

A Walkthrough of Supplemental Examination

Under the America Invents Act (AIA), a new post-grant proceeding (i.e., a proceeding available at the U.S. patent office regarding patents that have already been issued) was created in the form of supplemental examination. The purpose of supplemental examination is to consider, reconsider, or correct information that is believed to be relevant to an already issued patent. A request for supplemental examination cures the patent of claims of inequitable conduct with respect to the information submitted and considered as part of the supplemental examination. As such, a patent owner of an already issued patent may submit a request for supplemental examination that includes items of information that are relevant to the patent (e.g., relevant patents), yet were not considered during the original prosecution of the patent at the USPTO.

While curing inequitable conduct is a great benefit, fees associated with supplemental exam requests are fairly expensive and the requests themselves can be rather time-consuming to prepare. As such, it is vital, when considering a supplemental examination as a potential strategy, to determine whether curing inequitable conduct is likely to be necessary. If not, other post-grant proceedings such as reissue or ex-parte reexamination should also be considered as potential post-grant strategies.