

Quick Start Guide

SUPPLEMENTAL EXAMINATION



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1. Introduction

This guide is for Supplemental Examination. For general information on submitting applications electronically via EFS-Web please review the EFS-Web Quick Start Guide located at http://www.uspto.gov/patents/process/file/efs/guidance/EFS-WebQuickStartGuide.pdf

35 U.S.C. 257 provides for supplemental examination of an issued patent. A request for supplemental examination must be filed by the patent owner. A patent owner may request supplemental examination to "consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish". The "information" that forms the basis of the request is not limited to patents and printed publications, and may include other issues, such as, e.g., issues under 35 U.S.C. 101. The standard for granting the request is whether one or more of the items of information properly submitted as part of the request raises a substantial new question of patentability (SNQ). An item of information raises a substantial new question of patentability if the Office determines that there is a substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability. The request will be entitled to a filing date if the request meets all applicable requirements. Within 3 months after the filing date of a request meeting all applicable requirements, the Office will conduct supplemental examination and will conclude the examination by issuing a certificate indicating whether the information presented in the request raises an SNQ. If an SNQ is raised by one or more items of information properly submitted as part of the request, reexamination will be ordered, and will be conducted according to ex parte reexamination procedures (except patent owner will not have the right to file a statement pursuant to 35 U.S.C. 304). This provision is effective September 16, 2012, and will apply to any patent issued before, on, or after the effective date (retrospective effect).

The resource page for Supplemental Examination can be located at: http://www.uspto.gov/aia implementation/patents.jsp#heading-9

This Quick Start Guide will provide you with the information you need in order to rapidly understand how to file a request for supplemental examination, including a brief overview of the process and screen shots that identify critical aspects of the submission.

A more comprehensive guide on how to use EFS-Web can be found at the EFS-Web Guidance and Resources page located at: http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp

2. Basic Guidelines for Filing a Request for Supplemental Examination

- You must be able to access EFS-Web.
- The radio button "Supplemental Examination (of Utility, Design, Plant, or Reissue)" must be selected.

- You can be either a Registered or Unregistered eFiler.
- The "Save for Later" feature as a Registered eFiler is currently **not** available and will be added in the future.
- Only the owner(s) of the entire right, title, and interest in the patent may file a request for supplemental examination.
- A patent owner may request supplemental examination under 35 U.S.C. 257 of any utility, design, plant, or reissue patent.
- Consult the current fee schedule available at http://www.uspto.gov/about/offices/cfo/finance/fees.jsp for the correct fee amounts. The request for supplemental examination must be accompanied by the following fees: (1) \$5,140.00 for processing and treating a request for supplemental examination; (2) \$16,120.00 for an *ex parte* reexamination ordered as a result of a supplemental examination proceeding; and (3) any applicable document size fees. The document size fees apply to any non-patent documents over 20 pages in length that are submitted in a supplemental examination proceeding. The document size fees include (1) \$170.00 for each non-patent document having 21-50 pages; and (2) \$280.00 for each additional 50 page increment or a fraction thereof.
- If a request for supplemental examination has been submitted but a required component has been omitted, the omitted component can be submitted as a follow-on paper on the same day as the original submission. Requests for supplemental examination that are not compliant with all applicable requirements on the day they are submitted will not be entitled to a filing date.
- Any party other than the patent owner, i.e., any third party, may **not** file a request for supplemental examination. 37 CFR 1.601(b).

Warning: EFS-Web sessions will time-out after one hour of inactivity. A Supplemental Examination that has not been submitted after one hour of inactivity will be lost. You will need to login to EFS-Web again and re-enter the information from the start.

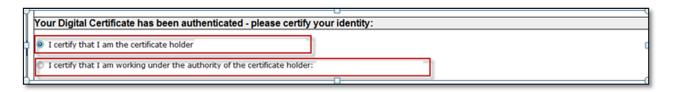
3. Filing a Supplemental Examination

3.1 Signing-On to EFS-Web

You have the option of signing-on to EFS-Web as either a Registered or Unregistered eFiler.

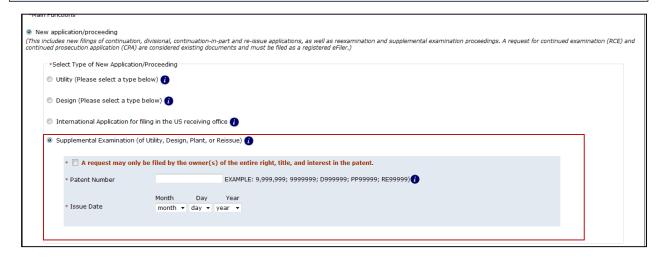
3.1.1 Registered eFiler

Once you have signed-on to EFS-Web as a Registered eFiler, you will need to certify that you are the certificate holder or working under the authority of the certificate holder. Registered eFilers who authenticate **cannot** save "In-progress" submissions and return to edit them.

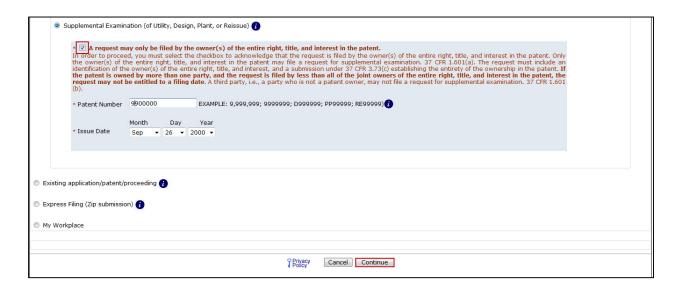


To submit a supplemental examination submission —select the radio button "New Application/Proceeding". The Web screen will expand to display additional options. Select the radio button located next to "Supplemental Examination (of Utility, Design, Plant, or Reissue)" and enter the Patent Number and Issue Date.

Note: In order to proceed, you **must** select the checkbox to acknowledge that the request is filed by the owner(s) of the entire right, title, and interest in the patent. Only the owner(s) of the entire right, title, and interest in the patent may file a request for supplemental examination. See 37 CFR 1.601(a). The request must include an identification of the owner(s) of the entire right, title, and interest, and a submission under 37 CFR 3.73(c) establishing the entirety of the ownership in the patent. If the patent is owned by more than one party, and the request is filed by less than all of the joint owners of the entire right, title, and interest in the patent, the request may not be entitled to a filing date. A third party, i.e., a party who is not a patent owner, may not file a request for supplemental examination.



If you do not select the check box acknowledging that the request is being filed by the owner(s) of the entire right, title, and interest in the patent, you will receive the following error:



The patent number and issue date must be correct. The issue date can be obtained by looking up the patent number in the Public Patent Application Information Retrieval (PAIR) System located at http://portal.uspto.gov/external/portal/pair and viewing the Bibliographic Data. If the system detects that the patent number entered does not have an active patent status you will receive a warning message; however, you will still be able to proceed. You may confirm the status of the patent in the PAIR system.

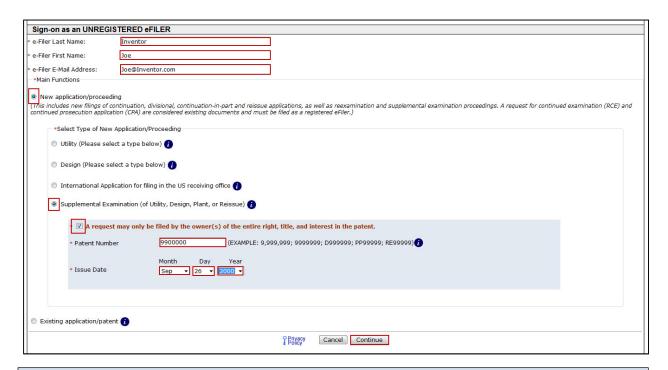
Next, to enter the data for Supplemental Examination click on the "Continue" button.

Note: At any time before you Submit, you may click the "**Cancel**" button at the bottom of page to restart the submission. By canceling the submission, any data entered will be lost and cannot be retrieved. -

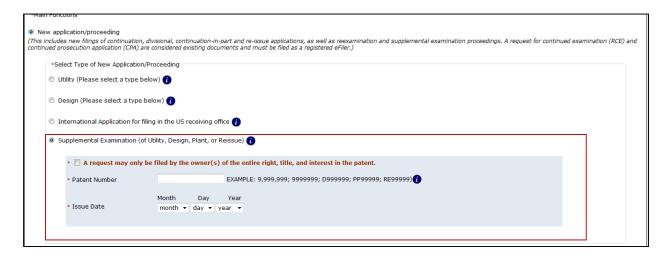
3.1.2 Unregistered eFiler

Once you have signed-on to EFS-Web as an Unregistered efiler, you will need to enter your last name, first name and e-mail address.

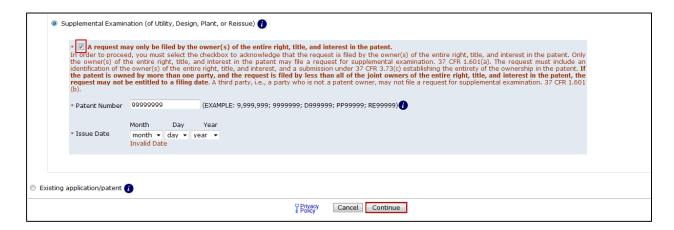
To submit a supplemental examination submission, select the "New Application/Proceeding" radio button. The Web screen will expand to display additional options. Select the radio button located next to "Supplemental Examination" and enter the patent number and issue date. The issue date can be obtained by looking up the application number in the Public Patent Application Information Retrieval (PAIR) System located at http://portal.uspto.gov/external/portal/pair and viewing the Bibliographic Data.



Note: In order to proceed, you **must** select the checkbox to acknowledge that the request is filed by the owner(s) of the entire right, title, and interest in the patent. Only the owner(s) of the entire right, title, and interest in the patent may file a request for supplemental examination. 37 CFR 1.601(a). The request must include an identification of the owner(s) of the entire right, title, and interest, and a submission under 37 CFR 3.73(c) establishing the entirety of the ownership in the patent. If the patent is owned by more than one party, and the request is filed by less than all of the joint owners of the entire right, title, and interest in the patent, the request may not be entitled to a filing date. A third party, i.e., a party who is not a patent owner, may not file a request for supplemental examination.



If you do not select the check box acknowledging that the request is being filed by the owner(s) of the entire right, title, and interest in the patent, you will receive the following error:



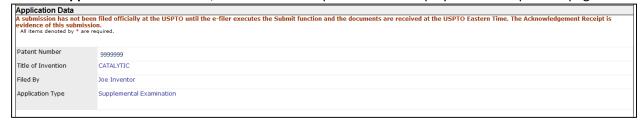
The patent number and issue date must be correct. The issue date can be obtained by looking up the patent number in the Public Patent Application Information Retrieval (PAIR) System located at http://portal.uspto.gov/external/portal/pair and viewing the Bibliographic Data. If the system detects that the patent number entered does not have an active patent status you will receive a warning message; however, you will still be able to proceed. You may confirm the status of the patent in the PAIR system.

Next, to enter the data for Supplemental Examination click on the "Continue" button.

Note: At any time before you Submit, you may click the "**Cancel**" button at the bottom of page to restart the submission. By canceling the submission, any data entered will be lost and cannot be retrieved. -

3.2 Entering Data for a Supplemental Examination

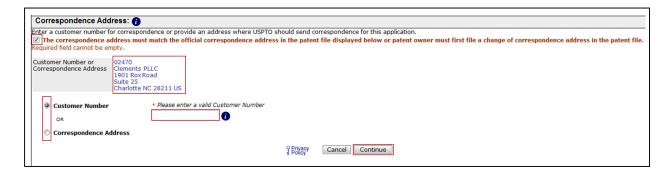
On the "Application Data" screen, the details of the patent will be displayed at the top of the page.



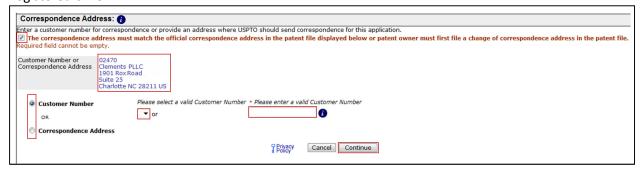
In the Correspondence Address section, enter a customer number for correspondence or provide an address where the USPTO should send correspondence for this application. This address should be identical to the official customer number and/or the correspondence address of the patent file. You **must** select the checkbox in order to proceed.

Unregistered eFilers can type in the customer number or address. Registered eFilers can either select from the customer number drop-down list, type in the customer number, or type in the correspondence address.

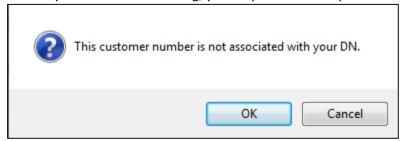
Unregistered eFiler:



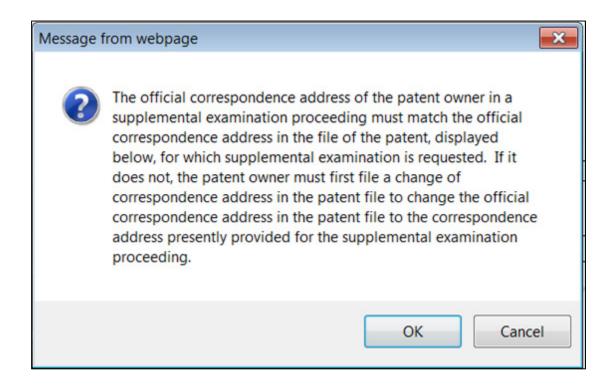
Registered eFiler: -



Registered eFilers will receive a pop-up warning message if the official customer number of the patent is not shown in the drop-down list and the customer number is entered in the provided customer number field. If you receive this warning, you may click "OK" to proceed.



If the entered customer number does not match the customer number of the patent, you will receive a warning message indicating that you must first file a change of correspondence address in the patent file to change the official correspondence address so that it matches the provided address presently provided for the supplemental examination proceeding.



3.2.1 Attach Documents

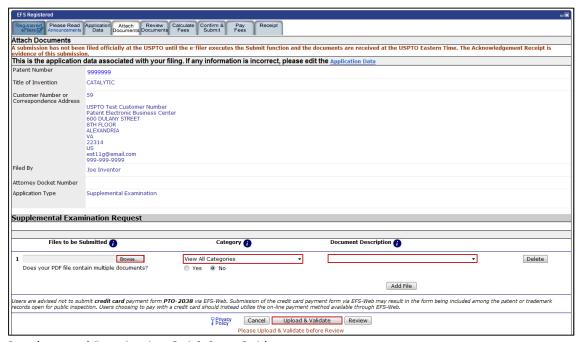
On the "Attach Documents" screen, you must upload all of the documents to be submitted in the supplemental examination proceeding. The required documents are listed below.

- o (1) An identification of the number of the patent for which supplemental examination is requested.
- (2) A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of 37 CFR 1.98(b).
- (3) A list identifying any other prior or concurrent post-patent Office proceedings involving the
 patent for which supplemental examination is being requested, including an identification of the
 type of proceeding, the identifying number of any such proceeding (e.g., a control number or
 reissue application number), and the filing date of any such proceeding.
- o (4) An identification of each claim of the patent for which supplemental examination is requested.
- o (5) 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 requested.
- o (6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent.

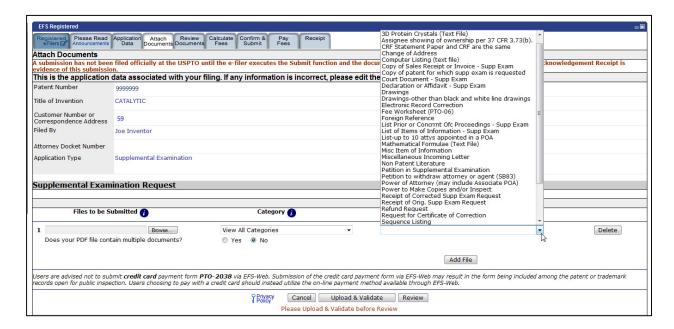
- (7) A copy of each item of information listed in (2), accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information. The patent owner is not required to submit copies of items of information that form part of the discussion within the body of the request as specified in 37 CFR 1.605(b), or copies of U.S. patents and U.S. patent application publications.
- (8) A summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length. The summary must include citations to the particular pages containing the relevant portions.
- (9) An identification of the owner(s) of the entire right, title, and interest in the patent requested to be examined, and a submission by the patent owner in compliance with 37 CFR 3.73(c) establishing the entirety of the ownership in the patent requested to be examined.
- (c) The request may also include:
- o (1) A cover sheet itemizing each component submitted as part of the request;
- o (2) A table of contents for the request;
- o (3) An explanation of how the claims patentably distinguish over the items of information; and
- (4) An explanation of why each item of information submitted with the request does or does not raise a substantial new question of patentability.

<u>Step 1</u>: Click on the "**Browse**" button to search your computer for the document to be uploaded.

<u>Step 2</u>: Once the document is uploaded, you will need to index it correctly. From the "Document Description" drop down menu, select the correct document description for the document being filed. The optional "Category" drop down menu can be used to display only document descriptions that pertain to the selected category.



To view the full Document Description list, please visit our website at http://www.uspto.gov/ebc/portal/efs/efsweb document descriptions.xls.



Once the appropriate selections have been made, click on the "**Upload & Validate**" button. You will need to repeat Steps 1 and 2 for each document to be uploaded. Click on the "**Review**" button after all documents have been uploaded.

3.2.2 Review Documents

On the "Review Documents" screen, confirm that all of the necessary documents uploaded properly. If you receive any validation errors you will not be able to proceed to the next screen until the errors are fixed. However, you will be able to proceed to the next screen if you receive any validation warnings.

Once you have uploaded all of the necessary documents for your submission and there are no validation errors, click on the "**Continue**" button to advance to the next screen.



3.2.3 Calculate Fees

On the "Calculate Fees" screen, the fees for supplemental examination will be displayed. Select the appropriate fee boxes and then click on the "Calculate" button to add up the selected fees.

Note: A request for supplemental examination must be accompanied by a total fee of \$21,260, broken down as (i) a fee of \$5,140 for processing and treating a request for supplemental examination; and (ii) a fee of \$16,120 for *ex parte* reexamination ordered as a result of a supplemental examination proceeding. In addition, a request for supplemental examination must be accompanied by any applicable document size fees.

The document size fees apply only to non-patent documents that have a length of more than 20 pages. Non-patent documents having a length of 20 pages or less are not subject to the document size fees. Non-patent documents include, for example, non-patent literature, transcripts of audio or video recordings, and court documents. Patent documents, such as U.S. patents, U.S. patent application publications, published international patent applications, and foreign patents, are not subject to the document size fees.

Non-patent documents having 21 - 50 pages are subject to a fee of \$170, which must be submitted with the request. Non-patent documents having greater than 50 pages are subject to an additional fee of \$280 for each additional 50-page increment, or a fraction thereof, which must also be paid at the time of filing the request. For example, if a journal article having a length of 145 pages is submitted as an item of information which forms part of a request for supplemental examination, a document size fee of \$730 is due upon the filing of the request. The \$730 document size fee is calculated by adding the \$170 fee for 21 - 50 pages, and two additional fees of \$280 for each additional 50 pages, or a fraction thereof (i.e., a \$280 fee for 51 - 100 pages, and a second \$280 fee for the remaining 45 pages, which is a fraction of a 50-page increment).

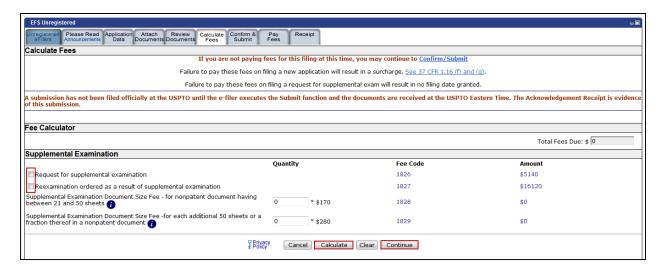
For more information regarding the document size fees for a nonpatent document having between 21 and 50 sheets, please visit: www.uspto.gov/patents/process/file/efs/guidance/Document Size Fee.jsp

For more information regarding the document size fees for each additional 50 sheets or a fraction thereof in a nonpatent document, please visit:

www.uspto.gov/patents/process/file/efs/guidance/Each Additional 50-Page Increment.jsp

If you are a Registered eFiler and you choose to pay fees in a follow-on submission, the fee payment must be processed before midnight 11:59:59 pm (Eastern Time) on the same day as the original submission. Failure to pay these fees on filing a request for supplemental examination will result in no filing date granted.

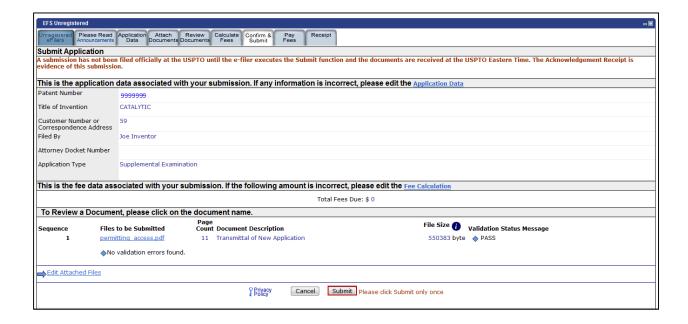
Next, click on the "Continue" button to reach the Confirm & Submit screen.



3.2.4 Confirm and Submit

On the "Confirm & Submit" screen, you will be presented with a review of the content of the active Supplemental Examination request. This will include all of the items uploaded on the "Attach Documents" screen and the fees indicated on the "Calculate Fees" screen.

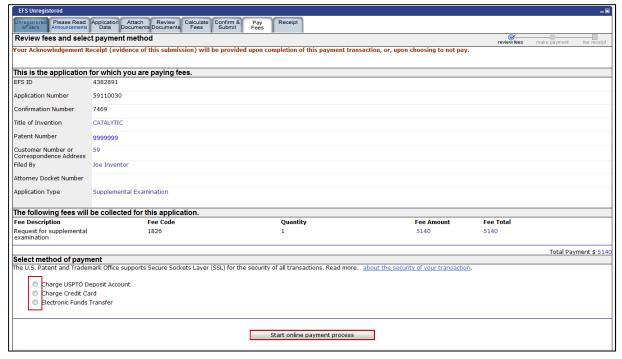
To submit your application click on the "Submit" button located at the bottom of the screen.



3.2.5 Pay Fees

On the "Pay Fees" screen, you have the option of paying via "Charge USPTO Deposit Account," "Charge Credit Card," or "Electronic Funds Transfer." Select the radio button that coincides with your method of payment. The "Fee Amount", "Fee Total" and "Total Payment" will be listed on the screen.

To make a payment, click the "**Start online payment process**" button located at the bottom of the screen.



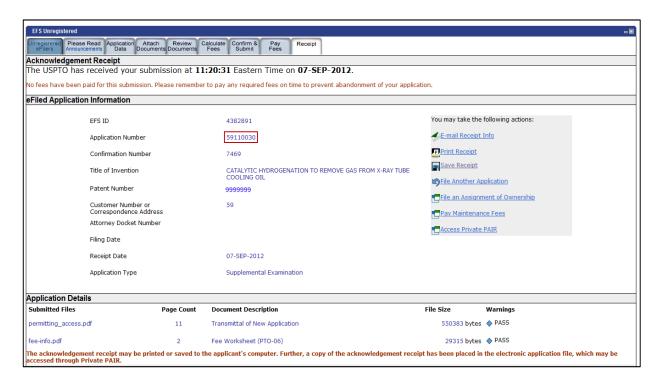
3.2.6 Acknowledgement Receipt

Once you have provided all of the necessary payment information and your payment is processed successfully, you will receive your Acknowledgement Receipt on the "Receipt" screen.

You may print or save the receipt. Registered eFilers will also have the option of viewing the Acknowledgement Receipt under "My Workplace" on EFS-Web.

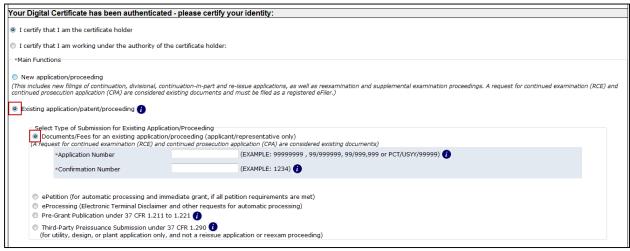
The Acknowledgement Receipt displays the details of the submission, such as the file names of the uploaded documents, time stamp, and total amount paid.

If you have any questions or concerns regarding filing in EFS-Web, please contact the Patent EBC Monday - Friday, from 6:00 a.m. to 12 Midnight Eastern Time, by email ebc@uspto.gov or telephone 866-217-9197.



4. Supplemental Examination Follow-On Submission

As a Registered eFiler, you have the option to file follow-on submissions for a Supplemental Examination. Once you have signed-on to EFS-Web as a Registered eFiler, you will need to certify that you are the certificate holder or working under the authority of the certificate holder. Next, click on "Existing application/patent/proceeding" then select "Document/Fees for an existing application/proceeding (applicant/representative only)"

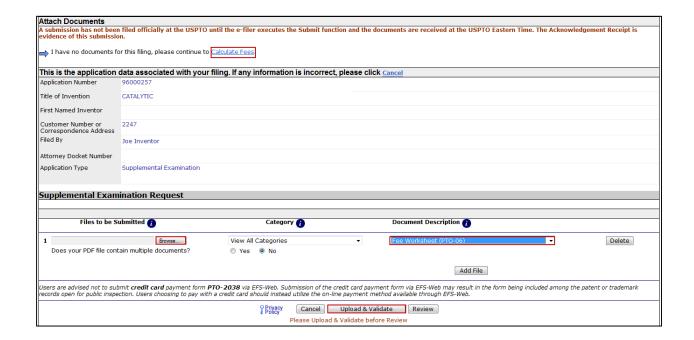


Enter the existing application number (in a supplemental examination proceeding, the - "application number" is the control number) and the confirmation number and click on "Continue". -

4.1 Attach Documents

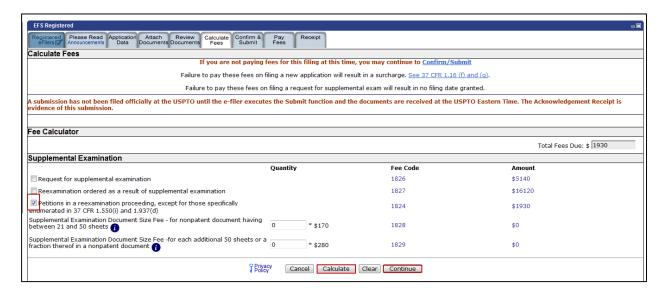
If you only need to pay fees, then click on the link shown below to advance to the Calculate Screens section. If not, you can browse and upload documents.

If you also wish to pay a fee that is not listed on the screen, you will need to attach a form authorizing the Office to charge the fee. Form PTO/SB/17 may be used for this purpose. When attaching the form, indicate the category as "General Transmittal" and the document description as "Fee Worksheet (SB06)".



4.2 Calculate Fees

On the "Calculate Fees" screen, the fees for Supplemental Examination will be displayed. Select the appropriate fee boxes and then click on the "Calculate" button to add up the selected fees. Next, click on the "Continue" button to reach the Confirm & Submit screen.

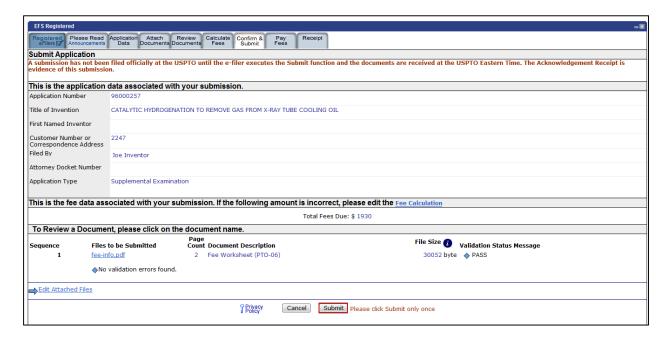


4.3 Confirm and Submit

On the "Confirm & Submit" screen, you will be presented with a review of the content of the active Supplemental Examination request. This will include all of the items uploaded on the "Attach Documents" screen and the fees indicated on the "Calculate Fees" screen.



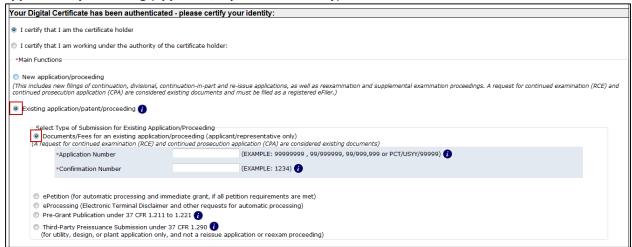
To submit your application click on the "Submit" button located at the bottom of the screen. -



5. Reexamination Based on Supplemental Examination Follow-On Submission

As a Registered eFiler, you have the option to file follow-on submissions for a reexamination based on a supplemental examination. Once you have signed-on to EFS-Web as a Registered eFiler, you will need to certify that you are the certificate holder or working under the authority of the certificate holder.

Next, click on "Existing application/patent/proceeding" then select "Document/Fees for an existing application/proceeding (applicant/representative only)"

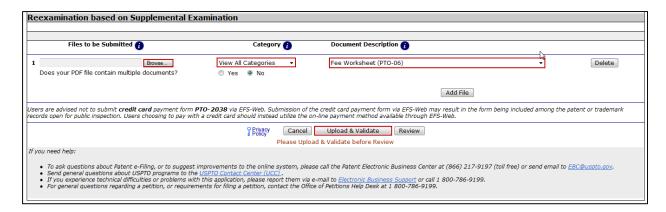


Enter the existing application number (in a reexamination proceeding based on a supplemental examination proceeding, the "application number" is the control number) and the confirmation number and click on "Continue".

5.1 Attach Documents

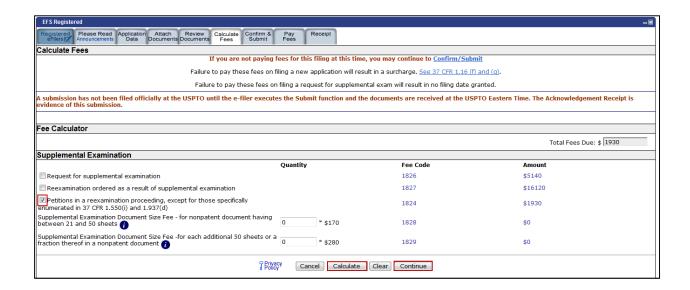
If you only need to pay fees, then click on the link stating "Calculate Fees" shown below to advance to the Calculate Screens section. If not, you can browse and upload additional documents. If reexamination has been ordered, the drop down menu for the "Document Description" should display documents appropriate for a reexamination proceeding based on a supplemental examination proceeding. Once the document is uploaded, you will need to index it correctly. The optional "Category" drop down menu can be used to display only document descriptions that pertain to the selected category. On the "Document Description" drop down menu select the correct document description for the document being filed.

If you wish to pay a fee that is not listed on the screen, you will need to attach a separate fee transmittal form authorizing the Office to charge the fee. Form PTO/SB/17 may be used for this purpose. When attaching the form, indicate the category as "General Transmittal" and the document description as "Fee Worksheet (SB06)".



5.2 Calculate Fees

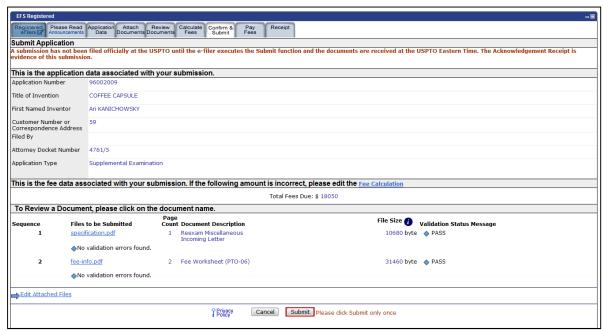
On the "Calculate Fees" screen, the fees appropriate for a reexamination proceeding based on a supplemental examination proceeding will be displayed. Select the appropriate fee boxes and then click on the "Calculate" button to add up the selected fees. Next, click on the "Continue" button to reach the Confirm & Submit screen.



5.3 Confirm and Submit

On the "Confirm & Submit" screen, you will be presented with a review of the content of the active reexamination proceeding. This will include all of the items uploaded on the "Attach Documents" screen and the fees indicated on the "Calculate Fees" screen.

To submit your application click on the "Submit" button located at the bottom of the screen.



If you have any questions or concerns regarding filing in EFS-Web, please contact the Patent EBC Monday - Friday, from 6:00 a.m. to 12 Midnight Eastern Time, by email ebc@uspto.gov or telephone 866-217-9197.