

In Re Swanson: The Federal Circuit's First Chance to Evaluate the Scope of the Amended "Substantial New Question of Patentability"

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Anyone is able to request a reexamination of an issued patent. In order to be granted such reexamination, there must be a "substantial new question of patentability affecting any claim of the patent," according to 35 U.S.C.A. § 303. When the Federal Circuit attempted to narrow the scope of what could be reexamined in *In re Portola Packaging Inc.*, 110 F.3d 786 (Fed. Cir. 1997), Congress disagreed. The Federal Circuit held that reexamination was precluded based on "prior art previously considered by the PTO in relation to the same or broader claims." In 2002, Congress amended the statute to include the point that a patent's previous citation by or to the PTO does not preclude it from reexamination. *In Re Swanson* presents the Federal Circuit with its first opportunity to evaluate the scope of the "substantial new question of patentability" since it has been amended.

Patent '484 was assigned to Surmodics, Inc. Surmodics argued that Deutsch, another patent, did not raise a "substantial new question of patentability" because Deutsch was considered by the PTO during the initial examination of patent '484 and was relied upon for rejecting several claims as obvious. The Federal Circuit declined to adopt a bright-line rule, per Surmodics' request, which "would preclude rejections in reexaminations based solely on references used in a rejection of claims in the original patent prosecution." This would violate the 2002 amendment. The question of whether previously relied upon prior art, in this case Deutsch, could create a question of patentability to allow for reexamination must be answered in the affirmative.

A "substantial new question of patentability" is not explicitly defined, although the amended statute refers to references "previously cited by or to the Office or considered by the Office." Further, Congress was only concerned with previous PTO examinations and not civil litigation.

The 2002 Amendment emphasizes not whether a particular reference was already considered, but whether that particular question of patentability was already considered. Since Deutsch was used only for limited purposes in the initial examination, the issue of whether Deutsch anticipated several of the claims in the past does not preclude a substantial new question of patentability.

Sources:

*In Re Swanson*, No. 07-1534, 2008 WL 4068691 (Fed. Cir. 2008), *available at* <http://www.cafc.uscourts.gov/opinions/07-1534.pdf>.