

America Invents Act Supplemental Examination

What is Supplemental Examination?

A supplemental examination proceeding permits a patent owner to request additional examination of a patent by the United States Patent and Trademark Office ("Office") so that the Office may consider, reconsider, or correct information believed to be relevant to the patent.

Who Can Request Supplemental Examination and When Can It Be Requested?

Only the owner of the patent subject to supplemental examination may request supplemental examination of that patent. Effective September 16, 2012, supplemental examination may be requested at any time during the period of enforceability of any patent owned by the patent owner, regardless of filing or issue date.

Who Participates in a Supplemental Examination Proceeding?

The Office's Central Reexamination Unit ("CRU") will be responsible for administering supplemental examinations, and the proceedings will unfold similarly to *ex parte* reexaminations. The patent owner is allowed to participate, but third parties are entirely excluded.

What Types of "Information" Can Form the Basis of Supplemental Examination?

Requests for supplemental examination proceedings may be based on *any* information believed to be relevant to the patent, and need not be limited to the consideration of prior art patents and printed publications. For example, any potential ground for unpatentability, such as issues under 35 U.S.C. § 101, issues under 35 U.S.C. § 112, or on-sale bar issues under 35 U.S.C. § 102(b), may form the basis for a supplemental examination request.

Why Should Patent Owners Consider Requesting Supplemental Examination?

Congress created supplemental examination to address concerns that charges of inequitable conduct had become far too common in district court patent litigation. If certain conditions are met, a supplemental examination may be used by a patent owner to establish a "safe harbor" against potential charges of inequitable conduct based on conduct during prior examination relating to information later considered by the Office in the supplemental examination. No such safe harbor is established, by statute, in any other post-issuance proceeding. Creative patent owners and patent practitioners will undoubtedly come up with other justifications for pursuing supplemental examination, as the proceeding need not be limited to addressing potential inequitable conduct issues.

The availability of supplemental examination proceedings will necessitate new strategies and considerations for patent owners and accused infringers alike. For more information, please contact:

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