



---

# USPTO Reexamination

Filing Date Requirements  
and Tips for Filing Reexamination Requests

November 2008



# Filing Date Requirements

## Tips for Filing Reexamination Requests

- Rules were amended in 2006 to clarify reexamination filing date requirements. See *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219 (August 4, 2006) (final rule).
- The rules as amended provide the USPTO, the patent owner whose patent is challenged, and the public as a whole, with a better understanding of the nature of the requester's challenge, **and requires** the requester to specify, with precision, the basis of each challenge, so that it can be specifically addressed.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

The main focus of the conditions necessary to receive a filing date (in addition to the fee requirement):

- A statement identifying each substantial new question of patentability (SNQ)
- An identification of every claim for which reexamination is requested
- A detailed explanation of how all of the cited documents apply to the limitations of each claim under reexamination



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Statement identifying each substantial new question of patentability (SNQ)

- The request must point out how any substantial new questions of patentability raised differ from those raised in the previous examination of the patent before the Office.
- It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination.
- It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Statement identifying each substantial new question of patentability (SNQ)

- The SNQ must be “new,” i.e., the requester must point out at least one new teaching or provide new evidence, as the basis for the SNQ, that was not discussed or considered on the record during the reexamination of the patent.
- “A[n] SNQ may be based solely on old art where the old art is being presented [or] viewed in a **new light**, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request” (emphasis added). MPEP 2242 II and 2642 II.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Statement identifying each substantial new question of patentability (SNQ)

- The new question of patentability must be "substantial."
- "A prior art patent or printed publication raises a substantial new question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable." MPEP 2242.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Statement identifying each substantial new question of patentability (SNQ)

- In order for a second or subsequent request for reexamination to be granted, the second or subsequent request must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination.
- Once the second or subsequent request has provided a “different” SNQ based on the claims in effect at the time of the determination, the second or subsequent request may also provide information directed to any proposed new or amended claim in the pending reexamination.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### An identification of every claim for which reexamination is requested

- If reexamination is requested for less than all of the patent claims, the USPTO will generally review on the merits only the claims for which reexamination is requested.
  - See *Notice of Clarification of Office Policy to Exercise Discretion in Reexamining Less Than All the Patent Claims*, 1311 *Off. Gaz. Pat. Office* 197 (October 31, 2006); MPEP 2240, 2640.
- In the examination stage of the proceeding, the USPTO will generally only examine the claim(s) for which:
  - reexamination was requested, **and**
  - a substantial new question of patentability (SNQ) was found in the order.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

A detailed explanation of how all of the cited documents apply to the limitations of each claim under reexamination

- For each identified SNQ/proposed rejection, the detailed explanation must explain how all of the cited documents identified as a basis for the SNQ/proposed rejection meet each of the limitations of the claims that are proposed to be rejected. See MPEP 2217 and 2617.



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Tips for Avoiding a Notice of Failure to Comply or a Decision Vacating Filing Date

- Propose specific rejections. For example:
  - Claims 1-5 are anticipated by A.
  - Claims 1-5 are obvious over A in view of B.
- Avoid shotgun statements such as:
  - The claims are anticipated and/or obvious over one or more of A, B, C, or D, taken alone or in combination.
  - The claims are obvious over A in view of the "prior art" (where the prior art is generally identified, in another portion of the request, as any one or more of a list of secondary references.)



# Filing Date Requirements

## Tips for Filing Reexamination Requests

### Tips for Avoiding a Notice of Failure to Comply or a Decision Vacating Filing Date (continued)

- Ensure that each of the references cited in the request is identified as the basis of at least one SNQ or as part of a proposed rejection based on an SNQ, and is specifically discussed in the corresponding detailed explanation
  - the detailed explanation must explain how all of the cited documents identified as a basis for the SNQ/proposed rejection meet each of the limitations of the claims that are proposed to be rejected, with the exception of a patent owner request, in which the patent owner may explain how the claims are distinguished from the documents identified as a basis for the SNQ.
- Avoid the citation of references in the request without an explanation of how the references are specifically to be applied to the claims.