Reexamination at the USPTO

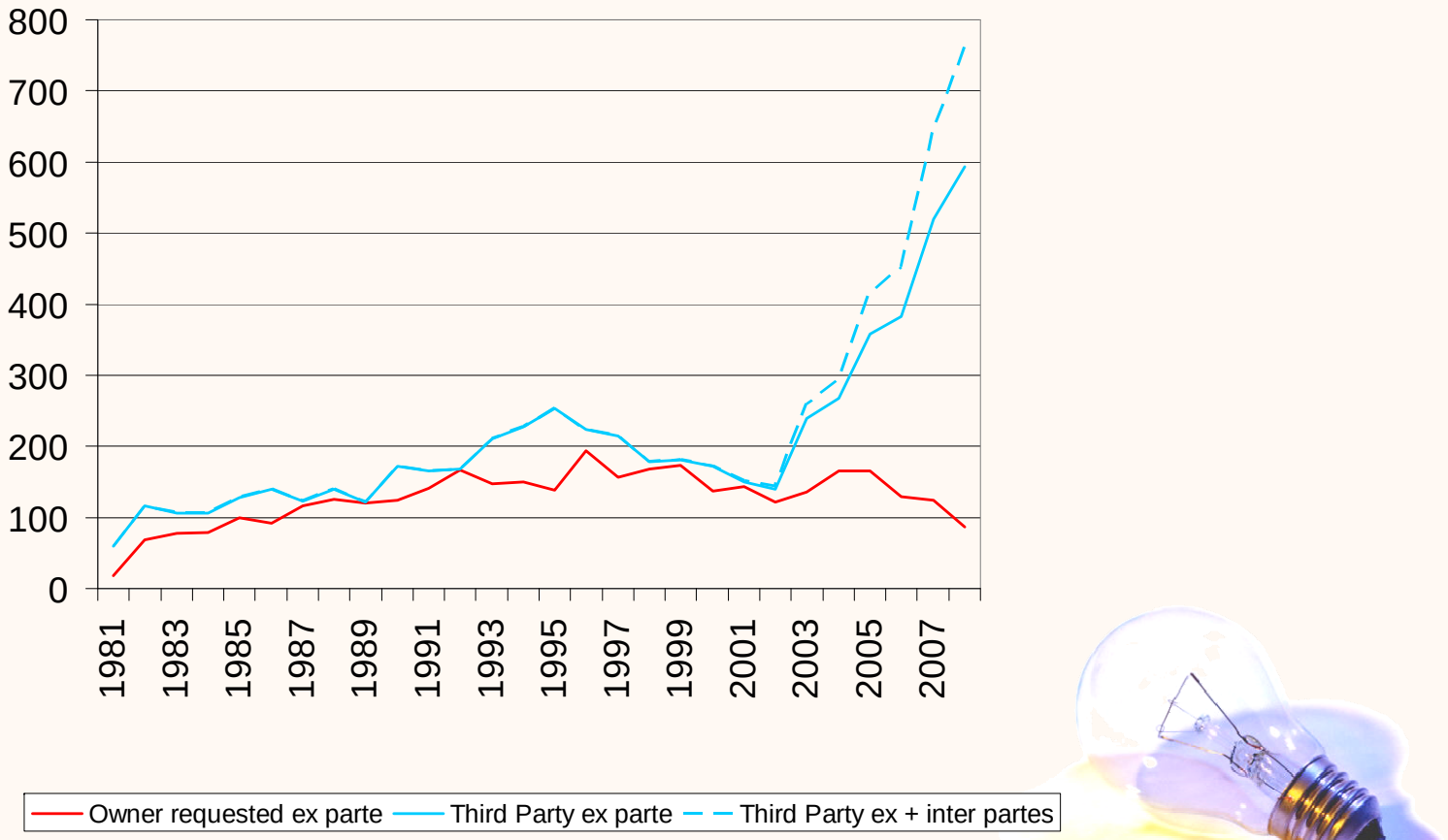
Greg Morse
Director, Central Reexamination Unit

ABA-IPL 25th Annual Conference

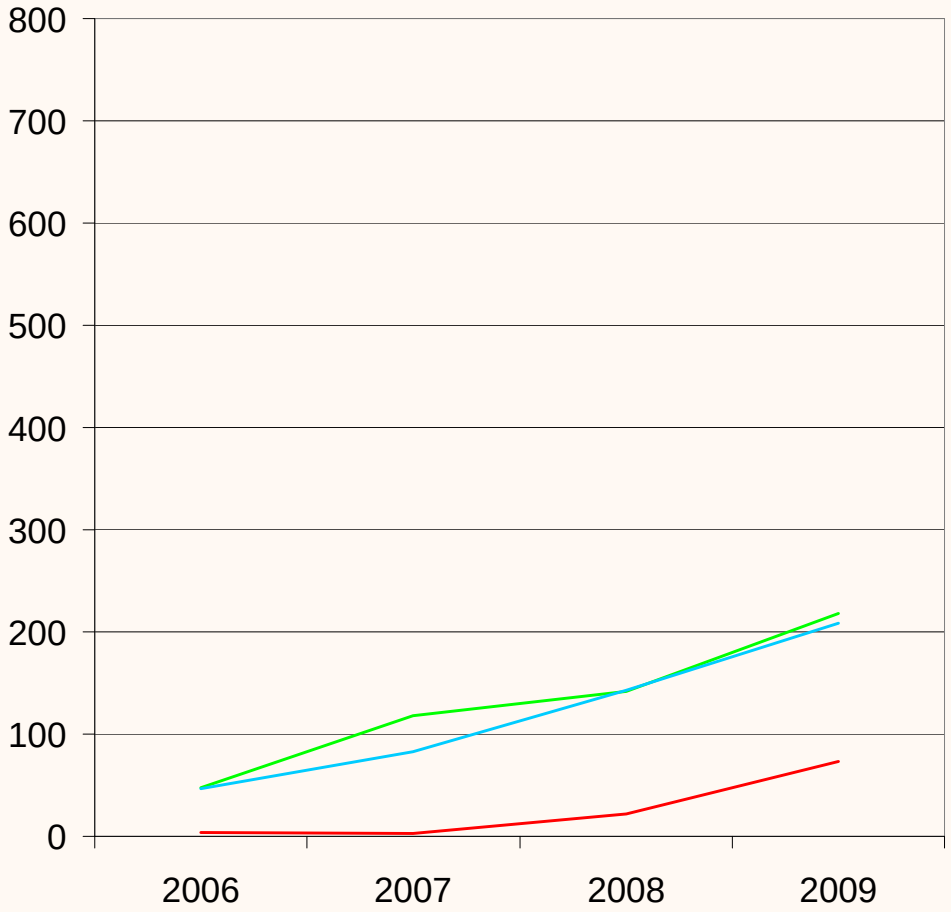
April, 2010

Reexamination Filings

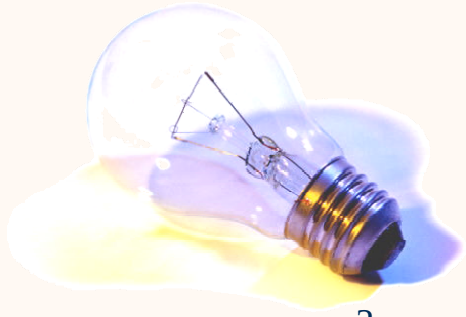
Source: USPTO Annual Reports. Excludes Director-ordered reexaminations.



Inter partes processing



Source:
Reexamination
Operational
Statistics



In re Swanson (Fed. Cir. 2008)

- Consideration of a question of patentability in district court or at the CAFC does not prevent the same question of patentability from being a substantial new question of patentability before the USPTO in reexamination since different rules and standards apply.
- Following the amendment to 35 USC 303(a), previously considered references may be applied in a new light to form a substantial new question of patentability. This might include (as in the facts of Swanson) where the reexamination considers the previously-considered reference for a different teaching or purpose than in the initial examination.

MPEP 2216

- The substantial new question of patentability 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 determining obviousness under 35 U.S.C. 103 in [*KSR*] does not alter the legal standard for determining whether a substantial new question of patentability exists.

Statistical reports

- *Ex parte* and *inter partes* historical statistics and reexamination operational statistics are available at www.uspto.gov