

## *In Re Swanson: The Federal Circuit Permits Re-Examination of Recycled Art*

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In April, 1997, the United States Court of Appeals for the Federal Circuit (“CAFC”) held *In re Portola Packaging* the United States Patent and Trademark Office (“PTO”) could not re-evaluate art the Office previously considered in relation to a similar or more expansive patent claim. CAFC’s holding stated “it is inappropriate for the PTO to re-evaluate previously considered questions of patentability on re-examination.” In response, the United States Congress in 2002 amended 35 U.S.C. §303 to over-rule CAFC’s holding in *Portola*. The amended statute reads “following the filing of a request for reexamination...the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. 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.”

*In re Swanson* concerns a patent Abbott Laboratories licensed from Swanson; thereafter, Abbott instituted suit against Syntron Bioresearch, Inc. for patent infringement. Syntron’s counter-suit alleged the patent Swanson licensed to Abbott Laboratories was not valid because Swanson’s patent included a reference to prior art which the PTO previously considered. The district court for the southern district of California upheld the validity of Swanson’s patent against the prior art claim; Syntron subsequently appealed the district court’s decision, and CAFC affirmed the district court’s ruling. Thereafter, Syntron filed a claim with the PTO which included the disputed art seeking re-examination, and the PTO invalidated Swanson’s patent.

Following Abbott Laboratories’ appeal, the CAFC held, notwithstanding the proceedings of the lower court, the PTO enjoyed the right to initiate re-examination proceedings. The court stated, “the 2002 amendment removes the focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability presented by the reference in re-examination was previously evaluated by the PTO. As was true before the amendment, an ‘argument already decided by the Office, whether during the original examination or an earlier re-examination’ cannot raise a new question of patentability.”

*In re Swanson* indicates the Court of Appeals for the Federal Circuit’s commitment to defer to the legislative decision of the United States Congress in amending the federal statute to specifically overturn the court’s decision *In re Portola*. The decision also demonstrates the wide latitude the court seems willing to provide the PTO in determining for itself what qualifies as a “new question of patentability.”

### Sources:

*In re Portola Packaging, Inc.*, 122 F.3d 1473 (Fed. Cir. 1997).

*In Re Swanson*, No. 07-1534, 2008 WL 4068691 (Fed. Cir. 2008).

*Abbott Laboratories v. Syntron Bioresearch, Inc.*, 120 Fed.Appx. 362 (Fed. Cir. 2005).