

REPORT

**USPTO ISSUES FINAL RULES FOR SUPPLEMENTAL
PATENT EXAMINATION AND RAISES THE FEE
FOR *EX PARTE* REEXAMINATION**

August 17, 2012

On August 14, the U.S. Patent and Trademark Office (USPTO) issued its final rules (1) to implement the supplemental examination provisions of the America Invents Act (AIA) and (2) to raise the fee for *ex parte* reexamination.¹ The rules will go into effect on September 16, 2012. Supplemental examination will be available beginning that day for all enforceable U.S. patents.²

I. Supplemental Examination**A. Introduction**

The AIA added 35 U.S.C. §257 to permit a patent owner to request supplemental

examination of a patent in order to have information considered, reconsidered, or corrected before the USPTO. Such information is not limited to patents or printed publications or even prior art information. Rather, the information may include any information the patent owner believes to be relevant to the patent, and which was not considered, was inadequately considered, or was incorrect during prosecution of the patent.

As of September 16, a patent owner may obtain supplemental examination by filing a request that presents information for consideration, reconsideration, or correction. In response to the request, the USPTO must determine, within three months, whether a substantial new question of patentability (SNQ) affecting any claim of the patent is raised by that information. The USPTO must then issue a supplemental examination certificate stating the result of its determination.

By rule, the USPTO will generally limit the determination of whether information raises an SNQ to only those claims identified by the patent owner in the request.³ The SNQ determination

¹ We previously reported on supplemental examination in our January 30, 2012 Special Report, entitled "USPTO Proposes Rules For Supplemental Patent Examination and Increased Fee for *Ex Parte* Reexamination," and in Section III.E. of our November 22, 2011 Special Report entitled "Updated Analysis of America Invents Act (AIA)." Our Special Reports are available in the News and Events section of our website (www.oliff.com).

² A patent is enforceable up to six years after it expires (whether expiration results from the full statutory term being exhausted or from failure to pay a maintenance fee).

³ Although the USPTO will generally not review non-identified claims, it is not precluded from doing so.

August 17, 2012

will generally not be made by the same examiner who examined the original patent application, because supplemental examination proceedings will be handled by the USPTO's Central Reexamination Unit, which is comprised of examiners that specialize in reexamination proceedings. If the USPTO determines that an SNQ has been raised, it will order *ex parte* reexamination of the patent directed to all issues (not just prior art issues) addressed in the request that raise an SNQ. If the USPTO determines that an SNQ has not been raised, supplemental examination is concluded. Third party participation is prohibited in both the supplemental examination stage and any resulting *ex parte* reexamination.

Following supplemental examination, with certain exceptions, a court may not hold a patent "unenforceable on the basis of conduct relating to information ... that was considered, reconsidered or corrected during a supplemental examination of a patent." Thus, a court should dismiss any charge of inequitable conduct that is based on conduct relating to such information. However, supplemental examination will not provide protection against the court holding a patent unenforceable if (1) an allegation of unenforceability is particularly pled in a civil action, or set forth with particularity in an ANDA paragraph iv notice received by the patent owner, before the filing date of a request for supplemental examination directed to information forming the basis of such allegation, or (2) an accused infringer raises the defense of unenforceability based on information addressed in a supplemental examination in an ITC or district court action filed before the supplemental examination, and any resulting *ex parte* reexamination if ordered, are concluded. Thus, a patent owner is only protected against a finding of unenforceability if supplemental examination (including *ex parte* reexamination if ordered) is concluded before unenforceability is raised as a

defense by an accused infringer in an action brought by the patent owner. However, a patent owner need only request supplemental examination before an opposing party particularly pleads an allegation of unenforceability in an action (e.g., a declaratory judgment action) brought by that opposing party or serves an ANDA paragraph iv notice containing such allegation.

Supplemental examination commences with the receipt of the request for supplemental examination and concludes with the issuance of the supplemental examination certificate. Thus, as confirmed in the USPTO rulemaking commentary, any information first submitted and considered during *ex parte* reexamination resulting from supplemental examination will not have been considered "during a supplemental examination" and thus will likely not receive the protection accorded by supplemental examination.

Supplemental examination cannot be used to correct a material fraud that occurred during original prosecution. During supplemental examination (including any *ex parte* reexamination ordered pursuant to supplemental examination), if the USPTO becomes aware of a material fraud, the USPTO will refer the matter to the U.S. Attorney General for further appropriate action (e.g., criminal charges against the patent owner and/or disciplinary charges against a patent practitioner). Thus, a patentee cannot intentionally withhold material information during prosecution to obtain the patent and then use supplemental examination to have the material information considered just prior to enforcement of the patent.

The USPTO rules set forth many requirements for and limitations on supplemental examination. We discuss some particularly important requirements and limitations below.

August 17, 2012

B. Each Supplemental Examination Is Limited to Twelve Items of Information

Each supplemental examination proceeding will be limited to USPTO consideration of no more than twelve items of information. As previously discussed in our January 30, 2012 Special Report, the USPTO originally proposed a ten-item-of-information limit. Thus, the USPTO slightly adjusted its original proposal upward to a twelve-item-of-information limit. The USPTO will permit multiple supplemental examination proceedings (with the appurtenant submissions and fees) to be simultaneously or consecutively instituted for a patent if the patent owner wants to obtain consideration, reconsideration, or correction of more than twelve items of information in the aggregate.

For the purpose of this twelve-item limit, the USPTO will count as an item of information: (1) a single document submitted as part of the request that contains information to be considered, reconsidered, or corrected, or (2) information discussed within the body of the request that is to be considered, reconsidered, or corrected if that information is not at least in part contained within or based on a separate document.

As to documents, it does not matter if a single item of information raises multiple issues of patentability. For instance, a single prior art reference may raise issues of anticipation and obviousness without being counted as two items of information. However, multiple documents directed to a single issue are treated as separate items of information. For example, a document and an opponent's email about it will count as two items. As another example, an invoice of a sale and a brochure describing the thing sold will count as two items. As a further example, a combination of a new reference with two references of record will count as three items. That is, items to be considered alone or in

combination will each count as an item of information, even if some of them were already of record during original prosecution.

As to information discussed within the body of the request, information solely contained in the request for supplemental examination will be counted as an item of information. For instance, a discussion of patent subject matter eligibility under §101 in the request that does not rely on any supporting documentation will be treated as an item of information.

However, the counting of items of information can be even more complex. For instance, the USPTO states that it will count a single declaration or affidavit that contains two or more "distinct" items of information as being two or more items of information. This determination by the USPTO is likely to be subjective in many instances. Thus, due to complexity, the number of items of information will need to be determined carefully on a case-by-case basis.

There is no limit on the types of information that can be submitted in connection with supplemental examination. However, all information would have to be submitted in written form, either in the request and/or as a supporting document. Thus, non-written information such as audio or video recordings would have to be converted into written form. Relevant documents include but are not limited to patent and non-patent publications, written communications, affidavits, declarations, and transcripts (including transcripts of audio and video information).

Because information first submitted and considered during *ex parte* reexamination will not have been considered during supplemental examination, a patent owner interested in obtaining unenforceability protection for a thirteenth item of information could not circumvent the twelve-item-of-information limit by waiting until reexamination to submit that item

August 17, 2012

of information. However, additional non-material items of information can be submitted during reexamination to confirm non-materiality. Any material information uncovered during reexamination would have to be submitted to the USPTO under the Rule 56 duty of disclosure.

C. Supplemental Examination Fees

Despite receiving a significant amount of criticism from the public on its original proposal, the USPTO will charge very high fees for supplemental examination. Specifically, the USPTO will charge \$5,140 for conducting supplemental examination and, if *ex parte* reexamination is ordered as a result of the supplemental examination, an additional \$16,120 for conducting the *ex parte* reexamination.

Additionally, the USPTO will charge document size fees for lengthy non-patent documents submitted in supplemental examination. These fees do not apply to patent documents submitted in supplemental examination or to the request for supplemental examination itself. For non-patent documents, the USPTO will charge \$170 for every such document (other than the request) that is over 20 pages long. In addition to that fee, for non-patent documents over 50 pages long, the USPTO will charge an additional incremental fee of \$280, per document, for each additional 50 sheets (or fraction thereof) over the first 50 pages. Redaction is encouraged to reduce the number of pages in a document unless the redaction would remove context such that the examiner would not be provided with a full indication of the relevance of the information. However, the protection of supplemental examination would not apply to information redacted out of a submitted document.

Supplemental examination fees are not discounted for small and micro entities. In a separate rulemaking, the USPTO may adjust the supplemental examination fees when adjusting other patent fees, and may provide 50% and 75%

discounts to small and micro entities, respectively. However, if the USPTO follows through on its proposed patent fee adjustment, it would increase, rather than decrease, the supplemental examination fees for large entities. We will keep you informed of any future patent fee adjustments made by the USPTO.

The USPTO will require the patent owner to submit the supplemental examination fee and the *ex parte* reexamination fee, totaling \$21,260, plus any applicable document size fees, with the request for supplemental examination. If the USPTO does not order *ex parte* reexamination, the \$16,120 *ex parte* reexamination fee will be refunded. The supplemental examination fee and document size fees will not be refunded.

D. Content Requirements for a Request for Supplemental Examination

As compared to its original proposal, the USPTO simplified the content requirements for the request for supplemental examination. According to the final rules, a request for supplemental examination will require:

- an identification of the number of the patent for which supplemental examination is requested;
- a list of the items of information that are requested to be considered, reconsidered, and corrected (the list must include, for any item of information that is solely contained within the request itself, identification of the pages of the request on which the item is discussed and a brief description of the item of information, such as "discussion in the request of why the claims are patentable under 35 U.S.C. 101, pages 7-11");

August 17, 2012

- a list identifying any other prior or concurrent post-patent USPTO proceedings involving the patent for which supplemental examination is being requested;⁴
- an identification of each claim of the patent for which supplemental examination is being requested;
- 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 being requested;
- a copy of the patent for which supplemental examination is being requested and a copy of any disclaimer or certificate issued for the patent (including any certificate of correction, certificate of extension, supplemental examination certificate, post-grant review certificate, *inter partes* review certificate, *ex parte* reexamination certificate, and/or *inter partes* reexamination certificate, issued for the patent);
- a copy of each documentary item of information (except for U.S. patents and patent application publications) accompanied by an English-language translation of all of the necessary and pertinent parts of any non-English-language document;⁵
- a summary of the relevant portions of any submitted document, other than the request, over 50 pages in length (including citations to the particular pages containing the relevant portions); and
- a showing of ownership by the patent owner (or owners) establishing the entirety of the ownership interest in the patent to be examined.⁶

Although not required, the request may also include:

- a cover sheet itemizing each component submitted as part of the request;
- a table of contents for the request;

⁵ In the rulemaking, the USPTO does not provide any significant guidance on the meaning of "necessary and pertinent" with respect to the parts of a non-English-language document for which an English-language translation must be submitted. However, courts are likely not to treat un-translated information as having been addressed in a supplemental examination.

⁶ Upon petition, the USPTO may, under rare circumstances, permit less than all of the owners to file a request for supplemental examination, such as when a joint owner is deceased or legally incapacitated or the joint owner refuses to join or cannot be found or reached after diligent effort. If a joint owner refuses to sign or cannot be found or reached after diligent effort, the remaining owners must provide proof of pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable harm, and the last known address of all the joint owners.

⁴ After the request is filed, the patent owner must, as soon as possible upon the discovery of any undisclosed prior or concurrent post-patent USPTO proceeding involving the patent for which supplemental examination is requested, file a paper notifying the USPTO of the proceeding. The paper cannot contain any discussion of issues.

August 17, 2012

- an explanation of how the claims patentably distinguish over the items of information; and
- an explanation of why each item of information submitted with the request does or does not raise an SNQ.

If a request for supplemental examination does not comply with all requirements, the USPTO will not grant a filing date for the request. A patent owner will be given notice and an opportunity to correct any defect in the request. However, the filing date of the supplemental examination request will be the date of receipt of the corrected request, not the filing date of the original request. If a defective request is not corrected, supplemental examination will not be conducted and the statutory protections will not apply.⁷

E. Amendments and Interviews

The USPTO will not permit amendments, including amendments to narrow claims, cancel claims, or correct inventorship, during the supplemental examination stage, even if submitted with the request for supplemental examination. Amendments to narrow claims, cancel claims, and to correct inventorship can be made during *ex parte* reexamination if ordered. Broadening claim amendments are not permitted during supplemental examination or *ex parte* reexamination. Examiner interviews will not be permitted during supplemental examination. Instead, the only opportunity for an examiner

interview will be during *ex parte* reexamination if ordered.

The USPTO will not permit a patent owner to cancel claims in the request for supplemental examination even to avoid reexamination being ordered based on information raising an SNQ with respect to a claim that is no longer desired. However, the patent owner will be permitted not to identify such a claim in the request, in order to avoid reexamination being ordered. However, as discussed below, the effect of such a strategy on the protections of supplemental examination may be subject to future judicial interpretation. Alternatively, the patent owner could file a disclaimer of such a claim before requesting supplemental examination (and provide such disclaimer with the request for supplemental examination) to prevent the claims from being in effect during supplemental examination. The USPTO's SNQ determination is limited to only those claims in effect at the time of the determination. A disclaimer of claimed subject matter is a relatively uncomplicated document to prepare and file. Its effect is immediate upon recordation by the USPTO. Accordingly, a patent owner could effectively "cancel" claims by disclaimer before requesting supplemental examination to reduce the risk of an unnecessary *ex parte* reexamination being ordered.

F. Analysis

The USPTO's clear intention is to limit patent owners' use of supplemental examination by making it an expensive proceeding. A patent owner will be required to pay substantial government fees. Additionally, although the content requirements for the request for supplemental examination are less burdensome than those originally proposed by the USPTO, significant attorney time will be required to prepare and file an effective request for supplemental examination, especially where the information being submitted is at least arguably

⁷ The USPTO is establishing a procedure in which a request will not be made available to the public until it is accepted for filing date purposes. Accordingly, a defective request would not be made available to the public until it is corrected, thus reducing the likelihood of a third party "racing" to create one of the exceptions discussed above.

August 17, 2012

material to patentability.⁸ At least because of expense, as well as because of risks of "material fraud" allegations, supplemental examination will not be a viable substitute for submitting Information Disclosure Statements during prosecution of a patent. Thus, Information Disclosure Statements should be filed during prosecution of a patent application, when possible, to have all known material (or possibly material) information considered by the USPTO.

As a significant departure from its original proposal, the USPTO will not require the request for supplemental examination to explicitly identify and explain issues of patentability raised by the information presented for supplemental examination. Instead, the USPTO will require that the request for supplemental examination provide a separate, detailed explanation of the relevance and manner of applying each item of information to each claim for which supplemental examination is being requested. As compared to its original proposal, this will provide patent owners with more flexibility to determine how information should be presented and discussed in the request for supplemental examination. Patent owners should consider how to best present and discuss information in the request to limit potential estoppels that could affect the value of the patent.

⁸ The USPTO now estimates that the average cost (in attorney time) for preparing and filing a request for supplemental examination will be \$19,000. Although the USPTO has simplified the content requirements for the request for supplemental examination, the USPTO doubled its estimate for average attorney cost to match its currently estimated average cost for requesting *ex parte* reexamination. It is unclear whether this USPTO estimate will prove to be accurate. Certainly, in complex cases, the actual attorney costs could be significantly higher.

The limit on items of information for supplemental examination will prevent a patent owner from submitting information involving multiple related documents for consideration without compounding the costs associated with supplemental examination, by requiring multiple proceedings. Further, a patent owner cannot simply request that a new reference be considered alone or in combination with any and all art of record. Instead, the patent owner will have to provide a detailed explanation of the relevance and manner of applying the new reference alone, or in combination with any specific reference of record, to each claim for which supplemental examination is being requested. Thus, depending on the number of references of record, it could require multiple supplemental examination proceedings to have all potential combinations considered. Moreover, it may be economically infeasible to have all such combinations considered.

The USPTO's approach to conducting supplemental examination on the basis of only those claims identified in the request is likely to at least initially complicate, rather than simplify, inequitable conduct litigation in some cases. The USPTO will determine whether an SNQ is raised by information presented in the request by generally limiting its review to those claims identified in the request. However, this approach is contrary to the plain language of §257(a), which states that the USPTO "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" (emphasis added). According to its plain meaning, §257(a) does not provide the USPTO with any discretion to limit supplemental examination to only those claims identified by the patent owner.

Further, according to the plain language of §257(c)(1), a court should dismiss any charge of

August 17, 2012

inequitable conduct that is based on conduct relating to "information [that] was considered, reconsidered, or corrected during supplemental examination of the patent" (emphasis added). The statutory protection against unenforceability is not limited by which claims are identified for supplemental examination. Accordingly, it is unclear how the courts will interpret the scope of unenforceability protection conferred by supplemental examination when less than all asserted patent claims are identified by the patent owner for supplemental examination.

It is possible that some patent owners will initially attempt to "game" supplemental examination to receive an unwarranted litigation advantage by requesting supplemental examination of information with respect to some patent claims, but not all claims to which the information may be relevant. In a later litigation, the patent owner could seek broad unenforceability protection based on that information being subjected to supplemental examination even if not considered with respect to all claims. If a court accords §257(c)(1) its plain meaning, the patent owner could receive unenforceability protection for all claims asserted in the litigation, including claims not identified and analyzed during supplemental examination. Therefore, at least initially in some cases, the USPTO's claim-identification approach to supplemental examination is likely to complicate, rather than simplify, inequitable conduct litigation. The USPTO in its rulemaking commentary simply dismissed such concerns as not being within its purview but "within the purview of the courts."

For patent owners, requesting supplemental examination will likely be preferable to traditional *ex parte* reexamination (especially if the twelve-item-of-information limit is not an issue), because of the statutory protections against unenforceability unique to supplemental examination and the possibility of having

non-prior art issues considered. Additionally, the requirements for requesting supplemental examination appear no more burdensome than the requirements for requesting *ex parte* reexamination. Similar to a requirement for requesting traditional *ex parte* reexamination, a request for supplemental examination will necessitate that the patent owner provide a detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is being requested, and may include an explanation as to why reexamination should not be ordered. As in requesting traditional *ex parte* reexamination, such explanations can be risky, and could create estoppels affecting the scope and validity of patent claims.

Additionally, regardless of whether *ex parte* reexamination is ordered through supplemental examination or directly as a result of an *ex parte* reexamination request, the *ex parte* reexamination proceeding has several potential drawbacks. *Ex parte* reexamination will immediately limit the enforceability of the patent and could result in claims being narrowed or canceled, and may create estoppels and intervening rights. *Ex parte* reexamination is conducted without the presumption of validity or the clear-and-convincing evidentiary standard applicable in court and ITC proceedings. Instead, patentability will be determined under the lower preponderance-of-the-evidence standard, and claims will be accorded their broadest reasonable interpretation consistent with the specification.

Further, *ex parte* reexamination only provides limited opportunities for a patent owner to present amendments, arguments, and evidence in favor of patentability. In *ex parte* reexamination, the USPTO sets shortened statutory periods for replying to Office Actions that are as short as 30 days and no longer than two months. Extensions of time are not granted as a matter of right. Additionally, a patent owner

August 17, 2012

is only guaranteed one opportunity, *i.e.*, in response to a first non-final Office Action, to freely amend rejected claims, add new claims, or present evidence of patentability. It is likely that any next Office Action will be made final, and at that point further amendments and evidence will only be entered as a matter of right if they merely cancel claims, adopt a suggestion of the examiner, remove issues for appeal, or in some other way only require a cursory review by the examiner. In *ex parte* reexamination, a patent owner cannot submit a Request for Continued Examination (RCE) or file a continuing application to obtain further prosecution.

A patent owner cannot withdraw from an *ex parte* reexamination proceeding once it has begun. If the patent owner fails to respond to an Office Action, the USPTO will issue a reexamination certificate adopting the positions set forth in the last Office Action.

In view of the considerable cost and potential drawbacks, supplemental examination is likely only a viable option for a patent that a patent owner reasonably foresees will be subject to litigation involving well-defined allegations of inequitable conduct. However, less risky and less costly mechanisms, such as reissue, should be considered to have the information considered, reconsidered, or corrected after a patent has been granted. A reissue application can be filed when a patent, through error, is wholly or partly inoperative or invalid by reason of the inventor claiming less or more than the inventor had the right to claim. While at least one error must be identified, not all errors need be identified. Thus, the identified error need not relate to information that one wants to have considered of record. For example, an inventor's failure to seek narrower dependent claims to which the inventor was entitled is an error that can form a basis for reissue. In reissue, the same information that could be presented for supplemental examination

can be disclosed to and considered by the USPTO during examination of the reissue application.

Although there is still the risk that claims may need to be narrowed or canceled, and that estoppels and intervening rights may be created, during reissue, examination of a reissue application proceeds much like examination of an original patent application and, thus, provides a patent owner more opportunities to present arguments, amendments, and evidence in favor of patentability. As compared to *ex parte* reexamination, a patent owner has full, extendible time periods for response, and can submit an RCE or file a continuing application to obtain further prosecution of a reissue application (without limit). Additionally, a reissue application can be abandoned without surrendering the original patent claims.

A drawback of reissue is that the time from filing the reissue application until the time the USPTO acts on the application can be lengthy despite the "special" status granted to reissue applications.⁹ However, although the USPTO must decide whether a request for supplemental examination raises an SNQ within three months, *ex parte* reexamination when ordered can also be lengthy, as there is no deadline set by statute or rule by which the reexamination must be concluded.

Additionally, the filing of a reissue application or the grant of a reissue patent does not provide statutory protection against unenforceability for conduct related to information considered, reconsidered, or corrected during reissue. As a practical matter, it would likely be very difficult for an opposing party in litigation to assert inequitable conduct based on information considered, reconsidered, or corrected during prosecution of a reissue patent.

⁹ Additionally, "Track 1" prioritized examination is not available for reissue applications.

August 17, 2012

However, once a reissue application becomes available for public inspection, there is the risk that an infringing party may be alerted to information that is material to patentability and that may form the basis for asserting inequitable conduct. The infringing party could then seek to have the original patent held unenforceable before the conclusion of reissue.

As one potential strategy, to receive the statutory protection against unenforceability provided by supplemental examination, the owner of a patent could pursue reissue of the patent to have information considered by the USPTO in the first instance, and then submit the same information for reconsideration in a supplemental examination proceeding. Because the information has already been considered during reissue, the USPTO is much less likely to find that such information raises an SNQ and order *ex parte* reexamination following a brief (maximum three months) supplemental examination. Thus, the patent owner would likely avoid reexamination while still obtaining statutory unenforceability protection. However, for such a strategy to be effective, supplemental examination would need to be concluded before unenforceability is raised as a defense by an accused infringer in an action brought by the patent owner. Also, a patent owner must request supplemental examination before an opposing party particularly pleads in an action brought by that party, or serves an ANDA paragraph iv notice, including an allegation of unenforceability based on the subject information. Because reissue may alert an infringing party of material information to be used in pleading an allegation of unenforceability, there is a risk that an infringing party will bring an action pleading, or serve an ANDA notice alleging, unenforceability before the patent is reissued and supplemental examination is requested by the patent owner.

II. All Other *Ex Parte* Reexaminations Are Subject To Increased Fees

As originally proposed, the USPTO will increase the current fee from \$2,520 to \$17,750 for all other *ex parte* reexaminations, *i.e.*, for those *ex parte* reexaminations that are not ordered pursuant to supplemental examination. If the USPTO determines that a request for *ex parte* reexamination does not raise an SNQ, the USPTO will refund all but \$4,320 of that fee. The *ex parte* reexamination fee is also not reduced for small and micro entities. However, the USPTO may provide small and micro entity discounts through future rulemaking. The USPTO will not increase fees for *inter partes* reexamination proceedings, because they can no longer be filed as of September 16.

The USPTO will also increase most petition fees, including fees for filing Rule 59, 181, 182, and 183 petitions, in *ex parte* reexaminations (including those ordered pursuant to supplemental examination), as well as in ongoing *inter partes* reexaminations. The current fees for such petitions are on the order of \$200 to \$400. The USPTO will raise these fees to \$1,930 for all such petitions. A few petition fees enumerated in Rules 550(i) and 937(d) relating to timing and inventorship correction are exempted from this increase.

In view of the significant increase in fees, any requests for *ex parte* reexamination should be filed before the new fees come into effect on September 16 if possible. However, we believe that *ex parte* reexaminations are generally less desirable for patent owners than are reissue applications. They are also often not the best approach for parties adverse to patent owners, especially once the new *inter partes* review proceeding becomes available on September 16.

August 17, 2012

III. Recommendations

We provide the following general recommendations for patent owners, parties adverse to patent owners, and anyone considering requesting *ex parte* reexamination:

1. File Information Disclosure Statements, and otherwise exercise a high level of care to avoid non-disclosure of potentially material information or presentation of erroneous information, during initial prosecution of patent applications, and do not rely on the availability of supplemental examination to avoid the cost of doing so during prosecution.

2. For patent owners, exercise substantial care before deciding to request supplemental examination of a patent to have information considered, reconsidered, or corrected, including carefully weighing the benefits, risks, and costs of other options such as disclaimer and/or reissue, optionally to be followed by supplemental examination, against the benefits, risks, and cost of supplemental examination;

3. For adverse parties, carefully monitor patents containing claims that may be asserted as being infringed for indications that a patent owner is considering litigation, including monitoring relevant patents to determine whether supplemental examination of any such patent has been requested or a reissue application has been filed for any such patent;

4. For anyone considering filing a request for *ex parte* reexamination, expedite the analysis before the new fees come into effect on September 16, if possible, including carefully considering other options, such as reissue for patent owners and the new *inter partes* review proceedings and post-grant review proceedings for adverse parties.

* * * * *

Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, email at email@oliff.com or mail at 277 South Washington Street, Suite 500, Alexandria, Virginia 22314. Information about our firm can also be found on our web site, www.oliff.com.

スペシャル・レポートの日本語版は、英語版の発行後、二週間以内にウェブ・サイトでご覧いただけます。