

Supplemental Examination



Jean Witz and Andrew Fischer
Central Reexamination Unit
United States Patent and Trademark Office



Supplemental Examination

35 U.S.C. 257

- New 35 U.S.C. 257 provides that a patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent
- Within 3 months from the filing date of the request, the Office must decide whether any of the items of information filed with the request raises a substantial new question of patentability. (35 U.S.C. 257(a); § 1.620(a))



Inequitable Conduct Immunization

- Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable, except that this immunity does not apply (35 U.S.C. 257(c)(1)-(2)):
 - To allegations pled in a civil action or notice to the patentee before the date of the request for supplemental examination, and
 - Unless the supplemental examination and any resulting *ex parte* reexamination is completed before the civil action is brought.



Filing of Papers

- A request may be filed:
 - on or after Sept. 16, 2012; and
 - at any time during the period of enforceability of the patent. (§ 1.601(c))
- Third party may not request supplemental examination or participate in a supplemental examination. (§ 1.601(b)).



Item of Information Limit

- The request may not include more than twelve items of information. § 1.605(a).
- More than one request for supplemental examination of the same patent may be filed at any time during the period of enforceability of the patent.
 - USPTO must be able to make a timely decision whether to order *ex parte* reexamination



Items of Information

- “An item of information” includes a document containing information that the patent owner requests the Office to consider, reconsider, or correct. (§ 1.605(b)).
- Information that forms the basis of the request is not limited to patents and printed publications.
- Any information believed to be relevant to the patent may be submitted, such as transcripts of audio or video recordings, etc.



Request Requirements

- A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested. (§ 1.610(b)(5))
 - Comparable to request requirement for *ex parte* reexamination
 - To meet this requirement, the patent owner should consider the guidance set forth in MPEP § 2214, which governs *ex parte* reexamination.



Conduct of Proceeding

- Within 3 months from the filing date of the request, the Office will determine whether any of the item(s) of information filed with the request raises a substantial new question of patentability affecting a claim of the patent.
- The determination will be:
 - Based on the claims in effect at the time of the determination, and
 - Generally limited to a review of the item(s) of information identified in the request as applied to the identified claim(s) of the patent.



Conduct of Proceeding

- The standard will be the similar to the standard for *ex parte* reexamination (see, *e.g.*, MPEP 2242):
 - Whether there is a substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability.



Conduct of Proceeding

- No amendment may be filed in a supplemental examination proceeding. § 1.620(f)
- If *ex parte* reexamination is ordered, an amendment may be filed after the issuance of the initial Office action in the *ex parte* reexamination proceeding. An amendment may not be filed prior to the initial Office action.
- Interviews are prohibited in a supplemental proceeding. § 1.620(e)



Conclusion of Proceeding

- The supplemental examination proceeding will conclude with the electronic issuance of the supplemental examination certificate. § 1.625(a).
- The certificate will indicate the result of the Office's determination whether any item of information filed with the request raises a substantial new question of patentability.



Conclusion of Proceeding

- The certificate will be electronically issued in the Office image file wrapper (IFW) and the Patent Application Retrieval (PAIR) systems within three months of the filing date of the request, and will be viewable by the public in Public PAIR.



Publication of Certificate

- If the supplemental examination certificate states that no substantial new question of patentability is raised by any of the items of information in the request:
 - *ex parte* reexamination will not be ordered;
 - the electronically-issued supplemental examination certificate will be published as part of the patent by the Office's patent publication process; and
 - The reexamination fee for supplemental examination will be refunded. (§ 1.625(c))



Publication of Certificate

- If the supplemental examination certificate states that a substantial new question of patentability is raised by one or more items of information in the request:
 - *ex parte* reexamination will be ordered;
 - upon the conclusion of the resulting *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published as part of the patent by the Office's patent publication process; and
 - the electronically issued supplemental examination certificate will remain as part of the public record of the patent. § 1.625(b).



Procedure After Conclusion

- Any *ex parte* reexamination ordered as a result of a supplemental examination proceeding will be conducted in accordance with the regulations governing *ex parte* reexamination proceedings (§§ 1.530 – 1.570), except that:
 - the patent owner will not have the right to file a patent owner statement under § 1.530, and the order will not set a time period to file such a statement (§ 1.625(d)(1));
 - reexamination of any patent claim may be conducted on the basis of any item of information, and is not limited to patents and printed publications or to subject matter added or deleted during reexamination (§ 1.625(d)(2));



Procedure After Conclusion

- issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved (§ 1.625(d)(3)); and
- information material to patentability will be defined by § 1.56(b) for the purposes of a supplemental examination proceeding, and for any resulting *ex parte* reexamination proceeding. (§ 1.625(d)(4))



Material Fraud

- If the Office becomes aware of a material fraud on the Office in connection with the patent under supplemental examination, then the matter will confidentially be referred to the U.S. Attorney General. § 1.620(g).
- The Office may take other action as set forth in 35 U.S.C. 257(e).
- The Office regards “material fraud” to be narrower in scope than inequitable conduct.



Q & A

Thank You