

# Chapter 2800 Supplemental Examination

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## 2801 Introduction [R-11.2013]

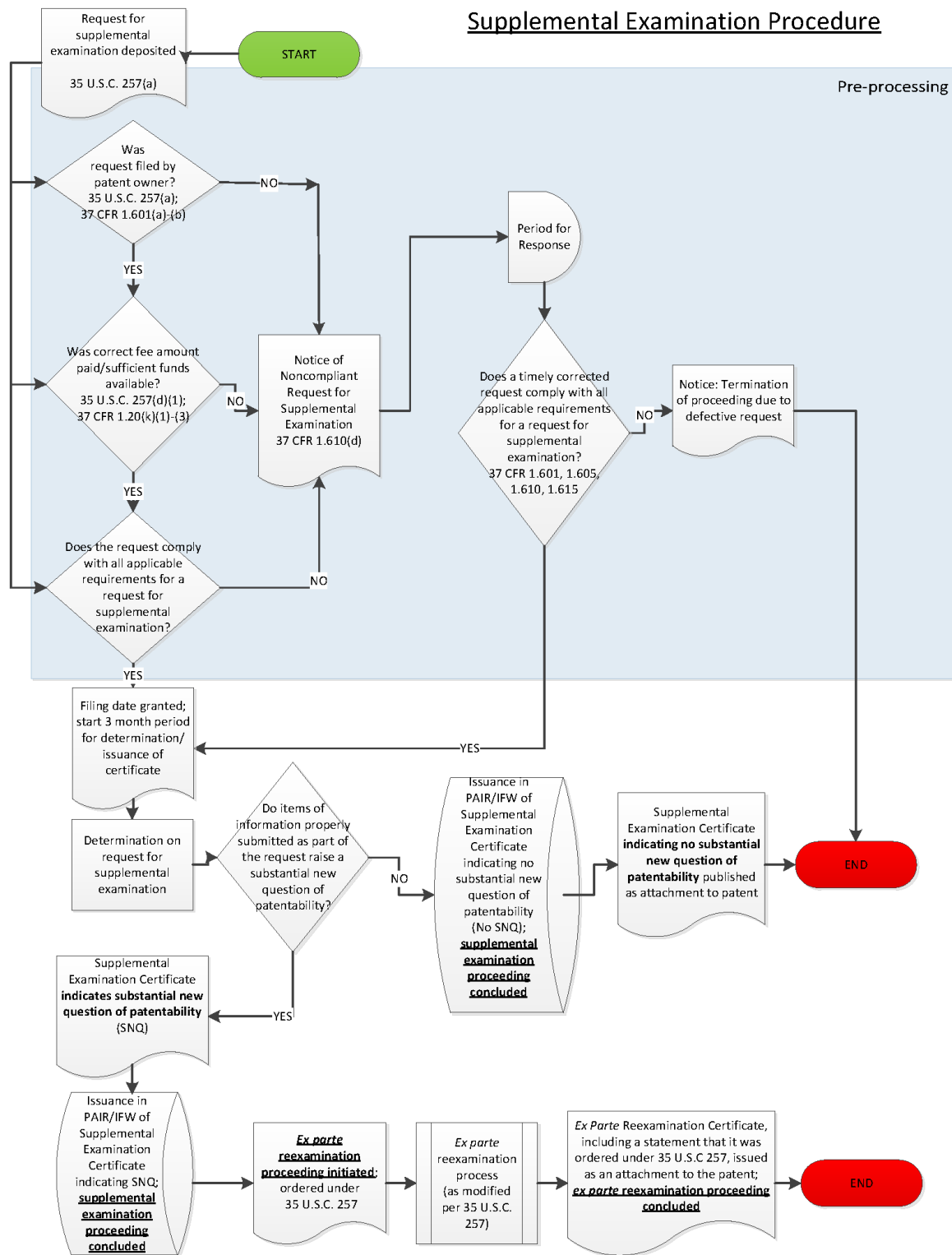
Supplemental examination became available on September 16, 2012, as a result of new section 257 of Title 35, United States Code, which was added by Public Law 112-29, enacted on September 16, 2011, known as the Leahy-Smith America Invents Act (AIA). Supplemental examination provisions of the AIA provide a patent owner with a mechanism to request that the Office consider, reconsider, or correct information believed to be relevant to the patent. The rules of practice in patent cases relating to supplemental examination were promulgated on August 14, 2012, at 77 Fed. Reg. 48828-48853.

Unlike *ex parte* reexamination practice, the information that the patent owner may request to be considered, reconsidered, or corrected in a supplemental examination proceeding is not limited to patents and printed publications. The "information" may include any information that the patent owner believes to be relevant to the patent. For example, the information may include not only

a patent or a journal article, but also a sales invoice, or a transcript of an audio or video recording. In addition, the information submitted as part of a request for supplemental examination may involve any ground of patentability, such as, for example, patent eligible subject matter, anticipation, public use or sale, obviousness, written description, enablement, indefiniteness, and double-patenting.

The flowchart below shows the general procedure for a supplemental examination proceeding, and for an *ex parte* reexamination proceeding initiated/ordered as a result of a supplemental examination proceeding.

### Supplemental Examination Procedure



## 2802 Supplemental Examination [R-11.2013]

### 35 U.S.C. 257 Supplemental examinations to consider, reconsider, or correct information.

(a) REQUEST FOR SUPPLEMENTAL EXAMINATION.—A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.

(b) REEXAMINATION ORDERED.—If the certificate issued under subsection (a) indicates that a substantial new question of patentability is raised by 1 or more items of information in the request, the Director shall order reexamination of the patent. The reexamination shall be conducted according to procedures established by chapter 30, except that the patent owner shall not have the right to file a statement pursuant to section 304. During the reexamination, the Director shall address each substantial new question of patentability identified during the supplemental examination, notwithstanding the limitations in chapter 30 relating to patents and printed publication or any other provision of such chapter.

(c) EFFECT.—

(1) IN GENERAL.—A patent shall not be held unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent. The making of a request under subsection (a), or the absence thereof, shall not be relevant to enforceability of the patent under section 282.

(2) EXCEPTIONS.—

(A) PRIOR ALLEGATIONS.—Paragraph (1) shall not apply to an allegation pled with particularity in a civil action, or set forth with particularity in a notice received by the patent owner under section 505(j)(2)(B)(iv)(II) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355(j)(2)(B)(iv)(II)), before the date of a supplemental examination request under subsection (a) to consider, reconsider, or correct information forming the basis for the allegation.

(B) PATENT ENFORCEMENT ACTIONS.—In an action brought under section 337(a) of the Tariff Act of 1930 (19 U.S.C. 1337(a)), or section 281 of this title, paragraph (1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or corrected pursuant to a supplemental examination request under subsection (a), unless the supplemental examination, and any reexamination ordered pursuant to the request, are concluded before the date on which the action is brought.

(d) FEES AND REGULATIONS.—

(1) FEES.—The Director shall, by regulation, establish fees for the submission of a request for supplemental examination of a patent, and to consider each item of information

submitted in the request. If reexamination is ordered under subsection (b), fees established and applicable to *ex parte* reexamination proceedings under chapter 30 shall be paid, in addition to fees applicable to supplemental examination.

(2) REGULATIONS.—The Director shall issue regulations governing the form, content, and other requirements of requests for supplemental examination, and establishing procedures for reviewing information submitted in such requests.

(e) FRAUD.—If the Director becomes aware, during the course of a supplemental examination or reexamination proceeding ordered under this section, that a material fraud on the Office may have been committed in connection with the patent that is the subject of the supplemental examination, then in addition to any other actions the Director is authorized to take, including the cancellation of any claims found to be invalid under section 307 as a result of a reexamination ordered under this section, the Director shall also refer the matter to the Attorney General for such further action as the Attorney General may deem appropriate. Any such referral shall be treated as confidential, shall not be included in the file of the patent, and shall not be disclosed to the public unless the United States charges a person with a criminal offense in connection with such referral.

(f) RULE OF CONSTRUCTION.—Nothing in this section shall be construed—

(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1001(a) of title 18, the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition);

(2) to limit the authority of the Director to investigate issues of possible misconduct and impose sanctions for misconduct in connection with matters or proceedings before the Office; or

(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by representatives practicing before the Office.

[35 U.S.C. 257\(a\)](#) provides that supplemental examination may be requested by the patent owner to consider, reconsider, or correct information believed to be relevant to the patent in accordance with requirements established by the Office. The information presented in a request for supplemental examination is not limited to patents and printed publications, and may include, for example, issues of patentability under [35 U.S.C. 101](#) and [112](#). Within three months of the receipt of a request for supplemental examination (meeting the requirements of [35 U.S.C. 257](#) including the requirements established by the Office), the Office shall conduct a supplemental examination and conclude the supplemental examination proceeding with the issuance of a supplemental examination certificate. The supplemental examination certificate shall

indicate whether the items of information presented in the request raise a substantial new question of patentability.

If the supplemental examination certificate, issued under [35 U.S.C. 257\(a\)](#), indicates that a substantial new question of patentability is raised by one or more items of information in the request for supplemental examination, the supplemental examination certificate will indicate that *ex parte* reexamination will be ordered by the Office. The resulting *ex parte* reexamination proceeding will be conducted according to *ex parte* reexamination procedures, except that the patent owner does not have the right to file a statement pursuant to [35 U.S.C. 304](#), and the basis of the *ex parte* reexamination is not limited to patents and printed publications. Each substantial new question of patentability identified during the supplemental examination proceeding will be addressed by the Office during the resulting *ex parte* reexamination proceeding. See [35 U.S.C. 257\(b\)](#).

[35 U.S.C. 257\(c\)](#) specifies the effect of a supplemental examination under [35 U.S.C. 257\(a\)](#) and any resulting *ex parte* reexamination under [35 U.S.C. 257\(b\)](#) on the enforceability of the patent.

[35 U.S.C. 257\(d\)\(1\)](#) provides the Director with authority to establish fees for filing a request for supplemental examination and for considering each item of information submitted with the request. If *ex parte* reexamination is ordered under [35 U.S.C. 257\(b\)](#), [35 U.S.C. 257\(d\)\(1\)](#) also establishes that the fees applicable to *ex parte* reexamination must be paid in addition to the fees for supplemental examination. [35 U.S.C. 257\(d\)\(2\)](#) provides the Director with authority to establish regulations governing the requirements of a request for supplemental examination, including its form and content.

In accordance with [35 U.S.C. 257\(e\)](#), if the Office becomes aware, during the course of a supplemental examination or *ex parte* reexamination ordered under [35 U.S.C. 257](#), that a material fraud on the Office may have been committed in connection with the patent that is the subject of the supplemental examination, the Office shall refer the matter to the U.S. Attorney General, in addition to any other

actions the Office is authorized to take, including the cancellation of any claims found to be invalid under [35 U.S.C. 307](#) as a result of *ex parte* reexamination ordered under [35 U.S.C. 257](#). The Office anticipates that such instances will be rare. The Office regards the term “material fraud” in [35 U.S.C. 257\(e\)](#) to be narrower in scope than inequitable conduct as defined by the U.S. Court of Appeals for the Federal Circuit in *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011).

Nothing in [35 U.S.C. 257](#) precludes the imposition of sanctions based upon criminal or antitrust laws (including 18 U.S.C. 1001(a)), the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition. See [35 U.S.C. 257\(f\)\(1\)](#). Section 12 of the AIA sets forth rules of construction, providing that [35 U.S.C. 257](#) shall not be construed to limit the authority of the Office to investigate issues of possible misconduct and impose sanctions for misconduct involving matters or proceedings before the Office, or to issue regulations under [35 U.S.C. 32](#) or [35 U.S.C. 33](#) relating to sanctions for misconduct by patent practitioners. See [35 U.S.C. 257\(f\)\(2\)](#) and [35 U.S.C. \(f\)\(3\)](#).

## 2803 Persons Who May File a Request for Supplemental Examination [R-11.2013]

### *37 CFR 1.601 Filing of papers in supplemental examination.*

(a) A request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest in the patent.

\*\*\*\*\*

Only a patent owner may file a request for supplemental examination of a patent. See [35 U.S.C. 257\(a\)](#) and [37 CFR 1.601\(a\)](#). The statute does not authorize the Office to accept a request for supplemental examination from a party who is not the patent owner. For example, a party who merely states that it is an exclusive licensee or that it is a person with sufficient proprietary interest under [35 U.S.C. 118](#) is not eligible to file a request for supplemental examination.

The request must be filed by the owner(s) of the entire right, title, and interest in the patent. A request for supplemental examination must include an

identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with [37 CFR 3.73\(c\)](#) establishing the entirety of the ownership in the patent requested to be examined. See [37 CFR 1.610\(b\)\(9\)](#). This is because the terms of a patent may be changed (e.g., by cancellation or amendment of the claims) during any *ex parte* reexamination proceeding that may be ordered as a result of the supplemental examination proceeding, and this change must be binding on all parties having an ownership interest in the patent. Furthermore, the Office has consistently required that all parties having an interest in a patent are deemed “a patent owner” as a composite entity and must act together in proceedings before the Office. See [MPEP §§ 301 and 324](#). This is also consistent with *ex parte* reexamination practice, which requires a patent owner requester of an *ex parte* reexamination to comply with the provisions of [37 CFR 3.71](#) and [37 CFR 3.73](#) for establishing an assignee’s right to take action when submitting a power of attorney. See [MPEP § 2222](#).

The Office may, under rare circumstances, permit less than all of the owners to file a request for supplemental examination if a grantable petition under [37 CFR 1.183](#) requesting waiver of the provisions of [37 CFR 3.71](#) and [37 CFR 3.73\(c\)](#) is filed. For example, such a petition may be filed in the case of a deceased or legally incapacitated joint owner, or where the *joint* owner refuses to join or cannot be found after diligent effort. See [MPEP § 409 et seq.](#) In the case of a deceased joint owner, the heirs, administrators, or executors of the joint owner may be permitted to join in filing the request for supplemental examination. If one of the owners is legally incapacitated, the legal representative of the joint owner may be permitted to join in filing the request for supplemental examination. If a joint owner refuses to sign or cannot be found or reached after diligent effort, the remaining owners must include, in the petition, proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and the last known address of all of the joint owners. Finally, if an owner of all or a portion of the entire right, title, and interest of the patent is an organization that is dissolved, the Office may require that a determination of the ownership of the patent

be obtained from a court of competent jurisdiction prior to accepting and according a filing date to a request for supplemental examination.

A legal representative of the patent owner may file a request for supplemental examination on behalf of the patent owner. See [MPEP § 2804](#).

### **2803.01 Inquiries from Persons Other Than the Patent Owner [R-11.2013]**

#### *37 CFR 1.601 Filing of papers in supplemental examination.*

\*\*\*\*\*

(b) Any party other than the patent owner (*i.e.*, any third party) is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding.

\*\*\*\*\*

[37 CFR 1.601\(b\)](#) prohibits third parties from filing papers or otherwise participating in any manner in a supplemental examination proceeding. In addition, because only the patent owner can file the request for supplemental examination, third party participation is prohibited in any *ex parte* reexamination ordered under [35 U.S.C. 257](#) and [37 CFR 1.625](#), pursuant to *ex parte* reexamination practice.

Office personnel, including both the examining and the technical support staff, should not enter into a discussion with, or answer inquiries from, third parties (*i.e.*, parties who are not the patent owner) regarding a supplemental examination proceeding. A party who is not the patent owner should be referred to the Central Reexamination Unit (CRU) Supervisory Patent Reexamination Specialist (SPRS) in the art unit of the assigned examiner. Only questions on strictly general procedural matters regarding supplemental examination, *i.e.*, not directed to any specific supplemental examination proceeding, may be discussed by the CRU SPRS with that party.

Employees of the Office, particularly CRU examiners who have conducted a supplemental examination proceeding that has been concluded, should not discuss or answer inquiries from any person outside the Office as to whether a certain reference or other particular evidence was considered during the proceeding, and whether that reference,

or other evidence, would have been determined to raise a substantial new question of patentability, had it been considered during the proceeding. Patent practitioners (or other members of the public) must not address improper inquiries to members of the patent examining corps and to the Office as a whole. Inquiries from members of the public relating to the matters discussed above must, of necessity, be refused and this refusal should not be considered discourteous or an expression of opinion by the Office as to the validity, patentability, or enforceability of the patent.

The definitions set forth in [37 CFR 104.1](#) and the exceptions in [37 CFR 104.21](#) are applicable to this section.

### **2803.02 Public Access [R-11.2013]**

The Office does not intend to provide the public with access, by Public PAIR or otherwise, to a request for supplemental examination, or to any papers or information submitted as part of or accompanying the request, until the request is granted a filing date by the Office.

After a filing date has been accorded the request, supplemental examination files are open to inspection by the general public by way of Public PAIR which is available on the USPTO's Internet site, [www.uspto.gov](http://www.uspto.gov). See [MPEP § 2232](#) (access guidance for PAIR). Copies of non-patent literature (NPL) cited in the proceeding, however, will not be available via Public PAIR and must be ordered as set forth below.

If a copy of the supplemental examination file or NPL cited in the proceeding is desired, it may be ordered from the Document Services Division of the Office of Public Records (OPR) upon payment of the applicable fee after the request for supplemental examination has been granted a filing date.

Orders for such copies must indicate the control number of the proceeding and should be addressed as follows:

Mail Stop Document Services  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

In addition, after the request for supplemental examination has been granted a filing date, a request for a copy of the file may also be sent via email to: [dsd@uspto.gov](mailto:dsd@uspto.gov), and the fee for the copy may be charged to a credit card or deposit account.

### **2804 Representative of Patent Owner [R-11.2013]**

Where an attorney or agent files a request on behalf of a patent owner, he or she may act under a power of attorney under [37 CFR 1.32](#), or in a representative capacity under [37 CFR 1.34](#). In order to act in a representative capacity under [37 CFR 1.34](#), an attorney or agent must provide his or her registration number, name, and signature. In order to act under a power of attorney from a patent owner, an attorney or agent must be provided with a power of attorney by the patent owner. Pursuant to [37 CFR 1.32\(c\)](#) a “power of attorney may only name as representative” either one or more inventors or registered patent practitioners. Thus, an attorney or agent representing a patent owner must be a registered patent practitioner. A patent owner may not be represented during a supplemental examination proceeding or any resulting *ex parte* reexamination proceeding by an attorney or other person who is not registered to practice before the Office.

**Any correspondence from the Office will be directed to the patent owner at the address indicated in the file of the patent for which supplemental examination is requested, pursuant to [37 CFR 1.33\(c\)](#), regardless of the address of the person filing the request**. If the patent owner wishes the Office to direct correspondence regarding the supplemental examination proceeding to an address other than the official correspondence address of record in the file of the patent, then the patent owner must file a change of correspondence address **in the file of the patent**. A change of correspondence address should also be filed in the supplemental examination proceeding. See [MPEP § 2805](#).

### **2804.01 Withdrawal of Attorney or Agent [R-11.2013]**

For a practitioner to withdraw from representation in a patent, supplemental examination proceeding, or a reexamination proceeding, the Office no longer requires that there be at least 30 days remaining in any running period for response between the approval of a request to withdraw and the expiration date of any running period for response. Instead, pursuant to [37 CFR 11.116\(d\)](#), a practitioner must take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. "Reasonable notice" should allow for a reasonable amount of time for the client to seek the services of another practitioner prior to the expiration of any applicable response period. When the correspondence address changes as a result of the withdrawal, the withdrawing practitioner(s) must request that the Office direct all future correspondence to the patent owner of record. Practitioners may do so by specifying either the correspondence address of the patent owner, or the address associated with the Customer Number of the patent owner. Withdrawing practitioner(s) cannot change the correspondence address to the address associated with the Customer Number of another law firm, or to any address other than that of the patent owner of record. See [MPEP §§ 402.06](#) and [2805](#).

### **2805 Correspondence with Patent Owner; Patent Owner Address [R-07.2015]**

The correspondence address of record for the patent for which supplemental examination is requested is the correct address for all notices, official letters, and other communications for patent owners in supplemental examination proceedings. This is consistent with reexamination practice. See, e.g., [37 CFR 1.33\(c\)](#). For this reason, the correspondence address of record **in the file of the patent for which supplemental examination is requested** will be utilized by the Office as the address of the patent owner when mailing any communications in

supplemental examination proceedings, and in any resulting *ex parte* reexamination proceedings.

If the patent owner desires the Office to send correspondence to a registered attorney or agent other than the attorney or agent of record in the file of the patent for which reexamination is requested, then a new power of attorney must be filed in **both**: 1) the file of the patent for which supplemental examination is requested; **and** 2) the file of the supplemental examination proceeding, or, if reexamination is ordered, in the resulting *ex parte* reexamination proceeding. Patent owners are strongly encouraged to use form PTO/AIA/81B when submitting a power of attorney and/or change of correspondence address in a supplemental examination proceeding or a reexamination proceeding.

After a request for supplemental examination has been filed, and/or after any *ex parte* reexamination resulting from the supplemental examination has been ordered, any submissions to the Office to change the power of attorney or the correspondence address should be addressed as set forth in [MPEP § 2806](#). Use of form PTO/AIA/81B is encouraged. If, however, the supplemental examination proceeding and any resulting reexamination proceeding is no longer pending, then such submissions should be addressed to Mail Stop Document Services, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

A submission requesting a change of correspondence address may be signed by all of the patent owners (see [MPEP § 2803](#)) or by the registered attorney or agent of record in the file of the patent under supplemental examination. If the application which became the patent under supplemental examination was filed on or after September 12, 2012, a patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in the file of the patent under supplemental examination may file a change of correspondence address, provided that the change of correspondence address is accompanied by a statement in accordance with [37 CFR 1.33\(g\)](#).

Papers filed on behalf of patent owners must be signed by the patent owners, by the registered



attorney or agent of record in the patent file, or by any registered attorney or agent acting in a representative capacity under [37 CFR 1.34](#). See [MPEP § 2804](#). Double correspondence with the patent owner and the attorney or agent will not normally be undertaken by the Office.

The following is a copy of form PTO/AIA/81B, which may be used for changing a power of attorney and/or a correspondence address in a supplemental examination proceeding and, if desired, simultaneously in the file of the patent.

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

<b>REEXAMINATION OR SUPPLEMENTAL EXAMINATION – PATENT OWNER POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS FOR REEXAMINATION OR SUPPLEMENTAL EXAMINATION AND PATENT</b>	Control Number(s)	
	Filing Date(s)	
	First Named Inventor	
	Title	
	Patent Number	
	Examiner Name	
	Attorney Docket No(s)	

**I. Power of Attorney.** This form may be used to change the Power of Attorney in a reexamination or supplemental examination proceeding (or multiple proceedings where merged). This form may also be used to change the Power of Attorney in the patent file; in such a case, a copy of this form will be placed in both the patent file and the reexamination or supplemental examination proceeding.

**A. Revocation of Previous Power of Attorney.** I hereby revoke all previous patent owner powers of attorney, if any, given:

- in the above-identified reexamination or supplemental examination proceeding control number(s) (more than one may be changed only if the proceedings are merged).
- in the file of the above-identified patent.

**(check BOTH boxes if change in BOTH the patent file and the reexamination or supplemental examination proceeding is requested).**

**B. Designation of Power of Attorney.**

A Power of Attorney is submitted herewith.

OR

I hereby appoint Practitioner(s) associated with the Customer Number identified in the box at right as my/our attorney(s) or agent(s) to prosecute the proceeding(s)/patent identified above and selected in section I(A), and to transact all business in the United States Patent and Trademark Office connected therewith:

--

OR

I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number

Authorization for the Power of Attorney is provided by the signature on page 2 of this form.

This collection of information is required by 37 CFR 1.31, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public, which is to update (and by the USPTO to process) the file of a patent or reexamination proceeding. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

PTO/AIA/81B (07-13)

Approved for use through 01/31/2018. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

**II. Change of Correspondence Address**

Please recognize or change the correspondence address for the above-identified reexamination or supplemental examination proceeding control number(s) (more than one may be changed **only** if they are merged proceedings) **and for the file of the above-identified patent** to be:

The address associated with the above-identified Customer Number.  
OR

The address associated with the Customer Number identified in the box at right:

<input type="checkbox"/> Firm or Individual Name				
Address				
City		State		Zip
Country				
Telephone		Email		

**NOTE: THE CORRESPONDENCE ADDRESS FOR THE REEXAMINATION OR SUPPLEMENTAL EXAMINATION PROCEEDING CONTROL NUMBER(S) MUST BE THE SAME AS THAT FOR THE PATENT. SEE 37 CFR 1.33.**

**III. Authorization for Power of Attorney and (if selected) Change of Correspondence Address**

I am the:

Inventor, having ownership of the patent being reexamined.  
OR

Patent owner.  
*Statement under 37 CFR 3.73(c) (Form PTO/AIA/96) submitted herewith or filed on \_\_\_\_\_.*

Signature of Inventor or Patent Owner		Date	
Name		Telephone	
Title and Company			

**NOTE:** Signatures of all the inventors or patent owners of the entire interest or their representative(s) are required. If more than one signature is required, submit multiple forms, check the box below, and identify the total number of forms submitted in the blank below.

A total of \_\_\_\_\_ forms are submitted. *If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

### **2806 How to File Papers in a Supplemental Examination Proceeding and in Any**

## Resulting *Ex Parte* Reexamination Proceeding [R-07.2015]

A request for supplemental examination should be deposited as a new, separate, and independent submission, and should not be deposited in the file of the patent for which supplemental examination is requested, or in the file of any other application, patent, or proceeding. The request should be clearly identified by, for example, providing a heading such as “REQUEST FOR SUPPLEMENTAL EXAMINATION” prominently at the top of the first page of the paper. Use of the new form PTO/SB/59 titled “Request for Supplemental Examination Transmittal Form,” which is available on the Office’s website [www.uspto.gov](http://www.uspto.gov), is also recommended. Requests for supplemental examination, any paper(s) other than a request submission that are to be filed in a supplemental examination proceeding, and any paper(s) to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding, should be addressed to the Office as set forth below.

The filing of any papers other than those forming part of a request for supplemental examination in the supplemental examination proceeding submission should be rare.

A supplemental examination proceeding is separate and distinct from any *ex parte* reexamination proceeding that may later result from it. A supplemental examination proceeding concludes with the electronic issuance of a supplemental examination certificate. [35 U.S.C. 257\(a\)](#) and [37 CFR 1.625\(a\)](#). Any reexamination resulting from a supplemental examination proceeding will be ordered after the conclusion of the supplemental examination proceeding. See [35 U.S.C. 257\(b\)](#) and [37 CFR 1.625\(b\)](#). The *ex parte* reexamination is a distinct proceeding initiated by its own order. If reexamination is ordered as a result of a supplemental examination proceeding, any papers submitted subsequent to the order should be filed in the resulting reexamination proceeding.

Supplemental examination proceedings will be assigned a “series 96” control number, such as, for example, 96/999,999. Any *ex parte* reexamination resulting from a concluded supplemental

examination proceeding will retain the same control number, even though the two proceedings are separate and distinct. After the filing of the request, any correspondence sent to the Office relating to the supplemental examination proceeding or to the resulting *ex parte* reexamination proceeding should identify the proceeding by the number of the patent, the control number assigned to the proceeding, the art unit, and the name of the examiner.

The certificate of mailing and transmission procedures ([37 CFR 1.8](#)) may be used to file any paper in a supplemental examination proceeding, except for a request or corrected request. See [MPEP § 512](#) regarding the use of the certificate of mailing and transmission procedures. The Priority Mail Express<sup>®</sup> mailing procedure ([37 CFR 1.10](#)) may be used to file any paper, including a request or corrected request, in a supplemental examination proceeding. See [MPEP § 513](#) as to the use of the Priority Mail Express<sup>®</sup> mailing procedure.

### I. ELECTRONIC SUBMISSION

Patent owners may submit papers in a supplemental examination proceeding via the Office’s Web-based electronic filing system (EFS-Web), available by accessing the Office’s website, [www.uspto.gov](http://www.uspto.gov). The electronic submission of requests for supplemental examination and “follow-on” papers (i.e., subsequent correspondence in the proceedings) is encouraged.

When filing a new supplemental examination request, the patent owner should select, in EFS-Web, the filing option “New application/proceeding,” and then select “Supplemental Examination.” Any paper(s) that are to be filed in an existing supplemental examination proceeding, and any paper(s) that are to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding, may be filed by selecting “Existing application/patent/proceeding” (e.g., a proceeding that has already been assigned a control number), “Documents/Fees for an existing application/proceeding,” and then entering the assigned control number and confirmation number for the proceeding. For example, a corrected request that is filed in response to a Notice of Noncompliant Supplemental Examination Request should be filed

as paper(s) in an existing proceeding. After the control number and confirmation number of the proceeding are entered, patent owners will be provided with a menu of document descriptions appropriate for a supplemental examination proceeding, unless reexamination has been ordered. If reexamination has been ordered, patent owners will be provided with a menu of document descriptions for a reexamination proceeding. For further information, see “EFS-Web Quick Start Guide to Filing a Supplemental Examination Request,” at [http://www.uspto.gov/sites/default/files/patents/process/file/efs/guidance/QSG\\_Supplemental\\_Exam.pdf](http://www.uspto.gov/sites/default/files/patents/process/file/efs/guidance/QSG_Supplemental_Exam.pdf).

Even though the concluded supplemental examination proceeding is separate and distinct from the resulting *ex parte* reexamination, the resulting reexamination retains the same control number as the concluded supplemental examination proceeding to simplify tracking and processing. Therefore, any paper to be submitted in the resulting reexamination proceeding is to be filed as a paper in an “existing application/patent/proceeding”, using the same control number as was used in the now concluded supplemental examination proceeding.

## II. PAPER FORM (HARD COPY) SUBMISSIONS

The Office accepts paper form (hard copy) requests for supplemental examination (i.e., request submissions), and any paper(s) other than request submissions that are filed in a supplemental examination proceeding. These papers should be addressed to “Mail Stop Supplemental Examination” at the appropriate address provided below.

Any papers to be submitted in paper form (hard copy) in a reexamination proceeding ordered as a result of a supplemental examination, other than correspondence to the Office of the General Counsel pursuant to [37 CFR 1.1\(a\)\(3\)](#) and [37 CFR 102.4](#), should be addressed to “Mail Stop *Ex Parte* Reexam” at the appropriate address provided below.

Mail to be delivered by the United States Postal Service (USPS) should be addressed as:

Mail Stop \_\_\_\_\_  
Central Reexamination Unit  
Commissioner for Patents P.O. Box 1450  
Alexandria, VA 22313-1450

Correspondence to be hand-carried or delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolator, etc.) should be addressed as:

United States Patent and Trademark Office  
Customer Service Window  
Mail Stop \_\_\_\_\_  
Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

Whether the correspondence is mailed via the U.S. Postal Service mail or is hand-carried to the Office, it is strongly recommended that the Mail Stop information be placed in a prominent position on the first page of each paper filed, utilizing a large font size to direct attention to it.

## III. FACSIMILE TRANSMISSION

**Requests for supplemental examination may not be facsimile-transmitted.** This is also true for a corrected request that is filed in response to a Notice of Noncompliant Supplemental Examination Request (see [MPEP §§ 2812.02 - 2812.03](#)), since the corrected request stands in place of the original request. Papers to be filed in a supplemental examination proceeding, other than a request or a corrected request for supplemental examination, and any papers to be filed in a reexamination proceeding resulting from a supplemental examination proceeding, if the papers to be filed in the reexamination proceeding may be properly filed via facsimile transmission in accordance with reexamination practice, may be facsimile-transmitted to the Central Reexamination Unit at (571) 273-9900. See [MPEP § 2224](#).

## 2807 Format of Papers Filed in a Supplemental Examination Proceeding [R-11.2013]

*37 CFR 1.615 Format of papers filed in a supplemental examination proceeding.*

(a) All papers submitted in a supplemental examination proceeding must be formatted in accordance with [§ 1.52](#).

(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.

[37 CFR 1.615\(a\)](#) requires that all papers submitted in a supplemental examination proceeding must be formatted in accordance with [37 CFR 1.52](#).

[37 CFR 1.615\(b\)](#) provides that 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.

If the requirements of [37 CFR 1.615](#) are not satisfied, the request will be considered to be defective. See [37 CFR 1.610\(d\)](#) and [MPEP § 2812.01](#).

Papers filed in a supplemental examination proceeding may be filed electronically via EFS-Web. See [MPEP § 2806](#), subsection I.

## **2808 Time for Requesting Supplemental Examination [R-11.2013]**

### ***37 CFR 1.601 Filing of papers in supplemental examination.***

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(c) A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent.

Under [37 CFR 1.601\(c\)](#), a patent owner may, at any time during the period of enforceability of a patent, file a request for supplemental examination. This period was set by rule, because the Office believes that Congress could not have intended the Office to expend resources on the supplemental examination of a patent which cannot be enforced. The enforceability period is generally determined by adding six years to the date on which the patent expires, but the period may be extended if litigation

is pending. Specifically, if litigation is instituted within the statute of limitations (see [35 U.S.C. 286](#)), requests for supplemental examination may be filed after the statute of limitations has expired, as long as the patent is still enforceable against someone.

It is the responsibility of the patent owner to determine the expiration date of the patent for which supplemental examination is requested. For example, the expiration date of a utility patent may be determined by taking into account the term of the patent, whether maintenance fees have been paid for the patent, whether any disclaimer was filed as to the patent to shorten its term, any patent term extensions or adjustments for delays within the Office under [35 U.S.C. 154](#) (see [MPEP § 2710](#), *et seq.*), and any patent term extensions available under [35 U.S.C. 156](#) for premarket regulatory review (see [MPEP § 2750](#) *et seq.*). Any other relevant information should also be taken into account.

## **2809 Items of Information [R-11.2013]**

### ***37 CFR 1.605 Items of information.***

(a) Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. 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.

(b) An item of information includes a document submitted as part of the request that contains information, believed to be relevant to the patent, that the patent owner requests the Office to consider, reconsider, or correct. If the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on any document submitted as part of the request, the discussion within the body of the request relative to the information will be considered as an item of information.

(c) An item of information 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.

(d) If one 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. Exceptions include the combination of a non-English language document and its translation, and the combination of a document that is over 50 pages in length and its summary pursuant to [§ 1.610\(b\)\(8\)](#).

An “item of information” includes a document submitted as part of a supplemental examination request that contains information believed to be relevant to the patent, that the patent owner is requesting the Office to consider, reconsider, or

correct. See [37 CFR 1.605\(b\)](#). Patent owners are encouraged to draft the supplemental examination request to clearly and consistently set forth the items of information the patent owner wishes the Office to consider, reconsider, or correct.

## **I. LIMIT ON THE NUMBER OF ITEMS OF INFORMATION SUBMITTED AS PART OF A SINGLE REQUEST**

Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. See [37 CFR 1.605\(a\)](#). [37 CFR 1.605\(a\)](#) also permits the filing of more than one request for supplemental examination of the same patent at any time during the period of enforceability of the patent. Therefore, patent owner is not precluded from obtaining review of any item of information despite the twelve-item limit, because the patent owner may file one or more additional requests for supplemental examination of the same patent sequentially or at the same time, each of which may include up to twelve additional items of information.

## **II. REQUIREMENTS FOR AN ITEM OF INFORMATION**

An item of information must be in writing. In most cases, an “item of information” is a separate document submitted as part of the request. Under certain conditions, however, an “item of information” may be contained within the body of the request.

### ***A. An Item of Information Must Be in Writing***

[37 CFR 1.605\(c\)](#) requires that an item of information must be in writing in accordance with [37 CFR 1.2](#). The Office does not currently have the capability of retaining records in unwritten form. For this reason, any audio or video recording must be submitted in the form of a written transcript in order to be considered. A transcript of a video may be submitted together with copies of selected images of the video, and a discussion of the correlation between the transcript and the copies of the video images. See also [MPEP § 2807](#) regarding the format requirements for papers submitted in a supplemental examination proceeding.

### ***B. An Item of Information Must Be Submitted as a Separate Document, Where Applicable***

In most cases, an item of information is a separate document submitted with the request which contains information relevant to the patent that the patent owner wants the Office to consider, reconsider, or correct. Examples of an item of information that must be submitted as a separate document include a journal article, a patent, an affidavit or declaration, a sales receipt, a foreign search report, a copy of a page of a dictionary containing a definition, a court document, and a transcript of an audio or video recording. However, if the item of information is a U.S. patent or a U.S. patent application publication, a copy is not required, but may be submitted. See [37 CFR 1.610\(b\)\(7\)](#).

### ***C. When an Item of Information May be Contained within the Body of the Request***

If the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on a supporting document submitted as part of the request, the discussion within the body of the request relative to that information will be considered as the item of information. For example, if the patent owner requests the Office to consider claim 1 of the patent on the basis of [35 U.S.C. 101](#), and the discussion of any potential application of [35 U.S.C. 101](#) to claim 1 is wholly contained within the body of the request and is not based, at least in part, on any supporting document, the discussion in the request will be considered as the item of information. Another example of an item of information that may be contained within the request is an admission by patent owner that certain facts or claim limitations were known at the time of the invention.

The patent owner may not avoid counting an item of information by inserting the content of the supporting document within the body of the request. For example, if the patent owner presents an image of a supporting document, such as an image of an electronic mail message or other document, within the body of the request, then a separate copy of the supporting document must be provided. The separate copy of the item will be considered as the item of information.



### III. HOW ITEMS OF INFORMATION ARE COUNTED

When counting the number of items of information submitted with a request for supplemental examination, the Office will tally the number of items of information, such as documents, presented.

The Office will not count the number of issues raised by, or the number of grounds which the patent owner requests the Office to consider, when determining the number of items of information. A single reference that raises multiple issues under multiple grounds, for example, under [35 U.S.C. 102](#), [35 U.S.C. 103](#), and [35 U.S.C. 112](#), will be counted as a single item of information. However, if the patent owner cites a combination of multiple references under [35 U.S.C. 103](#), then each reference of the combination will be separately counted as an item of information.

For example, if the patent owner states that the claims are patentable under [35 U.S.C. 103](#) over the combination of reference A in view of reference B, then references A and B must be separately listed as items of information, and will be counted as two items. If, however, a single item of information, such as a reference patent, raises a potential issue under [35 U.S.C. 102](#) as to claim 1 and another potential issue under [35 U.S.C. 103](#) as to claim 2, the reference patent will nevertheless be counted as a single item of information. The Office will count the number of items of information, but will not count the number of issues potentially raised by each item.

As another example, if the patent owner relies upon different abstracts bound together in a book of meeting abstracts, it is likely that the Office will treat each abstract as a separate item of information. In this example, the Office suggests that the patent owner cite and rely upon only the particular abstracts that are relevant to the patent and not cite an entire book of meeting abstracts.

Cumulative items of information will each be separately counted. For example, if the patent owner indicates that reference A is cumulative to reference B, references A and B will be counted as two items of information. If the patent owner believes that

multiple items of information are cumulative to each other, the patent owner is encouraged to select one or two documents as the items of information that will be submitted with the request.

If a discussion within the body of the request is based, at least in part, on a supporting document, then the supporting document, and not the discussion within the request, will be counted as the item of information. For example, if the patent owner discusses a potential public use or sale of the claimed invention, and also submits a supporting document, such as a sales invoice, with the request as possible evidence of a public use or sale, or the lack thereof, then the supporting document (e.g., the sales invoice), and not the discussion within the body of the request, will be considered as an item of information.

A declaration or affidavit submitted as part of a request would be considered an item of information. However, if the declaration presents two distinct items of information, such as information relating to a potential ground under [35 U.S.C. 101](#) as to patent claim 1 that was not considered during the prior examination of the patent, and information relating to erroneous facts or data presented during the prior examination of the patent with respect to an issue under [35 U.S.C. 103](#) as to patent claim 10, then each item of information contained within the declaration will be counted separately, resulting in two items of information.

The patent owner may not avoid the counting of multiple items of information by inserting the multiple items within the body of a declaration or by presenting them as exhibits accompanying the declaration. If the declaration presents one item of information, such as information regarding erroneous data presented during the prior examination of the patent with respect to an issue under [35 U.S.C. 103](#) as to a particular patent claim (such as, e.g., claim 10), and relies upon a single exhibit, such as a new table of data, to support facts presented in the declaration, the Office is likely to count the declaration, including the supporting exhibit, as a single item of information. If, however, the declaration relies upon two separate and distinct exhibits, then each exhibit may be counted separately. For example, if the declaration relies

upon two separate and distinct sales receipts as evidence of a potential sale of the invention (e.g., a sales receipt dated March 2011, and a second, separate sales receipt dated October 2011, which provides evidence of a second, separate sale of the invention), then each additional sales receipt will be counted separately, resulting in two items of information (one item consisting of the declaration and one sales receipt, and the second item consisting of the second sales receipt). As another example, if the declaration relies not only upon a sales receipt (e.g., exhibit 1) as evidence of a sale of the invention under [35 U.S.C. 102](#), but also upon a reference patent (e.g., exhibit 2) as evidence of a potential ground under [35 U.S.C. 103](#), then each additional exhibit will be counted separately. In this example, the declaration and the sales receipt will be counted as a first item of information and the reference patent will be counted as a second item of information.

[37 CFR 1.605\(d\)](#) provides that 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. If it is necessary to combine items of information in order to raise an issue, or to explain the relevance of the items of information to be considered, reconsidered, or corrected with respect to the identified claims, each item of information may be separately counted. For example, if the patent owner requests consideration of claim 1 of a patent in light of references A and B, and explains that it is the combination of references A and B that is relevant to claim 1, reference A and reference B must be separately listed as items of information, and will be counted as two items of information.

Exceptions to this provision include the combination of a non-English language document and its translation, and the combination of a document that is over 50 pages in length and its summary pursuant to [37 CFR 1.610\(b\)\(8\)](#).

#### **IV. INFORMATION THAT SHOULD NOT BE SUBMITTED WITH THE REQUEST**

Petitions should not be submitted with the request. Petitions including, for example, petitions for unintentionally delayed foreign priority or domestic benefit claims (see [MPEP § 2809.01](#)), should only

be filed after reexamination is ordered. If a petition is filed in a supplemental examination proceeding, it will generally be held in abeyance until after the issuance of the supplemental examination certificate. See [37 CFR 1.620\(b\)](#) and [MPEP § 2813](#). If the Office determines that a substantial new question of patentability is raised by the request, any petition held in abeyance will be addressed in due course after reexamination is ordered. If, however, the Office determines that no substantial new question of patentability is raised by the request, any petition held in abeyance will be dismissed as moot.

In addition, amendments to the patent may not be submitted with the request. No amendment may be filed in a supplemental examination proceeding. [37 CFR 1.620\(f\)](#). Any paper containing an amendment that is filed in a supplemental examination proceeding is an unauthorized paper, and will be expunged from the file if inadvertently entered. If reexamination is ordered, amendments may be filed after an initial Office action on the merits in the resulting reexamination proceeding. See [MPEP § 2813.01](#).

#### **2809.01 Information Relating to the Correction of Factual Information [R-11.2013]**

In a request for supplemental examination, the patent owner may inform the Office of factual information believed to be relevant to the patent, which the patent owner wishes to correct. The factual information to be corrected may include, for example, a missing or erroneous foreign priority or benefit claim, or missing or erroneous information relating to the common ownership of the claimed invention. The item of information may be, for example, a patent document relating to the factual information, such as a priority document or parent patent in the case of a missing or erroneous foreign priority or domestic benefit claim, a declaration under [37 CFR 1.132](#) limited to a discussion of the factual information to be corrected, or, if no supporting document is submitted with the request, a discussion within the body of the request relating to the correction of the factual information.

However, if the patent owner merely wishes to amend the patent file in order to correct factual

information, the patent owner should file a reissue application or a request for certificate of correction, where appropriate. See [MPEP §§ 1402](#) and [1405](#). If the patent owner only desires to correct the inventorship, the patent owner should file a request for a certificate of correction under the provisions of [35 U.S.C. 256](#) and [37 CFR 1.324](#), or, alternatively, the patent owner may file a reissue application. See [MPEP §§ 1402](#), [1412.04](#), and [1481.02](#). Correction of inventorship may also be made, if desired, in an *ex parte* reexamination proceeding. See [MPEP § 2258](#), subsection IV.F. If the information that the patent owner wishes to correct is only of a clerical or typographical nature, or of a minor character within the meaning of [35 U.S.C. 255](#) and [37 CFR 1.323](#), the patent owner should file a request for certificate of correction rather than a supplemental examination request. See, *e.g.*, [MPEP § 1481](#).

A deletion of an earlier-obtained domestic benefit claim in a supplemental examination proceeding or any resulting reexamination proceeding (or, for that matter, in any post-patent Office proceeding) will not operate to extend the term of the patent.

#### **I. SUPPLEMENTAL EXAMINATION IS LIMITED TO A DETERMINATION OF WHETHER THE REQUEST RAISES A SUBSTANTIAL NEW QUESTION OF PATENTABILITY**

A supplemental examination proceeding is limited to a determination of whether the information properly submitted as part of the request raises a substantial new question of patentability (SNQ). See [35 U.S.C. 257\(a\)](#).

However, an item of information limited to a correction of factual information, alone, may not raise a substantial new question of patentability. For example, an item of information limited to the correction of a missing or erroneous foreign priority or domestic benefit claim, alone, generally will not raise an issue of patentability. In order for the correction of a foreign priority or domestic benefit claim to raise a substantial new question of patentability, the request for supplemental examination should also include one or more additional item(s) of information, such as one or more intervening reference(s), that would cause the patentability of the claims under, *e.g.*, [35 U.S.C. 102](#)

or [103](#), to *depend upon* the foreign priority or domestic benefit claim. In such an instance, the item of information may raise a SNQ, *depending upon* whether the foreign priority or domestic benefit claim is or is not corrected. See [MPEP § 2816.02](#) for a further discussion of whether a document raises a SNQ depending upon the correction of a foreign priority or domestic benefit claim. Similarly, information limited to the correction of other factual information, such as the common ownership of the claims, alone, may not raise a SNQ, in the absence of one or more additional item(s) of information that would cause the patentability of the claims to *depend upon* the issue of common ownership.

If the Office determines that no SNQ is raised by the request, the supplemental examination proceeding concludes with the issuance of a supplemental examination certificate, indicating that no SNQ is raised. See [35 U.S.C. 257\(a\)](#), [37 CFR 1.620\(a\)](#), and [37 CFR 1.625\(a\)](#). Because no SNQ is raised by the request, *ex parte* reexamination is not ordered. In such an instance, the factual information cannot be corrected because the procedure for making the correction of the factual information is the reexamination that would have been ordered, had the Office determined that a SNQ was raised in the request. In other words, the patent owner may inform the Office of factual information to be corrected during the supplemental examination proceeding, and thus request supplemental examination “to correct information believed to be relevant to the patent” in accordance with [35 U.S.C. 257\(a\)](#). However, in the absence of information in the request that raises a SNQ, there is no opportunity to make the correction. Thus, the supplemental examination proceeding will not result in any correction to the patent. In such cases, the patent owner may wish to file a reissue application, a certificate of correction, or other proceeding, as applicable, in order to have the information corrected. See, *e.g.*, [MPEP §§ 1402](#), [1405](#) and [1481](#).

If, however, the Office determines that the request raises a SNQ, reexamination will be ordered. See [35 U.S.C. 257\(b\)](#) and [37 CFR 1.625\(b\)](#). The factual information may be corrected during the resulting reexamination proceeding in accordance with *ex parte* reexamination practice. For example, corrections may be made *during the resulting*

*reexamination proceeding* by filing, where appropriate, an amendment after the initial Office action on the merits (see [MPEP § 2813.01](#)), or a petition for an unintentionally delayed foreign priority or domestic benefit claim (see [MPEP § 2258](#), subsection IV.E.).

When analyzing a request for supplemental examination, the Office will only consider the item(s) of information provided by the patent owner. The Office will not initiate supplemental examination of the patent in view of any item of information that was not requested by the patent owner to be considered, reconsidered or corrected. For example, any prior art of record in the patent file, that is not properly submitted as one or more additional item(s) of information in the request, will not, in general, be considered during the supplemental examination proceeding, except to determine whether the item(s) of information properly submitted with the request are cumulative to the prior art of record. Furthermore, a request for supplemental examination “of all of the patent claims” solely in view of the “the factual information to be corrected”, without more, is improper. The patent owner is effectively requesting reconsideration of all of the patent claims in view of all prior art in existence (or, at a minimum, all of the prior art of record). Each prior art document, however, would be considered as a separate item of information. Such a request would be improper because it would not comply with the requirements of, for example, [37 CFR 1.610\(b\)](#). It would fail to include, e.g., (a) a separate list of each prior art document as an item of information; (b) a copy of each item of information, where appropriate; c) a separate, detailed explanation of the relevance and manner of applying each prior art document to every claim for which supplemental examination is requested, etc. In addition, “all prior art in existence” is likely to include more than twelve items of information. See [MPEP § 2811](#) for discussion of the required elements of a supplemental examination request as set forth in [37 CFR 1.610\(b\)](#).

In summary, the patent owner may inform the Office of factual information to be corrected during the supplemental examination proceeding, and thus request supplemental examination “to correct information believed to be relevant to the patent” in

accordance with [35 U.S.C. 257\(a\)](#). However, in the absence of information in the request that raises a SNQ, the supplemental examination proceeding will not result in a corrected patent. Any correction may only be made during a resulting reexamination proceeding, which is only initiated if the supplemental examination proceeding concludes with a determination that a SNQ was raised. For these reasons, the patent owner should include with the request, as one or more additional items of information, evidence that the patentability of the claims *depends upon* the factual information to be corrected. Such evidence may include, for example, one or more intervening references.

## II. RECOMMENDED INFORMATION TO BE SUBMITTED WITH THE REQUEST

The Office recommends that any request for supplemental examination, that includes an item of information limited to the correction of factual information, should also include one or more additional item(s) of information that potentially provide evidence that the patentability of the claims *depends upon* the factual information to be corrected.

For example, where the information to be corrected is a foreign priority or domestic benefit claim, the Office recommends that the patent owner include in the request, as one or more additional item(s) of information, any documents or other information, such as an intervening patent or printed publication, that caused the patent owner to reconsider the effective filing date of the claims. The effective date of some of the claims in a patent which resulted from a continuing application under [35 U.S.C. 120](#), for example, could be the filing date of the continuing application since those claims were not supported in the parent application. Therefore, intervening patents or printed publications may be available as prior art. See, e.g., *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also [MPEP § 211.05](#). Similarly, where the information to be corrected involves, for example, the common ownership of the claims, the patent owner should include with the request one or more additional items of information that cause(s) the patentability of the claims to depend upon the

common ownership issue, such any prior art or other documents or information that caused the patent owner to reconsider the common ownership of the claims.

Alternatively, the patent owner may include in the request one or more additional items of information which are unrelated to the factual information to be corrected, but which raise a SNQ. For example, the patent owner may include, in addition to information limited to the correction of a domestic benefit claim, an item of information such as a reference patent that would qualify as prior art under [35 U.S.C. 102](#) even if the domestic benefit claim is corrected.

### III. INFORMATION THAT SHOULD NOT BE SUBMITTED WITH THE REQUEST

See [MPEP § 2809](#), subsection IV. Petitions should not be submitted with the request. Petitions including, for example, petitions for unintentionally delayed foreign priority or domestic benefit claims, should only be filed after reexamination is ordered. See [MPEP § 2809.01](#). In addition, amendments to the patent may not be submitted with the request. No amendment may be filed in a supplemental examination proceeding. [37 CFR 1.620\(f\)](#). If reexamination is ordered, amendments may be filed after an initial Office action on the merits in the resulting reexamination proceeding. See [MPEP § 2813.01](#).

See [MPEP § 2816.02](#), subsection II, for a further discussion of situations where a SNQ is or is not raised, when the request includes information limited to the correction of factual information.

## 2810 Fees Due on Filing a Supplemental Examination Request [R-11.2013]

### *37 CFR 1.610 Content of request for supplemental examination.*

(a) A request for supplemental examination must be accompanied by the fee for filing a request for supplemental examination as set forth in [§ 1.20\(k\)\(1\)](#), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in [§ 1.20\(k\)\(2\)](#), and any applicable document size fees as set forth in [§ 1.20\(k\)\(3\)](#).

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(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, subject to

the discretion of the Office. If the Office determines that the request, as originally submitted, is not 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 this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.

Consistent with the requirement in [35 U.S.C. 257\(d\)](#) to establish fees, [37 CFR 1.610\(a\)](#) requires that the request be accompanied by the fee for filing a request for supplemental examination as set forth in [37 CFR 1.20\(k\)\(1\)](#), the fee for *ex parte* reexamination ordered as a result of a supplemental examination proceeding as set forth in [37 CFR 1.20\(k\)\(2\)](#), and any applicable document size fees as set forth in [37 CFR 1.20\(k\)\(3\)](#). These fees qualify for a 50 percent reduction for small entities and a 75 percent reduction for micro entities. See *Setting and Adjusting Patent Fees*, 78 Fed. Reg. 4212 (January 18, 2013) (final rule); *Changes to Implement Micro Entity Status for Paying Patent Fees*, 77 Fed. Reg. 65019 (December 19, 2012) (final rule). See [MPEP § 509.04](#).

If all of the required fees for supplemental examination are not paid at the time the request is filed, the request will be considered to be defective, and a filing date will not be granted. See [37 CFR 1.610\(d\)](#) and [MPEP § 2812.01](#) *et seq.* If, after notification of the failure to pay all of the required fees, the fees are not timely received, then the request will not receive a filing date, the processing of the request will be terminated, and a refund in accordance with [37 CFR 1.610\(d\)](#) of any fees paid will be made to the patent owner.

The fee under [37 CFR 1.20\(k\)\(2\)](#) for *ex parte* reexamination ordered as a result of a supplemental examination proceeding will be refunded, in accordance with [37 CFR 1.610\(d\)](#), if the supplemental examination certificate indicates that no substantial new question of patentability (SNQ) was raised by any of the items of information properly submitted as part of the request, and reexamination is not ordered.

## 2810.01 Document Size Fees [R-11.2013]

The document size fees, as set forth in [37 CFR 1.20\(k\)\(3\)](#), are only applicable to non-patent documents that having greater than 20 pages. Non-patent documents having 20 pages or less are not subject to the document size fees. Non-patent documents include, for example, non-patent literature, transcripts of audio or video recordings, and court documents. Patent documents, such as U.S. patents, U.S. patent application publications, published international patent applications, and foreign patents and patent application publications, are not subject to the document size fees. Translations of non-English language patent documents are also “patent documents” within the meaning of the rule, and are not subject to the document size fees.

Each non-patent document will be separately subject to the document size fees if greater than 20 pages. For example, each non-patent document attached to a declaration as an exhibit will be subject to its own document size fees if the document is greater than 20 pages. Thus, a 21-page journal article, which is designated as an exhibit to a declaration under [37 CFR 1.132](#), is considered to be a separate document for the purposes of the document size fees and its pages will be counted separately from the pages of the declaration.

Non-patent documents having 21–50 pages are subject to the fee pursuant to [37 CFR 1.20\(k\)\(3\)\(i\)](#), per document. Non-patent documents having greater than 50 pages are, in addition, subject to a document size fee for each additional 50-page increment, or a fraction thereof, per document, pursuant to [37 CFR 1.20\(k\)\(3\)\(ii\)](#).

The document size fees will not be pro-rated. For example, if a request for supplemental examination included a 51-page non-patent document and a 99-page non-patent document, the same total fee would be due for each document.

Blank pages will be counted. The Office uses an automatic page counter that does not subtract blank pages from the total page count for the non-patent document. This policy is consistent with the Office policy for application size fees.

### Examples

#### **Document Size Fee for Each Non-Patent Document Having 21–50 Pages**

A request for supplemental examination includes eight documents: two U.S. patents, one U.S. patent application publication, one published international patent application, one Japanese published application, two journal articles, and a court document. The Japanese published application is not in the English language. For this reason, the request also includes a ninth document, which is a 22-page translation of the Japanese published application. The first journal article is 20 pages long, the second journal article is 25 pages long, and the court document is 50 pages long.

In this example, the U.S. patents, the U.S. patent application publication, the published international patent application, and the Japanese published application and its 22-page translation, are all patent documents, and are not subject to the document size fees. The 20-page journal article, which has 20 pages or less, is also not subject to the document size fees.

In this example, there are only two documents which are subject to the document size fee for non-patent documents which have 21–50 pages: the 25-page journal article and the 50-page court document. Therefore, the request should be accompanied by a payment equivalent to two document size fees pursuant to [37 CFR 1.20\(k\)\(3\)\(i\)](#).

In addition, there are no non-patent documents having greater than 50 pages. Therefore, there are no non-patent documents subject to the document size fee pursuant to [37 CFR 1.20\(k\)\(3\)\(ii\)](#). For EFS-Web Filers: in this example, the number “2” should be entered into the box labeled “Quantity” for the number of documents subject to the fee for non-patent documents having 21–50 pages.

#### **Document Size Fee for Each Additional 50-Page Increment, Per Document**

A request for supplemental examination includes six documents: one U.S. patent, one 21-page journal article, one 30-page declaration under [37 CFR 1.132](#), one 2-page invoice or sales receipt, one 55-page transcript of an audio or video recording, and one 148-page copy of a catalog. The 2-page invoice or sales receipt is designated as an exhibit to the 30-page declaration.

In this example, the U.S. patent is a patent document, and is not subject to the document size fees. The 2-page invoice or sales receipt is considered to be a separate document for the purposes of the document size fees, even though it is designated as an exhibit to the declaration. It is not subject to the document size fee because it has less than 20 pages. (If the declaration designated as an exhibit included one or more non-patent documents each having greater than 20 pages, then each of the greater-than-20-page exhibits would be subject to the document size fees.)

The remaining documents are subject to the document size fees, which are calculated as follows:

	21-50 pages	Each additional 50 pages or a fraction
21-page journal article	1	
30-page declaration	1	
55-page transcript of audio or video recording	1	1
148-page chapter of textbook	1	2
	—	—
<b>Total Quantity</b>	4	3

In this example, the 21-page journal article and the 30-page declaration are each subject to the fee for a non-patent document having 21-50 pages. The 55-page transcript and the 148-page catalog also include pages 21-50, and are subject to the same fee. (For EFS-Web Filers: the number “4” should be entered into the box labeled “Quantity” for the number of documents subject to the fee for non-patent documents having 21–50 pages).

In addition, the 55-page transcript and the 148-page catalog each have greater than 50 pages, and therefore include all, or a fraction, of at least one additional 50-page increment. The 55-page transcript includes only one (5-page) fraction of a 50-page increment greater than 50 pages. The 148-page catalog includes two 50-page increments (or a fraction thereof): one for pages 51–100, and a second one for pages 101–148. (For EFS-Web Filers: the number “3” should be entered in the box labeled “Quantity” for the number of documents having additional 50-page increments or a fraction thereof).

Therefore, in this example, the request should be accompanied by a payment equivalent to four times the document size fee pursuant to [37 CFR 1.20\(k\)\(3\)\(i\)](#), plus three times the document size fee pursuant to [37 CFR 1.20\(k\)\(3\)\(ii\)](#).

**Note:** If the request in the above example also included a 562-page textbook, the document size fees for that document would include one fee under [37 CFR 1.20\(k\)\(3\)\(i\)](#) for pages 21-50, and, in addition, the equivalent of eleven fees under [37 CFR 1.20\(k\)\(3\)\(ii\)](#) for pages 51-562. The total document size fee for the 562-page textbook would be added to the total for all of the documents in the above example. If the 562-page textbook were designated as an exhibit to the 30-page declaration, the fee total would be the same, because the textbook would be considered as a separate document for the purposes of calculating the document size fees, even though it is designated as an exhibit to a declaration.

Patent owners are encouraged to redact 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.

For e-filing information, please see the “EFS-Web Quick Start Guide to Filing a Supplemental Examination Request,” which is available at [http://www.uspto.gov/sites/default/files/patents/process/file/efs/guidance/QSG\\_Supplemental\\_Exam.pdf](http://www.uspto.gov/sites/default/files/patents/process/file/efs/guidance/QSG_Supplemental_Exam.pdf).

## 2811 Content of Request for Supplemental Examination [R-11.2013]

### *37 CFR 1.610 Content of request for supplemental examination.*

(a) A request for supplemental examination must be accompanied by the fee for filing a request for supplemental examination as set forth in [§ 1.20\(k\)\(1\)](#), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in [§ 1.20\(k\)\(2\)](#), and any applicable document size fees as set forth in [§ 1.20\(k\)\(3\)](#).

(b) A request for supplemental examination must include:

- (1) An identification of the number of the patent for which supplemental examination is requested.
- (2) 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\(b\)](#).
- (3) 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, the identifying number of any such proceeding (e.g., a control number or reissue application number), and the filing date of any such proceeding.
- (4) An identification of each claim of the patent for which supplemental examination is requested.
- (5) 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.
- (6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent.
- (7) A copy of each item of information listed in paragraph (b)(2) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information. The patent owner

is not required to submit copies of items of information that form part of the discussion within the body of the request as specified in [§ 1.605\(b\)](#), or copies of U.S. patents and U.S. patent application publications.

(8) 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.

(9) An identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and 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.

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[37 CFR 1.610\(a\)](#) requires payment of the fee specified in [37 CFR 1.20\(k\)\(1\)](#), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in [37 CFR 1.20\(k\)\(2\)](#), and any applicable document size fees as set forth in [37 CFR 1.20\(k\)\(3\)](#). See [MPEP § 2810](#).

[37 CFR 1.610\(b\)](#) sets forth content requirements for a request for supplemental examination. The elements are as follows:

#### **I. AN IDENTIFICATION OF THE PATENT FOR WHICH SUPPLEMENTAL EXAMINATION IS REQUESTED**

[37 CFR 1.610\(b\)\(1\)](#) requires that the request include an identification of the number of the patent for which supplemental examination is requested.

#### **II. A LIST OF ALL ITEMS OF INFORMATION SUBMITTED WITH OR AS PART OF THE REQUEST**

[37 CFR 1.610\(b\)\(2\)](#) requires that the request include 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 [37 CFR 1.98\(b\)](#). For example, the list must include a publication date for each item of information, if applicable. If the item of information is a U.S. patent, it must be identified by inventor, patent number, and **issue date**, as required by [37 CFR 1.98\(b\)\(1\)](#).

This list must include each of the items of information submitted with or as part of the request. See [MPEP § 2809](#) for more information about requirements for items of information. 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, and 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. Patent owners are strongly encouraged to use Part B of Office Form PTO/SB/59 to provide the list.

The list must be limited to the items of information for which a separate, detailed explanation is provided in the request, as required by [37 CFR 1.610\(b\)\(5\)](#), and, of which a copy is provided with the request, when required by [37 CFR 1.610\(b\)\(7\)](#). If the list contains an item of information for which the required detailed explanation and required copy (if applicable) are not provided with the request, the request may not be granted a filing date, and a notice of noncompliant supplemental examination request, informing the patent owner of the defects, may be mailed by the Office.

The list should identify each item of the information in a manner that clearly corresponds to any copy of the item of information provided with the request and to the detailed explanation of the manner of applying the item of information, pursuant to [37 CFR 1.610\(b\)\(5\)](#), provided in the request.

The request must include a separate, detailed explanation of the relevance and manner of applying each item of information listed pursuant to [37 CFR 1.610\(b\)\(2\)](#) to each claim of the patent for which supplemental examination is requested. See [37 CFR 1.610\(b\)\(5\)](#). See also subsection V below, and [MPEP § 2811.01](#).

#### **III. A LIST OF PRIOR OR CONCURRENT POST-PATENT OFFICE PROCEEDINGS**

[37 CFR 1.610\(b\)\(3\)](#) requires that the request include a list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which the current supplemental examination is requested, including: an identification of the type of proceeding, the identification of Office serial number of any such proceeding (e.g., a control number or a reissue application number), and the filing date of any such proceeding. The type of proceeding may be, for example, an *ex parte* or *inter partes*



reexamination proceeding, a reissue application, an interference, another supplemental examination proceeding, a post-grant review proceeding, an *inter partes* review proceeding, or a covered business method review proceeding. Patent owners are strongly encouraged to use Office Form PTO/SB/59 to provide a list with a request.

If such notice has not been previously provided with the request, [37 CFR 1.620\(d\)](#) requires that 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 supplemental examination is requested, file a paper limited to notifying the Office of the post-patent Office proceeding. See [MPEP § 2820](#).

#### **IV. IDENTIFICATION OF EACH CLAIM OF THE PATENT FOR WHICH SUPPLEMENTAL EXAMINATION IS REQUESTED**

[37 CFR 1.610\(b\)\(4\)](#) requires that the request include an identification of each claim of the patent for which supplemental examination is requested. The result of a supplemental examination is a determination whether any of the items of information raises a SNQ. Because patentability relates to the claims of the patent, the patent owner must identify the patent claims to be examined in order for the Office to determine whether a SNQ affecting those claims has been raised by an item of information.

For example, if the information raises a question as to the adequacy of the written description portion of the specification, the SNQ pertains to the question of whether the specification provides adequate support under [35 U.S.C. 112](#) for the identified claim. If the information raises a question regarding whether the claimed invention may be anticipated or may be obvious, the SNQ pertains to the question of whether the identified claim is patentable under [35 U.S.C. 102](#) or [35 U.S.C. 103](#) in view of the item of information.

#### **V. A SEPARATE, DETAILED EXPLANATION OF RELEVANCE AND MANNER OF APPLYING EACH ITEM OF INFORMATION TO EACH**

#### **PATENT CLAIM FOR WHICH SUPPLEMENTAL EXAMINATION IS REQUESTED**

[37 CFR 1.610\(b\)\(5\)](#) requires that the request include 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. See [MPEP § 2811.01](#) for a detailed discussion of this requirement. In addition, patent owners may also consider the guidance set forth in [MPEP §§ 2214](#) and [2217](#), which govern the content of a request for *ex parte* reexamination.

#### **VI. A COPY OF THE PATENT FOR WHICH SUPPLEMENTAL EXAMINATION IS REQUESTED, AND A COPY OF ANY DISCLAIMER OR CERTIFICATE ISSUED FOR THE PATENT**

[37 CFR 1.610\(b\)\(6\)](#) requires that the request include a copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent. A copy of the patent, for which supplemental examination is requested, should be provided with the specification and claims submitted in a **double** column format. The drawing pages of the printed patent are presented as they appear in the printed patent; the same is true for the front page of the patent. Thus, a full copy of the printed patent (including the front page) can be used to provide the abstract, drawings, specification, and claims of the patent for the request for supplemental examination. The printed patent is to be reproduced on only one side of the paper; submission of a two-sided copy of the patent is not proper.

A “certificate issued for the patent” includes, for example, 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. Any disclaimer or certificate issued in the patent generally becomes a part of the patent. Thus, a copy of each must be supplied in order to provide the complete patent. The copy must have each page plainly written on only one side of a sheet of paper.

## VII. A COPY OF EACH ITEM OF INFORMATION

[37 CFR 1.610\(b\)\(7\)](#) requires that the request include a copy of each item of information listed in [37 CFR 1.610\(b\)\(2\)](#), accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language document. See [MPEP § 609.04\(a\)](#), subsection III, for more information regarding translations of non-English language documents. The requirement of [37 CFR 1.610\(b\)\(7\)](#) is important because it allows for all materials to be available to the examiner for full consideration within the three-month statutory time period for supplemental examination. The copy of each item of information listed under [37 CFR 1.610\(b\)\(2\)](#) must be legible, and must be otherwise in full compliance with [37 CFR 1.52](#). See [37 CFR 1.615](#) and [MPEP § 2807](#). The request must not include a copy of any item of information that is not listed under [37 CFR 1.610\(b\)\(2\)](#).

Items of information that form part of the discussion within the body of the request as specified in [37 CFR 1.605\(b\)](#) are not required to be submitted. As discussed previously, if the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on any supporting document submitted as part of the request, the discussion within the body of the request relative to the information will be considered as the item of information, a copy of which is not required under [37 CFR 1.610\(b\)\(7\)](#) to be separately submitted. See [MPEP § 2809](#), subsection II.C.

Copies of U.S. patents and U.S. patent application publications are not required, but may be submitted.

## VIII. A SUMMARY OF THE RELEVANT PORTIONS OF ANY DOCUMENT, OTHER THAN THE REQUEST, WHICH IS OVER FIFTY PAGES IN LENGTH

[37 CFR 1.610\(b\)\(8\)](#) requires that the request include a summary of the relevant portions of any submitted document (including patent documents), other than the request, that is over fifty (50) pages in length. The summary must include citations to the particular pages containing the relevant portions. This summary may be similar to the requirement for information disclosure statements of a discussion of the relevant

and pertinent parts of a non-English language document. See [MPEP § 609.04\(a\)](#), subsection III. This requirement will assist the Office in treating information presented in lengthy documents within the statutory three-month time period. Patent owners are encouraged to redact 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 teachings of the item of information with respect to the claimed invention.

## IX. AN IDENTIFICATION OF THE OWNER(S) OF THE ENTIRE RIGHT, TITLE, AND INTEREST IN THE PATENT REQUESTED TO BE EXAMINED, AND A SUBMISSION UNDER 37 CFR 3.73(c)

[37 CFR 1.610\(b\)](#) requires that the request must include an identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with [37 CFR 3.73\(c\)](#) establishing the entirety of the ownership in the patent requested to be examined. A request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest. See [37 CFR 1.601\(a\)](#). This is because the scope of a patent may be changed (*e.g.*, by cancellation or amendment of the claims) during any *ex parte* reexamination proceeding that may be ordered as a result of the supplemental examination proceeding, and this change must be binding on all parties having an ownership interest in the patent. Furthermore, the Office has consistently required that all parties having an interest in a patent are deemed “a patent owner” as a composite entity and must act together in proceedings before the Office. See [MPEP §§ 301](#) and [324](#). This is also consistent with *ex parte* reexamination practice, which requires a patent owner requester of an *ex parte* reexamination to comply with the provisions of [37 CFR 3.71](#) and [3.73](#) for establishing an assignee’s right to take action when submitting a power of attorney. See [MPEP § 2222](#).

The Office may, under rare circumstances, permit less than all of the owners to file a request for supplemental examination if a grantable petition under [37 CFR 1.183](#) requesting waiver of the

provisions of [37 CFR 3.71](#) and [3.73\(c\)](#) is filed. See [MPEP § 2803](#).

An application data sheet (ADS) under [37 CFR 1.76](#) cannot be submitted in a supplemental examination proceeding since a supplemental examination proceeding is not an “application.”

Form PTO/SB/59 should be helpful to persons filing requests for supplemental examination. The use of this form as, for example, the transmittal form, list of items of information, list of prior or concurrent post-patent Office proceedings, and cover sheet for a request for supplemental examination is encouraged. The following is a copy of form PTO/SB/59.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM**

Address to:  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

Attorney Docket No.:  
  
Date:

1.  This is a request for supplemental examination pursuant to 37 CFR 1.610 of patent number \_\_\_\_\_ issued \_\_\_\_\_. 37 CFR 1.610(b)(1).
2.  Supplemental examination of claim(s) \_\_\_\_\_ is requested. 37 CFR 1.610(b)(4).
3.  a. The name(s) of the patent owner(s) (**not** the patent practitioner(s)) is (are):  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_
- b. A submission by the patent owner(s) in compliance with 37 CFR 3.73(c), which establishes that the patent owner(s) has (have) the entirety of the ownership in the patent for which supplemental examination is requested, is included. 37 CFR 1.610(b)(9).
4.  a. A check in the amount of \$ \_\_\_\_\_ is enclosed to cover the fee for processing and treating a request for supplemental examination, the fee for reexamination ordered under 35 USC 257, and the fee for processing and treating each non-patent document over 20 sheets in length (37 CFR 1.20(k)(1 - 3));
- b. The Director is hereby authorized to charge all applicable fees as set forth in 37 CFR 1.20(k)(1 - 3) to Deposit Account No. \_\_\_\_\_; or
- c. Payment by credit card. Form PTO-2038 is attached. 37 CFR 1.610(a).
5.  Any refund should be made by  check or  credit to Deposit Account No. \_\_\_\_\_. 37 CFR 1.26(c). If payment is made by credit card, refund must be to the credit card account.
6.  A copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent are included. 37 CFR 1.610(b)(6).
7.  CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table  
 Landscape Table on CD
8.  Nucleotide and/or Amino Acid Sequence Submission  
*If applicable, items a. – c. are required.*
  - a.  Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i.  CD-ROM (2 copies) or CD-R (2 copies); or
    - ii.  paper
  - c.  Statements verifying the identity of above copies
9.  A list of no more than 12 items of information submitted as part of this request is provided in Part B of this form. Where appropriate, the list must meet the requirements of 37 CFR 1.98(b). 37 CFR 1.605(a), 1.610(b)(2).

[Page 1 of 2]

This collection of information is required by 37 CFR 1.610. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 0.3 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

Patent No. \_\_\_\_\_

PTO/SB/59 (07-12)  
Approved for use through 07/31/2015. OMB 0651-0064  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

10.  A legible copy of each item of information listed in Part B of this form, and an English language translation of all necessary and pertinent parts of each non-English language item of information are included.

Copies of items of information that form part of the discussion within the body of the request (see 37 CFR 1.605(b)), and copies of U.S. patents and patent application publications, are not required. 37 CFR 1.610(b)(7).

11.  A summary of the relevant portions of each non-patent document that is over 50 pages in length (other than the request) is included. The summary includes the required citations to the particular pages containing the relevant portions. 37 CFR 1.610(b)(8).

12.  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, is included. 37 CFR 1.610(b)(5).

13.  The below list includes all prior or concurrent post-patent Office proceedings (*ex parte* or *inter partes* reexamination, reissue, supplemental examination, post grant review, or *inter partes* review) involving the patent for which supplemental examination is being requested. 37 CFR 1.610(b)(3). An identifying number may be, e.g., a control no. or reissue application no. Any prior or concurrent post-patent Office proceedings not listed below are listed on a separate paper accompanying the request.

Type of Proceeding	Identifying Number	Filing Date
_____	_____	_____
_____	_____	_____
_____	_____	_____
_____	_____	_____

See accompanying paper for a list of additional prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is requested. The paper should be a separate sheet titled "List of Prior or Concurrent Post-Patent Office Proceedings" and must provide the type, identifying number, and filing date of the post-patent Office proceeding.

14. Correspondence Address: Please recognize, or change, the correspondence address for the file of the patent for which supplemental examination is requested **and** for the supplemental examination proceeding to be:

The address associated with Customer Number:  OR

Firm or Individual Name

Address

City	State	Zip
Country		
Telephone	Email	

15. **WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

_____	_____
Authorized Signature	Date
_____	_____
Typed/Printed Name	Registration No.

PTO/SB/59 (07-12)  
 Approved for use through 07/31/2015. OMB 0651-0064  
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(Also referred to as FORM PTO-XXXX)

**REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM  
 PART B – LIST OF ITEMS OF INFORMATION – Page 1**

Patent number for which supplemental examination is requested \_\_\_\_\_ Issue Date \_\_\_\_\_

**All items of information (no more than 12) submitted herewith as part of this request for supplemental examination of the above-identified patent are included in the following list:**

**U. S. PATENT DOCUMENTS**

Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	US-			
	US-			
	US-			
	US-			
	US-			
	US-			
	US-			
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**FOREIGN PATENT DOCUMENTS**

Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>2</sup>

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(Also referred to as FORM PTO-XXXX)

**REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM  
PART B – LIST OF ITEMS OF INFORMATION – Page 2**

Patent number for which supplemental examination is requested \_\_\_\_\_ Issue Date \_\_\_\_\_

All items of information (no more than 12) submitted herewith as part of this request for supplemental examination of the above- identified patent are included in the following list:

**OTHER DOCUMENTS**

Cite No. <sup>1</sup>	Document Information (include, where appropriate, name of the author, title of the article, book, magazine, journal, serial, symposium, catalog, etc., publication date, page(s), volume-issue number(s), publisher, city and/or country where published. If a court document, identify the specific court, the designation (case citation or numeric designation), the title of the document, and the date submitted in court. If a declaration, include the type (e.g., 37 CFR 1.132 or 1.131), name of declarant, and the date of declaration. If an invoice or sales receipt, include the date issued and the name of the issuer (e.g., the name of the corporation or other place of business). If a discussion within the body of the request, include the pages of the request on which the discussion appears, and a description of the discussion (e.g., "discussion in request of why the claims are patentable under 35 U.S.C. 101, pages 7-11.") For all other materials, include, where appropriate, the title, author, date, and any descriptive information that would describe the document.)	T <sup>2</sup>

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## 2811.01 Detailed Explanation of the Relevance and Manner of Applying Each Item of Information [R-11.2013]

### *37 CFR 1.610 Content of request for supplemental examination*

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(b) A request for supplemental examination must include:

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(5) 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.

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### I. GENERAL

A separate, detailed explanation required by [37 CFR 1.610\(b\)\(5\)](#) must include, for each item of information listed pursuant to [37 CFR 1.610\(b\)\(2\)](#), an explanation of how the item of information may be applied to the claims for which supplemental examination is requested. The patent owner must explain, for each claim requested to be examined, either (1) what the item of information teaches with respect to that claim, or (2) which teachings contained in the item of information may be considered by an examiner to be important when determining the patentability of that claim.

The explanation should include citations to particular portions or figures in the item of information in which the teachings are located. Ideally, the required explanation can be provided using an appropriately detailed claim chart that compares, limitation by limitation, each claim for which supplemental examination is requested with the teachings of each item of information cited in the request.

A general statement of relevance that is not tied to any particular claim limitation is not sufficient to meet the requirement.

Patent owners are strongly encouraged to specify which claims are to be examined in light of which items of information. If the patent owner desires to request supplemental examination of all of the claims of the patent in light of all of the items of information submitted with the request, the patent owner is encouraged to specifically request, for example, supplemental examination of claims 1-10 (i.e., all

of the claims of the patent) in light of, for example, “the following items of information” (after which a list of the items of information is provided). On the other hand, if the patent owner separately lists: 1) the claims for which supplemental examination is requested; and 2) the items of information submitted with the request, but does not specify which of the claims are to be examined in light of which items of information, the request will be taken as a request for the supplemental examination of all of the claims requested in light of each item of information submitted with the request. In either case, the patent owner must provide a separate, detailed explanation of the manner of applying every item of information submitted as part of the request to each claim for which supplemental examination is requested.

The Office will assume that all of the claims identified pursuant to [37 CFR 1.610\(b\)\(4\)](#) are requested to be considered in light of every item of information listed under [37 CFR 1.610\(b\)\(2\)](#), unless otherwise specified. For example, if, in a request for the supplemental examination of claims 1-10, five items of information are listed, and the patent owner wishes supplemental examination of claims 1-5 based on the first two items of information and supplemental examination of claims 1-10 based on the next three items of information, the patent owner must clearly indicate which claims are requested to be examined in light of which items of information. The patent owner can provide such an indication, for example, by use of the headings in the detailed explanation as discussed below, and/or in a table of contents.

A separate, detailed explanation is also required for each dependent claim for which supplemental examination is requested. If the patent owner wishes to rely upon the explanation of the manner of applying the item of information to the independent claim as the required explanation for the dependent claim, the patent owner should so state. For example, the patent owner may state: “Because dependent claims 2-5 each include all of the limitations of independent claim 1, the patent owner relies upon the required explanation under [37 CFR 1.610\(b\)\(5\)](#) of the manner of applying the Fisher article to independent claim 1, provided above, as the required explanation under [37 CFR 1.610\(b\)\(5\)](#) for dependent claims 2-5.” The patent owner is reminded, however,

that if the patent owner relies on a proper, detailed explanation of an independent claim as the detailed explanation for the dependent claims, then a review of the dependent claims may be limited to the detailed explanation of the independent claim provided by the patent owner.

If the request does not include an explicit statement incorporating the explanation for the independent claim as the required explanation for the dependent claims, or if the request fails to include separate explanations for the dependent claims, the Office may mail a notice of noncompliant request to inform the patent owner of the deficiency. See [MPEP § 2812.02](#).

The Office does not recommend that the detailed explanation under [37 CFR 1.610\(b\)\(5\)](#) be combined with an optional discussion, such as a discussion under [37 CFR 1.610\(c\)\(3\)](#) of how the claims patentably distinguish over the item of information. See [MPEP § 2812.02](#). Although the rules do not prevent the patent owner from combining such optional discussions within the detailed explanation, the Office recommends that this optional discussion be made under a separate subheading such as “Optional Explanation under [37 CFR 1.610\(c\)](#).” The Office has found that requests that combine the detailed explanation with the optional discussion typically include a lengthy discussion of why the claims are patentable over the items of information, or why the items of information do not raise a SNQ, with little to no explanation as to how the item of information is applicable to the claim limitations, as required by [37 CFR 1.610\(b\)\(5\)](#). By combining optional discussions with the required detailed explanation, the patent owner runs the risk of obscuring the “detailed explanation.” Such an obscured request could potentially result in the Office finding the “detailed explanation” was not provided, and therefore lead to a determination that the request failed to comply with the filing date requirements, and the loss of the date of the original deposit of the request as the filing date.

Use of headings and subheadings in the detailed explanation section of the supplemental examination request is encouraged. For example, headings that identify each item of information and which claims are being discussed are excellent tools to ensure

clarity in the explanations. In addition, under each heading, the Office highly recommends using separate subheadings for each independent claim and its associated dependent claims, if applicable.

For example, the patent owner may provide a series of statements which identify which claims are to be examined in light of each item of information listed under [37 CFR 1.610\(b\)\(2\)](#). The statements do not need to take the form of a proposed rejection, but should be sufficiently clear to determine the scope of the request. These statements will NOT be construed as an admission of unpatentability. These statements would only indicate that the patent owner is requesting that the Office consider whether certain issues may be raised by each item of information with respect to specific claims. If the patent owner is aware, or is made aware, that an item of information may raise particular patentability issue(s) (e.g., anticipation, obviousness, written description, enablement, etc...), the patent owner may identify these issues in the explanation under [37 CFR 1.610\(b\)\(5\)](#). These statements would provide a focused review on the potential issues and explicit consideration of those potential issues on the record.

The following are examples of statements that may be set forth as headings in the detailed explanation:

Supplemental examination is requested for claims 1-10 of the ‘123 patent in view of the Fisher article.

The patent owner requests the Office to consider whether the Fisher article raises a SNQ affecting claims 1, 4, 7, and 15 of the ‘123 patent.

Does Smith raise a SNQ affecting claims 1-3 and 5-7?

Does the Byrd declaration raise issues under [35 U.S.C. 101](#) affecting claims 1-7?

Does the Byrd declaration raise issues under [35 U.S.C. 112](#) affecting claims 2 and 8?

Are claims 1-5 entitled to the earlier filing date of March 5, 2008 in light of the Wolf declaration?

Patent owners are encouraged to be as comprehensive as possible in the explanation. This allows the patent owner to frame any potential issues, and assists the examiner in focusing on these potential issues to better determine if a SNQ is, or is not, raised. See also the guidance provided in [MPEP §§ 2214](#) and [2217](#) for *ex parte* reexamination proceedings.

Any failure to provide the required explanation for any item of information, or for any claim for which supplemental examination is requested, will be identified in a “Notice of Noncompliant Supplemental Examination Request ([37 CFR 1.610\(d\)](#)).” See [MPEP § 2812.02](#). Even if the request fails to strictly comply with the detailed explanation requirement, the Office may, in its sole discretion, accept the request if it is readily understood from the explanation provided in the request how the each of the items of information submitted with or as part of the request may be applied to each of the claims for which supplemental examination is requested.

## **II. REQUIREMENT CANNOT BE SATISFIED BY INCORPORATING BY REFERENCE A PAPER FROM ANOTHER PROCEEDING OR BY RELYING ON A PAPER BY A THIRD PARTY**

The requirement for a detailed explanation may not be met by incorporating by reference a paper from another proceeding, or by relying on a paper of a third party, which is submitted with the request.

A request for supplemental examination must stand on its own. A request for supplemental examination cannot be made, and the requirements for a detailed explanation pursuant to [37 CFR 1.610\(b\)\(5\)](#) cannot be satisfied, by incorporating by reference a paper from another proceeding. A paper filed in another proceeding must comply with the regulations and procedures set for that proceeding, and would address the issues specific to that proceeding, not to the present supplemental examination proceeding. A procedure which would require the examiner to sort through a paper filed in another proceeding and determine which issues may be raised and treated in a supplemental examination proceeding would frustrate the Office’s ability to conclude the supplemental examination proceeding within three months of the filing date of the request, as required

by [35 U.S.C. 257](#). For example, the patent owner cannot rely on an Office action from another proceeding as the detailed explanation required by [37 CFR 1.610\(b\)\(5\)](#) of the manner of applying the references cited in the Office action. Incorporation by reference would require Office staff to review any incorporated papers (such as, e.g., an Office action) to see if the papers happen to include a discussion of each item of information identified in the present supplemental examination proceeding and explain, in detail, how each item of information may be applied to each claim for which supplemental examination is requested, in order to determine if the filing date requirements are met. Such a procedure would absorb a greater portion of the three-month time period for conducting the supplemental examination and reduce the time available for a full and comprehensive analysis of each item of information submitted as part of the request. For these reasons, each request must stand on its own. The requirement for a detailed explanation cannot be satisfied by incorporating by reference a paper from another proceeding.

The detailed explanation must reflect the opinion of the patent owner, and not that of a third party (including a patent examiner). [35 U.S.C. 257\(a\)](#) specifies that a *patent owner* may request supplemental examination. The statute does not authorize the Office to accept a request for supplemental examination by a party other than the patent owner. The patent owner may not file papers on behalf of a third party and thus circumvent the intent of the legislation for supplemental examination. For this reason, the detailed explanation required under [37 CFR 1.610\(b\)\(5\)](#) must be drafted by the patent owner, and must reflect the opinion of the patent owner, i.e., what the patent owner believes is the relevance of each item of information, and what the patent owner believes is the manner of applying each item of information to each claim of the patent for which supplemental examination is requested. The patent owner may not rely on a paper filed by a third party (including a paper drafted by a patent examiner) to provide the detailed explanation required by [37 CFR 1.610\(b\)\(5\)](#) because the paper filed by the third party does not necessarily reflect the opinion of the patent owner.

If the patent owner wishes to have the examiner consider, in a supplemental examination proceeding, an Office action from another application or proceeding, the patent owner must separately list the Office action and any documents mentioned in the Office action as items of information pursuant to [37 CFR 1.610\(b\)\(2\)](#), and provide, when required under [37 CFR 1.610\(b\)\(7\)](#), copies of each item of information. In addition, the patent owner must supply its own detailed explanation under [37 CFR 1.610\(b\)\(5\)](#), of how the Office action and any documents mentioned in the Office action may be applied to the claims for which supplemental examination is requested.

### III. DETAILED EXPLANATION OF INFORMATION LIMITED TO CORRECTION OF FACTUAL INFORMATION

If the request includes an item of information limited to a correction of factual information, such as a foreign priority or domestic benefit claim, or the common ownership of the claimed invention, the request should also include one or more additional item(s) of information that potentially provide evidence that the patentability of the claims *depends upon* the factual information to be corrected. See [MPEP § 2809.01](#). In such a case, the request must include a detailed explanation required under [37 CFR 1.610\(b\)](#) of how each of the additional item(s) of information **may be applied** to the claims for which supplemental examination is requested. For example, if the patent owner wishes to correct the effective filing date of the patent to be examined by claiming the benefit of an earlier filing date of, e.g., a parent patent, the request should include a copy of the parent patent as a first item of information, and a copy of an intervening reference as a second item of information. The patent owner must include in the request a detailed explanation of how the intervening reference may be applied to the claims of the patent to be examined if the effective filing date **remains unchanged and is not corrected**. As another example, if the patent owner wishes to delete a benefit claim, or correct an earlier-obtained (incorrect) benefit claim in order to properly claim the benefit of a later filing date of a parent patent, the request should include, as separate items of information, a copy of any parent patent document on which the later (corrected) effective filing date

is based, and a copy of an intervening reference which would pre-date the effective filing date of the patent to be examined, if the domestic benefit claim were deleted or corrected to an appropriate later date. In this case, the patent owner must include in the request a detailed explanation of how the intervening reference may be applied to the patent claims if the effective filing date of the patent to be examined **is corrected** to the later date.

The request must also include an explanation of how the patent owner is entitled to the corrected factual information, where appropriate. For example, if the patent owner informs the Office that the effective filing date of the patent to be examined should reflect an earlier filing date of a parent patent, then the patent owner must also include in the request a detailed explanation of how the patent owner is entitled to the earlier effective filing date, by, for example, explaining how each claim limitation is supported by the parent patent. If, however, the patent owner merely wishes to delete a foreign priority or domestic benefit claim, an explanation of how the patent owner is entitled to the (new) effective filing date, if the domestic benefit claim (or, where appropriate, the foreign priority claim) is deleted, is not required.

#### *Example.*

A request for supplemental examination includes an item of information limited to the correction of the effective filing date of the patent, such as a copy of a parent patent and a discussion within the body of the request limited to how the effective filing date should be corrected, i.e., by changing the effective filing date of the patent to be examined to the earlier filing date of the parent patent. The request also includes a second item of information, i.e., an intervening reference, which causes the patentability of the claims to depend upon the domestic benefit claim. In such a case, the patent owner must include in the request a detailed explanation of how the intervening reference may be applied to the claims for which supplemental examination is requested, if the effective filing date of the patent to be examined remains unchanged and is not corrected. The patent owner must also include a detailed explanation of how the patent owner is entitled to the earlier effective filing date, by, for example, explaining how each claim limitation is supported by the parent patent.

## 2811.02 Optional Content [R-11.2013]

### *37 CFR 1.610 Content of request for supplemental examination.*

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- (c) The request may also include:

- (1) A cover sheet itemizing each component submitted as part of the request;
- (2) A table of contents for the request;
- (3) An explanation of how the claims patentably distinguish over the items of information; and
- (4) An explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

\*\*\*\*\*

[37 CFR 1.610\(c\)](#) provides that the request may optionally include the following enumerated elements:

#### **I. A COVER SHEET**

[37 CFR 1.610\(c\)\(1\)](#) permits the request to include a cover sheet itemizing each component submitted as part of the request. A “component” may be a certificate of mailing, the request, the patent to be examined, an item of information, and any other separate document that is deposited with or as part of the request. Submission of a cover sheet will assist the Office in the review of the request for compliance with the filing date requirements. For example, the Office may readily recognize that certain components listed as submitted on the cover sheet may be missing from the file and quickly contact the patent owner for correction. The Office encourages patent owners to submit a cover sheet with a request for supplemental examination. Use of the form PTO/SB/59 as the cover sheet is particularly encouraged.

#### **II. A TABLE OF CONTENTS**

[37 CFR 1.610\(c\)\(2\)](#) permits the request to include a table of contents for the request. Submission of a table of contents will provide clarity to the record and also help ensure that the request includes all of the required elements in accordance with [37 CFR 1.610\(a\)](#) and [37 CFR 1.610\(b\)](#). In addition, a table of contents will also assist in the initial review of the request to determine if the filing date requirements are met and in the examiner’s analysis of the request during the supplemental examination proceeding.

#### **III. AN EXPLANATION OF HOW THE CLAIMS PATENTABLY DISTINGUISH OVER THE ITEMS OF INFORMATION**

[37 CFR 1.610\(c\)\(3\)](#) provides that the request may include an explanation of how the claims patentably distinguish over the items of information. This optional discussion should be separately made under a separate subheading such as “Optional Explanation under [37 CFR 1.610\(c\)\(3\)](#).” The Office has found that requests that combine the detailed explanation under [37 CFR 1.610\(b\)\(5\)](#) with the optional discussion under [37 CFR 1.610\(c\)\(3\)](#) typically have a lengthy discussion of why the claims are patentable over the items of information with little to no explanation as to how the item of information is applicable to the claim limitations as required by [37 CFR 1.610\(b\)\(5\)](#). By combining the optional discussion with the required detailed explanation, the patent owner runs the risk that the Office will find that the required explanation was not provided, causing the request to be noncompliant, and the loss of the date of the original deposit of the request as the filing date. See [MPEP § 2812.02](#).

#### **IV. AN EXPLANATION OF WHY EACH ITEM OF INFORMATION SUBMITTED WITH THE REQUEST DOES OR DOES NOT RAISE A SUBSTANTIAL NEW QUESTION OF PATENTABILITY**

[37 CFR 1.610\(c\)\(4\)](#) provides that the request may include an explanation why each item of information does or does not raise a SNQ. Patent owners are encouraged to submit this explanation, which will assist the Office in analyzing the request. If the patent owner does submit this optional content, particularly where the patent owner explains why each item of information does not raise a SNQ, the Office strongly recommends that this optional discussion be separately presented, in the request, from the explanation required by [37 CFR 1.610\(b\)\(5\)](#), under a subheading such as “Optional Explanation under [37 CFR 1.610\(c\)\(4\)](#)”. See [MPEP §§ 2811.01](#) and [2812.02](#).

An application data sheet (ADS) under [37 CFR 1.76](#) cannot be submitted in a supplemental examination proceeding since a supplemental examination proceeding is not an “application.”

## 2812 Initial Processing of a Request for Supplemental Examination [R-11.2013]

All processing of requests for supplemental examination and of other papers filed in a supplemental examination proceeding and in any resulting *ex parte* reexamination proceeding will be performed by the staff of the Central Reexamination Unit.

### 2812.01 Filing Date of the Request [R-11.2013]

#### *37 CFR 1.610 Content of request for supplemental examination.*

(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, subject to the discretion of the Office. If the Office determines that the request, as originally submitted, is not 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 this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.

\*\*\*\*\*

The request must satisfy all the requirements of 37 CFR 1.605, 1.610 and 1.615, in order for a filing date to be granted. The Central Reexamination Unit will determine if a request for supplemental examination meets these requirements and will be granted a filing date. Even if the request is determined to be defective, the Office has the discretion under 37 CFR 1.610(d) to grant a filing date. However, the Office will not generally grant a filing date to a defective request unless the request contains only minor defects, such as minor formatting defects (e.g., improper margins, etc.).

If the request is not granted a filing date, the Office will mail a “Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d))”, detailing the defects in the request. See MPEP § 2812.02.

If the request is granted a filing date, the Office will mail a “Notice of Supplemental Examination Request Filing Date”. The following is a copy of such a notice.



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

Jones Law Firm  
123 Anywhere Street  
Anywhere, VA 12345

Patent No.: 5,123,456

Control No.: 96/999,999  
Date Mailed: 01/18/2013

**NOTICE OF SUPPLEMENTAL EXAMINATION REQUEST FILING DATE**

The patent owner is hereby notified that the filing date of the request for supplemental examination is 01/15/2013, the date that a request meeting all of the applicable requirements of 37 CFR §§ 1.605, 1.610, and 1.615 was received by the Office.

A supplemental examination certificate will issue within three months from the filing date of the request for supplemental examination. See 37 CFR 1.625.

This notice is being sent to the official correspondence address of record which, in a supplemental examination proceeding, is the official correspondence address of record in the patent file. See 37 CFR 1.33.

/Jane Doe/

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Legal Instruments Examiner  
Central Reexamination Unit 571 272 7705; FAX No. 571 272 9900

## 2812.02 Noncompliant Request for Supplemental Examination [R-11.2013]

### *37 CFR 1.610 Content of request for supplemental examination.*

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(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, subject to the discretion of the Office. If the Office determines that the request, as originally submitted, is not 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 this section, the filing date of the supplemental examination request will be the receipt date of the corrected request

If the Central Reexamination Unit (CRU) determines that the request, as originally submitted, does not satisfy all of the requirements of 37 CFR 1.605, 1.610 and 1.615, and all other applicable rules, and is not entitled to a filing date, the CRU will mail a Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d)) to the patent owner. The notice will be mailed to the patent owner at the correspondence address of record in the file of the patent for which supplemental examination is requested. See MPEP § 2805. The notice will specify the defects found in the request, and provide a specified time, generally 15 days, within which a corrected request may be timely filed. If further explanation is needed, an attachment to the notice will be provided specifically explaining why the request was non-compliant with the filing date requirements.

## 2812.03 Corrected Request [R-11.2013]

The patent owner has one opportunity to file a corrected request in response to a Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d)).

To be proper, a corrected request must properly address all of the defects set forth in the notice, and must otherwise comply with all of the requirements of 37 CFR 1.605, 1.610 and 1.615, and all other

applicable rules. The corrected request must include all of the components that the patent owner intends to include as part of the request, such as, for example, the request itself, copies of each of the items of information, a copy of the patent for which supplemental examination is requested, any transmittal sheet, a submission in compliance with 37 CFR 3.73(c), etc.

The patent owner must submit a complete, corrected request that will replace the originally-filed request. In other words, the patent owner must not submit a “supplemental” or corrected portion of the request, because the Office intends to expunge the entire originally-filed request once a corrected request is received. For this reason, a corrected request must contain all of the required information without reliance on any defective originally-filed request.

If all applicable fees have already been paid, these fees do not have to be resubmitted with the corrected request. Also, as discussed previously, even if the request (either the originally-filed request or the corrected request) is determined to be defective, the Office has the discretion under 37 CFR 1.610(d) to grant a filing date. See MPEP § 2812.01. For example, if the Office determines that a corrected request only contains one or more defects of minor character, the Office may, in its sole discretion, enter the defective corrected request, correct the defect(s) *sua sponte*, and/or request a submission from the patent owner in order to correct the defect(s). As a specific example, if the defect in the corrected request is limited to the omission of a copy of the patent for which supplemental examination is requested, and the copy of the patent was submitted with the originally-filed request, the Office may exercise its option to *sua sponte* accept the original submission of the copy of the patent as part of the corrected request.

The corrected request may be submitted using the Office’s Web-based electronic filing system (EFS-Web) at www.uspto.gov, or, if filed in paper form, may be addressed to the Central Reexamination Unit (CRU), Attn: “Mail Stop Supplemental Examination”. See MPEP § 2806. A corrected request must not be facsimile-transmitted. Any corrected request may be followed up by a



telephone call to the Central Reexamination Unit at (571) 272-7705 to ensure receipt.

If a proper corrected request is timely filed, the filing date of the supplemental examination request will be the receipt date of the corrected request. The Office will mail a Notice of Supplemental Examination Request Filing Date to the patent owner. A copy of such a notice is provided in [MPEP § 2812.01](#).

#### **2812.04 Termination Due to Defective/Improper Request or Corrected Request [R-11.2013]**

If, in response to a Notice of Noncompliant Supplemental Examination Request ([37 CFR 1.610\(d\)](#)), a proper corrected request is not filed or is not timely received, or if the corrected request is defective/improper (for example, if the corrected request does not address all of the defects set forth in the notice, or introduces a new defect which was not present in the original request), the request will not be granted a filing date, and the processing of the request will be terminated.

A single failure to comply with the Notice of Noncompliant Supplemental Examination Request ([37 CFR 1.610\(d\)](#)) will ordinarily result in the request not being granted a filing date. [37 CFR 1.610\(d\)](#) provides that “[i]f the patent owner does not timely comply with the notice, the request for supplemental examination will not be granted a filing date.” Thus, absent extraordinary circumstances, the patent owner will be given only one opportunity to correct the original request.

When terminating the request, the Office will mail a Notice of Termination, which will notify the patent owner of the defects found in the corrected request, or of the lack of receipt, or timely receipt, of a corrected request. The fee for reexamination as set forth in [37 CFR 1.20\(k\)\(2\)](#), if paid, will be refunded. The control number assigned to the request will be retained, but the request will not be granted a filing date, and will not be further considered. The request papers will not be returned, but will remain unavailable to the public. See [MPEP § 2813](#), subsection II.

If, after receiving a Notice of Termination, the patent owner still desires to request supplemental examination of the patent, the patent owner may file a new request for supplemental examination, which is complete and includes the missing information identified by the Office in the notice.

#### **2813 Handling of Papers, Other Than a Request, in a Supplemental Examination Proceeding [R-11.2013]**

*37 CFR 1.620 Conduct of supplemental examination proceeding.*

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(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](#).

(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.

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#### **I. ACTIONS ON PETITIONS OR PAPERS, OTHER THAN THE REQUEST, MAY BE HELD IN ABEYANCE**

[37 CFR 1.620\(b\)](#) provides that the Office may hold in abeyance an 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 [37 CFR 1.625](#). The only actions by the Office on the request for supplemental examination are:

- (1) a determination of whether the request is entitled to a filing date; and
- (2) a determination of whether any of the items of information submitted with the request raises a SNQ.

The only relevant type of petition that the Office anticipates will be filed in a supplemental examination proceeding would involve the filing date of the request, which is not relevant to the determination of whether any of the items of information submitted with the request raises a SNQ. Holding in abeyance a decision on such a petition will assist the Office in making the determination

regarding a SNQ within the three-month statutory period.

## II. UNAUTHORIZED OR IMPROPER PAPERS

[37 CFR 1.620\(c\)](#) provides that 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.

After filing a request for supplemental examination, no papers other than: (1) a corrected request filed in response to a notice of noncompliant supplemental examination request, or (2) a notice of a prior or concurrent post-patent Office proceeding pursuant to [37 CFR 1.620\(d\)](#), should be filed with the Office prior to the conclusion of the supplemental examination proceeding. Any papers directed to the merits of the supplemental examination proceeding other than (1) or (2) set forth above, will not be entered into the file, and may be discarded by the CRU without consideration. If such a paper is entered prior to its discovery, it may be expunged from the record.

Where an unauthorized or otherwise improper paper has already been scanned into the Image File Wrapper (IFW) of the supplemental examination proceeding before recognizing the nature of the paper, the paper cannot be physically returned to the party that submitted it. Instead, the paper will be expunged, i.e., by marking the paper “non-public” and “closed” so it does not appear in the public record of the supplemental examination proceeding. A copy of the Office communication notifying the patent owner of the return of the paper (or its expungement) will be made of record in the patent file. However, no copy of the returned/expunged paper will be retained by the Office. If a later submission of the returned/expunged paper is appropriate, such as during any resulting *ex parte* reexamination proceeding, then the paper may be filed and entered by the Office at that time. The date of the *later* submission will be the filing date of the paper.

### A. *Third Party Papers*

In accordance with [35 U.S.C. 257\(a\)](#), any party other than the patent owner is prohibited from filing papers or otherwise participating in any manner in the supplemental examination proceeding. See [37 CFR 1.601\(b\)](#). If a third party files any petition or other paper in a supplemental examination proceeding, it will not be entered into the official file or considered. If such papers are inadvertently entered, they will be expunged. See [37 CFR 1.620\(c\)](#).

### B. *Authorized but Defective Papers*

Where papers filed in a supplemental examination proceeding are defective (e.g., are not signed or fail to meet the filing date requirements), such papers may be expunged from the official file of the supplemental examination proceeding by marking the paper as “non-public” and “closed” so that it does not appear in the public record of the supplemental examination proceeding.

### C. *Application Data Sheet (ADS)*

An application data sheet (ADS) under [37 CFR 1.76](#) cannot be submitted in a supplemental examination proceeding since a supplemental examination proceeding is not an “application.”

## 2813.01 Amendments [R-11.2013]

### *37 CFR 1.620 Conduct of supplemental examination proceeding.*

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(f) No amendment may be filed in a supplemental examination proceeding.

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[37 CFR 1.620\(f\)](#) provides that no amendment may be filed in a supplemental examination proceeding. Amendments are not “information believed to be relevant to the patent” under [35 U.S.C. 257\(a\)](#) and a patent owner cannot file an amendment as part of a statement under [35 U.S.C. 304](#) because [35 U.S.C. 257\(b\)](#) expressly excludes the filing of a statement pursuant to [35 U.S.C. 304](#) in a supplemental examination proceeding.

Any paper containing an amendment that is filed in a supplemental examination proceeding is an

unauthorized paper, and will be expunged from the file if inadvertently entered. Amendments are not items of information, and are not appropriate in a supplemental examination proceeding.

An amendment may be submitted in an *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#). Patent owners, however, are reminded that [35 U.S.C. 257\(b\)](#) expressly removes the right of the patent owner to file a statement under [35 U.S.C. 304](#), which includes any amendment that the patent owner may wish to file prior to an initial Office action on the merits. Because the *ex parte* reexamination proceeding does not exist prior to the order under [35 U.S.C. 257](#), and because the patent owner is precluded from filing a statement under [35 U.S.C. 304](#), no amendment may be filed from the time the request for supplemental examination is filed, until after the issuance of an initial Office action on the merits in any *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#).

Patent owners are reminded that a statutory disclaimer under [35 U.S.C. 253](#) and [37 CFR 1.321\(a\)](#) may be submitted in the file of the patent prior to filing any request for supplemental examination. See [MPEP § 1490](#). Moreover, if the patent owner merely wishes to amend the patent claims, the patent owner may file a reissue application instead of a request for supplemental examination.

## 2814 Interviews Are Prohibited [R-11.2013]

### *37 CFR 1.620 Interviews Are Prohibited*

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

[37 CFR 1.620\(e\)](#) prohibits interviews in a supplemental examination proceeding. This requirement will assist the Office to process the request for supplemental examination within the three-month statutory period. Any paper requesting an interview that is filed in a supplemental examination proceeding is an unauthorized paper, and will be expunged from the file if inadvertently entered. A telephone call to the Office to confirm receipt of a request for supplemental examination, or to discuss general procedural questions, is not considered to be an interview for the purposes of this provision. This prohibition against interviews

applies only to supplemental examination proceedings. Interviews conducted in connection with any *ex parte* reexamination ordered under [35 U.S.C. 257](#) as a result of the supplemental examination proceeding are governed by the regulations governing *ex parte* reexamination proceedings. See, e.g., [37 CFR 1.560](#). Specifically, interviews are generally permitted to discuss issues of patentability, which are directly addressed during any *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#), and not during the supplemental examination proceeding.

## 2815 Time for Deciding Request [R-11.2013]

### *37 CFR 1.620 Conduct of supplemental examination proceeding.*

(a) Within three months after 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 item(s) of information identified in the request as applied to the identified claim(s) 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.

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Within 3 months following the filing date of a request for supplemental examination, the examiner will determine whether a SNQ affecting any claim of the patent is raised by any of the items of information properly presented in the request. See [35 U.S.C. 257\(a\)](#) and [37 CFR 1.620\(a\)](#). A supplemental examination proceeding concludes with the issuance of a supplemental examination certificate, indicating the results of the examiner's determination. If the three-month period ends on a Saturday, Sunday, or federal holiday within the District of Columbia, then the certificate should issue by the preceding business day.

The examiner should take up a request about 6 weeks after the request's filing date. A determination on the supplemental examination request may be made at any time during the period of enforceability of a patent. See [MPEP § 2808](#).

## 2816 Determination on the Request [R-07.2015]

### *37 CFR 1.620 Conduct of supplemental examination proceeding.*

Within three months after 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 item(s) of information identified in the request as applied to the identified claim(s) 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.

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### I. GENERAL GUIDANCE

[35 U.S.C. 257\(a\)](#) and [37 CFR 1.620\(b\)](#) require that, within three months following the filing date of a request for supplemental examination, the Office will determine whether a SNQ affecting any claim of the patent is raised by any of the items of information properly presented in the request. The standard for determining whether an item of information properly submitted as part of the request raises a SNQ will be the same as the standard set forth in the [MPEP § 2242](#) for *ex parte* reexaminations filed under [35 U.S.C. 302](#): i.e., whether there is a substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability. See [MPEP §§ 2816.02](#) and [2242](#).

The determination of whether such an item of information raises a SNQ will generally be limited to a review of the item(s) of information identified in the request with respect to the identified claim(s) of the patent. For example, a determination on a request that includes three items of information, where each item is requested to be considered with regard to claim 1, will generally be limited to whether any of the three items of information raise a SNQ with respect to claim 1. If the patent owner wishes to request consideration of an item of information with respect to multiple claims of the patent, the request for supplemental examination must include an identification of each claim in view of which the item of information is to be considered, and the required detailed explanation with respect to each claim. For example, if the patent owner fails

to request that the Office consider certain claims in view of an item of information, then the patent owner is not entitled to a determination for that item of information with respect to those claims. The determination will be based on the claims in effect at the time of the determination. See [MPEP § 2816.01](#). The supplemental examination certificate, which contains the results of the determination of whether a SNQ was raised by one or more of the items of information submitted as part of the request, will become a part of the official record of the patent.

### II. TREATMENT OF REQUEST WHEN LITIGATION IS COENDING

The patent owner may wish to consider the provisions of [35 U.S.C. 257\(c\)\(1\)](#) and [35 U.S.C. 257\(c\)\(2\)](#) on the effectiveness of any supplemental examination on already pending litigation when determining whether and when to file a request for supplemental examination. The Office takes no position on this issue.

The patent owner must promptly notify the Office of any federal court decision involving the patent.

#### A. *Litigation Search*

Before making a determination on the request for supplemental examination, a litigation search from the Technical Support Staff (TSS) of the Central Reexamination Unit (CRU) or the Scientific and Technical Information Center (STIC) may be done to check to see if the patent has been, or is, involved in litigation. A copy of the litigation search is scanned into the IFW file history. In the rare instance where the record of the supplemental examination proceeding or the litigation search indicates that additional information is desirable, guidance for making an additional litigation search may be obtained from the library of the Office of the Solicitor.

If litigation has concluded or is taking place in the patent on which a request for supplemental examination has been filed, or if the examiner discovers, at any time during the supplemental examination proceeding, that there is litigation or that there has been a federal court decision on the patent, the request must be promptly brought to the

attention of the Central Reexamination Unit (CRU) Supervisory Patent Reexamination Specialist (SPRS) or Technology Center (TC) Quality Assurance Specialist (QAS), who should review the decision on the request and any examiner's action to ensure that it conforms to current Office policy and guidelines set forth below.

### ***B. Supplemental Examination With Concurrent Litigation Prior to Federal Court Decision***

In view of the statutory mandate to make the determination on the request within three months, the determination on the request based on the record before the examiner will be made without awaiting a decision by the federal court. It is not realistic to attempt to determine what issues will be treated, or what issues will be finally decided, by the federal court prior to the court decision. Accordingly, the determination on the request will be made without considering the issues allegedly before the court. If an *ex parte* reexamination is ordered under [35 U.S.C. 257](#), the reexamination will continue until the Office becomes aware that a court decision has issued. At such time, the reexamination proceeding ordered under [35 U.S.C. 257](#) will be reviewed in accordance with the guidelines set forth in [MPEP § 2286](#).

### ***C. Federal Court Decision Issues After Request Filed But Before Supplemental Examination Certificate Issues***

A *non-final* federal court decision concerning a patent under supplemental examination will have no binding effect on the Office's determination whether a substantial new question of patentability has been raised in a supplemental examination proceeding. A non-final holding of claim invalidity or unenforceability (or, for that matter, a non-final holding of claim validity or enforceability) will not be controlling on the question of whether a substantial new question of patentability is present. A *final* federal court decision, i.e., after all appeals, *which upholds the validity* of one or more of the patent claims also *has no binding effect* on the supplemental examination proceeding. See, e.g., *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), in which the court states the Office is not bound by a court's holding of patent validity. While the Office may accord deference to factual

findings made by the court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity as it is not controlling on the Office. See, e.g., *In re Swanson et al.*, 540 F.3d 1368, 1378 (Fed. Cir. 2008), where the Federal Circuit approved of the Office's interpretation in [MPEP § 2242](#). See [MPEP § 2286](#) for further guidance.

A *final* holding of *claim invalidity or unenforceability* (after all appeals) *is controlling* on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. This policy tracks the Office's policy for *ex parte* reexamination. See, e.g., [MPEP § 2286](#), citing *Ethicon v. Quigg*. The Office will not intentionally conduct supplemental examination of patent claims which have been finally held to be invalid or unenforceable by a federal court.

If it is brought to the Office's attention that a federal court has issued a final holding of invalidity or unenforceability, any claims which are finally held invalid or unenforceable, and for which supplemental examination has been requested, will not be examined. If only some of the claims requested to be examined have been finally held invalid or unenforceable, the examiner will indicate, in the Reasons for Substantial New Question of Patentability Determination which accompanies the supplemental examination certificate (see [MPEP § 2816.03](#), subsection II), which requested claims were not under supplemental examination due to the final holding of invalidity or unenforceability. If all of the claims requested to be examined have been finally held invalid or unenforceable, the Office will not conduct the supplemental examination. If a filing date has been granted, it will be vacated by the Office. If it is brought to the Office's attention that, prior to the issuance of the supplemental examination certificate, a federal court has rendered a final decision, i.e., after all appeals, holding that all of the patent claims under supplemental examination are invalid or unenforceable, and if a supplemental examination certificate has inadvertently issued, the supplemental examination certificate will be vacated.

If a final federal court holding of invalidity or unenforceability is rendered after the date of electronic issuance of the supplemental examination certificate in the Office's electronic Image File Wrapper system (IFW) and in Public PAIR (see [MPEP § 2817.01](#)), the supplemental examination certificate will not be vacated. If reexamination has been ordered as a result of the supplemental examination proceeding, and if a final holding of invalidity or unenforceability is brought to the Office's attention, claims which are held invalid or unenforceable will be withdrawn from consideration in the reexamination. If all of the claims being examined in the reexamination proceeding are finally held invalid or unenforceable, the reexamination will be terminated by the CRU or TC Director as no longer containing a substantial new question of patentability. See [MPEP § 2286](#), subsection IV for further guidance.

### **2816.01 Claims Considered in Making the Determination [R-11.2013]**

The claims of the patent in effect at the time of the determination will be the basis for deciding whether "a substantial new question of patentability" (SNQ) is present. See [37 CFR 1.620\(a\)](#). In a supplemental examination proceeding, the determination will be limited to a review of the claim(s) for which supplemental examination is requested. The Office will generally not initiate supplemental examination of any patent claims for which supplemental examination was not requested by the patent owner.

[37 CFR 1.610\(b\)\(5\)](#) requires that the request must include "[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." If the patent owner fails to explain how any of the items of information may be applied to a patent claim, then the patent owner is not entitled to supplemental examination of that claim. If the patent owner does not provide an explanation of how an item of information may be applied to every claim requested to be examined in view of that item, the patent owner is not entitled to a determination on claims for which the required explanation was not provided. For example, if the patent owner requests supplemental examination of claims 1-10 in view of the Fisher

article, but only provides a separate, detailed explanation of the manner of applying the Fisher article to claims 1-5, then the patent owner is not entitled to a determination on claims 6-10, for which the required explanation was not provided. In such instances, a notice of noncompliant supplemental examination request should be mailed by the Office. See [MPEP § 2812.02](#).

If the examiner determines that a SNQ affecting a patent claim has been raised by at least one of the items of information submitted as part of the request, reexamination will be ordered under [35 U.S.C. 257](#). Once reexamination under [35 U.S.C. 257](#) is ordered, the Office may, in its sole discretion, reexamine claims other than the claims for which supplemental examination has been requested. See [35 U.S.C. 303\(a\)](#).

As a general rule, the Office will analyze a claim for which supplemental examination is requested only in light of the item(s) of information identified for that claim. For example, if the patent owner requests supplemental examination of claim 1 in light of three items of information, and requests supplemental examination of claim 5 in light of two other items of information, the Office will analyze, in general, only claim 1 in light of the three items of information identified for claim 1, and only claim 5 in light of the two items of information identified for claim 5. The examiner, however, has the discretion to determine whether any of the items of information properly submitted with the request raises a SNQ affecting any of the claims for which supplemental examination is requested. Based on the facts given in the above example, the examiner has the option to determine whether any of the five items of information provided with the request raises a SNQ affecting either claim 1 or claim 5. In other words, the examiner has the *option* of analyzing the items of information provided with the request with respect to any of the claims for which supplemental examination is requested, in a manner other than that provided by the patent owner in the request. The patent owner, however, is not *entitled* to a determination on a claim for which the required explanation under [37 CFR 1.610\(b\)\(5\)](#) has not been provided.

Amendments and/or new claims presented in any copending post-patent Office proceeding for the patent to be examined will not be considered nor commented upon when deciding a request for supplemental examination. However, if after reexamination of the patent under [35 U.S.C. 257](#) has been ordered, a certificate or reissued patent has been issued which amends the claims for which reexamination has been ordered under [35 U.S.C. 257](#), reexamination should be on the basis of the claims as amended by that certificate or reissued patent, because the certificate becomes part of the patent as of its issue date or the original patent is surrendered and replaced by the reissued patent as of the issue date of the reissued patent.

## 2816.02 Criteria for Making the Determination [R-07.2015]

The criteria for making the determination on the request for supplemental examination is whether any of the items of information submitted with or as part of the request raise a substantial new question of patentability affecting at least one claim of the patent. See [35 U.S.C. 257\(a\)](#).

### I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY (SNQ)

The examiner will determine if a SNQ is raised by each item of information. The SNQ standard in supplemental examination proceedings is identical to the “substantial new question of patentability” standard in *ex parte* reexamination proceedings. The meaning and scope of the term “a substantial new question of patentability” is not defined in the statute, and must be developed on a case-by-case basis, with reference to earlier case law involving *ex parte* reexamination proceedings.

If an item of information raises a substantial new question of patentability (SNQ) for at least one claim of the patent, then a substantial new question of patentability as to the claim is present, unless the **same** question of patentability has already been: (A) decided in a final holding of invalidity by a federal court in a decision on the merits involving the claim, after all appeals; (B) decided in an earlier concluded examination or review of the patent by the Office; or (C) raised to or by the Office in a pending

reexamination or supplemental examination of the patent. Issues involving [35 U.S.C. 325\(d\)](#) must be referred to the Director of the CRU. An “earlier concluded examination or review” of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; (C) the examination of the patent in an earlier concluded reexamination or supplemental examination of the patent; (D) the review of the patent in an earlier concluded trial by the Patent Trial and Appeal Board, such as a post-grant review, *inter partes* review, or covered business method review of the patent; or (E) any other contested proceeding, which has been concluded and which involved the patent.

For example, the **same** question of patentability may already have been decided if the Office has previously considered, in an earlier concluded examination or review of the patent, the same question of patentability based on the same prior art. See *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996). Prior art which has been cited or considered by the Office is referred to, for the sake of expediency, as “old art,” as coined by the Federal Circuit in its decision in *In re Hiniker*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998). Reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a SNQ. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s) or review(s), in view of a material new argument or interpretation presented in the request.

The answer to the question of whether a substantial new question of patentability (SNQ) exists, and therefore whether reexamination may be ordered, is decided by the Central Reexamination Unit (CRU), under the authority delegated by the Director of the USPTO.

An item of information raises a substantial new question of patentability where there is a substantial likelihood that a reasonable examiner would consider the item of information important in deciding whether or not the claim is patentable. For example, if the supplemental examination request states and explains that there may be a potential issue under [35 U.S.C. 101](#) regarding claim 5, the examiner would review the supplemental examination record to decide whether there is a substantial likelihood that a reasonable examiner would find the item of information (e.g., the discussion in the request regarding claim 5 and the potential issue under [35 U.S.C. 101](#)) important in determining the patentability of claim 5. If the item of information would be considered important, then the examiner should find a substantial new question of patentability unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by a federal court, decided by the Office in an earlier concluded examination or review, or raised to or by the Office in a pending reexamination or supplemental examination of the patent. For example, the same question of patentability may have already been decided by the Office where the examiner finds that the items of information, which are newly provided prior art patents or printed publications, are merely cumulative to prior art already fully considered by the Office in an earlier concluded examination or review of the claim.

For a substantial new question of patentability (SNQ) to be present, it is only necessary that: (A) an item of information raises a SNQ regarding at least one claim, i.e., the teaching of the item of information is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim, or raised to or by the Office in a pending reexamination or supplemental examination of the patent. It is not necessary that a “*prima facie*” case of unpatentability exist as to the claim in order for “a substantial new question of patentability” to be present as to the claim. Thus, a substantial new

question of patentability as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the items of information. As to the importance of the difference between a substantial new question of patentability and a “*prima facie*” case of unpatentability, see generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

Note that the clarification of the legal standard for determining obviousness under [35 U.S.C. 103](#) in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007) does not alter the legal standard for determining whether a SNQ exists.

## II. POLICY IN SPECIFIC SITUATIONS

An item of information *limited to* a correction of factual information, alone, may not raise a substantial new question of patentability (SNQ). For example, an item of information limited to the correction of a missing or erroneous foreign priority or domestic benefit claim, alone, generally will not raise an issue of patentability. In order for the correction of a foreign priority or domestic benefit claim to raise a SNQ, the request for supplemental examination should also include one or more additional item(s) of information, such as one or more intervening reference(s), that would cause the patentability of the claims under, e.g., [35 U.S.C. 102](#) or [103](#), to *depend upon* the foreign priority or domestic benefit claim. In such an instance, the item of information may raise a SNQ, *depending upon* whether the foreign priority or domestic benefit claim is or is not corrected. Similarly, information limited to the correction of other factual information, such as the common ownership of the claims, alone, may not raise a SNQ, in the absence of one or more additional item(s) of information that would cause the patentability of the claims to *depend upon* the issue of common ownership. For this reason, the Office recommends that any request for supplemental examination that includes an item of information limited to the correction of factual information, should also include one or more additional item(s) of information that potentially provide evidence that the patentability of the claims *depends upon* the



factual information to be corrected. See [MPEP § 2809.01](#).

*Example of Determination on Information Directed to a Missing Domestic Benefit Claim*

The patent owner informs the Office, in a request for supplemental examination, that the effective filing date of the patent to be examined should be corrected to reflect the earlier filing date of a parent patent. The request includes, as an item of information, a copy of the parent patent and a discussion within the body of the request explaining how each claim limitation of the patent to be examined is supported by the disclosure of the parent patent. The request also includes, as a second item of information, a copy of an intervening patent or printed publication that caused the patent owner to reconsider the effective filing date of the claims. In such a case, the examiner will first determine whether the second item of information, i.e., the intervening reference, would raise a substantial new question of patentability (SNQ) if the effective filing date of the patent to be examined remains unchanged and is not corrected.

If the examiner determines that a SNQ would be raised by the intervening reference if the effective filing date of the patent to be examined remains unchanged and is not corrected, the examiner may, at the examiner's option, then make a *preliminary* determination of whether the patent owner is entitled to the benefit of the earlier filing date by, for example, analyzing whether the claim limitations of the patent to be examined are supported by the disclosure of the parent patent. A *final* determination, however, that the patent owner is entitled to the benefit of the earlier filing date will, in general, only be made during any resulting reexamination proceeding, when, for example, any appropriate amendment to the specification, and the required petition for an unintentionally delayed benefit claim under [37 CFR 1.78](#), may be filed. See [MPEP §§ 2813–2813.01](#). For a discussion of the explanation under [37 CFR 1.610\(b\)\(5\)](#) that must be provided in such a case, see [MPEP § 2811.01](#), subsection III. Where the examiner determines that a substantial new question of patentability is raised, reexamination will be ordered, and the domestic benefit claim may be added during the resulting

reexamination proceeding. See [MPEP § 2809.01](#) and [MPEP § 2816.03](#), subsection II.

If the examiner determines that the intervening reference does not raise a substantial new question of patentability even if the effective filing date of the patent to be examined remains unchanged and is not corrected, then the item of information limited to the correction of the missing domestic benefit claim, i.e., the parent patent and the discussion within the body of the request showing how each claim limitation is supported by the disclosure of the parent patent, will not be further considered on the merits. The examiner will issue a supplemental examination certificate indicating that no substantial new question of patentability is raised by the request, and the domestic benefit claim will not be added to the patent. See [MPEP § 2816.03](#), subsection II.

*Example of a Determination on Information Directed to the Deletion of an Earlier-Obtained Domestic Benefit Claim*

The patent owner, in a request for supplemental examination, requests the deletion of an earlier-obtained domestic benefit claim. The request includes, as an item of information, an intervening reference which caused the patent owner to reconsider the effective filing date of the claims, and which would pre-date the effective filing date of the patent to be examined, if the domestic benefit claim is deleted. The request also includes a detailed explanation of how the intervening reference may be applied to the patent claims if the domestic benefit claim is deleted. See [MPEP § 2811.01](#), subsection III. In this case, the examiner would determine whether the intervening reference would raise a substantial new question of patentability (SNQ) affecting the identified claims of the patent if the domestic benefit claim is deleted and the effective filing date of the patent to be examined **is corrected** to an appropriate later filing date. If the examiner determines that the intervening reference does not raise a SNQ, then the examiner will issue a supplemental examination certificate indicating that no SNQ is raised by the request. If the examiner determines that the intervening reference raises a SNQ, then the examiner will issue a supplemental examination certificate indicating that a SNQ affecting at least one claim of the patent is raised in

the request. Reexamination will be ordered, and the domestic benefit claim may be corrected during the resulting reexamination proceeding. Patent owners are reminded, however, that the deletion of the domestic benefit claim in this example will not operate to extend the term of the patent. See [MPEP § 2809.01](#) and [MPEP § 2816.03](#), subsection II.

*Determination Where the Request Only Includes Information Limited to the Correction of Factual Information*

If the only information provided with the request is solely directed to the correction of factual information, such as the correction of a missing or erroneous foreign priority or domestic benefit claim, or the correction of the common ownership of the claims, which does not, itself, raise a substantial new question of patentability (SNQ), then (1) the supplemental examination certificate will state that no SNQ is raised in the request for supplemental examination; and (2) the reasons for SNQ determination will indicate that the information regarding the correction of factual information did not raise a SNQ because the patent owner did not include with the request any additional items of information that caused the patentability of the claim(s) to depend upon the corrected factual information.

For example, if the request only includes one item of information, and that item of information is limited to the correction of an erroneous domestic benefit claim, such as, e.g., i.e., a copy of a parent patent and a discussion within the body of the request showing how each claim limitation is supported by the disclosure of the parent patent, then the reasons for SNQ determination should indicate that the information regarding the domestic benefit claim did not raise a SNQ because the patent owner did not include with the request any intervening art or other information that caused the patentability of the claim(s) to depend upon the domestic benefit claim. See [MPEP § 2809.01](#).

*Determination Where the Request Includes Information Limited to Correction of Factual Information and Additional Information Unrelated to the Factual Information to be Corrected*

Alternatively, the request may include one or more additional items of information which are unrelated to the factual information to be corrected, but which raise a substantial new question of patentability (SNQ). For example, the patent owner may include, in addition to information limited to the correction of a domestic benefit claim, an item of information such as a reference patent that would qualify as prior art under [35 U.S.C. 102](#) even if the domestic benefit claim is corrected. If the examiner determines that a SNQ is raised in the request, the examiner may, at the examiner's option, make a preliminary determination of whether the patent owner is entitled to the benefit of the corrected benefit claim, as discussed previously. Reexamination will be ordered, and the domestic benefit claim may be corrected during the resulting reexamination proceeding. See [MPEP § 2809.01](#) and [MPEP § 2816.03](#), subsection II. If the examiner determines that no SNQ is raised by the additional item(s) of information, the information limited to a correction of the domestic benefit claim will not be further considered on the merits. A supplemental examination certificate, which indicates that no SNQ is raised by the request, will be issued, and the benefit claim will not be corrected.

See also [MPEP § 2242](#), subsections II and III, for more information on how a substantial new question of patentability may be determined in specific situations.

## **2816.03 Content of the Determination [R-11.2013]**

### **35 U.S.C. 257 Supplemental examinations to consider, reconsider, or correct information.**

(a) REQUEST FOR SUPPLEMENTAL EXAMINATION.—A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.

\*\*\*\*\*

### **37 CFR 1.620 Conduct of supplemental examination proceeding.**

(a) Within three months after 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 item(s) of information identified in the request as applied to the identified claim(s) 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.

\*\*\*\*\*

Once a determination is made on the request as to whether the items of information raise a substantial new question of patentability (SNQ), the examiner will prepare: (1) the Supplemental Examination Certificate; and (2) the Reasons for Substantial New Question of Patentability Determination (the "reasons document").

#### **I. THE SUPPLEMENTAL EXAMINATION CERTIFICATE**

The supplemental examination certificate is prepared by utilizing a form captioned "Supplemental Examination Certificate." The form lists all of the

items of information properly submitted as part of the supplemental examination request and states whether a SNQ affecting at least one claim of the patent is raised in the request.

Examiners should not initial, sign and date the listing of the items of information ([37 CFR 1.610\(b\)\(2\)](#)) submitted with the request. This practice is different from the current practice regarding prior art citations in applications or proceedings involving patents. There is no need to initial, sign, and date the listing submitted under [37 CFR 1.610\(b\)\(2\)](#) because the supplemental examination certificate includes a citation to each item of information properly submitted as part of the request.

A copy of a supplemental examination certificate indicating that a SNQ affecting at least one claim of the patent is raised in the request, and a copy of a supplemental examination certificate indicating that no SNQ is raised in the request, appear below.

(12) **SUPPLEMENTAL EXAMINATION CERTIFICATE****United States Patent  
Smith et al.****(10) Number: US 9,999,999 F1  
(45) Certificate Issued: Dec. 10, 2012****Control No.: 96/999,999  
Primary Examiner: Cynthia L. Nessler****Filing Date: Sep. 16, 2012**

A substantial new question of patentability affecting at least one claim of the patent is raised in the request for supplemental examination. See the Reasons for Substantial New Question of Patentability Determination in the file of this proceeding. Accordingly, *ex parte* reexamination will be ordered pursuant to 35 U.S.C. 257.

(56) **Items of Information**

## U.S. PATENT DOCUMENTS

9999999	3/2006	Updike
9999990	4/2007	Kerouac

## FOREIGN PATENT DOCUMENTS

DE	9999999 A1	11/2003
SE	9999999 A2	10/2001

## OTHER DOCUMENTS

Schmidt et al., Fundamentals of Building Construction Materials, Journal of Engineering, January 2005, pp. 16-18.

Webster's Dictionary, Houghton Mifflin Company (publishers), 1984, p. 303 (definition of construction).

(12) **SUPPLEMENTAL EXAMINATION CERTIFICATE****United States Patent**  
**Smith et al.****(10) Number: US 9,999,999 F1**  
**(45) Certificate Issued: Dec. 10, 2012****Control No.: 96/999,999**  
**Primary Examiner: Cynthia L. Nessler****Filing Date: Sep. 16, 2012**

No substantial new question of patentability is raised in the request for supplemental examination. See the Reasons for Substantial New Question of Patentability Determination in the file of this proceeding.

(56) **Items of Information**

## U.S. PATENT DOCUMENTS

9999999	3/2006	Updike
9999990	4/2007	Kerouac

## FOREIGN PATENT DOCUMENTS

DE	9999999 A1	11/2003
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## OTHER DOCUMENTS

Schmidt et al., Fundamentals of Building Construction Materials, Journal of Engineering, January 2005, pp. 16-18.

Webster's Dictionary, Houghton Mifflin Company (publishers), 1984, p. 303 (definition of construction).

## II. THE REASONS FOR SUBSTANTIAL NEW QUESTION OF PATENTABILITY DETERMINATION (REASONS DOCUMENT)

The Reasons for Substantial New Question of Patentability (SNQ) Determination (or “reasons document”) will typically accompany the supplemental examination certificate. This document will explain, for each item of information, why each item does or does not raise a SNQ. Form paragraph 28.01 should be used as the heading for the reasons document.

### A. *Where At Least One Substantial New Question of Patentability is Found*

If the request is determined to raise at least one SNQ, the supplemental examination certificate will indicate that a SNQ affecting at least one claim of the patent has been raised, and will refer to the reasons document. For each item of information, the reasons document should include:

(1) A statement that the item of information, as presented in the request, raises a SNQ, and an identification of the claims for which a SNQ is raised.

(2) Where appropriate, a statement that the item of information, as presented in the request, does not raise a SNQ, and an identification of the claims for which a SNQ is not raised.

(3) A brief statement of the basis for the determination that a SNQ affecting the identified claims was raised by the item, or was not raised by the item.

Where an item of information is determined to raise a SNQ, but the SNQ is determined to affect less than all of the claims which were requested to be examined in view of the item, the reasons document may also include, in addition to (1) above, an identification of the claims for which a SNQ was not raised by the item, and a brief statement of the basis for that determination.

For each item of information, the examiner need only identify one SNQ (e.g., a teaching that would be important to a reasonable examiner when determining patentability) for each identified claim. The examiner may rely upon a determination that a

SNQ is raised for an independent claim as the basis that a SNQ is raised for each dependent claim that incorporates the subject matter of the independent claim, if the dependent claims were also requested to be examined by the patent owner. For example, if the examiner finds that item of information A raises a SNQ for independent claim 1, the examiner may rely upon the explanation of how item A raises a SNQ for claim 1 as the explanation of how item A raises a SNQ for dependent claims 2-10, which were also requested to be examined by the patent owner. Form paragraph 28.03 should be used to explain why an item of information raises a SNQ.

**For each item of information, if the examiner determines that a substantial new question of patentability is raised by the item, the reasons document should point out:**

(A) That the item of information raises a SNQ affecting specific claims of the patent (where the specific claims are listed);

(B) The recitation of the specific claim limitation(s) affected by the teaching(s) of the item of information;

(C) What the teaching(s) are, and where in the item of information the teaching(s) are to be found;

(D) Why a reasonable examiner would consider the teaching(s) to be important in determining the patentability of the specific claim(s) (where the specific claims are listed) for which supplemental examination is being requested; and

(E) Where appropriate, whether the item of information is prior art (e.g., due to its issue date or publication date) to specific patent claims (where the specific claims are listed) and, when applicable, the reasons why the item of information is deemed to be available as prior art against the patent claims.

**For each item of information, if the examiner determines that a substantial new question of patentability is not raised by the item, the reasons document should point out:**

(A) That the item of information does not raise a SNQ affecting specific claims of the patent (where the specific claims are listed);

(B) The recitation of the specific claim limitation(s), if any, which were discussed in the

request with respect to the teaching(s) of the item of information;

(C) What the teaching(s) are, if any, and where in the item of information the teaching(s) are to be found;

(D) Why a reasonable examiner would not consider the teaching(s) to be important in determining the patentability of the specific claim(s) (where the specific claims are listed) for which supplemental examination is being requested (e.g., why the teaching(s) are cumulative to the teachings considered in the earlier concluded examination or review of the patent, or are not important even though the teaching(s) are not cumulative and are available against the claim);

(E) Where appropriate, whether the item of information is available as prior art (e.g., due to its issue date or publication date) against specific patent claims (where specific claims are listed) and, when applicable, the reasons why the item of information is or is not deemed to be available as prior art against the patent claims; and

(F) If the item of information is not deemed to be available as prior art against specific patent claims, a further statement, when applicable, that the item does not contain information that raises any other issues of patentability with respect to the specific claims (where the specific claims are listed). For example, a request for the supplemental examination of claims 1-3 includes, as an item of information, a copy of a foreign search report which is determined not to raise any issues of patentability under [35 U.S.C. 101](#), [102](#), [103](#), or [35 U.S.C. 112](#) affecting claims 1-3. In the reasons document, the examiner should explain why the foreign search report does not qualify as prior art (under, e.g., [35 U.S.C. 102](#) or [103](#)) against any of claims 1-3, and should also state that the foreign search report does not contain information that raises any other issues of patentability with respect to claims 1-3 of the patent.

Where applicable, the examiner should also explain why an item of information that was cited in the record of the patent is barred by the guidelines set forth in [MPEP § 2242](#), subsection II.A.

**Where it is not clear from the patent file or supplemental examination record, the reasons**

**document may optionally include, for each item of information:**

(i) An explanation that the teaching was not previously considered or addressed in any prior examination or proceeding involving the patent or a final holding of invalidity of the patent by the federal courts; or

(ii) An explanation that the teaching, if considered in a previous examination or proceeding of the patent or of the application that became the patent, is presented in a new light, or in a different way, by the arguments presented in the request.

If the examiner determines that an item of information does not raise a SNQ affecting every claim to which the item of information was applied in the request, the examiner should state the claim(s) for which the SNQ was not raised and a brief statement of the reasons why the item did not raise a SNQ affecting the identified claim(s). If the patent owner applied the item of information to an independent claim, but did not apply the item to its dependent claims, the examiner may rely upon a determination that a SNQ is not raised for the independent claim as the basis for the determination that a SNQ is not raised for each dependent claim, for which supplemental examination was also requested, and which incorporates the subject matter of the independent claim. For example, if the patent owner provided a detailed explanation of the manner of applying item of information A to independent claim 11 as required by [37 CFR 1.610\(b\)\(5\)](#), and relied on that explanation as the only required explanation for dependent claims 12-21 (for which supplemental examination was also requested), and if the examiner finds that item of information A does not raise a SNQ for independent claim 11, then the examiner may rely upon the explanation of how item A does not raise a SNQ for claim 11 as the explanation for its dependent claims 12-21. Form paragraph 28.02 should be used to explain why an item of information does not raise a SNQ.

The examiner will not decide, and no statement should be made, as to whether the claims are rejected over the items of information. It is unnecessary for the examiner to decide questions of patentability of the claims in a supplemental examination

proceeding. The examiner only decides whether there is a SNQ.

***B. Where No Substantial New Question of Patentability is Found***

If the examiner determines that none of the items of information properly submitted as part of the request raise a SNQ, the supplemental examination certificate will state that no SNQ is raised in the request for supplemental examination, and will refer to the Reasons for Substantial New Question of Patentability Determination (i.e., "the reasons document"). The reasons document should explain why each item of information did not raise a SNQ for every claim to which that item of information was applied in the supplemental examination request. See subsection II.A., above. Form paragraph 28.02 should be used to explain why each item of information does not raise a SNQ.

***C. Where the Request Includes Factual Information to be Corrected***

Where the request includes an item of information limited to the correction of factual information, the request should also include one or more additional item(s) of information, such as one or more intervening reference(s), that potentially provide evidence that the patentability of the claims *depends upon* the factual information to be corrected. In such an instance, the item of information may raise a SNQ, *depending upon* whether the foreign priority or domestic benefit claim is or is not corrected.

*Example 1.* The request includes a first item of information limited to the addition of a claim for the benefit of an earlier effective filing date, a second item of information which is an intervening reference, and a detailed explanation of how the intervening reference may be applied to the patent claims if the domestic benefit claim remains unchanged, and is not corrected. If the examiner determines that a SNQ is raised by the intervening reference, the examiner should include, in the reasons document, the reasons why the intervening reference raises a SNQ, in accordance with the general guidance set forth above in subsection II.A. If the examiner determines that no SNQ is raised by the intervening reference, the examiner should

provide, in the reasons document, the reasons for the determination that the second item of information, i.e., the intervening reference, does not raise a SNQ in accordance with the general guidance set forth above in subsection II.B., even if the domestic benefit claim remains unchanged and is not corrected. The examiner should also provide a statement to the effect that the first item of information, which is limited to the correction of a domestic benefit claim, does not raise a SNQ because the patent owner did not include with the request any additional items of information that cause the patentability of the claim(s) to depend upon the domestic benefit claim, even if the domestic benefit claim remains unchanged and is not corrected.

*Example 2.* The request includes a first item of information limited to the deletion of a benefit claim, a second item of information which is a reference that pre-dates the effective filing date of the patent if the benefit claim is deleted (i.e., an intervening reference), and a detailed explanation of how the intervening reference may be applied to the patent claims if the benefit claim is deleted. If the examiner determines that a SNQ is raised by the intervening reference if the benefit claim is deleted, the examiner should include, in the reasons document, the reasons why the intervening reference raises a SNQ if the domestic benefit claim is deleted, in accordance with the general guidance set forth above in subsection II.A. If the examiner determines that no SNQ is raised by the intervening reference, the examiner should provide, in the reasons document, the reasons for the determination that the second item of information, i.e., the intervening reference, does not raise a SNQ in accordance with the general guidance set forth above in subsection II.B., even if the domestic benefit claim was deleted. The examiner should also provide a statement to the effect that the first item of information, which is limited to the deletion of the domestic benefit claim, does not raise a SNQ because the patent owner did not include with the request any additional items of information that cause the patentability of the claim(s) to depend upon the domestic benefit claim, even if the domestic benefit claim were to be deleted.



#### *D. Panel Review*

After an examiner has made a preliminary determination, the examiner will formulate a draft Supplemental Examination Certificate and a draft Reasons for Substantial New Question of Patentability Determination (i.e., a draft "reasons document"). The examiner will then inform his/her CRU Supervisory Patent Reexamination Specialist (SPRS) of his/her preliminary determination. A panel review conference will be convened, and the conference members will review the preliminary determination. See [MPEP § 2271.01](#) for the make-up of the panel. If the conference confirms the examiner's preliminary determination, the Supplemental Examination Certificate shall be issued by its publication in the Office's Image File Wrapper System, IFW, which will be viewable in Public PAIR. The reasons document will be labeled "Reasons for SNQ Determination" in IFW, and it will generally be available for viewing at the same time as, or shortly after, the issuance of the certificate. The reasons document will be signed by the examiner, with the two other conferees initialing as "conferee" to indicate their presence in the conference.

If the conference does not confirm the examiner's preliminary determination, the examiner will reevaluate and make appropriate changes to the draft Supplemental Examination Certificate and draft reasons document, in accordance with any agreement reached at the conference.

#### *E. Form Paragraphs for the Reasons for Substantial New Question of Patentability Determination*

The following are the form paragraphs that should be used in the Reasons for Substantial New Question of Patentability Determination:

##### **¶ 28.01 Header for Statement of Reasons for Substantial New Question of Patentability Determination**

REASONS FOR SUBSTANTIAL NEW QUESTION OF PATENTABILITY DETERMINATION

##### **¶ 28.02 Reasons for Finding No Substantial New Question of Patentability**

[1], as presented in the request, does not raise a substantial new question of patentability because [2].

##### **Examiner Note:**

1. In bracket 1, insert the name or description, as appropriate, for the item of information. For example, a patent or patent application publication may be designated using the name of the patentee or first-named inventor, such as "the Jones patent," "the Jones patent application publication," or the number of the patent or patent application publication. A non-patent literature document may be designated by the name of the author, such as the "the Sherwood publication" and the date of the publication, if desired. A sales receipt or invoice should be designated using the date of the receipt, and any appropriate descriptive information, such as "the March 11, 2011, BigBoxStore sales receipt," or "the April 1, 2011 XYZ Corporation invoice." An affidavit or declaration should be designated using the name of the declarant and the date of the affidavit or declaration, such as "the Schmidt declaration dated January 20, 2012." A transcript of an audio or video recording should be designated using the title of the recording and the date of the recording, if applicable, such as "the transcript of the September 16, 2012 XYZ Corporation Marketing Video." A discussion within the body of the request regarding a potential issue under [35 U.S.C. 101](#) may be designated, for example, as "the discussion on pages 7-11 of the request regarding a potential issue under [35 U.S.C. 101](#)."

2. In bracket 2, insert the reasons for the determination that the item of information does not raise a substantial new question of patentability.

##### **¶ 28.03 Reasons for Finding A Substantial New Question of Patentability**

[1], as presented in the request, raises a substantial new question of patentability affecting patent claim(s) [2] because [3].

##### **Examiner Note:**

1. In bracket 1, insert the name or description, as appropriate, for the item of information. For example, a patent or patent application publication may be designated using the name of the patentee or first-named inventor, such as "the Jones patent," "the Jones patent application publication," or the number of the patent or patent application publication. A non-patent literature document may be designated by the name of the author, such as the "the Sherwood publication" and the date of the publication, if desired. A sales receipt or invoice should be designated using the date of the receipt, and any appropriate descriptive information, such as "the March 11, 2011, BigBoxStore sales receipt," or "the April 1, 2011, XYZ Corporation invoice." An affidavit or declaration should be designated using the name of the declarant and the date of the affidavit or declaration, such as "the Schmidt declaration dated January 20, 2012." A transcript of an audio or video recording should be designated using the title of the recording and the date of the recording, if applicable, such as "the transcript of the September 16, 2012, XYZ Corporation Marketing Video." A discussion within the body of the request regarding a potential issue under [35 U.S.C. 101](#) may be designated, for example, as "the discussion on pages 7-11 of the request regarding a potential issue under [35 U.S.C. 101](#)."

2. In bracket 2, insert the claims for which a substantial new question of patentability has been raised.

3. In bracket 3, insert the reasons for the determination that the item of information raises a substantial new question of patentability (SNQ). If a SNQ is found for only a portion of the claims identified with respect to the item of information, then an additional statement may be included explaining why a SNQ was found with respect to some of the identified claims, and why a SNQ was not found with respect to the remainder of the identified claims. For example, if the patent owner requests supplemental examination of claims 1-10 in view of the Schmidt patent, and the examiner finds that a substantial new question of patentability affecting only patent claims 1-5 is raised by that item of information, then the form paragraph may be completed by, for example, stating “The Schmidt patent, as presented in the request, raises a substantial new question of patentability affecting patent claims 1-5 because [provide reasons]. However, the Schmidt patent, as presented in the request, does not raise a substantial new question of patentability affecting patent claims 6-10 because [provide reasons].”

### **2816.04 Effect of the Determination [R-11.2013]**

If the examiner determines that a SNQ 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](#). See [37 CFR 1.625\(b\)](#) and [\(d\)](#). See [MPEP § 2818.01](#).

If the supplemental examination certificate indicates that no SNQ is raised by any of the items of information in the request, *ex parte* reexamination will not be ordered, and the fee for reexamination ordered as a result of supplemental examination, as set forth in [37 CFR 1.20\(k\)\(2\)](#), will be refunded in accordance with [37 CFR 1.610\(d\)](#). See [MPEP § 2818.02](#).

### **2817 Conclusion of Supplemental Examination [R-11.2013]**

#### ***37 CFR 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.***

(a) A supplemental examination proceeding will conclude with the electronic issuance of a supplemental examination certificate. 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.

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[35 U.S.C. 257\(a\)](#) requires that supplemental examination “shall conclude with the issuance of a certificate indicating whether the information presented in the request raises a substantial new

question of patentability.” A supplemental examination proceeding is initiated by the filing of a request for supplemental examination that complies with [35 U.S.C. 257](#) and [37 CFR 1.601 et seq.](#), and all other applicable rules, and ends with the electronic issuance of the supplemental examination certificate. The supplemental examination certificate will state the result of the Office’s determination whether any of the items of information submitted as part of the request raises a SNQ.

If the supplemental examination certificate states that a SNQ is raised by one or more of the items of information submitted as part of the request, *ex parte* reexamination of the patent will be ordered under [35 U.S.C. 257](#). In other words, if the supplemental examination certificate states that a SNQ is raised, an *ex parte* reexamination proceeding will be initiated after the conclusion of the supplemental examination proceeding. If, however, the supplemental examination certificate states that no substantial new question of patentability is raised in the request, then an *ex parte* reexamination proceeding will not be initiated at the conclusion of the supplemental examination proceeding.

### **2817.01 Processing and Electronic Issuance of Supplemental Examination Certificate [R-11.2013]**

After the examiner has prepared the Supplemental Examination Certificate and the Reasons for Substantial New Question of Patentability Determination (“reasons document”), these documents, and the supplemental examination file, are referred to the Central Reexamination Unit (CRU) Legal Instrument Examiner (LIE) for coordinating the clerical processing carried out by the technical support staff.

The Supplemental Examination Certificate and the reasons document are made of record in the electronic file of the supplemental examination proceeding. Copies of both documents are also mailed to the patent owner.

The supplemental examination certificate will be electronically issued in the Office’s electronic Image File Wrapper system and will be visible in Public PAIR within three months of the filing date of the

request. Electronic issuance of the supplemental examination certificate will permit the Office to issue the certificate within the three-month statutory period and will permit sufficient time to review the items of information submitted as part of the request. The certificate will be viewable by the public in Public PAIR.

The electronically issued supplemental examination certificate will display the filing date of the request. The electronically issued supplemental examination certificate will also list each of the items of information properly submitted as part of the request, and state whether the request raises a SNQ affecting at least one claim of the patent.

If the supplemental examination certificate indicates that a SNQ is raised 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 as an attachment to the patent by the Office's patent publication process in accordance with established *ex parte* reexamination practice (see [37 CFR 1.570](#)). The electronically issued supplemental examination certificate will also remain as part of the public record for the patent.

If the supplemental examination certificate indicates that no SNQ is raised in the request, the electronically issued supplemental examination certificate, which will remain as part of the public record for the patent, will also be published in due course by the Office's patent publication process as an attachment to the patent. The fee for reexamination ordered as a result of supplemental examination, as set forth in [37 CFR 1.20\(k\)\(2\)](#), will be refunded in accordance with [37 CFR 1.610\(d\)](#).

## 2818 Procedure after Conclusion of Supplemental Examination [R-11.2013]

*37 CFR 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.*

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(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.

(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 fee for reexamination ordered as a result of supplemental examination, as set forth in [§ 1.20\(k\)\(2\)](#), will be refunded in accordance with [1.26\(c\)](#).

(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 claim 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\(b\)](#).

Supplemental examination is concluded by the electronic publication of the certificate. The Office procedure after publication of the certificate depends on whether the Office determines that a SNQ affecting at least one claim of the patent is raised in the request.

If the supplemental examination certificate indicates that a SNQ is raised, *ex parte* reexamination of the patent will be ordered under [35 U.S.C. 257](#). See [37 CFR 1.625\(b\)](#). An *ex parte* reexamination ordered as a result of a supplemental examination proceeding will be conducted in accordance with the existing rules governing *ex parte* reexamination, except that: (i) the patent owner will not have the right to file a patent owner statement; and (ii) the Office will address each SNQ without regard to whether it is raised by a patent or printed publication. See [37 CFR 1.625\(d\)](#) and [MPEP § 2818.01](#).

If the supplemental examination certificate indicates that no SNQ is raised, *ex parte* reexamination will not be ordered under [35 U.S.C. 257](#). In this case, the electronically issued supplemental examination certificate will be published in due course by the Office's patent publication process as an attachment to the patent. The fee for reexamination ordered as a result of supplemental examination, as set forth in [37 CFR 1.20\(k\)\(2\)](#), will be refunded in accordance with [37 CFR 1.610\(d\)](#). See [MPEP § 2818.02](#).

### **2818.01 After Determination Finding a Substantial New Question of Patentability [R-07.2015]**

[37 CFR 1.625\(d\)](#) provides that any *ex parte* reexamination ordered under [35 U.S.C. 257](#) will be conducted in accordance with [37 CFR 1.530](#) through [37 CFR 1.570](#), which govern *ex parte* reexamination, except that:

(1) the patent owner will not have the right to file a statement pursuant to [37 CFR 1.530](#), and the order will not set a time period within which to file such a statement;

(2) *ex parte* reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in [37 CFR 1.605](#), and is not limited to patents and printed publications or to subject matter that has been added or deleted during a reexamination proceeding, which differs from the provisions of [37 CFR 1.552\(a\)](#);

(3) issues in addition to those raised by patents and printed publications and by subject matter added or deleted during an *ex parte* reexamination proceeding may be considered and resolved, which differs from [37 CFR 1.552\(c\)](#); and

(4) information material to patentability will be defined by [37 CFR 1.56](#) for the purposes of a supplemental examination proceeding and any resulting *ex parte* reexamination proceeding.

The material to patentability standard ([37 CFR 1.56\(b\)](#)) applicable to patent applications is also applicable to an *ex parte* reexamination proceeding under [35 U.S.C. 257](#) resulting from a supplemental examination proceeding because, like patent application examination, an *ex parte* reexamination proceeding ordered pursuant to [35 U.S.C. 257](#) is not limited to patents and printed publications. In contrast, the material to patentability standard under [37 CFR 1.555\(b\)](#), which is applicable to *ex parte* reexaminations ordered pursuant to [35 U.S.C. 302](#), is limited to patents and printed publications. Any reference to "applicant" in [37 CFR 1.56\(b\)](#) will be read as "patent owner" in the context of a supplemental examination proceeding and any resulting *ex parte* reexamination proceeding under [35 U.S.C. 257](#), because these proceedings are only available to a patent owner.

After the issuance and mailing of the supplemental examination certificate and the accompanying reasons document, the examiner will prepare an order for *ex parte* reexamination based on the determination made in the supplemental examination proceeding. To order reexamination under [35 U.S.C. 257](#), the examiner may use form PTO-2302 or include form paragraph 28.04 at the beginning of an initial Office action on the merits in the resulting reexamination proceeding. The order may refer to the reasons document that was created with the supplemental examination certificate.

The following is a copy of form PTO-2302:

<b>Ex Parte Reexamination Ordered Pursuant to 35 U.S.C. 257</b>	Control No.	Patent Under Reexamination
	Examiner	Art Unit
<p><b>--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--</b></p> <p>The supplemental examination proceeding filed on _____, concluded with the issuance of the supplemental examination certificate on _____. The certificate indicated that one or more items of information submitted as part of the request for supplemental examination raises a substantial new question of patentability. See the Reasons for Substantial New Question of Patentability Determination in the file of this proceeding.</p> <p>Accordingly, <i>ex parte</i> reexamination of claim(s) _____ of U.S. Patent No. _____ is ordered. See 35 U.S.C. 257(b) and 37 CFR 1.625(b). This <i>ex parte</i> reexamination proceeding is hereby initiated by the mailing of this order. <i>Ex parte</i> reexamination under 35 U.S.C. 257 will be conducted in accordance with 37 CFR 1.530 through 1.570, which govern <i>ex parte</i> reexamination, subject to the exceptions enumerated in 37 CFR 1.625(d), and, in addition, to the exception that a patent owner's statement, including any amendment, under 37 CFR 1.530(a)-(c) may not be filed. For this reason, no amendment in an <i>ex parte</i> reexamination proceeding ordered under 35 U.S.C. 257 may be filed until after the mailing of a first Office action on the merits.</p> <p>This reexamination proceeding has been assigned to the art unit listed above. All future correspondence should be directed to the assigned art unit and should be identified by the control number listed above, which is identical to the control number assigned to the now-concluded supplemental examination proceeding.</p>		

The following is a form paragraph that may be used at the beginning of an initial Office action on the merits to order reexamination under [35 U.S.C. 257](#):

**¶ 28.04 Reexamination Ordered Pursuant to 35 U.S.C. 257**  
Reexamination Ordered Pursuant to 35 U.S.C. 257

The supplemental examination proceeding, filed on [1], concluded with the issuance of the supplemental examination certificate on [2]. The certificate indicated that one or more of the items of information submitted as part of the request for supplemental examination raises a substantial new question of patentability. See the Reasons for Substantial New Question of Patentability Determination in the file of this proceeding.

Accordingly, *ex parte* reexamination of claim(s) [3] of U.S. Patent No. [4] is ordered. See [35 U.S.C. 257\(b\)](#) and [37 CFR 1.625\(b\)](#). This *ex parte* reexamination proceeding is hereby initiated by the mailing of this order. *Ex parte* reexamination under [35 U.S.C. 257](#) will be conducted in accordance with [37 CFR 1.530](#) through [1.570](#), which govern *ex parte* reexamination, subject to the exceptions enumerated in [37 CFR 1.625\(d\)](#), and, in addition, to the exception that a patent owner's statement, including any amendment, under [37 CFR 1.530\(a\)-\(c\)](#) may not be filed. See [35 U.S.C. 257\(b\)](#). For this reason, no amendment in an *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#) may be filed until after the mailing of a first Office action on the merits (which appears below). This reexamination proceeding has been assigned to the art unit listed at the top of the cover page of this action. All future correspondence should be directed to the assigned art unit and should be identified by the control number, which is also listed at the top of the cover page of this action, and which is identical to the control number assigned to the now-concluded supplemental examination proceeding.

A first Office action on the merits appears below.

**Examiner Note:**

1. In brackets 1 and 2, insert the filing date of the supplemental examination proceeding and the issue date of the supplemental examination certificate, respectively, as they appear on the certificate.
2. In bracket 3, list the claims for which a substantial new question of patentability was found, per the Statement of Reasons for Substantial New Question of Patentability Determination.
3. In bracket 4, list the patent number as shown on the supplemental examination certificate.

See, generally, [MPEP § 2254](#) and [MPEP §§ 2260 - 2296](#) for a detailed discussion of *ex parte* reexamination procedures and processes. The guidance provided in [MPEP § 2250](#) is applicable to amendments submitted after the first Office action in an *ex parte* reexamination proceeding resulting from a supplemental examination proceeding. As stated previously, a reexamination ordered as a result

of supplemental examination is subject to the regulations and procedures of *ex parte* reexamination, subject to the above-noted exceptions.

**2818.02 After Determination Finding No Substantial New Question of Patentability [R-11.2013]**

If the supplemental examination certificate indicates that no SNQ is raised in the request, the electronically issued supplemental examination certificate will be published in due course by the Office's patent publication process as an attachment to the patent. The fee for reexamination ordered as a result of supplemental examination, as set forth in [37 CFR 1.20\(k\)\(2\)](#), will be refunded in accordance with [37 CFR 1.610\(d\)](#).

**2819 Discovery of Possible Material Fraud [R-11.2013]**

*37 CFR 1.620 Conduct of supplemental examination proceeding.*

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(g) If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under [35 U.S.C. 257](#) as a result of the supplemental examination proceeding, that a material fraud on the Office may have been committed in connection with 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\(e\)](#).

[37 CFR 1.620\(g\)](#) provides that, if the Office becomes aware, during the course of a supplemental examination or of any *ex parte* reexamination ordered under [35 U.S.C. 257](#) as a result of the supplemental examination proceeding, that a material fraud on the Office may have been committed in connection with the patent requested to be examined, the supplemental examination proceeding or any *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#) will continue. The matter will be referred to the U.S. Attorney General in accordance with [35 U.S.C. 257\(e\)](#).

The Office anticipates that such instances will be rare. Accordingly, the Office does not intend to create a unit to investigate instances of material fraud. If an employee of the Office, such as an

examiner in the CRU, becomes aware, during the course of supplemental examination or any reexamination ordered under [35 U.S.C. 257](#), that a material fraud on the Office may have been committed in connection with the patent subject to a supplemental examination or resulting reexamination ordered under [35 U.S.C. 257](#), the employee would notify the supervisory official in charge of the section of the Office to which the employee is assigned, such as the Director of the CRU. The supplemental examination proceeding, or any reexamination proceeding ordered under [35 U.S.C. 257](#), would continue. If the supervisory official concurs, he or she would refer the matter to the Deputy Commissioner for Patent Examination Policy. If the Deputy Commissioner for Patent Examination Policy concurs, the matter would be referred to the Office's General Counsel, who would determine if the matter should be referred to the U.S. Attorney General in accordance with [35 U.S.C. 257\(e\)](#).

## **2820 Submission of Notification of Other Prior or Concurrent Post-Patent Office Proceedings [R-11.2013]**

*37 CFR 1.620 Conduct of supplemental examination proceeding.*

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(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 notifying the Office 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 Office proceeding, including the type of proceeding, 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).

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[37 CFR 1.620\(d\)](#) requires that 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 notifying the Office of the post-patent Office proceeding, if such notice has not been previously provided with the request. The Office anticipates that a patent for which supplemental

examination is requested may be involved in other post-patent Office proceedings, including another supplemental examination proceeding. Knowledge of other proceedings is important to ensure a quality determination. In addition, notice is required due to the statutory three-month period within which the Office must conclude the supplemental examination. The notice is limited to an identification of the post patent Office proceeding, including the type (e.g., *ex parte* or *inter partes* reexamination, reissue, supplemental examination, post-grant review, *inter partes* review, or covered business method patent review), an identifying number, such as a control number or reissue application number, and the filing date of the other post-patent Office proceeding. The notice may not include further arguments or information, including any discussion of the issues present in the current supplemental examination proceeding or in the identified post-patent Office proceeding(s). A notice pursuant to [37 CFR 1.620\(d\)](#) must not include copies of papers filed in a prior or concurrent Office proceeding. If the paper containing the notice is not so limited, the paper will be held to be improper, and will be processed as an unauthorized paper pursuant to [37 CFR 1.620\(c\)](#).

## **2821 Multiple Post-Patent Office Proceedings [R-07.2015]**

A supplemental examination proceeding must conclude within three months from the filing date of the request. As a general rule, the Office will not merge a supplemental examination proceeding with any other supplemental examination proceeding. The Office, however, reserves its option to merge/consolidate supplemental examination proceedings as circumstances arise. The Office, likewise, does not anticipate that a supplemental examination proceeding or *ex parte* reexamination proceeding resulting from a supplemental examination proceeding will be merged with any other type of Office proceeding. The Office similarly reserves its option to merge reexamination proceedings that are ordered as a result of supplemental examination proceedings as circumstances arise. In such circumstances, filing a petition to merge is not necessary, since the Office will generally make a decision *sua sponte* whether to merge.

If multiple post-patent proceedings are simultaneously filed, any determination of which proceedings to initiate, and the order in which to initiate them, will be made on a case-by-case basis.

If the patent owner files a request for supplemental examination that is in compliance with [35 U.S.C. 257](#) and all applicable rules, the Office is required under [35 U.S.C. 257\(a\)](#) to conduct the examination and conclude the proceeding within three months from the filing date of the request. Any reexamination proceeding resulting from the supplemental examination proceeding must, in accordance with [35 U.S.C. 257\(b\)](#), be conducted “according to the procedures established by chapter 30,” which govern *ex parte* reexamination. If reexamination is ordered, the Office is required to proceed with the reexamination. [35 U.S.C. 304](#) requires the Office to resolve any substantial new question of patentability determined to be raised:

If... the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question (emphasis added).

In addition, [35 U.S.C. 305](#) expressly provides that, after the order (and after the time period set for filing a patent owner statement under [35 U.S.C. 304](#), which is excluded by [35 U.S.C. 257\(b\)](#)), “reexamination will be conducted.” Therefore, once reexamination is ordered, the Office is required by statute to conduct the reexamination. Further, [35 U.S.C. 305](#) requires that an *ex parte* reexamination proceeding “be conducted with special dispatch within the Office.” See also, *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988). The Office, however, reserves its option, pursuant to [35 U.S.C. 315\(d\)](#) or [35 U.S.C. 325\(d\)](#), to determine the manner in which a reexamination proceeding ordered under [35 U.S.C. 257](#) may proceed, including providing for stay, transfer, consolidation or termination, when there is a copending *inter partes* review, post grant review, or covered business method review. The patent owner may wish to consider the provisions of [35 U.S.C. 257\(c\)\(1\)](#) and [35 U.S.C. 257\(c\)\(2\)](#) on the effectiveness of any supplemental examination on already pending litigation when determining whether

and when to file a request for supplemental examination.

See [MPEP § 2283](#) for information on mergers involving an *ex parte* reexamination proceeding.

See the Trial Practice Guide for information involving concurrent trials.

## **2822 Assignment of the Supplemental Examination Proceeding [R-11.2013]**

Supplemental examination requests will be assigned to the Central Reexamination Unit (CRU) in the same manner in which reexamination requests are assigned. The CRU art unit which examines the technology (Chemical, Electrical, Mechanical, etc.) in which the patent to be examined is currently classified as an original patent, will be assigned the supplemental examination request. In that art unit, the CRU Supervisory Patent Examiner (SPE) will assign the request to a primary examiner, other than the examiner who originally examined the patent application, who is most familiar with the claimed subject matter of the patent. See, generally, [MPEP § 2236](#).

Although the number of supplemental examination requests which must be transferred to another examiner should be very small, the procedures established for transferring reexamination proceedings will be generally followed when transferring supplemental examination proceedings. See [MPEP § 2237](#).

## **2823 Differences Between an *Ex Parte* Reexamination Proceeding Ordered Pursuant to 35 U.S.C. 257 and an *Ex Parte* Reexamination Proceeding Ordered Pursuant to 35 U.S.C. 302 [R-11.2013]**

*Ex parte* reexamination ordered under [35 U.S.C. 257](#), i.e., as a result of a supplemental examination, will be conducted in accordance with regulations and procedures that govern *ex parte* reexamination ordered pursuant to [35 U.S.C. 302](#) (e.g., [37 CFR 1.530](#) through [37 CFR 1.570](#)), except that:

(1) the patent owner will not have the right to file a statement pursuant to [37 CFR 1.530](#), and the



order will not set a time period within which to file such a statement;

(2) the patent owner cannot file an amendment to the patent until after supplemental examination is concluded and after the issuance of an initial Office action on the merits in any *ex parte* reexamination proceeding ordered under [35 U.S.C. 257](#);

(3) *ex parte* reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in [37 CFR 1.605](#), and is not limited to patents and printed publications or to subject matter that has been added or deleted during a reexamination proceeding, which differs from the provisions of [37 CFR 1.552\(a\)](#);

(4) issues in addition to those raised by patents and printed publications and by subject matter added or deleted during an *ex parte* reexamination proceeding may be considered and resolved, which differs from [37 CFR 1.552\(c\)](#); and

(5) information material to patentability will be defined by [37 CFR 1.56\(b\)](#) for an *ex parte* reexamination proceeding resulting from a supplemental examination proceeding.