

EXHIBIT B



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2258.01 Use of Previously Cited/Considered Art in Rejections [R-7] - 2200 Citation of Prior Art and Ex Parte Reexamination of Patents

2258.01 Use of Previously Cited/Considered Art in Rejections [R-7]

In the examining stage of a reexamination proceeding, the examiner will consider whether the claims are subject to rejection based on art. Before making such a rejection, the examiner should check the patent's file history to ascertain whether the art that will provide the basis for the rejection was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

If the rejection to be made by the examiner will be based on a combination of "old art" and art newly cited during the reexamination proceeding, the rejection is proper, and should be made. See *In re Hiniker*, 150 F.3d at 1367, 47 USPQ2d at 1527. (Court held the reexamination proceeding was supported by a substantial new question of patentability where the rejection before the court was based on a combination of art that had been before the examiner during the original prosecution, and art newly cited during the reexamination proceeding.)

If the "old art" provides the **sole basis** for a rejection, the following applies:

(A) Reexamination was ordered **on or after November 2, 2002**:

For a reexamination that was ordered on or after November 2, 2002 (the date of enactment of Public Law 107-273; see Section 13105, of the Patent and Trademark Office Authorization Act of 2002), reliance solely on old art (as the basis for a rejection) does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being 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.

When an Office action is being considered, and it is newly determined that a SNQ based solely on old art is raised by a request in a reexamination that was ordered on or after November 2, 2002, form paragraph [22.01.01](#) should be included in the Office action. Form

paragraph **22.01.01** should be included in any Office action in which a SNQ based solely on the old art is first set forth (i.e., it was not set forth in the order granting reexamination or a prior Office action in the proceeding).

¶ **22.01.01 Criteria for Applying "Old Art" as Sole Basis for Reexamination**

The above **[1]** is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. **303(a)** and **312(a)**:

"The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on **[2]**. A discussion of the specifics now follows:

[3]

Examiner Note:

1. In bracket 1, insert "substantial new question of patentability" if the present form paragraph is used in an order granting reexamination (or a TC or CRU Director's decision on petition of the denial of reexamination). If this form paragraph is used in an Office action, insert "ground of rejection".
2. In bracket 2, insert the old art that is being applied as the sole basis of the SNQ. For example, "the patent to Schor" or "the patent to Schor when taken with the Jones publication" or "the combination of the patent to Schor and the Smith publication" could be inserted. Where more than one SNQ is presented based solely on old art, the examiner would insert all such bases for SNQ.
3. In bracket 3, for each basis identified in bracket 2, explain how and why that fact situation applies in the proceeding being acted on. The explanation could be for example that the old art is being 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. See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
4. This form paragraph is only used the first time the "already cited/considered" art is applied, and is not repeated for the same art in subsequent Office actions.

(B) Reexamination was ordered **prior to November 2, 2002**:

For a reexamination that was ordered prior to November 2, 2002, old art **cannot** (subject to the exceptions set forth below) be used as the **sole basis** for a rejection.

In determining the presence or absence of "a substantial new question of patentability" on which to base a rejection, the use of "old art" in a reexamination that was ordered prior to November 2, 2002, is controlled by *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). (Note that *Portola Packaging* was decided based on the reexamination statute as it existed prior to the amendment by Public Law 107-273, Section 13105 of the Patent and Trademark Office Authorization Act of 2002). The amendment by Public Law 107-273, Section 13105, overruled the *Portola Packaging* decision for any reexamination that was ordered on or after November 2, 2002. See *In re Bass*, 314 F.3d 575, 576-77, 65 USPQ2d 1156, 1157 (Fed. Cir. 2002) where the Court stated in the sole footnote:

The following guidelines are provided for reviewing ongoing reexaminations ordered **prior to November 2, 2002**, for compliance with the *Portola Packaging* decision.

On November 2, 2002, 35 U.S.C. 303(a) was amended by the passage of Pub. L. No. 107-273, 13105, (116 Stat.) 1758, 1900, to add "[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office," thereby overruling *Portola Packaging*. The following guidelines are provided for reviewing ongoing reexaminations ordered **prior to November 2, 2002**, for compliance with the *Portola Packaging* decision.

(1) General principles governing compliance with *Portola Packaging* for ongoing reexaminations ordered prior to November 2, 2002.

If prior art was previously relied upon to reject a claim in a concluded prior related Office proceeding, the Office will not conduct reexamination based only on such prior art. "Prior related Office proceedings" include the application which matured into the patent that is being reexamined, any reissue application for the patent, and any reexamination proceeding for the patent.

If prior art was not relied upon to reject a claim, but was cited in the record of a concluded prior related Office proceeding, and its relevance to the patentability of any claim was actually discussed on the record, the Office will not conduct reexamination based only on such prior art. The relevance of the prior art to patentability may have been discussed by either the applicant, patentee, examiner, or any third party. However, 37 CFR 1.2 requires that all Office business be transacted in writing. Thus, the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) submitted with an information disclosure statement. Thus, any specific discussion of prior art must appear on the record of a prior related Office proceeding. Generalized statements such as the prior art is "cited to show the state of the art," "cited to show the background of the invention," or "cited of interest" would not preclude reexamination.

The Office may conduct reexamination based on prior art that was cited but whose relevance to patentability of the claims was not discussed in any prior related Office proceeding.

(2) Procedures for determining whether the prosecution of an ongoing reexamination must be terminated in compliance with *Portola Packaging*.

Office personnel must adhere to the following procedures when determining whether the prosecution of an ongoing reexamination should be terminated in compliance with the Federal Circuit's decision in *Portola Packaging*.

(a) Ascertain that the order granting reexamination was mailed prior to November 2, 2002. If the order granting reexamination was not mailed prior to November 2, 2002, see above "Reexamination was ordered on or after November 2, 2002" for guidance.

(b) Prior to making any rejection in the ongoing reexamination, determine for any prior related Office proceeding what prior art was (i) relied upon to reject any claim, or (ii) cited and discussed.

(c) Base any and all rejections of the patent claims under reexamination at least in part on prior art that was, in any prior related Office proceeding, neither (i) relied upon to reject any claim, nor (ii) cited and its relevance to patentability of any claim discussed.

(d) Withdraw any rejections based only on prior art that was, in any prior related Office proceeding, previously either (i) relied upon to reject any claim, or (ii) cited and its relevance to patentability of any claim discussed.

(e) Terminate the prosecution of any reexamination in which the only remaining rejections are entirely based on prior art that was, in any prior related Office proceeding, previously (i) relied upon to reject any claim, and/or (ii) cited and its relevance to patentability of a claim discussed.

The Director of the USPTO may conduct a search for new art to determine whether a substantial new question of patentability exists prior to terminating the prosecution of any ongoing reexamination proceeding. See 35 U.S.C. 303. See also 35 U.S.C. 305 (indicating that "reexamination will be conducted according to the procedures established for initial examination," thereby suggesting that the Director of the USPTO may conduct a search during an ongoing reexamination proceeding).

(3) Application of *Portola Packaging* to unusual fact patterns.

The Office recognizes that each case must be decided on its particular facts and that cases with unusual fact patterns will occur. In such a case, the reexamination should be brought to the attention of the Central Reexamination Unit (CRU) or Technology Center (TC) Director who will then determine the appropriate action to be taken.

Unusual fact patterns may appear in cases in which prior art was relied upon to reject any claim or cited and discussed with respect to the patentability of a claim in a prior related Office proceeding, but other evidence clearly shows that the examiner did not appreciate the issues raised in the reexamination request or the ongoing reexamination with respect to that art. Such other evidence may appear in the reexamination request, in the nature of the prior art, in the prosecution history of the prior examination, or in an admission by the patent owner, applicant, or inventor. See 37 CFR 1.104(c)(3).

The following examples are intended to be illustrative and not inclusive.

For example, if a textbook was cited during prosecution of the application which matured

into the patent, the record of that examination may show that only select information from the textbook was discussed with respect to the patentability of the claims. The file history of the prior Office proceeding should indicate which portion of the textbook was previously considered. See 37 CFR 1.98(a)(2)(ii) (an information disclosure statement must include a copy of each "publication or that portion which caused it to be listed"). If a subsequent reexamination request relied upon other information in the textbook that actually teaches what is required by the claims, it may be appropriate to rely on this other information in the textbook to order and/or conduct reexamination. However, a reexamination request that merely provides a new interpretation of a reference already previously relied upon or actually discussed by the Office does not create a substantial new question of patentability.

Another example involves the situation where an examiner discussed a reference in a prior Office proceeding, but did not either reject a claim based upon the reference or maintain the rejection based on the mistaken belief that the reference did not qualify as prior art. For example, the examiner may not have believed that the reference qualified as prior art because: (i) the reference was undated or was believed to have a bad date; (ii) the applicant submitted a declaration believed to be sufficient to antedate the reference under 37 CFR 1.131; or (iii) the examiner attributed an incorrect filing date to the claimed invention. If the reexamination request were to explain how and why the reference actually does qualify as prior art, it may be appropriate to rely on the reference to order and/or conduct reexamination. For example, the request could: (i) verify the date of the reference; (ii) undermine the sufficiency of the declaration filed under 37 CFR 1.131 >(by a showing of an inaccuracy/mistake of fact in the declaration)<; or (iii) explain the correct filing date accorded a claim >where the issue was not previously addressed in an earlier examination of the patent<. See e.g., *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001) (reexamination on the basis of art previously presented without adequate proof of date may proceed if prior art status is now established).

Another example involves foreign language prior art references. If a foreign language prior art reference was cited and discussed in any prior Office proceeding but the foreign language prior art reference was never completely and accurately translated into English during the original prosecution, *Portola Packaging* may not prohibit reexamination over a complete and accurate translation of that foreign language prior art reference. Specifically, if a reexamination request were to explain why a more complete and accurate translation of that same foreign language prior art reference actually teaches what is required by the patent claims, it may be appropriate to rely on the foreign language prior art reference to order and/or conduct reexamination.

Another example of an unusual fact pattern involves cumulative references. To the extent that a cumulative reference is repetitive of a prior art reference that was previously applied or discussed, *Portola Packaging* may prohibit reexamination of the patent claims based only on the repetitive reference. For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.

(4) Notices regarding compliance with *Portola Packaging*.

(a) If the prosecution of an ongoing reexamination is terminated under (2)(e) above in order to comply with the Federal Circuit's decision in *Portola Packaging*, the Notice of Intent to Issue *Ex Parte* Reexamination Certificate should state: "The prosecution of this reexamination is terminated based on *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). No patentability determination has been made in this reexamination proceeding."

(b) If a rejection in the reexamination has previously been issued and that rejection is withdrawn under (2)(d) above in order to comply with the Federal Circuit's decision in *Portola Packaging*, the Office action withdrawing such rejection should state: "The rejection(s) based upon _____ is/are withdrawn in view of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). No patentability determination of the claims of the patent in view of such prior art has been made in this reexamination proceeding."

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