



# AMERICA INVENTS ACT

## IMPLEMENTATION

# Supplemental Examination

## NCET<sub>2</sub> WEBINAR

# Supplemental Examination

- 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
- Provides patentees with an alternative to litigating inequitable conduct allegations

# Supplemental Examination 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.

# Supplemental Examination

- 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))

# Supplemental Examination Filing of Papers

- A request for supplemental examination must be filed by owner(s) of the entire right, title, and interest in the patent. (§ 1.601(a)).
  - The scope of the patent claims may be changed (e.g., by cancellation or amendment) during any reexamination resulting from a supplemental examination proceeding.
  - The change in scope will be binding on all parties having an ownership interest in the patent.

# Supplemental Examination 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 parties may not request supplemental examination or participate in a supplemental examination proceeding (§ 1.601(b)).

# Supplemental Examination 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.

# Supplemental Examination 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.

# Supplemental Examination Items of Information

- An item of information must be in writing. Any audio or video recording must be filed in the form of a written transcript. (§ 1.605(c)).
- If an item of information is combined in the request with one or more additional items of information, each item of information of the combination may be separately counted. (§ 1.605(d)).
  - For example:

If a patent owner requests the Office to consider the patentability of the claims in view of a combination of reference A and reference B, reference A and reference B may be separately counted, resulting in two items of information.



# Supplemental Examination Items of Information

- Any one item of information may raise multiple issues of patentability. For example:
  - A document, which raises issues under 35 U.S.C. 101 and also under 35 U.S.C. 112 with respect to the original disclosure, will be counted as one item of information.
- The Office will count the number of items of information, but will not count the number of issues raised by any one item.

# Supplemental Examination Items of Information

- A declaration or affidavit may be counted as an item of information.
  - If the declaration presents one item of information, such as information regarding erroneous data presented during the prior examination with respect to an issue under 35 U.S.C. 103 affecting claim 10 of the patent, and relies on, or refers to, a single exhibit such as a new table of data to support facts presented in the declaration, then the declaration and the single supporting exhibit may be counted together as one item of information.

# Supplemental Examination Items of Information

- Cumulative items of information may be separately counted.
- When considering the submission, as items of information, of multiple documents that are believed to be cumulative, the Office recommends the selection of one or two of the documents as the items of information that will be submitted with the request.

# Supplemental Examination Fees

- A request for supplemental examination must include payment of the following fees:

Service	Cost
Filing fee (for processing and treating a request for supplemental examination)	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
<b>TOTAL</b>	<b>\$21,260</b>
<b>REFUND</b> (if the Office decides not to order an ex parte reexamination proceeding)	<b>\$16,120</b>

- Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length

# Supplemental Examination Request Requirements

The request must also include:

- An identification of the number of the patent for which supplemental examination is requested. (§ 1.610(b)(1))

# Supplemental Examination Request Requirements

- A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of § 1.98(b). (§ 1.610(b)(2))
  - If the item of information is a discussion within the body of the request as set forth in § 1.605(b), the pages of the request on which the discussion appears, and a brief description of the item of information, such as “discussion in request of why claims are patentable under 35 U.S.C. 101, pages 7-11” must be listed.

# Supplemental Examination Request Requirements

- A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is requested (§ 1.610(b)(3)), including :
  - The type of proceeding (*e.g.*, a reissue application, or an *ex parte* or *inter partes* reexamination, supplemental examination, post-grant review, or *inter partes* review proceeding);
  - The identifying number (*e.g.*, control number or reissue application number); and
  - The filing date of the proceeding.

# Supplemental Examination Request Requirements

- An identification of each claim of the patent for which supplemental examination is requested. (§ 1.610(b)(4))
- 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

# Supplemental Examination Request Requirements

- A legible copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent.  
(§ 1.610(b)(6))
  - A “certificate issued for the patent” includes, *e.g.*, a certificate of correction, a certificate of extension, a supplemental examination certificate, a post-grant review certificate, an *inter partes* review certificate, an *ex parte* reexamination certificate, and/or an *inter partes* reexamination certificate issued for the patent.

# Supplemental Examination Request Requirements

- A legible copy of each item of information including:
  - A written English language translation of all of the necessary and pertinent parts of any non-English language document. (§ 1.610(b)(7))
- Copies of U.S. patents and U.S. patent application publications are not required, but are encouraged to be submitted.
- Copies of items of information that form part of the discussion within the body of the request as specified in § 1.605(b) are not required to be submitted.

# Supplemental Examination Request Requirements

- A summary of the relevant portions of any submitted document (including patent documents), other than the request, that is over 50 pages in length. § 1.610(b)(8).
  - The summary must include citations to the particular pages containing the relevant portions.
  - Redaction of lengthy documents is encouraged, unless the redaction would remove the context of the relevant portions.

# Supplemental Examination Request Requirements

- An identification of the owner(s) of the entire right title, and interest in the patent requested to be examined. (§ 1.610(b)(9))
- A submission by the patent owner in compliance with § 3.73(c) establishing the entirety of the ownership in the patent requested to be examined. (§ 1.610(b)(9))

# Supplemental Examination Optional Request Components

- A table of contents for the request (§ 1.610(c)(2));
- An explanation of how the claims are patentable over an item of information (§ 1.610(c)(3)); and
- An explanation of why each item of information submitted as part of the request does or does not raise a substantial new question of patentability (§ 1.610(c)(4)).

# Supplemental Examination Filing Date of Request

- A request will not be granted a filing date if it is not in compliance with all of the requirements for the request, including the requirements for the number of items of information, and for the content and format of the request. (§ 1.610(d))
  - The granting of a filing date is subject to the discretion of the Office. For example, a filing date may be granted to a request if the only defect in the request is the presence of improper margins, but the text is legible and reproducible.

# Supplemental Examination Filing Date of Request

- If the Office determines that the request, as originally submitted, is not entitled to a filing date, the patent owner will be notified and will be given an opportunity to complete the request within a specified time. (§ 1.610(d))
  - A procedure is being established in which the request, and any other papers or information submitted as part of or accompanying the request, will not be available in Public PAIR until the request is granted a filing date.

# Supplemental Examination Filing Date of Request

- If, in response to the notice informing the patent owner that the request is not entitled to a filing date, the patent owner does not timely file a corrected request that complies with all of the requirements of the request as set forth in §§ 1.605, 1.610, and 1.615 , then:
  - the request will not be granted a filing date,
  - the processing of the request will be terminated, and
  - the fee for reexamination will be refunded. § 1.610(d).

# Supplemental Examination Filing Date of Request

- If, in response to the notice, the patent owner timely files a corrected request that properly addresses all of the defects set forth in the notice, and that otherwise complies with all of the requirements of the request as set forth in §§ 1.605, 1.610, and 1.615, then **the filing date of the request will be the receipt date of the corrected request.** (§ 1.610(d))

# Supplemental Examination 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.

# Supplemental Examination 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.

# Supplemental Examination 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.

# Supplemental Examination 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.

# Supplemental Examination 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.

# Supplemental Examination 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 will be refunded. (§ 1.625(c))

# Supplemental Examination 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).

# Supplemental Examination 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));

# Supplemental Examination 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))