



Small Entity Compliance Guide

Request for Supplemental Examination

**U.S. Department of Commerce
United States Patent and Trademark Office
September 2012**

Section 12 of the Leahy-Smith America Invents Act (AIA) adds a new 35 U.S.C. 257 to provide that a patent owner may request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent. This Compliance Guide has been prepared by the United States Patent and Trademark Office (USPTO) in accordance with the requirements of Section 212 of the Small Business Regulatory Enforcement Fairness Act of 1996. It is intended to help small entities—small businesses, small organizations (non-profits), and small governmental jurisdictions—comply with the USPTO’s supplemental examination regulations at 37 CFR 1.601 through 1.625. A copy of 35 U.S.C. 257 and 37 CFR 1.601 through 1.625 is attached as Appendix A. The USPTO has also posted a copy of the final rule to implement supplemental examination (*Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees*, 77 Fed. Reg. 48828 (Aug. 14, 2012)), as well as frequently asked questions and answers and other information concerning supplemental examination, on its Internet Web site (www.uspto.gov).

This Compliance Guide is not intended to replace the rules and, therefore, final authority rests solely with the provisions of 35 U.S.C. 257 and 37 CFR 1.601 through 1.625. Although the USPTO has attempted to cover all parts of the rules that might be especially important to small entities, the coverage may not be exhaustive. This Compliance Guide may, perhaps, not apply in a particular situation based upon the circumstances, and the USPTO retains the discretion to adopt approaches on a case-by-case basis that may differ from this Compliance Guide, where appropriate. Any decisions regarding a particular small entity will be based on the provisions of 35 U.S.C. 257 and 37 CFR 1.601 through 1.625.

A patent owner (other than a juristic entity) may file his or her own request for supplemental examination. Patent owners are advised to secure the services of a registered patent attorney or agent to file the request for supplemental examination and prosecute any resulting *ex parte* reexamination, since the value of a patent is largely dependent upon skilled preparation and prosecution. The USPTO cannot aid in the selection of an attorney or agent.

Who may file a request for supplemental examination?

A request for supplemental examination of a patent must be filed by the owner of the entire right, title, and interest in the patent. Any request for supplemental examination of a patent filed by someone other than the owner of the entire right, title, and interest in the patent (*e.g.*, an exclusive licensee or partial assignee) must be accompanied by a petition under 37 CFR 1.183 that includes a showing of extraordinary circumstances. A third party is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding.

A patent owner who is the inventor may file his or her own request for supplemental examination, but a juristic entity must be represented by a registered patent attorney or agent.

Why would a patent owner file a request for supplemental examination?

35 U.S.C. 257(c)(1) provides that, with two exceptions, a patent shall not be held unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent.

The first exception is that 35 U.S.C. 257(c)(1) shall not apply to an allegation pled with particularity in a civil action, or set forth with particularity in a notice received by the patent owner under section 505(j)(2)(B)(iv)(II) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355(j)(2)(B)(iv)(II)), before the date of a supplemental examination request under 35 U.S.C. 257(a) to consider, reconsider, or correct information forming the basis for the allegation (35 U.S.C. 257(c)(2)(A)).

The second exception is that in an action brought under section 337(a) of the Tariff Act of 1930 (19 U.S.C. 1337(a)) or 35 U.S.C. 281, 35 U.S.C. 257(c)(1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or corrected pursuant to a supplemental examination request under 35 U.S.C. 257(a), unless the supplemental examination, and any *ex parte* reexamination ordered pursuant to the request, are concluded before the date on which the action is brought (35 U.S.C. 257(c)(2)(B)).

When may a request for supplemental examination be filed?

The USPTO's regulations provide that a request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent. As discussed previously, a request for supplemental examination would need to be filed prior to the date specified in 35 U.S.C. 257(c)(2)(A) or (B) to have the effect provided for in 35 U.S.C. 257(c)(1).

Are there any limits on the amount of information that may be included with the request for supplemental examination?

Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. An item of information is most commonly a patent document (a patent or published application) or non-patent literature (*e.g.*, a journal article or book). However, an item of information could be other items such as a commercial document (*e.g.*, a sales receipt), a transcript of an audio or video recording, or an affidavit or declaration. Patent owners are cautioned against seeking to avoid the twelve item limit by inserting multiple items within the body of the request for supplemental examination or by including multiple items as exhibits accompanying the declaration, because each of the multiple items may be separately counted as an item of information.

A patent owner who wants supplemental examination of a patent on the basis of more than twelve items of information may file multiple requests for supplemental examination of the same patent at any time during the period of enforceability of the patent.

What must be included with a request for supplemental examination?

A request for supplemental examination must meet specified content and format requirements, and include the applicable fees. The USPTO provides a form (PTO/SB/59) for a request for supplemental examination transmittal. The USPTO does not require patent owners to use this form to file a request for supplemental examination, but use of the form is encouraged to assist the patent owner in ensuring that the request for supplemental examination complies with the applicable requirements. A copy of the request for supplemental examination transmittal form (PTO/SB/59) is attached as Appendix B. The request for supplemental examination transmittal form (PTO/SB/59) will be made available at the USPTO's Internet Web site www.uspto.gov on September 16, 2012.

Content requirements:

Identification of the patent for which supplemental examination is requested: A request for supplemental examination must identify (by patent number) the patent for which supplemental examination is requested.

List of items of information: A request for supplemental examination must include a list of the items of information that are requested to be considered, reconsidered, or corrected. The list must meet the requirements of 37 CFR 1.98(b) (the regulation that governs the filing of

information disclosure statements in patent applications), as appropriate. For example, the list must include a publication date for each item of information, where appropriate.

37 CFR 1.98(b) sets out the requirements for the submission of patent documents and publications in an information disclosure statement in a patent application. 37 CFR 1.98(b) provides that: (1) each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date; (2) each U.S. patent application publication listed in an information disclosure statement must be identified by applicant, patent application publication number, and publication date; (3) each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date; (4) each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application; and (5) each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

Identification of other prior or concurrent post-patent USPTO proceedings: A request for supplemental examination must identify any other prior or concurrent post-patent USPTO proceedings involving the patent for which the current supplemental examination is requested. This requires an identification of the type of proceeding, the identifying number of the proceeding (e.g., a control number or a reissue application number), and the filing date of the proceeding. The type of proceeding may be, for example, an *ex parte* or *inter partes* reexamination proceeding, a reissue application, a supplemental examination proceeding, a post-grant review proceeding, or an *inter partes* review proceeding.

In addition, the patent owner must, as soon as possible upon the discovery of any other prior or concurrent post-patent USPTO proceeding involving the patent for which the current supplemental examination is requested, notify the USPTO of the post-patent USPTO proceeding (if not previously provided with the request). The notice is limited to an identification of the type, identifying number, and filing date of the proceeding, as described above, and may not include any discussion of the issues present in the current supplemental examination proceeding or in the identified post-patent USPTO proceeding(s).

Identification of each claim of the patent for which supplemental examination is requested: A request for supplemental examination must identify each claim of the patent for which supplemental examination is requested. The result of a supplemental examination is a determination of whether any of the items of information raises a substantial new question of patentability. Because patentability relates to the claims of the patent, the patent owner must identify the patent claims to be examined in order for the USPTO to determine whether a substantial new question of patentability as to those claims has been raised by an item of information.

Detailed explanation of the relevance and manner of applying each item of information: A request for supplemental examination must include a separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested. Ideally, the required explanation can be

provided using an appropriately detailed claim chart that compares the limitations of each claim for which supplemental examination is requested with the relevant teachings of each item of information cited in the request for supplemental examination.

A request for supplemental examination may optionally include other information, such as an explanation of how the claims patentably distinguish over the items of information and/or why each item of information does or does not raise a substantial new question of patentability.

Copy of the patent for which supplemental examination is requested: A request for supplemental examination must include a copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent. A “certificate issued for the patent” includes, for example, a certificate of correction, a certificate of extension, a supplemental examination certificate, a post-grant review certificate, an *inter partes* review certificate, an *ex parte* reexamination certificate, and/or an *inter partes* reexamination certificate issued for the patent.

Copy of each listed item of information: A request for supplemental examination must include a legible copy of each listed item of information, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language document. Items of information that form part of the discussion within the body of the request for supplemental examination itself are not required to be submitted. Copies of U.S. patents and U.S. patent application publications are also not required, but may be submitted.

Summary of documents over 50 pages in length: A request for supplemental examination must include a summary of the relevant portions of any submitted document (including patent documents), other than the request itself, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions. This summary may be similar to the discussion of the relevant and pertinent parts of a non-English language document required for information disclosure statements. Patent owners are encouraged to redact lengthy documents to include only the relevant portions, unless the redaction would remove context such that the examiner would not be provided with a full indication of the relevance of the information.

Identification of the patent owner: A request for supplemental examination must identify the owner of the entire right, title, and interest in the patent requested to be examined, and include a submission by the patent owner in compliance with 37 CFR 3.73(c) establishing the entirety of the ownership in the patent requested to be examined. As discussed previously, only a patent owner may file a request for supplemental examination of a patent.

Format requirements:

Any item of information must be in writing (37 CFR 1.2). The USPTO does not currently have the capability of retaining records in unwritten form. For this reason, any audio or video recording must be submitted in the form of a written transcript in order to be considered. A transcript of a video may be submitted together with copies of selected

images of the video, and a discussion of the correlation between the transcript and the copies of the video images.

All papers submitted in a supplemental examination proceeding must be formatted in accordance with 37 CFR 1.52 (the regulation that governs the filing of papers in other patent-related proceedings). For example, a request for supplemental examination must be sheets of paper that are the same size, plainly and legibly written on only one side in portrait orientation either by a typewriter or machine printer in permanent dark ink or its equivalent, and either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches).

Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents, and if a court document, to the document submitted in court, and must not otherwise be reduced in size or modified, particularly in terms of font type, font size, line spacing, and margins. Patents, patent application publications, and third-party-generated affidavits or declarations must not be reduced in size or otherwise modified.

Fees:

The fee for processing and treating a request for supplemental examination (\$5,140) plus the fee for *ex parte* reexamination ordered as a result of a supplemental examination (\$16,120), resulting in a total in fees of \$21,260, is due with a request for supplemental examination. In addition, following fees are due if any item of information is a non-patent document over 20 pages in length: \$170 for each document between 21 and 50 pages, and \$280 for each additional 50 pages or a fraction thereof for each document over 50 pages in length. There is currently no small or micro entity reduction in the supplemental examination fees.

The USPTO will post more detailed information concerning the calculation of document size fees on its Internet Web site (www.uspto.gov).

How does a patent owner file a request for supplemental examination?

A request for supplemental examination should be deposited as a separate and independent submission, and should not be deposited in the file of the patent for which supplemental examination is requested, or in the file of any other application, patent, or proceeding. The request should be clearly identified by, for example, providing a heading such as "REQUEST FOR SUPPLEMENTAL EXAMINATION" prominently at the top of the first page of the paper. As previously discussed, the USPTO provides a request for supplemental examination transmittal form (PTO/SB/59). The USPTO does not require patent owners to use this form to file a request for supplemental examination, but use of the form is encouraged to assist the patent owner in ensuring that the request for supplemental examination complies with the applicable requirements.

Requests for supplemental examination, any paper(s) other than a request submission that are to be filed in a supplemental examination proceeding, and any paper(s) to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding, should be addressed to the USPTO according to the following guidance.

If reexamination is ordered as a result of the request for supplemental examination, any papers submitted subsequent to the order should be filed in the resulting reexamination proceeding. The filing of any papers other than those forming part of a request for supplemental examination in the supplemental reexamination proceeding should be rare.

A supplemental examination proceeding is separate and distinct from any *ex parte* reexamination proceeding resulting from the supplemental examination proceeding. A supplemental examination proceeding concludes with the electronic issuance of a supplemental examination certificate. Any reexamination resulting from a supplemental examination proceeding will be ordered after the conclusion of the supplemental examination proceeding. The ordering of *ex parte* reexamination initiates an *ex parte* reexamination proceeding.

Supplemental examination proceedings will be assigned a “series 96” control number (e.g., 96/999,999). Any *ex parte* reexamination proceeding resulting from the concluded supplemental examination proceeding will retain the same control number; however, the two proceedings are separate and distinct proceedings.

Electronic Submission: On or after September 16, 2012, patent owners may submit papers in a supplemental examination proceeding via the electronic filing system EFS-Web at www.uspto.gov. When filing a new request for supplemental examination, the patent owner should select the filing option “New application/proceeding”, and then select “Supplemental Examination”. Any paper(s) that are to be filed in an existing supplemental examination proceeding, and any paper(s) that are to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding, may be filed by selecting “Existing application/patent/proceeding” (e.g., a proceeding that has already been assigned a control number), “Documents/Fees for an existing application/proceeding”, and then entering the assigned control number and confirmation number for the proceeding. After the control number and confirmation number of the proceeding are entered, patent owners will be provided with a menu of document descriptions appropriate for a supplemental examination proceeding, unless reexamination has been ordered. If reexamination has been ordered, patent owners will be provided with a menu of document descriptions appropriate for a reexamination proceeding. For further information, please see the “EFS-Web Quick Start Guide to Filing a Supplemental Examination Request”, which will be available at [http://www.uspto.gov/patents/process/file/efs/guidance/QSG Supplemental Exam.pdf](http://www.uspto.gov/patents/process/file/efs/guidance/QSG_Supplemental_Exam.pdf) .

Even though the concluded supplemental examination proceeding is separate and distinct from the resulting *ex parte* reexamination proceeding, patent owners in EFS-Web must file any paper to be submitted in a resulting reexamination proceeding as a paper in an existing “application/patent/proceeding”, because the reexamination proceeding retains the same control number as the concluded supplemental examination proceeding.

Submission in Paper Form (Hard Copy): On or after September 16, 2012, the Office will be accepting the submission in paper form (hard copy) of a request for supplemental examination, and of any paper(s) other than a request submission that are to be filed in a supplemental examination proceeding. These papers should be addressed to “Mail Stop

Supplemental Examination” at the appropriate address provided below. Any papers submitted in paper form (hard copy) in a reexamination proceeding ordered as a result of a supplemental reexamination proceeding should be addressed to “Mail Stop Ex Parte Reexam” at the appropriate address provided below.

Mail to be delivered by the United States Postal Service (USPS) should be addressed as:

Mail Stop _____
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Correspondence to be hand-carried or delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolator, etc.) should be addressed as:

United States Patent and Trademark Office
Customer Service Window
Mail Stop _____
Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Facsimile Transmission: Requests for supplemental examination may **not** be facsimile-transmitted. Papers other than a request for supplemental examination that are to be filed in a supplemental examination proceeding, and any papers that are to be filed in a reexamination proceeding resulting from a supplemental examination proceeding, and that may be properly filed via facsimile transmission in accordance with reexamination practice, may be facsimile-transmitted to the Central Reexamination Unit at (571) 273-9900, on or after September 16, 2012.

What is the filing date of a request for supplemental examination?

The filing date of a request for supplemental examination is the date that a request in compliance with the previously discussed content, format, and fee requirements is received in the USPTO. A request for supplemental examination that does not comply with the previously discussed content, format, and fee requirements will not be accorded a filing date, except that the USPTO may grant a filing date to a request for supplemental examination if the non-compliance amounts to only minor defects, such as improper margins or other format issues.

If a request for supplemental examination does not comply with the previously discussed content, format, and fee requirements, the patent owner will be notified and given an opportunity to complete the request for supplemental examination within a specified time. If the patent owner timely files a corrected request for supplemental examination that complies with the previously discussed content, format, and fees requirements and addresses

all of the defects set forth in the notice, the filing date of the supplemental examination request will be the receipt date of the corrected request for supplemental examination.

A request for supplemental examination that is entitled to a filing date will be entered into the USPTO image file wrapper (IFW) and Patent Application Information Retrieval (PAIR) system, and will be viewable by the public via the Public PAIR system. However, a request for supplemental examination will not be available in Public PAIR until the request for supplemental examination meets the conditions to be entitled to a filing date.

What will happen if a patent owner files a request for supplemental examination?

Within three months following the filing date of a request for supplemental examination, the USPTO will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information properly presented in the request.

Interviews and amendments are not permitted in a supplemental examination proceeding. A telephone call to the USPTO to confirm receipt of a request for supplemental examination, or to discuss general procedural questions, is not considered to be an interview. The prohibition against interviews and amendments applies only to supplemental examination proceedings. If *ex parte* reexamination is ordered under 35 U.S.C. 257 as a result of the supplemental examination proceeding, interviews and amendments are governed by the regulations governing *ex parte* reexamination proceedings, except that the patent owner does not have the right to file a patent owner's statement under 35 U.S.C. 304 (a statement by the patent owner in response to the order granting reexamination) in an *ex parte* reexamination is ordered under 35 U.S.C. 257 as a result of the supplemental examination proceeding.

The supplemental examination proceeding will conclude with the electronic issuance of the supplemental examination certificate. The supplemental examination certificate will be electronically issued in the USPTO IFW system and will be visible in the USPTO PAIR system within three months of the filing date of the request. The certificate will be viewable by the public in Public PAIR. The supplemental examination certificate will indicate the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.

If the supplemental examination certificate indicates that a substantial new question of patentability is raised by one or more items of information in the request, *ex parte* reexamination of the patent will be ordered under 35 U.S.C. 257. Upon the conclusion of the *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published as an attachment to the patent by the USPTO's patent publication process. The electronically issued supplemental examination certificate will also remain as part of the public record.

If the supplemental examination certificate indicates that no substantial new question of patentability is raised by any of the items of information in the request, and *ex parte*

reexamination is not ordered under 35 U.S.C. 257, the electronically issued supplemental examination certificate will be published in due course by the USPTO's patent publication process as an attachment to the patent. The fee for reexamination ordered as a result of supplemental examination will be refunded.

If the USPTO becomes aware, during the course of a supplemental examination or of any *ex parte* reexamination ordered under 35 U.S.C. 257 as a result of the supplemental examination proceeding, that a material fraud on the USPTO may have been committed in connection with the patent requested to be examined, the USPTO is required by 35 U.S.C. 257(e) to refer the matter to the U.S. Attorney General. The supplemental examination proceeding or any *ex parte* reexamination proceeding ordered under 35 U.S.C. 257, however, will continue.

Appendix A

35 U.S.C. § 257 – Supplemental Examination to consider, reconsider, or correct information.

(a) Request for Supplemental Examination.— A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.

(b) Reexamination Ordered.— If the certificate issued under subsection (a) indicates that a substantial new question of patentability is raised by 1 or more items of information in the request, the Director shall order reexamination of the patent. The reexamination shall be conducted according to procedures established by chapter 30, except that the patent owner shall not have the right to file a statement pursuant to section 304. During the reexamination, the Director shall address each substantial new question of patentability identified during the supplemental examination, notwithstanding the limitations in chapter 30 relating to patents and printed publication or any other provision of such chapter.

(c) Effect.—

(1) In general.— A patent shall not be held unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent. The making of a request under subsection (a), or the absence thereof, shall not be relevant to enforceability of the patent under section 282.

(2) Exceptions.—

(A) Prior allegations.— Paragraph (1) shall not apply to an allegation pled with particularity in a civil action, or set forth with particularity in a notice received by the patent owner under section 505(j)(2)(B)(iv)(II) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355(j)(2)(B)(iv)(II)), before the date of a supplemental examination request under subsection (a) to consider, reconsider, or correct information forming the basis for the allegation.

(B) Patent enforcement actions.— In an action brought under section 337(a) of the Tariff Act of 1930 (19 U.S.C. 1337(a)), or section 281 of this title, paragraph (1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or corrected pursuant to a supplemental examination request under subsection (a), unless the supplemental examination, and any reexamination ordered pursuant to the request, are concluded before the date on which the action is brought.

(d) Fees and Regulations.—

(1) Fees.— The Director shall, by regulation, establish fees for the submission of a request for supplemental examination of a patent, and to consider each item of information submitted in the request. If reexamination is ordered under subsection (b), fees established and applicable to ex parte reexamination proceedings under chapter 30 shall be paid, in addition to fees applicable to supplemental examination.

(2) Regulations.— The Director shall issue regulations governing the form, content, and other requirements of requests for supplemental examination, and establishing procedures for reviewing information submitted in such requests.

(e) Fraud.— If the Director becomes aware, during the course of a supplemental examination or reexamination proceeding ordered under this section, that a material fraud on the Office may have been committed in connection with the patent that is the subject of the supplemental examination, then in addition to any other actions the Director is authorized to take, including the cancellation of any claims found to be invalid under section 307 as a result of a reexamination ordered under this section, the Director shall also refer the matter to the Attorney General for such further action as the Attorney General may deem appropriate. Any such referral shall be treated as confidential, shall not be included in the file of the patent, and shall not be disclosed to the public unless the United States charges a person with a criminal offense in connection with such referral.

(f) Rule of Construction.— Nothing in this section shall be construed—

(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1001(a) of title 18, the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition);

(2) to limit the authority of the Director to investigate issues of possible misconduct and impose sanctions for misconduct in connection with matters or proceedings before the Office; or

(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by representatives practicing before the Office.

37 CFR 1.601 Filing of papers in supplemental examination.

(a) A request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest in the patent.

(b) Any party other than the patent owner (*i.e.*, any third party) is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding.

(c) A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent.

37 CFR 1.605 Items of information.

(a) Each request for supplemental examination may include no more than twelve items of information believed to be relevant to the patent. More than one request for supplemental examination of the same patent may be filed at any time during the period of enforceability of the patent.

(b) An item of information includes a document submitted as part of the request that contains information, believed to be relevant to the patent, that the patent owner requests the Office to consider, reconsider, or correct. If the information to be considered, reconsidered, or corrected is not, at least in part, contained within or based on any document submitted as part of the request, the discussion within the body of the request relative to the information will be considered as an item of information.

(c) An item of information must be in writing in accordance with § 1.2. To be considered, any audio or video recording must be submitted in the form of a written transcript.

(d) If one item of information is combined in the request with one or more additional items of information, each item of information of the combination may be separately counted. Exceptions include the combination of a non-English language document and its translation, and the combination of a document that is over 50 pages in length and its summary pursuant to §1.610(b)(8).

37 CFR 1.610 Content of request for supplemental examination.

(a) A request for supplemental examination must be accompanied by the fee for filing a request for supplemental examination as set forth in § 1.20(k)(1), the fee for reexamination ordered as a result of a supplemental examination proceeding as set forth in § 1.20(k)(2), and any applicable document size fees as set forth in § 1.20(k)(3).

(b) A request for supplemental examination must include:

(1) An identification of the number of the patent for which supplemental examination is requested.

(2) A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of § 1.98(b).

(3) A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding.

(4) An identification of each claim of the patent for which supplemental examination is requested.

(5) A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested.

(6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent.

(7) A copy of each item of information listed in paragraph (b)(2) of this section, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information. The patent owner is not required to submit copies of items of information that form part of the discussion within the body of the request as specified in § 1.605(b), or copies of U.S. patents and U.S. patent application publications.

(8) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.

(9) An identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with § 3.73(c) establishing the entirety of the ownership in the patent requested to be examined.

(c) The request may also include:

(1) A cover sheet itemizing each component submitted as part of the request;

(2) A table of contents for the request;

(3) An explanation of how the claims patentably distinguish over the items of information; and

(4) An explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

(d) The filing date of a request for supplemental examination will not be granted if the request is not in compliance with §§ 1.605, 1.615, and this section, subject to the discretion of the Office. If the Office determines that the request, as originally submitted, is not entitled to a filing date, the patent owner will be so notified and will be given an opportunity to complete the request within a specified time. If the patent owner does not timely comply with the notice, the request for supplemental examination will not be granted a filing date and the fee for reexamination as set forth in § 1.20(k)(2) will be refunded. If the patent owner timely files a corrected request in response to the notice that properly addresses all of the defects set forth in the notice and that otherwise complies with all of the requirements of §§ 1.605, 1.615, and this section, the filing date of the supplemental examination request will be the receipt date of the corrected request.

37 CFR 1.615 Format of papers filed in a supplemental examination proceeding.

(a) All papers submitted in a supplemental examination proceeding must be formatted in accordance with § 1.52.

(b) Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents, and, if a court document, to the document submitted in court, and must not otherwise be reduced in size or modified, particularly in terms of font type, font size, line spacing, and margins. Patents, patent application publications, and third-party-generated affidavits or declarations must not be reduced in size or otherwise modified in the manner described in this paragraph.

37 CFR 1.620 Conduct of supplemental examination proceeding.

(a) Within three months after the filing date of a request for supplemental examination, the Office will determine whether a substantial new question of patentability affecting any claim of the patent is raised by any of the items of information presented in the request. The determination will generally be limited to a review of the item(s) of information identified in the request as applied to the identified claim(s) of the patent. The determination will be based on the claims in effect at the time of the determination and will become a part of the official record of the patent.

(b) The Office may hold in abeyance action on any petition or other paper filed in a supplemental examination proceeding until after the proceeding is concluded by the electronic issuance of the supplemental examination certificate as set forth in § 1.625.

(c) If an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently entered, it will be expunged.

(d) The patent owner must, as soon as possible upon the discovery of any other prior or concurrent post-patent Office proceeding involving the patent for which the current supplemental examination is requested, file a paper limited to notifying the Office of the post-patent Office proceeding, if such notice has not been previously provided with the request. The notice shall be limited to an identification of the post-patent Office proceeding, including the type of proceeding, the identifying number of any such proceeding (*e.g.*, a control number or reissue application number), and the filing date of any such proceeding, without any discussion of the issues of the current supplemental examination proceeding or of the identified post-patent Office proceeding(s).

(e) Interviews are prohibited in a supplemental examination proceeding.

(f) No amendment may be filed in a supplemental examination proceeding.

(g) If the Office becomes aware, during the course of supplemental examination or of any reexamination ordered under 35 U.S.C. 257 as a result of the supplemental

examination proceeding, that a material fraud on the Office may have been committed in connection with the patent requested to be examined, the supplemental examination proceeding or any reexamination proceeding ordered under 35 U.S.C. 257 will continue, and the matter will be referred to the U.S. Attorney General in accordance with 35 U.S.C. 257(e).

37 CFR 1.625 Conclusion of supplemental examination; publication of supplemental examination certificate; procedure after conclusion.

(a) A supplemental examination proceeding will conclude with the electronic issuance of a supplemental examination certificate. The supplemental examination certificate will indicate the result of the determination whether any of the items of information presented in the request raised a substantial new question of patentability.

(b) If the supplemental examination certificate states that a substantial new question of patentability is raised by one or more items of information in the request, *ex parte* reexamination of the patent will be ordered under 35 U.S.C. 257. Upon the conclusion of the *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published. The electronically issued supplemental examination certificate will remain as part of the public record of the patent.

(c) If the supplemental examination certificate indicates that no substantial new question of patentability is raised by any of the items of information in the request, and *ex parte* reexamination is not ordered under 35 U.S.C. 257, the electronically issued supplemental examination certificate will be published in due course. The fee for reexamination ordered as a result of supplemental examination, as set forth in § 1.20(k)(2), will be refunded in accordance with § 1.26(c).

(d) Any *ex parte* reexamination ordered under 35 U.S.C. 257 will be conducted in accordance with §§ 1.530 through 1.570, which govern *ex parte* reexamination, except that:

(1) The patent owner will not have the right to file a statement pursuant to § 1.530, and the order will not set a time period within which to file such a statement;

(2) Reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in § 1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding § 1.552(a);

(3) Issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved, notwithstanding § 1.552(c); and

(4) Information material to patentability will be defined by § 1.56(b), notwithstanding § 1.555(b).

REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM

Address to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**Attorney Docket No.:****Date:**

1. This is a request for supplemental examination pursuant to 37 CFR 1.610 of patent number _____ issued _____. 37 CFR 1.610(b)(1).
2. Supplemental examination of claim(s) _____ is requested. 37 CFR 1.610(b)(4).
3. a. The name(s) of the patent owner(s) (**not** the patent practitioner(s)) is (are):

- b. A submission by the patent owner(s) in compliance with 37 CFR 3.73(c), which establishes that the patent owner(s) has (have) the entirety of the ownership in the patent for which supplemental examination is requested, is included. 37 CFR 1.610(b)(9).
4. a. A check in the amount of \$_____ is enclosed to cover the fee for processing and treating a request for supplemental examination, the fee for reexamination ordered under 35 USC 257, and the fee for processing and treating each non-patent document over 20 sheets in length (37 CFR 1.20(k)(1 - 3));
- b. The Director is hereby authorized to charge all applicable fees as set forth in 37 CFR 1.20(k)(1 - 3) to Deposit Account No. _____; or
- c. Payment by credit card. Form PTO-2038 is attached. 37 CFR 1.610(a).
5. Any refund should be made by check or credit to Deposit Account No. _____. 37 CFR 1.26(c). If payment is made by credit card, refund must be to the credit card account.
6. A copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent are included. 37 CFR 1.610(b)(6).
7. CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
 Landscape Table on CD
8. Nucleotide and/or Amino Acid Sequence Submission
If applicable, items a. – c. are required.
- a. Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. CD-ROM (2 copies) or CD-R (2 copies); or
- ii. paper
- c. Statements verifying the identity of above copies
9. A list of no more than 12 items of information submitted as part of this request is provided in Part B of this form. Where appropriate, the list must meet the requirements of 37 CFR 1.98(b). 37 CFR 1.605(a), 1.610(b)(2).

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

10. A legible copy of each item of information listed in Part B of this form, and an English language translation of all necessary and pertinent parts of each non-English language item of information are included.

Copies of items of information that form part of the discussion within the body of the request (see 37 CFR 1.605(b)), and copies of U.S. patents and patent application publications, are not required. 37 CFR 1.610(b)(7).

11. A summary of the relevant portions of each non-patent document that is over 50 pages in length (other than the request) is included. The summary includes the required citations to the particular pages containing the relevant portions. 37 CFR 1.610(b)(8).

12. A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested, is included. 37 CFR 1.610(b)(5).

13. The below list includes all prior or concurrent post-patent Office proceedings (*ex parte* or *inter partes* reexamination, reissue, supplemental examination, post grant review, or *inter partes* review) involving the patent for which supplemental examination is being requested. 37 CFR 1.610(b)(3). An identifying number may be, e.g., a control no. or reissue application no. Any prior or concurrent post-patent Office proceedings not listed below are listed on a separate paper accompanying the request.

Type of Proceeding	Identifying Number	Filing Date
--------------------	--------------------	-------------

_____	_____	_____
_____	_____	_____
_____	_____	_____

See accompanying paper for a list of additional prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is requested. The paper should be a separate sheet titled "List of Prior or Concurrent Post-Patent Office Proceedings" and must provide the type, identifying number, and filing date of the post-patent Office proceeding.

14. Correspondence Address: Please recognize, or change, the correspondence address for the file of the patent for which supplemental examination is requested **and** for the supplemental examination proceeding to be:

The address associated with Customer Number: **OR**

Firm or Individual Name

Address

City	State	Zip
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Country

Telephone	Email
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15. **WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

Authorized Signature

Date

Typed/Printed Name

Registration No.

(Also referred to as FORM PTO-XXXX)

REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM PART B – LIST OF ITEMS OF INFORMATION – Page 1

Patent number for which supplemental examination is requested _____ Issue Date _____

All items of information (no more than 12) submitted herewith as part of this request for supplemental examination of the above-identified patent are included in the following list:

U. S. PATENT DOCUMENTS

Cite No. ¹	Document Number	Publication Date MM-DD- YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	Number-Kind Code ² (if known)			
	US-			
	US-			
	US-			
	US-			
	US-			
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FOREIGN PATENT DOCUMENTS

Cite No. ¹	Foreign Patent Document	Publication Date MM-DD- YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ²
	Country Code ³ -Number ⁴ - Kind Code ⁵ (if known)				

¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.