

Legal Updates & News

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Reexam Interrupted: The PTO Cracks Down on Filing Informalities

January 2010

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In recent months, patent reexamination practitioners have spotted an alarming trend. Increasingly, the PTO has refused to grant filing dates to reexamination requests due to alleged noncompliance with filing formalities. That is, the requests are “bounced” for failing to pass an initial, formal hurdle before any review on the merits.

A recent review of PTO reexamination records has revealed that approximately 60% of *ex parte* requests filed in the third quarter of 2009 were not granted their original filing date, compared with 27%-38% in the preceding three quarters.^[1] The sharp rise in the number of noncompliant requests may stem from the PTO’s struggle to keep up with the robust growth of new reexamination filings.^[2]

Procedures

In denying a filing date, the PTO will send the requester either a Notice of Failure to Comply with Reexamination Request Filing Requirements (“Notice”) or a Decision Vacating Reexamination Filing Date (“Decision”) if the PTO decides to retract a previously granted filing date.^[3] The Notice or Decision will identify the alleged filing deficiencies and solicit a correction.

The PTO will not grant a filing date until the requester files an acceptable, corrected request. The filing date of the accepted request is not retroactive to the date of the original, defective request. Although a Notice or Decision provides the requester only one opportunity to correct noncompliance within a specified period of time (usually 30 days),^[4] the PTO will accept a request filed after that time; the request will simply be treated as a new request rather than a corrected request. Nevertheless, practitioners certainly would prefer to avoid missing out on a filing date in the first place. Denial of a filing date will delay the order of a reexamination, and probably require substantial attorney time to correct the request.

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An SNQ Must Be Both “Substantial” and “New”

The primary reason for rejection of reexamination requests on first filing is failure to clearly state a substantial new question of patentability (SNQ). The applicable statute requires at least one SNQ for the request to be granted.^[5] An SNQ comprises a *substantial* and *new*, non-cumulative technological teaching that was not previously considered and discussed on the record during prosecution of the original patent application or in any prior reexamination proceeding.^[6] Thus, not only must the request raise a technological teaching in a reference that a reasonable examiner would likely consider important (*i.e.*, “substantial”) to the patentability of at least one claim, but the request must also show that the teaching was not cumulative with other prior art teachings that had been considered and discussed on the record.

Avoiding a bounce

To address this issue, it is advisable to include a separate section early in the request that expressly identifies and explains every proposed SNQ for each claim. This SNQ section should focus on new technological teachings, as opposed to merely pointing out that a prior art reference, as a whole, was not previously considered and discussed on the record. To this end, it is often helpful to quote the PTO’s reasons for allowance of each independent claim for which reexamination is requested, and explain how the cited prior art fills the technological “gap(s)” that purportedly resulted in the claims being allowed or affirmed.

In this regard, it is important to keep in mind that the cited prior art does not have to be new. A previously cited reference may be used as long as it is presented in a “new light,” *e.g.*, the requester clearly identifies a teaching of the reference that was not previously addressed on the record.^[7]

In addition to at least one SNQ, a reexamination request must include a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.^[8] Another common reason for denying a reexamination request is failure to clearly explain the proposed grounds for rejection. In some cases, the alleged lack of clarity is due to incorporation of prior arguments by reference. Also, the PTO frequently objects to grouping or “lumping” of proposed alternative grounds for rejection. Both of these devices can make it more difficult for the examiner to follow the arguments in a linear fashion.

Addressing these types of objections is relatively straightforward, but can be cumbersome if the request addresses a large number of claims and/or proposed SNQs. The requester may be wise to avoid incorporating by reference prior arguments for previous claims into later arguments in the request, unless the arguments and claim limitations are nearly identical. Although incorporation by reference may often seem like an effective way to streamline a request, some examiners appear to find such incorporation confusing.

As to the “lumping” objection, it is recommended that requesters avoid referring to the alternative use of secondary references in proposed rejections with terms the PTO may consider objectionable (*e.g.*, “alternatively,” “optionally,” and “and/or”), particularly in argument headings of the request. Instead, the requester may find it prudent to provide separate headings for each proposed ground for rejection, at least for every independent claim. Thus, instead of a heading stating “claim 1 is rendered obvious over Smith in view of Jones and/or Brown” it is safer to assert separately that “claim 1 is rendered obvious over Smith in view of Jones” and “claim 1 is rendered obvious over Smith in view of Brown.” Note, however, that a super-heading that “lumps” rejections together may be proper as long as the subheadings break apart the rejections into separate, individual grounds.

In conclusion, the growing number of new reexamination requests appears to have resulted in stricter enforcement of PTO filing requirements. To avoid the extra cost and effort of filing a corrected request, it is advisable to explicitly lay out each proposed SNQ and to organize the arguments in a manner that is easy to follow in a linear fashion.

Footnotes

[1] Authors' statistical analysis of Patent Application Information Retrieval (PAIR) accessible *ex parte* reexamination requests filed between October 1, 2008 and September 30, 2009 (hereinafter "PAIR Study").

[2] As of September 30, 2009, 658 *ex parte* and 258 *inter partes* requests have been filed this year, compared with 680 *ex parte* and 168 *inter partes* requests filed in all of 2008. See *Ex Parte* Reexamination Filing Data – September 30, 2009 (http://www.uspto.gov/patents/stats/ex_parte_historical_stats_sept302009.pdf); *Inter Partes* Reexamination Filing Data – September 30, 2009 (http://www.uspto.gov/patents/stats/inter_partes_historical_stats_sept302009.pdf).

[3] MPEP § 2227 (decisions vacating a filing date are fairly uncommon and seem to account for about 5% of all *ex parte* reexamination requests; see PAIR Study, *supra*).

[4] MPEP §§ 2227 and 2627; 37 C.F.R. §§ 1.510(c) and 1.915(d).

[5] 35 U.S.C. §§ 303, 304, 312 and 313.

[6] MPEP §§ 2216, 2242, 2616 and 2642.

[7] 35 U.S.C. § 303(a); *In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008).

[8] 37 C.F.R. §§ 1.510(b) and 1.915(b).