

Best Practices to Meet Certain Supplemental Examination Filing Requirements

This document is intended to assist patent owners in filing requests to ensure compliance with certain requirements of 37 CFR 1.610(b) and provide a quality record for the examiner to make his or her determination. The advice below is intended to define best practices and may go beyond the minimum disclosure needed to meet the filing date requirements.

This document adds to, but does not replace, the Final Rule published in the Federal Register on August 14, 2012, *Changes to Implement the Supplemental Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees*, 77 Fed. Reg. 48828. For a complete discussion of the requirements for filing a request for supplemental examination, see the [Final Rule](#).

1. **37 CFR 1.610(b)(2)** – A listing of the items of information.
 - a. The listing includes all documents mentioned in the request, including, for example:
 - i. Documents (e.g., cited references, replies, or Office actions) from a prior examination.
 - ii. Dictionary definitions
 - iii. Court documents
 - b. The listing does NOT include any document that is not applied under 37 CFR 1.610(b)(5).
 - c. Use Office form PTO/SB/59 to provide the listing.

2. **37 CFR 1.610(b)(4)** - Listing each claim for which supplemental examination is requested.
 - a. Provide a listing identifying each claim for which supplemental examination is requested.
 - b. Unless otherwise specified, the Office will assume that every item of information is applied to each claim requested.
 - c. To be more specific, patent owner may provide a listing identifying each item of information listed under 37 CFR 1.610(b)(2) and to which claims the item of information is applied, or supply such information in the explanation under 37 CFR 1.610(b)(5).
 - i. The listing does not need to take the form of a proposed rejection, but must be sufficiently clear to determine the scope of the request.
 - ii. The identification will NOT be construed as an admission of unpatentability; only that the patent owner is requesting that the Office consider whether issues are raised.
 - iii. If patent owner is aware, or is made aware, that an item of information raises particular patentability issue(s) (e.g., anticipation, obviousness, written description, enablement, etc...), patent owner could identify these issues. This will provide focused review on particular issues and explicit consideration of such issues on the record.
 - iv. Examples:
 1. “Does Smith raise a substantial new question for claims 1-3 and 4-6?”
 2. “Does Jones in view of Heir render unpatentable claims 1 and 7-10?”
 3. “Does the Byrd declaration raise new issues for claims 1-7?”

3. **37 CFR 1.610(b)(5)** - A separate explanation for each identified application of the items of information that covers each and every claim so identified under 37 CFR 1.610(b)(4).
 - a. The explanation states how the patent owner is applying the item of information to each limitation that is pertinent to the item's teaching(s) for each claim identified in the listing. A general statement of relevance that is not tied to any particular claim limitation is not sufficient to meet the requirement. See MPEP 2214 for guidance.
 - i. The explanation does not need to positively state that an item of information "teaches" a limitation; only that it has teachings that a reasonable examiner might view as important in regard to the limitation.
 - ii. The explanation includes citations to particular portions or figures in the item of information in which the applied teachings are located.
 - iii. Patent owner is encouraged to be as comprehensive as possible in the explanation. This allows for the patent owner to frame the issues for review and assists the examiner in focusing on the pertinent issues to better determine if a substantial new question of patentability (SNQ) is raised.
 - b. Use of subheadings identifying the item of information and what claims are being discussed is highly encouraged.
 - c. Include a separate discussion for each identified independent claim for each identified application of an item of information. Identification by a separate subheading for each independent claim (and its associated dependent claims) is highly recommended.
 - d. Include a separate discussion for each identified dependent claim for each identified application of an item of information, unless the request makes it clear that the application of the item of information to the independent claim is being relied upon as the explanation for the dependent claim(s).
 - i. The request provides a clear statement, such as "Patent owner relies upon the explanation for claim 1 as the explanation for dependent claims 2-5."
 - ii. If the patent owner relies on a proper, detailed explanation of an independent claim as the detailed explanation for the dependent claims, then a review of the dependent claims may be limited to the detailed explanation of the independent claim provided by the patent owner.
 - e. The explanation should NOT state what the item of information does NOT teach. Such an optional discussion is recommended to be made under a separate subheading (e.g., "Explanation under 37 CFR 1.610(c)(3)").
 - i. By combining the optional discussion with the required detailed explanation, the patent owner runs the risk that the Office may not recognize that the required explanation was provided, which will result in a filing date notice and delayed granting of a filing date.
 - f. The explanation is NOT met by incorporating by reference a paper in another proceeding.
 - g. The explanation must NOT be a third party paper submitted with the request.
4. **37 CFR 1.610(b)(7)** – A copy of each item of information
 - a. Provide a legible copy of each item of information listed under 37 CFR 1.610(b)(2), if applicable.
 - b. Do NOT provide a copy of any document that is not listed under 37 CFR 1.610(b)(2).
 - c. Provide a translation for any document not in the English language. See MPEP 609.04(a), subsection III.