



Patent Reform 2011:

Supplemental Examination

Purpose:

- A new procedure available only to patent owners. The issues considered in Supplemental Examination are very broad, especially when compared to ex parte reexamination. It allows a patent owner to remedy problems in order to attempt to eliminate the possibility of an inequitable conduct defense in patent litigation.

Scope:

- A patent owner may request supplemental examination of a patent to consider, reconsider, or correct any “information believed to be relevant to the patent.”
- There are no limitations on the nature of the “information” being considered or corrected. For example, public use or offers for sale, written description or enablement issues, accuracy of prior declarations, statements regarding inventorship, and printed publications and patents, can be raised and possible inequitable conduct cured in a Supplemental Examination. There is no provision for discovery by the PTO.

Timing and Threshold:

- Within three months of filing the Supplemental Examination request, the Director must conduct and conclude the supplemental examination and issue a certificate indicating whether the information submitted in the request raises a substantial new question of patentability (SNQ).

Conduct:

- If the information raises a SNQ the Director will order a reexamination of each SNQ in a proceeding much like an ex parte reexamination proceeding. The proceeding will likely be conducted in the Central Reexamination Unit (CRU). Presumably the patentee will have the opportunity to amend or cancel claims during the proceeding, much as in regular reexamination. Significantly amended claims may be subject to intervening rights by an alleged infringer.

Effect:

- A patent in subsequent litigation will not be found unenforceable on the basis of conduct relating to information or prior art considered, reconsidered or corrected during a supplemental examination.

- This defense to a claim of inequitable conduct shall not apply where allegations are pled with particularity in certain civil actions before the filing date of a supplemental examination request. Nor will the defense apply in certain other actions, such as an ITC action, unless the supplemental examination and any reexamination ordered by the Director are concluded before the date on which such actions are brought.

Possible Referral for Fraud:

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

Effective Date:

- This procedure becomes available 1 year from the date of enactment and will apply to any patent issued before, on, or after the effective date.