Best Practices and FAQs for filing requests for reexamination compliant with 37 CFR 1.510 and 1.915

Each request for reexamination is reviewed in the Central Reexamination Unit (CRU) for compliance with 37 CFR 1.510 or 1.915 before it is assigned a filing date. After it is assigned a filing date, it is sent to an examiner who decides if reexamination should be ordered. This document is intended to assist reexamination requesters in filing requests for reexamination that are compliant with 37 CFR 1.510 and 1.915, so that the requests will be assigned a filing date and forwarded to the examiner. Compliance with these rules will also tend to highlight information relevant to the examiner's decision on whether to grant the reexamination.

This document does not replace the notice published in the Federal Register on August 4, 2006, *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219 (4 Aug 2006), 1309 OG 216 (29 Aug 2006).

This document is divided into two sections. The first section is a list of "Best Practices" that gives suggestions for avoiding common defects in reexamination requests and suggestions that facilitate processing of the request at the USPTO. The second section addresses common high-level issues in a "Frequently Asked Questions" format.

Best Practices for Filing Reexamination Proceedings

This "Best Practices" section of the paper is intended as a helpful guide, and is not a substitute or amendment to the Federal Register Notice - *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219 (4 Aug 2006), 1309 OG 216, (29 Aug 2006). Inclusion of a guideline in this list of best practices, by itself, does not make an item a requirement for a filing date in a reexamination proceeding.

(1) File electronically.

a. Requests for reexamination may be filed as "new applications" in EFS-Web. After selecting "New applications," select either utility or design as appropriate, with a type of "Reexam." Once "Reexam" is selected, there is a drop-down box that designates if the request is an *ex parte* request or an *inter partes* request.

b. A guide to document codes for EFS-Web filing is available at http://www.uspto.gov/patents/process/file/efs/guidance/efsweb_document_descriptions.xls , primarily under the category "reexamination." If you need assistance with the document codes for a request for reexamination,

please call the CRU customer service line at 571-272-7705 or the Electronic Business Center at ebc@uspto.gov or 571-272-4100.

(2) Get the basics correct.

a. Use form PTO/SB/57 for *ex parte* requests, and use form PTO/SB/58 for *inter partes* requests, in addition to an attached detailed request. The forms are available at www.uspto.gov -> Patents (in the navigation bar at the top) -> Patent Forms (in the drop-down menu).
b. Include the correct fee. Current fee schedules are at www.uspto.gov -> Patents (in the navigation bar at the top) -> Patent Processes (in the drop down menu) -> View Fee Schedule (in the column on the left).
c. Include a copy of the patent to be reexamined including any disclaimer(s), certificate(s) of correction or prior reexamination certificate(s).
d. Remember that the papers filed will be scanned or transferred into the image file wrapper system. Small type (below 12 point), colors, photographs and small detailed drawings do not scan well and may be illegible in the image file wrapper system. Also, line spacing of at least 1.5 should be used to ensure the scanned text is legible.

(3) Provide a clear Statement of a Substantial New Question of Patentability (SNQ)

a. *For **at least one** patent or publication cited in each proposed rejection or application of the art*, provide a concise statement of what the **new** technological **teaching** is, e.g., state what the new technological teaching is or how the reference is technologically presented in a "new light," for every claim for which reexamination is requested.
b. A new technological teaching presentation includes, for example, a discussion of subject matter in the cited reference that relates to at least one of the claim limitations and provides a teaching that was not considered by an examiner in the application of the art in the prior examination(s).
    - **i.** This discussion can be done in a single section of the request for all of the cited references.
    - **ii.** The requester should provide citations to specific portion(s) of the references that support the showing of a SNQ.
    - **iii.** In general, do not attempt to identify every limitation of the claim as the new technical teaching. This tends to obscure what new information, in comparison to the prior examination, is being added by the patents or printed publications.
c. State whether the reference was previously considered and to what extent it was considered ***in addition*** to stating what the new technological teaching is.
d. Provide the statements of the SNQs ***separate from*** the identification and explanation of the proposed rejections to which the SNQ is directed.
e. See the Manual of Patent Examiner Procedure (MPEP), sections 2216 and 2616.

(4) State clearly each and every Proposed Rejection

a. ***Do NOT lump*** together multiple proposed rejections based on different grounds.
   - **i.** Separate rejections based on anticipation and rejections based on obviousness.
   - **ii.** Separate rejections based on alternative primary or secondary teachings in obviousness rejections.
   - **iii.** Do not lump together multiple rejections by using "and/or."

b. **DO group** together **rejections for multiple claims** based on the **same ground** of rejection (e.g., claims 1-4, 6, 8, and 12 should be rejected under 35 U.S.C. 102(b) as anticipated by Smith).
   - **i.** **Clearly state what claims are applicable** to each and every proposed rejection.
   - **ii.** Do NOT use the phrase "at least" in front of listing the claims (e.g., "at least claims 1 and 2").

c. **Do NOT "*suggest*"** other proposed rejections in footnotes or "disclaimer-type" language.

d. For Patent Owner filed requests in *ex parte* reexamination, clearly state which references apply to which claims and how. The application of the art in the detailed explanation should be similar in format to a rejection based on anticipation or obviousness except that it will identify which elements of the claim are shown or taught by the references and also identify which elements are not.

(5) Provide a Detailed Explanation for each Proposed Rejection or Application of the Art

a. Provide a ***separate*** explanation for ***each*** proposed rejection, or, for Patent-Owner requests, for ***each*** application of the art.

b. Clearly state how the references apply to ***every*** claim limitation for ***each*** claim to which the proposed rejection is applied.
   - **i.** For every limitation:
     1. Apply at least one of the references (i.e., point out how the reference meets/teaches the limitation);
     2. In the case of a patent owner filed request, state that the limitation is not covered by the references; OR
     3. In the case of a patent owner request, say/admit that the limitation is known or old in the art, or similar language.
   - **ii.** For a dependent claim, the explanation should clearly state how the prior art applies to the limitation(s) added by way of the dependent claim and also refer to the explanation of the claims from which it depends for the limitations set forth in those claims.

c. For **obviousness** proposed rejections, explain:
   - **i.** ***What*** claim limitations the primary or base reference teaches and what limitations it fails to teach;

ii. ***How*** the prior art teaches limitations not taught by the primary or base reference, or (in the case of a patent owner filed request) that such limitations are known in the art; **AND**

iii. ***Why*** it would be obvious to one of ordinary skill in the art at the time the invention was made to combine or modify the teachings (e.g., provide a reason for the combination or modification).

d. The explanation must be in a claim chart or prose (narrative) format.

i. Do NOT do both as it lengthens the request and may result in inconsistencies between the claim chart and prose explanations.

e. Make sure the detailed explanation is **consistent and congruent** with the proposed rejections.

i. The explanation should include *only* the claims and references listed in the proposed rejection.

ii. The explanation should only explain anticipation when the proposed rejection is under 35 U.S.C. 102 and only explain obviousness when the proposed rejection is under 35 U.S.C. 103.

iii. Make sure a dependent claim is not subject to a proposed anticipation rejection when the claim it depends from is only subject to a proposed obviousness rejection.

(6) Citation of Patents and Publications

a. Provide a listing of all patents and publications that form the basis of the proposed rejections on form PTO/SB/08, PTO/SB/42, PTO-1449, or equivalent.

i. **ONLY list** documents that form the basis of a proposed rejection.

ii. **Do NOT include** litigation documents or "background" documents on the listing. "Background" documents should be avoided. If a document, that the requester considers to be a "background" document, is discussed in the detailed explanation of any proposed rejection, then the document must be cited as a basis for the proposed rejection, and must be included in the listing of all patents and publications that form the basis of the proposed rejection.

b. Provide a copy of each and every reference that is cited, except for U.S. Patent documents.

c. Provide an English language translation for the entire document or relevant portions, if the reference is not in the English language.

(7) If you are a third party requesting reexamination, make sure you **serve** the Request and all related papers to the Patent Owner **at its correspondence address** (37 CFR 1.33(a)) **in the patent file**.

a. Check PAIR to see the current address that is of record **in the file of the patent** for which reexamination is being requested.

b. **Do NOT use** the correspondence address in the **assignment records** or the address on the front of the patent without verifying the address with current records in PAIR.

(8) If you are a patent owner, update the correspondence address in the patent file as needed. Correspondence is sent to the address in the patent file. See MPEP 2222.

(9) If filing an *inter partes* reexamination request, make sure you:

a. Identify the real party or parties in interest.
b. Make the required certification that the estoppel provisions of 37 CFR 1.907 do not prohibit *inter partes* reexamination.
c. Check to see if the patent issued from an application filed on or after November 29, 1999; if not *inter partes* reexamination cannot be used. See MPEP 2611.

(10) Sign the Request.

a. Do not just sign the transmittal or cover letter.
b. Make sure the request is signed by a patent practitioner under 37 CFR 1.34 or a person authorized to act on behalf of the requester (e.g., the president of the company requesting reexamination).
c. Make sure the signature is in compliance with 37 CFR 1.4(d)(1) for handwritten signatures or 37 CFR 1.4(d)(2) for s-signatures.

(11) In drafting the request, be mindful of the statutory constraints on the information that may be included in a reexamination (patents and printed publications), by <u>not</u> including:

a. Comments pertaining to any alleged misconduct, including inequitable conduct, of the patent owner.
b. Notification of litigation must be limited to bare notice, and must not include arguments or information. See MPEP 2282 and 2686.
c. Proposed rejections based on lack of utility or enablement under 35 U.S.C. 101.
d. Proposed rejections based on 35 U.S.C. 112.
e. Proposed rejections based on prior use or prior knowledge.

FAQs- Filing date compliance in reexamination

The questions and answers which follow address some of the high-level issues which arise in reviewing new requests for reexamination. They are intended to assist requesters in understanding the requirements for a compliant request.

1. **Why does the USPTO review incoming requests for reexamination prior to assigning a filing date to the requests, and why are some identified as defective?**

The USPTO reviews incoming reexamination requests prior to assigning a filing date in order to ensure that the requests are filing-date-compliant. See "*Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings,*" 71 Fed. Reg. 44219 (4 August 2006), 1309 OG 216 (29 August 2006).

> [Prior to this change, r]eexamination requesters did not always comply with these statutory requirements when submitting requests for reexamination. Furthermore, the information missing due to a lack of compliance with Sec. 1.510(b) or with Sec. 1.915(b) was often relevant to the decision on whether to grant the request for reexamination. This presented a difficulty for the Office in view of the statutory requirements of 35 U.S.C. 303 (for *ex parte* reexamination) and 35 U.S.C. 312 (for *inter partes* reexamination) that the decision on the request must be issued within three months of the filing date of the request for reexamination, because the process of notifying the requester of the non-compliance and obtaining the missing information may very well extend beyond the three-month statutory deadline, or the information may be provided so close to the deadline that there is not sufficient time to properly evaluate it. (71 Fed. Reg. 44219, 44220)

2. **How do I avoid submitting a non-compliant request?**

It is helpful if reexamination requesters use forms PTO/SB/57 (for *ex parte* requests) or PTO/SB/58 (for *inter partes* requests) in addition to an attached detailed request. The "Clarification of Filing Date Requirements" notice identified items that will be reviewed to determine if a request should be assigned a filing date or, alternatively, identified as defective. Those items are (from 71 Fed. Reg. 44219, 44221):

> (1) The complete reexamination fee. [Fee amount is subject to change. Check the Fee Schedule posted on www.uspto.gov].
>
> (2) A statement pointing out each substantial new question of patentability based on the cited patents and publications (i.e., the cited prior art or double patenting art).
>
> (3) An identification of every claim for which reexamination is requested.

(4) A detailed explanation of how all of the cited documents are applied to the claims for which reexamination is requested. For each identified substantial new question of patentability (SNQ), the request must explain how all of the cited documents identified for that SNQ are applied to meet/teach the claim limitations to thus establish the identified SNQ.

(5) A legible copy of every patent or printed publication relied upon or referred to in the request. (To conform to current practice, this provision is not being enforced to require copies of U.S. patents and U.S. patent publications; the provision is deemed waived to that extent.) It is to be noted that the required "copy of every patent or printed publication" is construed by the Office to be a legible copy, since a non-legible copy cannot be used. Any copy of a patent or printed publication received by the Office that is illegible will not be accepted, and will be deemed to have not been received by the Office.

(6) Some translation (at least of the relevant portion(s)) of any non-English language patent or printed publication.

(7) A legible copy of the entire patent to be reexamined. The copy must include the front face, drawings, and specification/claims (in double column format) of the printed patent, and each page must be plainly written on only one side of a sheet of paper.

(8) A legible copy of any disclaimer, certificate of correction, or reexamination certificate issued for the patent [to be reexamined], each page plainly written on only one side of a sheet of paper.

(9) If the request is not filed by the patent owner--A certificate of service on the patent owner at the address as provided for in Sec. 1.33(c). The name and address of the party served must be given in the certificate of service. If service was not possible, a duplicate copy of the request papers must be supplied to the Office together with a factual explanation of what efforts were made to effect service, and why they were not successful.

(10) If the request is filed by an attorney/agent and identifies another party on whose behalf the request is being filed, then a power of attorney must be attached, or the attorney/agent must be acting in a representative capacity pursuant to Sec. 1.34.[1]

For *inter partes* reexamination, the request papers must also include--

(11) A certification by the requester that the estoppel provisions of Sec. 1.907 do not prohibit the *inter partes* reexamination being requested.

---

[1] Form PTO/SB/81B may be used to record a third-party requester power of attorney. Third party requester change of address should be designated by form PTO/SB/123B. Both are available at http://www.uspto.gov/forms/index.jsp

(12) A statement identifying the real party in interest for whom (on whose behalf) the request is being filed.

See 71 Fed. Reg. 44219, 44221.

Inclusion of these items marked with an appropriate and clear heading simplifies review by USPTO support staff as well as the examiner, the patent owner, and the public as a whole, and it is likely to avoid unnecessary identification of defects and/or denial of reexamination, because this information is readily identifiable and clearly organized.

While only the patent owner is required under 37 CFR 1.565 and 1.985 to keep the USPTO informed of prior or concurrent proceedings **involving the patent for which reexamination is requested**,[2] it is useful if a third party requester includes a reference to prior or concurrent litigation by case name, district, docket number and filing date and a reference to prior or concurrent reexamination proceedings by control number.

3. How can I expedite the processing of my request so that it reaches the examiner as soon as possible?

File the request electronically. Electronic filing avoids time delay for mail delivery, internal handling at the USPTO, and scanning of the paper documents. Reexamination requests that are filed electronically are generally visible the same day or within several days. By contrast, requests that are filed in paper may take several weeks to become visible in the image file wrapper (IFW) system due to processing delays identified above.

In addition, there are occasionally procedural details that need to be resolved with a third party requester, including queries on requests that have not yet been processed and assigned to an examiner. Where a request has been filed in paper and is not yet visible in the image file wrapper system, resolution of these issues are delayed until the document is visible in the image file wrapper system. Electronic filing allows USPTO personnel at all levels and locations to access the details of the request and expedite resolution of these issues.

Please note that it is possible to accidentally file a “request for reexamination” as a follow-on paper in the file of the patent for which reexamination is requested, either in paper or electronically; this is especially so if the filed paper is mislabeled. New requests

[2] In order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent for which reexamination is/has been requested and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office. See MPEP 2282.

for reexamination must be filed as "new applications"[3] in EFS-Web or as a request for reexamination in paper and not as follow-on papers in the patent.

4. What are the most common defects that are identified in the initial review?

In general, the most common defects identified in reviewing incoming requests concern requirements for SNQs, identification of claims for which reexamination is requested, and the detailed explanation (items (2-4) in the list above from FAQ 2. With regard to the requirement to identify a SNQ under item (2) above, many requests do not distinguish a SNQ from the detailed explanation of a proposed rejection. With regard to the detailed description of how references are applied to the claims under item (4) above, requests either group (e.g., lump) references together without separate explanations or cite to references that are not discussed in the detailed description of the request.

5. Where can I look in the MPEP for this information?

Information on SNQ in *ex parte* reexamination is provided in MPEP 2216 and 2242. For *inter partes* reexamination, see MPEP 2616 and 2642.

Information on the detailed explanation in *ex parte* reexamination is provided in MPEP 2217. For *inter partes* reexamination, see MPEP 2617.

6. What are the common defects identified in a "statement pointing out each substantial new question of patentability"?

Item (2) in the list from FAQ 2 is a statement pointing out what the requester believes to be each SNQ. In addition to the requirement in 37 CFR 1.510 and 1.915 that a request identify a SNQ to be accorded a filing date, a SNQ must be found in order for the Office to grant a request for reexamination.

A statement as to what SNQ is raised by a reference should solely focus on the new technical teaching provided by the cited patent or printed publication. For example, a SNQ can be established for a claim if it is shown that the cited reference teaches a limitation found to be missing in the prior examination. A statement of a SNQ should be concise and limited to the new technical teaching in the cited reference.

Many requests for reexamination are written in a way that does not distinguish a SNQ from a proposed rejection. As a general matter, most requests have too much extraneous material rather than focusing on specific features of a reference when they describe how certain references establish a SNQ. General reiteration of the law and detailed explanations of entire proposed rejections tend to obscure the identification of the proposed SNQ.

[3] Although a request for reexamination is not an "application" for patent but rather a request for the Director to order a reexamination proceeding, the request is submitted in EFS by selecting the "new application" feature.

The SNQ requirement of 35 U.S.C. 303(a) and 312 is the subject of relevant Federal Circuit decisions[4] and an amendment to the statute in 2002,[5] as well as MPEP sections 2216, 2242, 2616, and 2642. Together, those clarify that a SNQ is not the same as a proposed rejection.

> [I]n passing the original reexamination statute, Congress stated that this new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application.

In re Swanson, 540 F.3d 1368, 1377 (Fed. Cir. 2008).

> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.

See MPEP §§2216 and 2616.

Many requests are identified as defective if the request simply states, in a conclusory fashion, the cited reference was not cited in a prior examination and it anticipates or renders obvious a claim. When these requests are identified as defective for lack of a SNQ, it is not based on an analysis of the merits of the proposed rejection. Rather, it is because the detailed explanation of the proposed rejection is not a valid substitute for identifying a particular new technical teaching that raises a SNQ to support the proposed rejection.

<u>What is the difference between a statement pointing out a SNQ and a detailed explanation of the how the references are applied to the claims?</u>

As described in MPEP 2242 and 2642, "[t]he meaning and scope of the term 'a substantial new question of patentability' is not defined in the statute and must be developed to some extent on a case-by-case basis." As described in MPEP 2216 and 2616, "[i]t is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed."

---

[4] *See In re Recreative Technologies*, 83 F.3d 1394 (Fed. Cir 1996*); In re Portola*, 110 F.3d 786 (Fed. Cir 1997) (overruled by statute), and *In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008).
[5] 21st Century Department of Justice Appropriations Authorization Act, Pub. L. No. 107-273, §13105, 116 Stat. 1757, 1900 (2002).

Put succinctly:

> A statement pointing out an SNQ is a statement that identifies the new, non-cumulative technological teaching.
>
> A detailed explanation of how the references are applied to the claims is (in the context of a third-party requested reexamination) a proposed rejection that includes that new, non-cumulative technological teaching.

The discussion that follows does not replace the guidance given in the MPEP – it is intended as a thought exercise to help understand what the USPTO is looking for to identify a "statement pointing out each substantial new question of patentability."

Put yourself "in the shoes" of the examiner of the original application (that is, the application that became the patent for which reexamination is being requested) at the point just before the notice of allowability is mailed in the original application. All of the paperwork in the actual record of the original application to allow the application has been prepared, and a new reference has just been discovered, or a part/aspect of a reference in the record that has not been considered has just been discovered. The new, non-cumulative technical teaching in that reference is the new technical feature that the examiner has not considered and that should be considered. Put another way, what technical feature in this reference would cause further exploration of the limits of the reference in light of the other evidence of record and cause the examiner to reconsider allowing the application? The statement pointing out the SNQ for the reexam request is not the entire rejection that the examiner will write; that part of the request is placed separately in the detailed explanation. The statement pointing out the SNQ identifies the new technical feature resulting from the reference plus some analysis of the prosecution history of the patent that informs/explains why this feature is a new teaching and should have been considered.

In the simplest case, the examiner, in the original examination, drafted a reason for allowance that identifies a specific claim limitation that was not found. If the new reference raised in the reexamination request shows a feature that meets the claim limitation in the appropriate context, that feature is the "new, non-cumulative technical teaching."

On the other hand, if the examiner already had another reference with basically the same feature, and the record in the application indicates why a rejection was not made, such a feature would probably be cumulative, i.e., it would not be a "new, non-cumulative technical teaching," even though the examiner had not seen the specific reference before, unless something in that reference newly teaches how to combine the feature or newly gives a reason to do so.

<u>Do you have an example of an SNQ that I can look at?</u>

The following edited examples are taken from requests and used to show examples that would be compliant with the requirement in 37 CFR 1.510 and 1.915 that the request contain a statement identifying a SNQ. No conclusion should be drawn about whether these teachings actually would raise a SNQ; these are cited only for the purpose of showing filing date requirement compliance.

(1) Example from the electrical context:

> The Smith publication was cited by the patent owner in an information disclosure statement in the original examination. However, the existence of a substantial new question of patentability based on the Smith publication is not precluded by the fact that the Smith publication was previously cited to the Office. See 35 U.S.C. §312(a). Although the Examiner initialed the information disclosure statement, no evidence exists that the examiner considered any of the technical teachings of the Smith publication to a greater degree than documents are generally considered during a search of Office file records.[6] Furthermore, the Smith publication was not applied in any rejection of the claims or discussed on the record during prosecution of the '000 patent for which reexamination is requested.
>
> The Nguyen patent was the only reference applied and discussed during prosecution of the '000 patent for which reexamination is requested. The Nguyen patent teaches a real-time proximity warning system. The system of the Nguyen patent operates in real-time on a vehicle to help the vehicle avoid collisions with obstacles. See Nguyen patent (Abstract).
>
> In contrast, the '000 patent is directed to designing highway warning signals. The design methods of the '000 patent do not operate in real-time on a vehicle. Like the '000 patent, the Smith publication is directed to methods that do not operate in real-time on vehicles. Further, the Smith publication is directed specifically to the design of highway warning signals, precisely the same subject matter as claimed in the '000 patent. Thus, the Smith publication is not cumulative to the Nguyen patent, and is much more applicable to the claimed subject matter of the '000 patent than the Nguyen patent.
>
> Furthermore, the Smith publication teaches the limitations added to the claims in order to overcome the rejections made by the examiner during prosecution of the '000 patent. In particular, in the sole Office action, the examiner indicated that original application claim 2 recited allowable subject matter. In response to this Office action, patent owner amended claim 1 to include the limitations of original application claim 2.
>
> The Smith publication teaches precisely these limitations of original application claim 2. For example, in the abstract, Smith teaches a highway warning signal that

[6] Consideration of information cited in an IDS means "nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search." MPEP 609, at page 600-142.

automatically warns drivers of nearby road hazards based on remote detection of vehicle speed.

Therefore, the Smith publication provides new, non-cumulative technological teachings that were not previously considered by the USPTO during prosecution of the application that resulted in the ‘000 patent. Accordingly, the Smith publication raises a SNQ that greatly differs from those raised during prosecution of the ‘000 patent.

(2) Example from the electrical context:

The '000 patent for which reexamination is requested is directed to reducing quantization effects of a decoded image. See '000 Patent (Title).

Applicant filed the original utility application for the '000 patent in May 2001. The examiner rejected all of the claims as anticipated under 35 U.S.C § 102(e) by the Rose patent (Non-final rejection of October 2005). In reply, applicants presented remarks without amending the claims (except for cancellation of claim 6). Applicant argued that the claimed invention required a non-linear relationship between threshold values and the quantization parameters of the decoded image, and argued that the prior art of record did not show this limitation.

Applicant argued that "Rose describes another system for minimizing edge effects by object edge detection based on the selection of threshold values having a linear relationship with the quantization parameters". (Response to non-final rejection of December 1, 2005). Applicant further argued that, because "the prior art of record does not describe ‘selected threshold values having a non-linear relationship with varying quantization parameter values of the image’, then claim 1 must be considered novel." The examiner allowed the application after patent owner made these arguments.

Brown is newly cited in the present request, and Brown newly describes a set of proposed changes to image processing protocol ABC 2.0. Brown, page 6. Brown proposes a way to reduce quantization effects in a decoded image using an improved filter. Brown, page 29. Brown discloses performing object edge detection using threshold values having a non-linear relationship to the quantization parameter for the decoded block. Brown at 19. This new technological teaching of Brown raises a substantial new question of patentability with respect to the claims of the ‘000 patent.

(3) Example of a patent owner request for reexamination:

The newly detected prior art is an article entitled "Brush guards for increased passenger safety on escalators.”

The article appears to predate the critical date of the patent, i.e., the priority date, and the publication is available as a prior art reference against the patent.

In a first Office action for the application which resulted in the patent for which reexamination was requested, the examiner indicated that claim 10 would be allowable, subject to being rewritten in independent form. Claim 10, dependent on independent claim 3, contained the limitation that the brush bristles increase in length up to a desired length. Applicant amended claim 3 to add the language of claim 10. The examiner's indicated allowability of claim 10 of the application was apparently based, at least in part, on the fact that he had not found a teaching in the prior art towards the increasing length of the brush bristles.

The newly detected magazine article contains a statement which may be viewed as suggesting such a teaching. Specifically, the article states: “Finishing details include tapered lead-in brushes and end-caps to provide a gentle profile change from the smooth skirt panel to the extent of the brush projection.” This new technological teaching in the article raises a substantial new question of patentability of claim 3.

(Patent owner would then be free to argue why the claims are patentable despite the newly proffered magazine article, in the portion of the request that applies the art to the claims.)

(4) Example from the mechanical context:

The '000 patent is directed to an automated device that fills a syringe with a dose of medication by handling a source vial containing the medication, withdrawing the necessary medication from the vial, and then dispensing the medication into the syringe. The claims of the '000 patent recite a robotic vial gripper device and a vial orientation detector. The vial orientation detector serves to ensure that the end of the vial with the rubber stopper is pointed in the correct direction, thereby enabling the system to withdraw medication from the vial.

During the prosecution of the application which matured into the ‘000 patent, the applicant did not dispute that the prior art taught the recited gripper device - the focus was rather on whether the prior art taught "a detector that determines whether the vial is in an upright orientation" as recited in the claims. The examiner ultimately allowed the '000 patent on the basis that the prior art of record failed to teach use of a sensor to detect "spatial orientation" of the vial.

A reference that was not before the examiner, patent ‘999 to Krinski, teaches a vial handling device that includes not only the recited gripper device but also the recited vial orientation sensor. Krinski discloses an automated system for manipulating vials in preparation for chemical testing.

> Figure 1 of Krinski depicts the gripper device 1 as well as "a fiber optic retro-reflective infrared sensor 2 ... used to detect ... whether the vial is oriented properly, i.e., with the end or bottom of the vial directed downwardly, so that the vial can receive and retain a sample." This technological teaching was never before considered and therefore raises a SNQ. As described in more detail below, the Krinski reference anticipates both independent claims (1 and 12), as well as dependent claims (2 and 21) of the '000 patent.

<u>What if the patent was allowed on first action with no reasons for allowance, or the patent is a design patent?</u>

Even where the record does not indicate which specific claimed limitations resulted in allowance of the patent application, or where the patent is a design patent, identification of a SNQ is still required. The request should not merely provide a statement that the reference was not cited in the prior examination. Rather, it should identify at least one new technical teaching that was not discussed on the record in the prior examination. As a suggestion, identify a couple of comparatively narrow claim limitations so that the examiner has a starting point, and identify where they are taught in the reference cited in the reexamination request. In a design patent, identify an ornamental feature of the patent and identify where it is taught in the reference cited in the request. It is generally not useful to find every feature of a claim in a reference and argue that every feature independently is the basis for a SNQ.

7. What are common defects identified in a "detailed explanation of how all of the cited documents are applied to the claims"?

For third party reexamination requesters, the "detailed explanation of how all of the cited documents are applied to the claims" is your opportunity to suggest to the examiner what rejections of the patent claims should be made. For patent owner requesters, the "detailed explanation" is your opportunity to show what claim limitations are taught by the references and what claim limitations are not taught by the references. Many of the requests that are identified as defective either: (1) do not explain how some of the references apply to the claim limitations or (2) group references or statutory bases of rejections in a way that does not clearly identify what rejections are proposed by the third party requesters, or what applications of the art are proposed by patent owner requesters.

<u>Ensure that at least one of the references in each proposed rejection (or proposed application of the art for patent owner requesters) has a new, non-cumulative technical teaching identified in the SNQ section.</u>

Each proposed rejection or application of the art should unambiguously include at least one of the new technical teachings from the "statement pointing out each substantial new question of patentability." A reexamination proceeding is ordered "for resolution of the [SNQ]." See 35 U.S.C. 304 and 313. Therefore, the proposed rejections or application of the art must tend to resolve the SNQ. In each proposed rejection, include a patent or

printed publication from the statement identifying each SNQ and the new technological teaching from that patent or printed publication so that a decision on the proposed rejection will resolve the SNQ. For example, if the request shows that reference A has a new, non-cumulative technical feature that raises a SNQ, a proposed 35 U.S.C. 102 rejection of claims as anticipated by A would tend to resolve the question, as would a proposed 35 U.S.C. 103 rejection as unpatentable over B in view of A (assuming that the modified "B in view of A" includes the feature).

Where a rejection is proposed that does not include a reference that raises an asserted SNQ, the request will be identified as noncompliant with filing date requirements, because it is not apparent how the proposed rejection will resolve a SNQ. For example, a proposed 35 U.S.C. 102 rejection as anticipated by reference B would not be expected to resolve the SNQ raised by reference A.

Do not include documents in the citations of prior art that are not a basis for the proposed rejections.

If a document is cited (listed) on a citation form (e.g. PTO/SB/08), or equivalent, and not identified as a basis for a proposed rejection (or applied to the claims, in a patent owner request), the request may be deemed noncompliant with the filing date requirements. While it might be tempting to write a disclaimer-type sentence to the effect of "References A, B, and/or C (not explained) could also be used to reject the claims," such statements do not clearly identify and adequately explain the proposed rejections and (in an *inter partes* proceeding) do not identify issues that may later be appealed. If there is a reference that is essential to a rejection, such as a document that establishes the publication date of a document that is part of the rejection, that reference should be explained in the detailed explanation so that the reason for citing the document is clear.

Clearly identify what portion of the statute is relied on for a proposed rejection.

Generally, the detailed explanation should identify if a reference is applied under 35 U.S.C. 102 or if it is to be applied under 35 U.S.C. 103. If there is one basis for proposed rejection under 35 U.S.C. 102, and another basis for a proposed rejection under 35 U.S.C. 103, explain both proposed rejections separately rather than trying to lump them together in a single explanation to avoid confusion. Further, do not state, at the end of a proposed 35 U.S.C. 102 rejection, "In addition, reference A also makes Claim 1 obvious" without providing a detailed explanation for the proposed obviousness rejection.

Avoid using alternate cumulative references in a proposed rejection.

In many cases, a rejection that reads "Claim 1 should be rejected under 35 U.S.C. 103(a) as unpatentable over Reference X in view of one or more of References A, B, C and/or D" will be found to be noncompliant with the filing date requirements. If a request suggests rejections or combinations that are not separately and clearly explained, it is likely to be identified as defective. In other words, write out the explanation of the proposed rejections separately.

Do not leave loose ends dangling in headers or other comments

Some requests for reexamination are found noncompliant where rejections are suggested in a heading but not explained. For example, a heading might read "Claim 1 is unpatentable over references A and/or B in view of either C and/or D", and then explain "A in view of C", "B in view of C", "A and B in view of D", and "B in view of C and D". However, the header suggests a variety of other rejections (such as "A in view of D") that are not later explained. If a heading or other comment summarizes a group of rejections in a way that includes other non-explained rejections, the request is likely to be identified as defective.

8. Do I need to include both a narrative explanation and a claim chart for the "detailed explanation of how all of the cited documents are applied to the claims"?

No. Generally, it is more helpful to the examiner if you provide a single explanation of the proposed rejection. Providing both a narrative explanation and a lengthy claim chart appendix unduly increases the length of the request, and introduces the risk that the narrative explanation may be inconsistent with the claim chart explanation. While it is the job of the examiner to set forth a *prima facie* case of unpatentability where appropriate, most reexamination requesters want as much input to the process as possible. The best way to achieve this kind of input is to give the examiner the rejections you (as requester) want to see, in the form you want to see them. Put another way, the ideal outcome for the third-party requester should be that the examiner reads the detailed explanation and determines that the explanation contains at least one rejection that, in the examiner's opinion, sets forth a *prima facie* case of unpatentability. In such an instance, the examiner could simply copy each such rejection to his/her Office action. Proposed rejections that clearly and concisely identify and provide support for a *prima facie* case of unpatentability are more likely to be adopted by the examiner. Explanations that are incomplete, unclear, or confusing may result in the examiner not adopting the proposed rejection or not understanding the requester's position on how the references are applied to the claim limitations.

9. I filed a request for reexamination 10 years ago and didn't have any of these problems. What changed?

The 2002 "*Portola* override" amendments to 35 U.S.C. 303(a) and 312, the decision in *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008), the rule making *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*", 71 Fed. Reg. 44219 (4 Aug 2006), 1309 OG 216 (29 Aug 2006), and the growth of *inter partes* reexaminations have modified reexamination practice and procedure, placing a new focus on identifying exactly what portion of a reference raises a SNQ and on identifying and explaining exactly what rejections are being proposed.

10. Does it help to restate the relevant case law on reexamination or 35 U.S.C. 102 and 103?

No, unless the relevant case law is cited to make a particular point. Long citations of general case law or MPEP sections only serve to increase the length of reexamination requests.

Language discussing the parameters of *Graham v. Deere*, *KSR*, *Ethicon v. Quigg*, or *In re Swanson* without specific reference to the facts of a particular reexamination is likely to be given cursory review by the examiner, and any specific facts buried in such language are more likely to be overlooked. If you must include an extensive description of the legal landscape, it is recommended that it is presented in a separate section of the request without facts specific to the particular proceeding in that section.