



## America Invents Act

### Supplemental Examination

---

The America Invents Act (AIA) has created a new proceeding to conduct a supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent. The proceeding may strengthen the patent, and has the advantage of eliminating or reducing the threat of inequitable conduct allegations, with respect to such information. However, a supplemental examination proceeding may be followed by a reexamination proceeding, and cancellation or amendment of some or all claims is a distinct possibility. In contrast to *ex parte* reexamination performed without a supplemental examination, in which patents are reexamined to address narrow issues of patentability based only on patents and printed publications, supplemental examination allows consideration by the U.S. Patent and Trademark Office (USPTO) of broader issues of patentability based on broader categories of information.

#### **Scope:**

Any information may be cited to the USPTO with the request for supplemental information. The information can relate to many broad issues of patentability such as teachings of prior art, obviousness, public uses, offers for sale, actual sales, written description, enablement, patent eligibility, and inventorship. The information can include patents and printed publications, as well as letters, receipts, affidavits and declarations, and transcripts of recordings, or other written information.

Only the owner of the entire right, title, and interest may request supplemental examination. A request must include fees for both supplemental examination and reexamination, but the reexamination fee is refunded if it is not ordered. Each request is limited to 12 items of information, and the patent owner must explain the relevance of each item with respect to each claim for which supplemental examination is requested. There is no limit on the number of requests that can be filed during the period of enforceability of the patent.

#### **Timing and Threshold:**

Within three months of filing of a request, the USPTO must determine whether the information presented in the request raises a substantial new question of patentability (SNQ) affecting any claim in the patent. The USPTO will issue a supplemental examination certificate indicating whether or not the information raises an SNQ, thus concluding the supplemental examination proceeding.

**Conduct:**

If the USPTO determines that at least one SNQ is raised, the USPTO will order an *ex parte* reexamination of the patent. The resulting *ex parte* reexamination generally follows the established procedures, except that the patent owner does not have a right to file a statement in response to the determination of the SNQ, and the reexamination is conducted based on the information provided, which is not limited to patents and publications. Upon the conclusion of the *ex parte* reexamination, the USPTO will issue a reexamination certificate indicating the status of the reexamined claims.

If, during the course of a supplemental examination or reexamination proceeding, the director becomes aware that a material fraud on the USPTO may have been committed in connection with the patent, the director may refer the matter to the U.S. Attorney General.

**Effect:**

The effect of a supplemental examination, or any *ex parte* reexamination resulting therefrom, is that, with exceptions for delays in filing, a patent shall not be held unenforceable on the basis of conduct relating to the information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent.

In order to receive the benefit of enforceability described above, time limits must be adhered to. If a patent owner is aware of any information that should be considered, a patent owner must conclude supplemental examination and any resulting reexamination before bringing any enforcement action involving the patent. A patent owner must file a request for supplemental examination to consider information before a civil action or similar notice is brought against a patent owner where such information forms the basis for an allegation.