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Comments on USPTO's Streamlined Patent Reexamination Proceedings Public Meeting
and Request for Comments;

1. Page 22855, A1. Proposed requirement for requester to separately explain how each SNQ Presented in the Request of "new" relative to Other Examinations of the patent Claims.

The current requirement is to set forth a substantially new question of patentability to justify initiating another reexam proceeding. I think that this requirement is already in place. However, making such a requirement explicit is reasonable.

2. Page 22855, A2. Requester must explain how the references apply to every limitation of every claim for which reexamination is requested.

This will clearly save the Examiner handling the request for reexamination time in formulating rejections based on the art which forms the basis for the SNQ, and will tend to reduce weak arguments and rejections. However, a patent owner who is a requester may not want to do this. Consider relaxing this requirement for third party requesters and Commissioner ordered reexamination proceedings.

3. Page 22856, A3 Requester must explain how multiple SNQs raised in the same request are non-cumulative of each other and cumulative requests will be deemed to constitute a single request.

This proposal is really at odds with the requirement in MPEP Chapter 700, section 706.02(I), that the Examiner should limit rejections to the best art and not make alternative rejections of the same claims on different art. Just as Examiners should not make cumulative rejections, third party requesters should be subject to the same requirements. Third party requesters should be required to pick their best rejection for each claim sought to be reexamined, and leave it at that. In other words, preclude third party requesters from presenting multiple SNQs in a reexamination request.

The estoppel provisions in Inter Partes Reexamination should be interpreted to take this into account concerning what could have been raised.

4. Page 22856 A4. The Examiner may select one or more representative rejections from a group of adopted rejections.

Although this suggestion discusses MPEP Section 706.02(I), I think it puts too much of a burden on the Office's limited resources and on the patent owner, and that the allegedly "representative" rejection should be limited to the one "best" rejection that the third party requester is limited to presenting – as noted above.

Reexamination has gotten out of hand. It should be limited to the best art and the single best rejection of a specific claim, and the examiner can agree or not with the rejection and, if he or she decides to do so, should make a new rejection that the patent owner has to respond to, and the patent owner should only have to respond to the examiner's rejection.

5. Page 22856 A.5. Requester's declaration and other evidence will be mainly limited to the Request.

I recommend making a third party's Rule 132 declarations and test evidence to be limited to rebuttal only because this is not a patent interference proceeding with inter partes testing available to the parties. Moreover, and it is well settled that an Examiner may not reject claims based on an ex parte declaration or affidavit.

6. Page 22857, A.6. Patent Owner's amendments and Evidence will be mainly limited to the First Action Response

The requirement to limit a patent owner to the four listed options regarding amendments after a final Office Action are too drastic. A final Office Action can (and sometimes does) make statements adverse to patentability without entering a new ground of rejection, and a patent owner should be able to respond to by filing an amendment to be entered as a matter of right.

Please consider changing the four permissible reasons for entering an after final amendment to include "appropriate circumstances." Appropriate circumstances may include overcoming adverse non-prior art patentability issues statements by an examiner, and stated interpretations by an examiner of claim language not previously presented by the Examiner, but appearing in a final Office Action.

7. Page 22857 A.7. Claim amendments will not be entered unless accompanied by a statement explaining how the proposed new claim language renders the claims patentable in light of an SNQ

I think it's about time that In re Freeman was distinguished, because reexamination should permit a patent owner to rectify whatever problems exist with their patent claims, just as they could do in a reissue application, and just as Patent Interference Trial Section Board members permit them to do based on preliminary motions conferences, without the need to file a reissue application when a reexamination proceeding will permit the same thing to be done. In this regard, the PTO has

expanded the types of issues that can be corrected in reexamination, including inventorship and other "certificate of correction" type matters, and should continue to do so in reexamination proceedings.

8. Page 22858, A.8 Petitions Practice will be clearly Defined.

It appears that the proposed table of what is and is not petitionable is a good idea.

9. Page 22858B.1. Make Permanent the Pilot that allows the patent owner to optionally waive the Patent Owner's statement.

In general, a time saver

10. Page 22859, B.2. Where the Patent Owner does not waive the Statement, the Order granting reexamination will include a provisional FAOM, which may be made final in the next Office Action.

This proposal essentially does away with the PTO taking responsibility for premature final Office Actions. The status quo is fairer to the patent owner.

11. Page 22859 C.1. Third Party Requester may dispute the Examiner's Designation that a rejection is "representative" of other rejections in the group.

As noted above, there should only be one "best" rejection for each claim presented by the third party requester, and only one rejection by the Examiner, based solely on the "best art," for each claim, thereby eliminating any concept of a "representative" rejection.

12. Page 22859, C.2. Final Office Action closes prosecution and triggers appeal rights.

This is a drastic change from the original Inter Partes Reexamination Rules package, where a final action on the merits (FAOM) was instituted to preclude Applicants from the right to appeal any final Office Action in reexamination.

By retaining the current practice, i.e., not permitting a right to appeal based on a final office action and/or twice-rejected claims, the Examiner can conduct a telephone (or personal) inter partes interview to best get the proceeding in condition for appeal by resolving non-prior art patentability issues, reducing or simplifying issues for appeal, setting a realistic briefing schedule for the parties that matches their schedules and workloads and personal commitments, and ensures that the appeal will be in great shape for expeditious handling at the BPAI. The current practice, which includes FAOMs, was designed to leave control of the proceeding before appeal was taken with the examiner to make sure that the proceeding was in the best shape for appeal. I definitely think that the current practice should be maintained.

13. Page 22859 C.3 Third Party Requesters Appellant brief is limited to appealing a decision that a claim is patentable. Additional grounds to cancel a rejected claim can only be argued in a respondent's brief following a patent owner's appellant brief.

As noted above, I would limit the third party to a single rejection of each claim based on a "best prior art" rejection. Only if the Examiner's rejection differs from the third party requester's proposed rejection should a third party requester be permitted to raise different grounds of rejection in a Respondent's brief and then, only if it was part of the third party requester's single "best prior art" proposed rejection.

14. Page 22860 -INVITED COMMENTS

- 1. The USPTO should NOT proceed with just ANY efforts to streamline reexamination practice. They should only proceed with those efforts which also permit a patent owner to address issues that affect their claims other than prior art rejection type issues.**
- 2. The USPTO should DEFINITELY NOT place word limits on requests for reexamination. This is a very shortsighted policy which is inconsistent with requiring a requester to put forth a single best rejection (or SNQ basis) for each claim. moreover, as noted above, third party request SNQ's should be limited to" best prior art" rejections for each patent claim.**
- 3. The USPTO should DEFINITELY NOT have any word or page limits on reexamination proceedings following the filing of a request for reexamination for reasons similar to those set forth above.**
- 4. The USPTO should not place any limitations or criteria on the addition of new claims by a patent owner. A Patent owner cannot broaden the scope of a patent in any way, and should be able to present claims of narrower scope, as they can in reissue (see, for example, the recent Federal Circuit decision in In re Tanaka, for example).**
- 5. The USPTO should retain its existing interpretation of a SNQ.**
- 6. Response times should be tailored to the particular reexamination proceeding and be set after an interview (ex parte in ex parte reexamination proceedings, and inter partes, in inter partes reexamination proceedings). This way, the Board will be presented with the best possible briefs.**

- 7. Durations of extensions should not be set arbitrarily, but should be tailored to the circumstances – and involve a telephone interview to discuss the factors involved, including parties' time commitments in place and what is needed to be done to respond, e.g., tests, obtaining rebuttal evidence, etc. One should not rush to have all briefs filed in an exceedingly fast time frame only to have the Board take years to decide the appeal.**
- 8. IDS practice should consistent in all PTO proceedings, including non-provisional applications, reexam proceedings and reissue applications, and no additional explanations as discussed in this question should be required.**
- 9. Merger should be handled as it has been handled for decades. The basic criterion of overlapping claims in reexamination proceedings and/or reissue applications should control.**
- 10. The USPTO should require that all papers required to be served contain a certificate of service that complies with Rule 248, and also clearly state the date on which the party being served must file any responsive paper - to avoid missed response deadlines.**
- 11. The USPTO should encourage electronic filing of papers, but should not require it.**
- 12. The Board has traditionally had the option of instituting a new ground of rejection on its own, or of remanding the proceeding to the Examining Corps to issue a new ground of rejection. That practice should remain. Unless jurisdiction of handling reexamination proceedings from start to finish is transferred to the Board, all responses to rejections by the Board should be filed with the examining Corps.**
- 13. The USPTO should conduct inter partes interviews in inter partes reexamination proceedings similar to those conducted in preliminary motions conferences held in patent interference proceedings, to set reasonable response times and to work with the parties to streamline the appeal process.**