

Training Module for Chapter 22 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 22: Citation of Prior Art and Ex Parte Reexamination of Patents

- Issued patents may be modified or invalidated by two established practices established by the UDPTO. They are:

(1) citation of prior art, and

(2) interference.

The chapter relates to citation of prior art and the next relates to interference.

- **Any person** at any time may cite to the USPTO in writing prior art consisting of patents or printed publications which that person believe have a bearing on the patentability of any claim of a particular patent. This is considered to be an ex parte request for re-examination

The **AIA** has expanded the scope of information that may be cited to include written statements of a patent owner filed in a proceeding before a Federal court or the USPTO regarding the scope of any claim of the patent.

- If the person explains in writing the pertinence and manor of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the USPTO.
- This citation is considered to be a request for re-examination of a patent – a procedure that first became available in 1981.

RECALL: An ex parte re-examination does not involve the requestor

beyond his/her citation of prior art.

- At the written request of the person citing the prior art, his/her identity will be excluded from the patent file and kept confidential.

NOTE: This is a cost effective approach for initiating a challenging to an existing patent and, if requested, the challenger's name and affiliation are not exposed.

- Prior art citations are limited to written prior art consisting of patents and printed material. Thus, allegations of prior use, or sale, or inequitable conduct and other information not based on written prior art is not a valid grounds for re-examination.
- The USPTO initially determines if a *substantial new question of patentability* is presented by the prior art in the requested re-examination.
- If this is the case, re-examination moves forward in an expedited fashion.

NOTE: Once initiated, the re-examination process is very similar to a regular examination procedure for a patent application.

- But, unlike a patent application, all re-examination and patent files are open to the public.

Selected Questions and Answers for Chapter 22

Question 22-1 (Oct03am-31a)

Reexamination has been ordered following receipt of a request for reexamination of U.S. Patent X, filed by the patentee. Patent X contains independent claims 1 through 4, each directed to a hydrocyclone separator apparatus. They are the only claims that were ever presented during prosecution of the application that matured into Patent X. In the first Office action during reexamination, claims 1 through 4 are rejected as being obvious under 35 USC 103 over U.S. Patent Z. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assume there are no issues under 35 USC 102, 103, or 112, and that any dependent claim is properly dependent. Recommend which of the following claims, if any, would be subject to rejection under 35 USC 305 for

improperly enlarging the scope of the original claim in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frustro-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

ANSWER: (C). 35 U.S.C. § 305; MPEP §§ 2258 and 1412.03. MPEP § 2258, under the heading “Claims In Proceeding Must Not Enlarge Scope Of The Claims Of The Patent,” states “[w]here new or amended claims are presented . . . the claims of the reexamination proceeding should be examined under 35 U.S.C. 305, to determine whether they enlarge the scope of the original claims. 35 U.S.C. 305 states that ‘no proposed amended or new claim enlarging the scope of the claims of the patent will be permitted in a reexamination proceeding...’” Under the further subheading “Criteria for Enlargement of the Scope of the Claims,” MPEP § 2258 states “A claim presented in a reexamination proceeding ‘enlarges the scope’ of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, i.e., what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination.” MPEP § 1412.03, under the heading “New Category of Invention Added In Reissue – Broadening,” states “[t]he addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Inter. 1989).” MPEP 2258, under the further subheading “Rejection of Claims Where There Is Enlargement,” states “[a]ny claim in a reexamination proceeding which enlarges the scope of the claims of the patent should be rejected under 35 U.S.C. 305.” Since no claims drawn to a method were ever presented during prosecution of Patent X (claims 1 through 4 “are the only claims that were ever presented during prosecution of the application that matured into Patent X”), the claim recited in (C) is not directed to “the invention as claimed.” (A), (B), and (D) are all

incorrect because each of their claims are directed to a hydrocyclone separator apparatus, *i.e.*, “the invention as claimed,” and they do not enlarge the scope of the claims in Patent X. (E) is an incorrect answer because (C) is the correct answer.

In-Depth Review of Chapter 22

Chapter 22 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

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