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“Tip of the Month”

US Patents: Reissue or Supplemental Examination What is the Best Option?

The America Invents Act (AIA) led to changes in the re-issue provisions and introduced a new procedure called the supplemental examination. Both provisions allow a patent owner to cure some defects or problems in a patent. What is the best option? The lawyerly answer is “it depends.”

The popular mantra is, “use supplemental examination to confirm a patent - use re-issue to repair a patent and/or prepare it for enforcement.”

Advantages and disadvantages of seeking a reissue:

1. Less expensive than a supplemental examination.
2. “Without deceptive intent” language removed from statute under the AIA.
3. Allows for addition of narrower, dependent claims.
4. Patent owner has option to file a request for continued examination.
5. Patent owned may abandon the reissue application and the parent patent will still have the original, issued claims.
6. Patent owner must admit to a defect in the patent.

Advantages and disadvantages of seeking a supplemental examination:

1. Faster than reissue – USPTO must conduct supplemental examination and issue a certificate whether information presented in the request raises a substantial new question of patentability.
2. If information presented does not raise a substantial new question of patentability, then the request for supplemental examination ends with that determination.
3. Statute specifically states that a patent cannot be held unenforceable based upon information that was considered, reconsidered, or corrected during the supplemental examination.
4. Patent owner not required to admit a defect in the patent.
5. More expensive than a reissue – especially if the information presented does raise a substantial new question of patentability.
6. May result in an *ex parte* reexamination if substantial new question of patentability is found, which is very costly.
7. Patent owner cannot stop an *ex parte* re-examination.
8. No option for patent owner to file a request for continued examination after a final office action; only option is an appeal to the Board of Patent Appeals and Interferences or an appeal to the courts.

Both reissue and supplemental examination are powerful and versatile tools available to patent owners. The choice must balance concerns of cost and of the patent itself.

If you have questions about your patents, please do not hesitate to contact the attorneys at Mesmer & Deleault by calling (603) 668-1971 or by email at mailbox@biz-patlaw.com.

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