

Requesting Reexamination: Requirements and Best Practices

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A request for reexamination is the initial document in any reexamination proceeding. In an *ex parte* reexamination requested by a third party, the request very likely will be the only document that the third-party requester submits. As such, the request is a critical document for any third-party requester and should be prepared with care. This article discusses the filing requirements for a reexamination request, best practices for preparing a request, and guidance recently published by the PTO regarding filing compliant requests.¹

REQUEST REQUIREMENTS

Rule 510(b) sets forth various parts of a reexamination request that a requester must include. If a required part is missing, the request will not be granted a filing date. The required parts of an *ex parte* request are (1) a copy of the entire patent for which reexamination is requested, as well as any disclaimer, certificate of correction, and prior reexamination certificate; (2) a copy of every printed publication relied upon in the request (except U.S. patents and published U.S. patent applications); (3)

an identification of each claim for which reexamination is requested; (4) a statement that clearly points out each substantial new question of patentability (SNQP) in view of the cited prior art printed publications; (5) an explanation of the pertinence and manner of applying the prior art to each identified claim; (6) the filing fee (currently \$2,520 for *ex parte* reexamination); and (7) a certificate of service on the patent owner (if the requester is a third party).² *Inter partes* reexamination requests have some additional requirements, which will be the topic of a future article.

The two most critical parts of the request are (4) and (5) above – the SNQP and the explanation of the application of the art – which were compared and contrasted in our April 2010 article.³ Failure to keep those two parts separate and to properly address each one are common reasons why the PTO deems requests to be noncompliant.⁴

OPTIONAL ADDITIONAL ITEMS

Some additional items that the requester may want to include with the request are (1) a transmittal form; (2) claim charts; (3) declarations; (4) old prior art; (5) parent patent applications; (6) patent owner admissions; and (7) patentability arguments and/or amendments, if the requester is the patent owner.

Transmittal Form

Transmittal form PTO/SB/57 (also referred to as a Form PTO 1465) serves as a checklist of the parts that must be included in the request and, when properly completed, itself fulfills several of the request requirements (*e.g.*, identification of claims for which reexamination is requested). The PTO recommends that requesters use this form.⁵

Claim Charts

A third-party requester should consider including a claim chart that compares the cited art to each element of the claims. A good claim chart can be very effective in explaining how the cited prior art applies to the claims. A patent-owner requester probably does not want to present a claim chart because it risks making unnecessary admissions about claim limitations that are

not presently the basis for distinction over the prior art.

Should a third-party requester present its proposed rejections via claim charts or regular narrative paragraphs or both? One approach is to include a narrative version of the proposed rejections exactly as the requester would like the examiner to state them in an Office action, which typically do not use claim charts to present rejections. The rationale for that approach is to make the examiner’s job as easy as possible to adopt the proposed rejections. Under that approach, claim charts can be included as a supplement to, not a substitute for, the narrative rejection. If it is unduly duplicative to include the claim charts in the main body of the request, they can be appended as separate attachments to the request.

However, providing a proposed rejection in both a claim chart and narrative risks inconsistency. For that reason, and because the duplication adds to the quantity of material that the PTO must consider, the PTO asks that requesters choose one form or the other but not both.⁶ A requester who chooses to submit both should definitely check them carefully for inconsistencies.

The authors almost always utilize claim charts at least to formulate their positions and then decide whether to include the charts in the request and, if so, where and whether alone or in addition to a narrative explanation of the rejection.

Declarations

A requester may want to consider submitting supporting declarations. Two common types of declarations filed with a reexamination request are those that (1) authenticate prior art and its dates of public availability and (2) explain the content of a prior art printed publication. While the latter type can certainly be useful, a rejection in reexamination “cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.”⁷

Old Prior Art

It may sometimes be helpful to include copies of prior art previously considered by the PTO. In some cases it may be advantageous to compare the new prior art upon which the reexamination request is based against the old art of record to show that the new prior art contains a new, non-cumulative technological teaching and therefore raises an SNQP. One way to do this is with a three-column claim chart, with columns

for the claim language, the old prior art, and the new prior art.

Parent Patent Applications

If the effective filing date of the patent is relevant to a patentability question, such as when the printed publication on which the request is based became publicly available after a priority date but before the actual filing date, then copies of parent patent applications can be submitted with the request to facilitate the PTO's determination of the effective filing date for the claims at issue.

Patent Owner Admissions

A third-party requester may also want to consider submitting admissions by the patent owner. Such an admission must be of record in either the patent or reexamination file or a court file. Like a declaration, "an admission, *per se*, may not be the basis for establishing a substantial new question of patentability."⁸ When the patent is in litigation, and reexamination is contemplated, reexamination counsel and litigation counsel should consult about the possibility of acquiring admissions and then utilizing them in the reexamination.

Patent Owner Arguments and Amendments

A patent owner's request may include proposed amendments to the claims, specifications, or drawings. However, the PTO will decide whether to grant the request based on the claims in effect, without considering any proposed claim amendments. If the request is granted, then subsequent examination will be based on the claims as amended.

A patent-owner requester can also include patentability arguments in the request. The patent owner cannot argue that there is not an SNQP but can argue that the answer to the SNQP is that the claims are patentable.

COMMON DEFICIENCIES

The PTO is picky about the formal requirements for a reexamination request to be granted a filing date because the filing date triggers the immutable three-month statutory deadline for the PTO to issue a decision on the request. With the current popularity of reexamination, the resulting high workload of the Central Reexamination Unit (CRU) provides some motivation for the PTO to find reasons not to grant a filing date to a request.

Currently common reasons cited by the PTO for not granting a filing date to a request include (1) ambiguity in the state-

ment of the SNQP or proposed rejection; (2) failure to apply all the cited prior art in the SNQPs or proposed rejections; and (3) referring to issues outside the scope of reexamination.

Ambiguities

A requester should clearly and separately state each SNQP and corresponding proposed rejection. Lumping together different alternatives should be avoided.⁹ For example, it is better to say separately, "Claim 2 is anticipated by Jones," and "Claim 3 is obvious over Jones in view of Smith," rather than "Claims 2 and/or 3 are anticipated by and/or obvious over one or more of Smith and Jones, alone or in combination." MPEP § 2217 provides helpful examples of appropriate and inappropriate statements of proposed rejections. All of the inappropriate examples share a common trait: alternative language. Alternative language to express either the claims at issue, the statutory basis for the proposed rejection, or the reference(s) to be applied is problematic. A requester should eliminate the word "or" from all statements of proposed rejections and state each alternative separately. Clear organization and helpful headings to separate different SNQPs and proposed rejections go a long way toward avoiding ambiguities.

Failure to Apply All Cited References

A reexamination request must apply all of the prior art cited in the request.¹⁰ No extraneous or "background" prior art printed publications should be cited. There should be a one-to-one-to-one mapping of the prior art references listed on a Form PTO-1449, identified in the SNQPs, and applied in the proposed rejections. If a background reference is not part of an SNQP, it should not be listed on a Form PTO-1449. A paralegal at the CRU checks the request to see that each reference listed on a Form PTO-1449 is included in at least one SNQP. It is advisable to draft the request's section headings using the reference names to make the paralegal's job easy.

Reference to Prohibited Issues


The only issues that can be raised in a reexamination request are patentability issues under 35 U.S.C. §§ 102, 103 or double patenting based on prior art printed publications. Referring (even obliquely) to other issues such as inequitable conduct, compliance with 35 U.S.C. § 101, or com-

pliance with 35 U.S.C. § 112 risks that the PTO will deem the request noncompliant.¹¹

OTHER RECOMMENDED PRACTICES

In addition to most of the tips discussed above, the PTO's recently published guidance has other worthwhile advice. For example, the PTO recommends electronic filing of reexamination requests, using the patent owner's address of record in PAIR (rather than another address found in other PTO records) for service, and signing the request itself and not just the transmittal form.¹² Anyone now working on a reexamination request should review the PTO's guidance before filing.

CONCLUSION

Preparation of a reexamination request today must be done with considerably more attention to detail than was acceptable just a few years ago.¹³ Careful attention to the request is now necessary to file a compliant request that is granted a filing date. Moreover, an effective request, besides just complying with the requirements, should be prepared with thoughtful attention to its contents, organization, and clarity. 

ENDNOTES

1. USPTO, *Best Practices and FAQs for Filing Requests for Reexamination Compliant with 37 CFR 1.510 and 1.915*, (May 2010), available at http://www.uspto.gov/patents/Best_Practices_and_FAQs_for_filing_reexaminations_5_10_10.pdf; see also Andy Kashnikow, *Filing Compliant Reexam Requests* (June 2010), available at http://www.cabic.com/bcp/060110/AKashnikow_RBP.ppt.
2. 37 C.F.R. § 1.510(b). MPEP § 2219 also requires a copy of any Federal Court decision, complaint in a pending civil action, or interference decision; however, the PTO does not seem to enforce that requirement.
3. Matthew C. Phillips & Kevin B. Laurence, *Substantial New Questions of Patentability*, *Intellectual Property Today* 34-35 (Apr. 2010).
4. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 2, 3-4, 9-17.
5. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 2.
6. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 17.
7. MPEP § 2258.
8. MPEP § 2217(III).
9. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 3.
10. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 4.
11. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 5.
12. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 1-2, 4, 5.
13. USPTO, *Best Practices and FAQs*, note 1 *supra*, at 17.