

# Proposed New USPTO Rules for Supplemental Examination

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## Subpart E—Supplemental Examination of Patents

### § 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.
- (b) The patent owner must establish the entirety of the ownership interest in the patent of paragraph (a) by filing, as part of the request, a submission in compliance with the provisions of § 3.73(b) of this chapter.
- (c) 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.

### § 1.605 Items of information.

- (a) Each request for supplemental examination may request that the Office consider, reconsider, or correct no more than ten 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.
- (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, including instances where it may be necessary to combine items of information in order to raise an issue to be considered, reconsidered, or corrected, 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)(11).

### § 1.610 Content of request for supplemental examination.

- (a) The request 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 each of the elements set forth in paragraphs (b)(1) through (b)(12) of this section.
  - (1) A cover sheet itemizing each component submitted as part of the request.
  - (2) A table of contents for the request.
  - (3) An identification of the number, the date of issue, and the first named inventor of the patent for which supplemental examination is requested.
  - (4) A list of each item of information that is requested to be considered, reconsidered, or corrected, and the publication date for each item of information, if applicable; and a statement that:
    - (i) Identifies each item of information that was not considered in the prior examination of the

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- patent, and explains why consideration of the item of information is being requested;
- (ii) Identifies each item of information that was not adequately considered in the prior examination of the patent, and explains why reconsideration of the item of information is being requested; and
  - (iii) Identifies each item of information that was incorrect in the prior examination of the patent, and explains how it is being corrected.
- (5) A list identifying any other prior or concurrent post patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding (*e.g.*, *ex parte* or *inter partes* reexamination, reissue, supplemental examination, post-grant review, or *inter partes* review), the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding.
  - (6) An identification of each aspect of the patent for which supplemental examination is sought, including an identification of the structure, material, or acts in the specification that correspond to each means-plus-function or step-plus-function element, as set forth in 35 U.S.C. 112(f), in any claim to be examined.
  - (7) An identification of each issue raised by each item of information.
  - (8) A separate, detailed explanation for each identified issue, discussing how each item of information is relevant to each aspect of the patent identified for examination, and how each item of information raises each issue identified for examination, including:
    - (i) Where an identified issue involves the application of 35 U.S.C. 101 (other than double patenting) or 35 U.S.C. 112, an explanation discussing the support in the specification for each limitation of each claim identified for examination with respect to this issue; and
    - (ii) Where an identified issue involves the application of 35 U.S.C. 102, 35 U.S.C. 103, or double patenting, an explanation of how each limitation of each claim identified for examination with respect to this issue is met, or is not met, by each item of information. The detailed explanation may also include an explanation of how the claims distinguish over the items of information.
  - (9) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer, certificate of correction, certificate of extension, supplemental examination certificate, post grant review certificate, *inter partes* review certificate, or reexamination certificate issued for the patent.
  - (10) A copy of each item of information listed in paragraph (b)(3) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language document. Items of information that form part of the discussion within the body of the request as specified in § 1.605(b), and copies of U.S. patents and U.S. patent application publications, are not required to be submitted.
  - (11) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.
  - (12) A submission by the patent owner in compliance with § 3.73(b) of this chapter establishing the entirety of the ownership in the patent requested to be examined as set forth in § 1.601(b).
- (c) The request may also include an explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.
  - (d) The filing date of a request for supplemental examination will not be granted if the request is not in compliance with § 1.605, § 1.615, and this section. A defective request may receive a

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filing date if the defects are limited to the omission of one or more of the requirements set forth in paragraph (b)(1) or (b)(2) of this section, subject to the discretion of the Office.

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

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

### § 1.620 Conduct of supplemental examination proceeding.

- (a) Within three months following the filing date of a request for supplemental examination, the Office will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information presented in the request. The determination will generally be limited to a review of the issues identified in the request as applied to the identified aspects of the patent. The determination will be based on the claims in effect at the time of the determination and will become a part of the official record of the patent.
- (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.
- (d) The patent owner must, as soon as possible upon the discovery of any other prior or concurrent post patent Office proceeding involving the patent for which the current supplemental examination is requested, file a paper limited to notice of the post patent Office proceeding, if such notice has not been previously provided with the request. The notice shall be limited to an identification of the post patent proceeding, including the type (*e.g., ex parte or inter partes* reexamination, reissue, supplemental examination, post-grant

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review, or *inter partes* review), the identifying number of any such proceeding (e.g., a control number or reissue application number), and the filing date of any such proceeding, without any discussion of the issues of the current supplemental examination proceeding or of the identified post patent Office proceeding(s).

- (e) Interviews are prohibited in a supplemental examination proceeding.
- (f) No amendment to any aspect of the patent may be filed in a supplemental examination proceeding.
- (g) If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under 35 U.S.C. 257, of a material fraud on the Office involving the patent requested to be examined, the supplemental examination proceeding or any reexamination proceeding ordered under 35 U.S.C. 257 will continue, and the matter will be referred to the U.S. Attorney General in accordance with 35 U.S.C. 257(e).

### § 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.

- (a) A supplemental examination proceeding will conclude when the supplemental examination certificate is electronically issued. The supplemental examination certificate will indicate the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.
- (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 reexamination fee for 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 aspect of the patent may be conducted on the basis of any item of information as set forth in § 1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding § 1.552(a);
  - (3) Issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved, notwithstanding § 1.552(c); and
  - (4) Information material to patentability will be defined by § 1.56(b), notwithstanding § 1.555(b).

### § 1.937 Conduct of *inter partes* reexamination.

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- (d) A petition in an *inter partes* reexamination proceeding must be accompanied by the fee set forth in § 1.20(c)(6), except for petitions under § 1.956 to extend the period for response by a patent owner, petitions under § 1.958 to accept a delayed response by a patent owner, petitions under § 1.78 to accept an unintentionally delayed benefit claim, and petitions under § 1.530(l) for correction of inventorship in a reexamination proceeding.