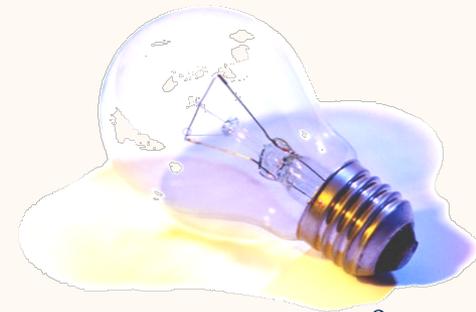
- 9) If the request is not filed by the patent owner--A certificate of service on the patent owner at the address as provided for in 37 CFR 1.33(c); i.e., the correspondence address of record in the patent file
- 10) If the request is filed by an attorney/agent and identifies another party on whose behalf the request is being filed, the attorney/agent should attach a power of attorney from that party if he/she is not acting in a representative capacity pursuant to 37 CFR 1.34



# Content of Request

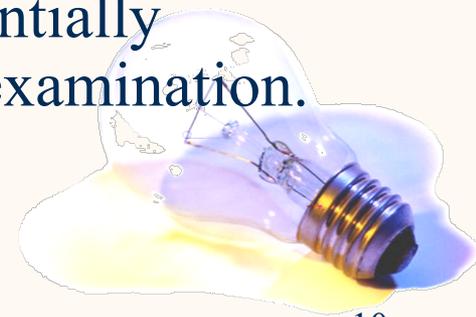
*Inter partes* requests also require:

- A certification by the requester that the estoppel provisions of 37 CFR 1.907 do not prohibit the *inter partes* reexamination
- A statement identifying the real party in interest for whom (on whose behalf) the request is being filed



# Case Law: *In re Swanson* (Fed. Cir. 2008)

- [I]n passing the original reexamination statute, Congress stated that "this new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application" (citation omitted) *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008).
- Following the amendment to 35 USC 303(a), previously considered references may be applied in a new light to form a substantial new question of patentability. This might include (as in the facts of *Swanson*) where the reexamination considers the previously-considered reference for a substantially different teaching or purpose than in the initial examination.



# Common Defects

- Statement pointing out each SNQ identifies rejections rather than new technical teachings
- Detailed explanation does not address all cited documents or all requested claims
- Detailed explanation groups proposed rejections in a manner that does not provide a clear explanation of each
- Detailed explanation suggests, but does not explain, other possible rejections



# Best Practices

- File electronically.
- Use form PTO/SB/57 for *ex parte* requests, and use form PTO/SB/58 for *inter partes* requests.
- Remember that the papers filed will be scanned or transferred into the image file wrapper system. Small type (below 12 point), colors, photographs and small detailed drawings do not scan well and may be illegible in the image file wrapper system.



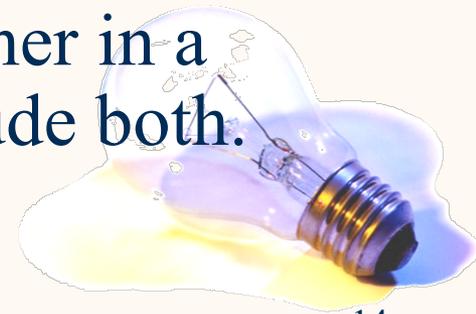
# Best Practices

- Understand the difference between a statement of an SNQ and a detailed explanation.
- A statement pointing out an SNQ is a statement that identifies the new, non-cumulative technological teaching.
- A detailed explanation of how the references are applied to the claims is (in the context of a third-party requested reexamination) a proposed rejection that includes that new, non-cumulative technological teaching.



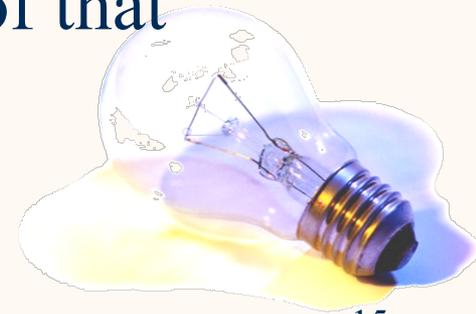
# Best Practices

- State clearly each and every proposed rejection.
- Do NOT lump together multiple proposed rejections based on different grounds.
- DO group together rejections for multiple claims based on the same ground of rejection (e.g., claims 1-4, 6, 8, and 12 should be rejected under 35 U.S.C. 102(b) as anticipated by Smith).
- Do NOT “suggest” other proposed rejections in footnotes or “disclaimer-type” language.
- Provide a single detailed explanation, either in a narrative or in a claim chart. Do not include both.



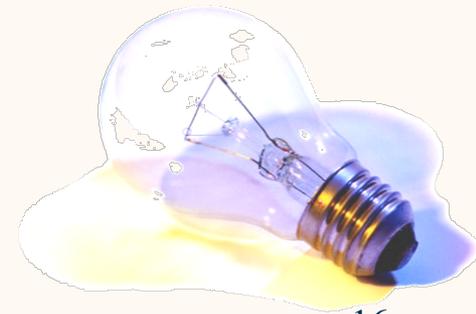
# Best Practices

- Provide a listing of all patents and publications that form the basis of the proposed rejections on form PTO/SB/08, PTO/SB/42, PTO-1449, or equivalent.
- Only list documents that form the basis of a proposed rejection.
- Do not include litigation documents or “background” documents on the listing. However, any “background” document discussed in the body of a proposed rejection must be cited as part of that rejection and included in the listing.



# Best Practices

- If you are a third party requesting reexamination, make sure you serve the request and all related papers to the patent owner at its correspondence address (37 CFR 1.33(a)) in the patent file.
- If you are a patent owner, update the correspondence address in the patent file as needed. Correspondence is sent to the address in the patent file.



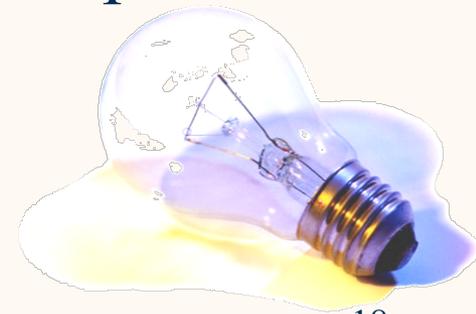
# Best Practices

- Sign the request, not just the transmittal or cover letter.
- Make sure that the signature is in compliance with 37 CFR 1.4(d)(1) for handwritten signatures or 37 CFR 1.4(d)(2) for s-signatures.



# Best Practices

- Do not include:
  - ◆ Comments pertaining to any alleged misconduct, including inequitable conduct, of the patent owner
  - ◆ Proposed rejections based on lack of either utility or patent-eligible subject matter under 35 U.S.C. 101
  - ◆ Proposed rejections based on 35 U.S.C. 112
  - ◆ Proposed rejections based on prior use or prior knowledge



# Contact Information

Andy Kashnikow

SPE, Central Reexamination Unit

[Andres.Kashnikow@uspto.gov](mailto:Andres.Kashnikow@uspto.gov)

