Legal Comment – Supplemental Examination of Issued Patents

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The American Invents Act (AIA) created a new “supplemental examination” proceeding by which issued United States patents may undergo additional examination by the United States Patent and Trademark Office in order to consider, or correct information that is believed to be relevant to the patent.

The statutory basis for the supplemental examination proceeding is 35 U.S.C. 257. The AIA specifically amended Chapter 25 of Title 35 of the United States Code to include new Section 257, which provides:

(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.

The statutory mandate contained in 35 U.S.C §257, the United States Patent and Trademark Office issued regulations governing the supplemental examination proceeding. These regulations can be found at 37 C.F.R. §1.601-1.625.

Effective Date/Availability of Supplemental Examination.

The effective date for the new supplemental examination proceeding is September 16, 2012, and applies to any issued United States patent that is enforceable on or after this date. The request for supplemental examination of an issued United States patent may be filed at any time during the enforceability of the patent. Therefore, supplemental examination may be filed at any time prior to the date of expiration of an issued patent and generally during a period of 6 years following the date of expiration of the issue patent.

Who May Request Supplemental Examination.

One of the stated goals of supplemental examination is to provide a mechanism by which the patentee can attempt to protect an issued United States patent from an allegation of inequitable conduct during a court proceeding involving the patent. The new supplemental examination proceeding may only be requested by the patent owner. In the event that there are joint owners of an issued United States patent, all of the joint owners must act together in the supplemental examination proceeding. Only in rare situations will the United States Patent and Trademark Office permit approve a request for supplemental examination requested by fewer than all of the joint owners of an issued patent. Third parties, including licensees of an issued patent, may not request supplemental examination of an issued United States patent and may not participate in the supplemental examination proceeding before the United States Patent and Trademark Office.

Filing Requirements.

The request for supplemental examination must be in writing and must identify the filing as a request for supplemental examination. The patent owner would be wise to utilize the USPTO’s “Request For Supplemental Examination Transmittal Form”, which can be accessed via the USPTO’s internet website. The required contents of the request include (1) identification of the patent number and issue date for which supplemental examination is being requested, (2) identification of each claim for which supplemental examination is being requested, (3) the name or names (in the case of joint owners) of the patent owner(s), (4) a listing of the items of information that the patent owner wishes the USPTO to consider during the supplemental examination proceeding, (5) a detailed explanation of the relevance of each item of information to each claim for which supplemental examination is requested, (6) a summary of the relevancy of any submitted document that is over 50 pages in length, and (7) the required USPTO filing fee.

Items of Information Submitted with the Request.

The information submitted to the USPTO as part of the request for supplemental examination is not limited to patents and printed publications. While the statute does not specifically list the types of information that can be considered during a supplemental examination proceeding, or otherwise characterize the nature of such information, the statute suggests that any information that a patent owner believes is relevant to the issued patent and which requires consideration or reconsideration may be submitted with the request. The request for supplemental examination may include no more than 12 items of information which the patent owner wishes to be considered or reconsidered by the USPTO during the supplemental examination proceeding. While only a limited number of items of information may be submitted in any one given request for supplemental examination, the patent owner(s) may file more than one request for supplemental examination of the same patent at anytime.

Fees.

A request for supplemental examination is a costly procedure for a patent owner. According to the current fee schedule issued by the USPTO, the fees charged by the filing fee for the request for supplemental examination is $5,140.00 and the fee for the ex parte reexamination of the patent ordered in response to a request for supplemental examination is $16,260.00. Both the supplemental examination fee and the reexamination fee must be paid at the time the request for supplemental examination is filed, however, if the USPTO does not order an ex parte reexamination proceeding, then it will refund the reexamination fee to the patent owner.
Processing of a Request for Supplemental Examination.

The process commences by the patent owner filing a proper request for supplemental examination. The USPTO has three months to conduct the supplemental examination and issue a supplemental examination certificate to the patent owner. During the supplemental examination, the USPTO will determine whether or not any item of information submitted with the request raises a substantial new question of patentability (referred to as "SNQ"). The supplemental examination will conclude with the issuance of a supplemental examination certificate which will indicate the results of the examination. If items of information indeed raise a SNQ, then the USPTO will order *ex parte* reexamination of the issued patent.

Conclusion.

The decision to request supplemental examination of an issued patent is an important one. The primary objective of the supplemental examination proceeding is to add a unique examination proceeding that may result in providing a "safe harbor" for patentees and their patent counsel for charges of inequitable conduct/fraud on the patent office that are based on information that was not considered during the prosecution of the application prior to issuance of the patent. Recent court cases have made it more difficult to prove a charge of inequitable conduct, however, it is likely that allegations of inequitable conduct will remain part of patent litigation. The United States Patent and Trademark Office published statistics relating to number of filings of requests for supplemental examination. For the time period from the effective date of September 26, 2012 to September 27, 2013, a total of 42 requests for supplemental examination have been filed. It is still unclear to what extent patent owners will utilize the supplemental examination proceeding and how the results of any such proceedings will be treated by the courts during litigation.

Disclaimer: Nothing contained in this article constitutes individualized legal advice. The views expressed in this article are those of the author and not of Curatolo Sidoti Co., LPA, or any of its past, present or future client.

Salvatore Sidoti is a regular contributor to the Bulletin with his legal column. If you have questions contact sidoti@patentandtm.com.

Book Review

by Donald M. Mattox, Management Plus, Inc.


I just couldn't resist! Ever since I learned about this 643 page "data dump" about the word "sputtering" I have wondered what it would cover. The word sputtering in the context of vacuum coating seems to have been derived from the word "spluttering" in the early 1900s [1] – the word spluttering was not covered in this book.

According to this book the first recorded use of the word sputtering was in a Richard de Bury quotation in 1316. The word was used occasionally after that and the first use in context of films or surfaces was in 1924 in the paper "Some effects of gas upon the resistance and resistance- temperature coefficient of sputtered platinum films" by F.W. Reynolds. In the 1960s and 1970s many sputtering conferences and "schools" are listed. From the 1980s on most of the entries are patents listed by inventor. Many of these entries include brief abstracts of what the patents cover. I estimate there are about 4000 entries. In summary the listing is not close to being comprehensive but it does make for very interesting perusal.

1. The Foundations of Coating Technology, Donald M. Mattox, p. 19, Noyes Publication (2003) – this publication is available on the svc.org – History of Vacuum Coating