



MEMORANDUM

Date: March 27, 2008

To: Marian C. Knode
Jacqueline M. Stone
Technology Center Group Directors

From: John J. Love 
Deputy Commissioner for Patent Examination Policy

Subject: The Supreme Court's *KSR* Obviousness Standard Clarification - Its Application
in Reexamination

The legal standard for ordering reexamination is set by 35 U.S.C. §§ 303(a) and 312(a) and requires a substantial new question of patentability (SNQ). The SNQ may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination. The clarification of the legal standard for unpatentability under 35 U.S.C. 103 in *KSR*¹ does not alter the legal standard for determining whether a SNQ exists. The requirement for SNQ remains in place even if it is clear from the record of a patent for which reexamination is requested that the patent was granted because the Office did not show “motivation” to combine, or otherwise satisfy the teaching, suggestion, or motivation (TSM) test. Thus, a reexamination request relying on previously applied prior art that asks the Office to look at the art again based solely on the Court’s clarification of the legal standard for unpatentability of claims based on 35 U.S.C. 103 in *KSR*, without presenting the art in new light or different way, will not raise a SNQ as to the patent claims, and reexamination will not be ordered.

After the enactment of the Patent and Trademark Office Authorization Act of 2002 (“the 2002 Act”), a SNQ can be raised by patents and printed publications “previously cited by or to the Office or considered by the Office” (“old art”). The 2002 Act did not negate the statutory requirement for a SNQ that requires raising new questions about pre-existing technology. In implementation of the 2002 Act, MPEP 2242, part II.A. was revised. The revision permits raising a SNQ based solely on old art, but only if the old art is “presented/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.” Thus, a request may properly raise an SNQ by raising a material new analysis of previously considered reference(s) under the rubric authorized by *KSR*.

Inquiries regarding this matter may be directed to Kenneth M. Schor, Senior Legal Advisor, Office of Patent Legal Administration at telephone: (571) 272-7710.

¹ *KSR Int'l Co. v. Teleflex Inc. et al*, April 30, 2007, 550 U. S. ____, 127 S.Ct. 1727, 167 L.Ed. 2d 705, 82 USPQ2d 1385