

Training Module for Chapter 28 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 28: Supplemental Examination

NOTE: Recall, that in the Summary of Chapter 26 (Optional *Inter Partes* Re-examination) that no requests for *Inter Partes* re-examination may be filled on or after September 16, 2012 as established in the AIA. However, it was mentioned *Inter Partes* re-examination has found a new life that is more fully described in this chapter covering the topic of Supplemental Examination.

A patent owner may now request a Supplemental Examination of his/her patent to review any matter, such as a questions of infringement, that might have come up since his/her patent was issued. The result of such a Supplemental Examination will be either to provide the owner with a certificate indicating that the patent remains valid or to refer the case to an *Inter Partes* re-examination for a final determination. In effect, the new procedure for Supplemental Examination serves as a limiting gateway to reduce the total number of cases previously reaching *inter partes* re-examination at the USPTO. (Prior to this change, the percentage of applications granted *for inter partes* re-examination was in the range of 95% – causing somewhat of a log-jam at the USPTO.)

To further limit the number of cases reaching *inter partes* re-examination, more stringent acceptance criteria were introduced by the AIA. A transition period began starting on September 16, 2011 and ended September 15, 2012, during which *inter partes* re-examinations were still accepted by the USPTO. But, the

acceptance criteria was elevated from the old criteria of a Substantial New Question (SNQ) of patentability to a reasonable likelihood that the request will prevail (RLP = reasonable likelihood of prevailing) with regards to at least one of the claims challenged in the request. After September 16, 2012, the USPTO no longer accepts requests for *inter partes* re-examination, but the acceptance criteria for such cases that arise from Supplemental Examinations has returned to the SNQ.

Section 2801 – Introduction

- Supplemental examination became available on September 16, 2012 as a result of the AIA.
- Only a patent owner may file a request for supplemental examination of a patent (Section 2803). So, supplemental examination is generally considered to be a benefit for the patent owner.
- Unlike ex parte re-examination 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 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.

Section 2803.02 – Public Access

- After a filing date has been accorded for a supplemental examination, the files are open to inspection by the general public.

Section 2806 (III) Facsimile Transmission

- Requests for supplemental examination may **not** be transmitted by facsimile.

Section 2808 (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 12 items of information believed to be relevant to the patent. (Multiple requests are acceptable to cover more than 12 items.)

NOTE: Defining an “item of information” is discussed in some detail in this section.

Section 2809.01 Information Relating to the Correction of Factual Information

- If a patent owner merely wishes to amend a patent file in order to correct factual information, he/she should file a reissue application or a request for a certificate of correction, where appropriate.

Section 2816.03 (B) Where No Substantial New Question of Patentability is Found

- If the examiner determines that none of the items of information in the supplemental examination raise a SNQ of patentability, a supplemental examination certificate will be issued to state that no SNQ is raised in the request for supplemental examination.
- Alternatively, if a SNQ is raised, the examination certificate will state that the case is being referred for *inter partes* re-examination.

Selected Questions and Answers for Chapter 26 – None

In-Depth Review of Chapter 28

Please click on the link, below, to bring up a special version of Chapter 28 in the MPEP that has been prepared exclusively by **PassPatentBar** to complete your review of this chapter. It is recommended that you quickly scan through most of this chapter while reading only those sections, about 10% of the total, that are highlighted in yellow. When you are finished with this review, please return here by using the return arrow at the top-left on your screen.

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