

Proposed Rules for Supplemental Examinations Under the America Invents Act

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The Pillsbury logo, consisting of the word "pillsbury" in a lowercase, sans-serif font. The letters are a reddish-orange color. The logo is positioned on a white rectangular background that is part of a larger white banner at the bottom right of the slide.



Proposed Rules for Supplemental Examinations Under the America Invents Act

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The United States Patent and Trademark Office (PTO) published their proposed rules for implementing the Supplemental Examination provision of the Leahy-Smith America Invents Act (AIA – 35 U.S.C. §257). Written comments on the proposed rules are due on or before March 26, 2012. The rules are scheduled to go into effect prior to September 16, 2012, at which point patentees can file requests for supplemental examination.

I. Key Elements of Supplemental Examination

- Filing fee of \$21,300 (large entity) must be included – includes fee for considering request and reexamination fee (refunded if no reexamination) – extra fees as well for any document over 50 pages in length;
- Request must comply with content requirements – many items needed in request, such as list of items, detailed discussion of each issue, summary of any document over 50 pages (12 items listed in 37 C.F.R. §1.610(b)(1)-(12));
- Can only include 10 items in the request;
- Any document over 50 pages must be summarized, although documents can be redacted;
- Any issue may be considered during ex parte reexamination, including priority, Section 101, and Section 112 issues;
- If the PTO becomes aware of a material fraud on the office, they WILL refer the matter to the Attorney General.

II. Requirements for a Request for Supplemental Examination:

1.) The fee, which includes the fee for processing the Request for Supplemental Examination - \$5,180, (37 CFR 120(K)(1)) the fees for processing and treating an *ex parte* Reexamination- \$16,120 (37 CFR 120(k)(2)); and



2.) A Request for Supplemental Examination

The Request for Supplemental Examination requires a number of “components,” and if deficient, the patentee will be notified and given an opportunity to cure the defect. The filing date of the request will be the date upon which a complete request is filed. The PTO then will have 3 months to process and consider the Request. Processing the request can result in one of two decisions:

A. No Substantial New Question of Patentability – PTO electronically issues a supplemental examination certificate in due course

B. There is a Substantial New Question of Patentability – PTO orders *ex parte* reexamination. *Ex parte* reexamination not limited to prior art and printed publications. Upon conclusion of reexamination, PTO issues an *ex parte* reexamination certificate that indicates that reexamination was ordered under 35 U.S.C. §257.

NOTE: The rules do not state that the decision as to whether the request for supplemental examination raises a substantial new question of patentability is not appealable. For *Inter Partes* review and *ex parte* reexamination, the decision of the Director is not appealable (*see* 35 U.S.C. §314(d) for *Inter Partes* review, and 35 U.S.C. §303(c) for *ex parte* reexamination). For requests for supplemental examination, however, the decision appears to be appealable.

A. 37 C.F.R. §1.601 governs who may file a request

37 CFR 1.601 governs the filing of a request for supplemental examination. 1.601(a) states that the request can only be filed by the patent owner; 1.601(b) requires the owner to establish an ownership interest in accordance with §3.73(b); and 1.601(c) precludes third parties from filing papers.

B. 37 C.F.R. §1.605 governs the items of information to be submitted

1.605(a) - the request for supplemental examination is limited to ten (10) items of information that may be submitted as part of the request;

1.605(b) - an item of information includes a supporting document – if no document (e.g., a video deposition (transcript should be submitted – see 1.605(c)), or a sales receipt to support a 102(b) sale), then the description of that item in the body of the request will be considered an item for purposes of the ten item limit;

1.605(c) – item must be in writing in accordance with §1.2. To be considered, any audio or video recording must be submitted in the form of a written transcript;

1.605(d) – each item of information used in a combination may be counted separately, except translation of non-English language document, and a combination



of a document that is over 50 pages in length and its summary pursuant to §1.610(b)(11)

III. Content of the Request - governed by 37 CFR 1.610:

The request for supplemental examination must meet certain content requirements. Specifically, the request for supplemental examination must include:

- an identification of the patent for which supplemental examination is requested;
- a list of each item of information and its publication date, if applicable – limited to 10 items for each request for supplemental examination;
- a list identifying any other prior or concurrent post patent Office proceedings involving the patent to be examined;
- an identification of each aspect of the patent to be examined;
- an identification of each issue raised by each item of information;
- a separate, detailed explanation for each identified issue;
- an explanation of how each item of information is relevant to each aspect of the patent to be examined and of how each item of information raises each identified issue;
- a copy of each item of information; and a summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length.

A request for supplemental examination that does not comply with the content requirements may not be granted a filing date.

A. §1.610 governs the content of the request

1.610(a) – Request must be accompanied by fee for filing (1.20(k)(1) - \$5,180); fee for reexamination (1.20(k)(2) - \$16,120); plus any applicable document size fees (1.20(k)(3) - \$170 for between 21-50 sheets; and \$280 for each additional 50 sheets or a fraction thereof). – Cannot print on both sides because rules state that papers must be in compliance with 37 C.F.R. §1.52, (*see* 37 C.F.R. §1.615(a)), which requires writing on only one side in portrait orientation.

1.610(b) - A request for supplemental examination must include each of the elements set forth in paragraphs (b)(1) through (b)(12) of this section.

- (1) A cover sheet itemizing each component submitted as part of the request.



NOTE: The term “component” may include a certificate of mailing, the request, the patent to be examined, the item(s) of information, and any other separate document.

(2) A table of contents for the request.

(3) An identification of the number, the date of issue, and the first named inventor of the patent for which supplemental examination is requested.

(4) A list of each item of information that is requested to be considered, reconsidered, or corrected, and the publication date for each item of information, if applicable; and a statement that:

(i) Identifies each item of information that was not considered in the prior examination of the patent, and explains why consideration of the item of information is being requested;

(ii) Identifies each item of information that was not adequately considered in the prior examination of the patent, and explains why reconsideration of the item of information is being requested; and

(iii) Identifies each item of information that was incorrect in the prior examination of the patent, and explains how it is being corrected.

NOTE: If the item of information is a discussion contained within the body of the request, the pages of the request on which the discussion appears, a brief description of the item of information, such as “discussion in request of why the claims are patentable under 35 U.S.C. 101, pages 7–11”, must be listed as an “item” and counted against the 10 item limit.

The patent owner may present a corrected declaration under Rule 132 and explain how the previously submitted, erroneous data is being corrected. The corrected declaration is considered an “item” to be counted against the 10 item limit.

If a portion of a document is being used to support an argument by the patentee, and that portion (e.g., an image) is included in the request, then the full supporting document must be listed and counted as an “item” in determining the 10 item limit.

NO AMENDMENTS – If an amendment is needed, then the patent owner should file a reissue. Amendments may be made during *ex parte* reexamination, if ordered under 35 U.S.C. §257, but not in the request for supplemental examination.

(5) A list identifying any other prior or concurrent post patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding (e.g., *ex parte* or *inter*



partes reexamination, reissue, supplemental examination, post-grant review, or *inter partes* review), the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding.

(6) An identification of each aspect of the patent for which supplemental examination is sought, including an identification of the structure, material, or acts in the specification that correspond to each means-plus-function or step-plus-function element, as set forth in 35 U.S.C. 112(f), in any claim to be examined.

NOTE: An “aspect” of the patent includes the abstract, any drawing, specification, patent claims, or benefit claims.

(7) An identification of each issue raised by each item of information.

(8) A separate, detailed explanation for each identified issue, discussing how each item of information is relevant to each aspect of the patent identified for examination, and how each item of information raises each issue identified for examination, including:

(i) Where an identified issue involves the application of 35 U.S.C. 101 (other than double patenting) or 35 U.S.C. 112, an explanation discussing the support in the specification for each limitation of each claim identified for examination with respect to this issue; and

(ii) Where an identified issue involves the application of 35 U.S.C. 102, 35 U.S.C. 103, or double patenting, an explanation of how each limitation of each claim identified for examination with respect to this issue is met, or is not met, by each item of information. The detailed explanation may also include an explanation of how the claims distinguish over the items of information.

NOTE: The rules state that the detailed discussion of issues regarding prior art should be similar to the requirements for a detailed explanation under 37 C.F.R. §1.510(b)(2) in a request for *ex parte* reexamination. The rules prefer the use of claim charts that match the claim limitation to cited portions of the item of information, as applicable.

(9) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer, certificate of correction, certificate of extension, supplemental examination certificate, post grant review certificate, *inter partes* review certificate, or reexamination certificate issued for the patent.

(10) A copy of each item of information listed in paragraph (b)(3) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language document. Items of information that form



part of the discussion within the body of the request as specified in § 1.605(b), and copies of U.S. patents and U.S. patent application publications, are not required to be submitted.

(11) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.

NOTE: The proposed rules encourage patent owners to redact portions of lengthy documents to include only the relevant portions, unless the redaction would remove context such that the examiner would not be provided with a full indication of the relevance of the information (*see* 37 C.F.R. §1.615(b)). Patents and US patent application publications do not need to be submitted, and consequently, 1.610(b)(11) does not apply to lengthy US patents and published applications.

(12) A submission by the patent owner in compliance with § 3.73(b) of this chapter establishing the entirety of the ownership in the patent requested to be examined as set forth in § 1.601(b).

1.610(c) - The request may also include an explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

NOTE: The proposed rules strongly encourage patent owners to submit such an explanation, stating that it will assist the Office in analyzing the request.

1.610(d) - The filing date of a request for supplemental examination will not be granted if the request is not in compliance with § 1.605, § 1.615, and this section. A defective request may receive a filing date if the defects are limited to the omission of one or more of the requirements set forth in paragraph (b)(1) or (b)(2) of this section, subject to the discretion of the Office.

1.610(e) - If the Office determines that the request, as originally submitted, does not meet the requirements of paragraph (d) of this section to be entitled to a filing date, the patent owner will be so notified and will be given an opportunity to complete the request within a specified time. If the patent owner does not timely comply with the notice, the request for supplemental examination will not be granted a filing date and the fee for reexamination as set forth in § 1.20(k)(2) will be refunded. If the patent owner timely files a corrected request in response to the notice that properly addresses all of the defects set forth in the notice and that otherwise complies with all of the requirements of §§ 1.605, 1.615 and of this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.



B. §1.615 governs the format of the request

1.615 (a) - All papers submitted in a supplemental examination proceeding must be formatted in accordance with § 1.52, including the request for supplemental examination and any other documents generated by the patent owner/requester, such as translations of non-English language documents, transcripts of audio or video recordings, affidavits or declarations, and summaries of documents over 50 pages in length pursuant to § 1.610(b)(11). Exceptions include tables of contents, curriculum vitae, claim charts, court documents, third-party generated affidavits or declarations, and any other document generated by a third party, including patents, patent application publications, and non patent literature. All documents must be presented in a form having sufficient clarity and contrast between the paper and the text or image to permit the direct reproduction of readily legible copies by use of digital imaging and optical character recognition.

NOTE: 37 C.F.R. § 1.52 requires papers submitted to the office to be printed on one side only. Thus, the 50 page limit for submissions cannot be met if a document is printed on both sides.

1.615 (b) - Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents, and, if a court document, to the document submitted in court, and must not otherwise be reduced in size or modified, particularly in terms of font type, font size, line spacing, and margins. Patents, patent application publications, and third-party-generated affidavits or declarations must not be reduced in size or otherwise modified in the manner described in this paragraph.

C. §1.620 governs the consideration of the Request by the PTO

1.620(a) - Within three months following the filing date of a request for supplemental examination, the Office will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information presented in the request. The determination will generally be limited to a review of the issues identified in the request as applied to the identified aspects of the patent. The determination will be based on the claims in effect at the time of the determination and will become a part of the official record of the patent.

NOTE: The standard set forth in the MPEP will be used to determine if there is a substantial new question of patentability – “whether there is a substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability (MPEP §2242 (8th ed. 2001) [Rev. 8, July 2010]). The determination will be based only on the information submitted and only



for the issues presented. For example, if the request lists 3 items of information that raise an issue under §102 with respect to claim 1, then that is all the Director will consider. Those 3 items will not be considered under §103, or for any other claims.

As stated previously, the determination by the Director appears to be appealable. There is nothing in the rules or the statute that precludes an appeal of the Director's decision.

1.620(b) - The Office may hold in abeyance action on any petition or other paper filed in a supplemental examination proceeding until after the proceeding is concluded by the electronic issuance of the supplemental examination certificate as set forth in § 1.625.

1.620(c) - If an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently entered, it will be expunged.

1.620(d) - The patent owner must, as soon as possible upon the discovery of any other prior or concurrent post patent Office proceeding involving the patent for which the current supplemental examination is requested, file a paper limited to notice of the post patent Office proceeding, if such notice has not been previously provided with the request. The notice shall be limited to an identification of the post patent proceeding, including the type (*e.g.*, *ex parte* or *inter partes* reexamination, reissue, supplemental examination, post-grant review, or *inter partes* review), the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding, without any discussion of the issues of the current supplemental examination proceeding or of the identified post patent Office proceeding(s).

NOTE: The notice should be very brief and only identify the other proceeding. No comments or discussion of issues are permitted.

1.620(e) - Interviews are prohibited in a supplemental examination proceeding.

NOTE – Interviews will be permitted during *ex parte* reexamination, if ordered. It is only during supplemental examination – this is to permit the Director to make the determination within 3 months. A call to the clerk regarding formatting or according a filing date is not considered an interview.

1.620(f) - No amendment to any aspect of the patent may be filed in a supplemental examination proceeding.

1.620(g) - If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under 35 U.S.C. 257, of a material fraud



on the Office involving the patent requested to be examined, the supplemental examination proceeding or any reexamination proceeding ordered under 35 U.S.C. 257 will continue, and the matter will be referred to the U.S. Attorney General in accordance with 35 U.S.C. 257(e).

NOTE: No discretion is permitted in the rules or in the statute (35 U.S.C. §257(e)) for referring the matter to the US Attorney General. If the PTO becomes aware of a material fraud, they **WILL** refer the matter to the Attorney General.

IV. Conclusion of Supplement Examination

A. § 1.625 Conclusion of supplemental examination

1.625(a) A supplemental examination proceeding will conclude when the supplemental examination certificate is electronically issued. The supplemental examination certificate will indicate the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.

NOTE: The certificate will be electronically issued and available on PAIR.

1.625(b) 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 of the patent will be ordered under 35 U.S.C. 257. Upon the conclusion of the *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. The electronically issued supplemental examination certificate will remain as part of the public record of the patent.

1.625(c) If the supplemental examination certificate indicates that no substantial new question of patentability is raised by any of the items of information in the request, and *ex parte* reexamination is not ordered under 35 U.S.C. 257, the electronically issued supplemental examination certificate will be published in due course. The reexamination fee for supplemental examination, as set forth in § 1.20(k)(2), will be refunded in accordance with § 1.26(c).

1.625(d) Any *ex parte* reexamination ordered under 35 U.S.C. 257 will be conducted in accordance with §§ 1.530 through 1.570, which govern *ex parte* reexamination, except that:

(1) The patent owner will not have the right to file a statement pursuant to § 1.530, and the order will not set a time period within which to file such a statement;



(2) Reexamination of any aspect of the patent may be conducted on the basis of any item of information as set forth in § 1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding § 1.552(a);

(3) 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, notwithstanding § 1.552(c); and

(4) Information material to patentability will be defined by § 1.56(b), notwithstanding § 1.555(b).

NOTE: The rules appear to give the PTO authority to consider any issues during reexamination ordered pursuant to 1.625(b), and is not limited solely to those issues raised in the request. Supplemental examination therefore opens up the issued patent to areas of attack similar to what might occur during a reissue proceeding.