UNITED STATES PATENT AND TRADEMARK OFFICE

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MEMORANDUM

DATE: June 3, 2003

TO: Patent Examining Corps
Technology Center Directors
Board of Patent Appeals and Interferences
United States Patent and Trademark Office

FROM: /s/
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

SUBJECT: **Revised Guidance on Usage of Previously Cited/Considered Prior Art as References in Reexamination**

The present memorandum sets forth reexamination policy and practice now in effect as a result of revision of the reexamination statute recently made by the Patent and Trademark Office Authorization Act of 2002 (hereinafter referred to as the "Act of 2002").[1]

In the decision of *In re Portola Packaging Inc.,*[2] prior art was essentially precluded from being applied as the **sole** basis for providing a substantial new question of patentability (SNQ) in a reexamination proceeding if the art was: (1) relied upon to reject any claim in an earlier examination of the patent; or (2) cited in an earlier examination and its relevance to the patentability of any claim was discussed in that examination. Such art will be referred to as "old art" throughout this memorandum.[3]

The Act of 2002 revised the reexamination statute by adding, *inter alia*, the following new last sentence of 35 U.S.C. §§ 303(a) and 312(a):

> "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

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[1] See § 13105, part (a), of the Patent and Trademark Office Authorization Act of 2002, enacted in Public Law 107-273, 21st Century Department of Justice Appropriations Authorization Act, 116 Stat. 1758 (2002).

[2] *See In re Portola Packaging Inc.* 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

[3] The term"old art" was coined in the decision of *In re Hiniker Co.,* 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998) where the Court stated "[w]e extended that holding in *In re Portola Packaging* ... which held that prior art that was before the original examiner could not support a reexamination proceeding despite the fact that it was not the basis of a rejection in the original prosecution; as long as the art was before the original examiner, it would be considered **'old art.'"** [Emphasis added]

This revision to the statute made by the Act of 2002, in effect, overruled the *Portola Packaging* decision [4] Accordingly, for any reexamination ordered on or after November 2, 2002 (the effective date of the statutory revision), the Office is hereby repealing the *Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc*., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997); Notice, 64 FR 15346 (March 31, 1999), 1223 *Off. Gaz. Pat. Office* 124 (June 22, 1999), which were promulgated in order to conform with the decision of *In re Portola Packaging Inc.*, *supra*.

Thus, in any reexamination ordered on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a SNQ that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.

When it is determined that a SNQ based solely on old art is raised by a request in a reexamination that was ordered, or is to be ordered, on or after November 2, 2002, Form Paragraph A (attached) should be included in the order for reexamination or Office action in which the SNQ based solely on the old art is first set forth.

For a reexamination ordered before November 2, 2002: The change made by the Act of 2002 is not applicable to reexamination proceedings ordered prior to November 2, 2002. For all such reexamination proceedings, the policy set forth in MPEP § 2242, Policy in Specific Situations, Part A, should be followed.

Inquiries: Inquiries as to using "old art" in a reexamination proceeding should be addressed to Jerry Dost [305-8610] or Ken Schor [308-6710], Senior Legal Advisors of the Office of Patent Legal Administration.

Attachment: Form paragraph to use by examiner

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[4] See the sole footnote of *In re Robert T. Bass,* 314 F.3d 575, 576-77, 65 USPQ2d 1156, 1157 (Fed. Cir. 2002) which states that Public Law 107-273 overruled *Portola Packaging*.

Attachment: ***Form Paragraph A: Criteria for Applying "Old Art" as Sole Basis for Reexamination***

The above **[1]** is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

> "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art , i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on **[2]**. A discussion of the specifics now follows:

[3]

Examiner Note:

1. In bracket [1], insert "substantial new question of patentability" if the present form paragraph is used in an order granting reexamination (or a TC Director's decision on petition of the denial of reexamination). If this form paragraph is used in an Office action, insert "ground of rejection."

2. In bracket [2], insert the old art that is being applied as the sole basis of the SNQ. Thus, for example, "Schor" or "Schor when taken with the Jones publication" or "the combination of Schor and the Smith publication" could be inserted. Where more than one SNQ is presented based solely on old art, the examiner would insert all such bases for SNQ. Thus, for example, " (1) Schor when taken with the Jones publication and (2) the combination of Jones and Smith" could be inserted.

3. In bracket [3], for each basis identified in bracket [2], explain how and why that fact situation applies in the proceeding being acted on. The explanation could be for example that the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. *See Ex parte Chicago Rawhide,* 223 USPQ 351 (Bd. Pat. App. & Inter., 1984).

4. This form paragraph is only used the first time the "already cited/considered" art is applied, and is not repeated for the same art in subsequent Office actions.