

Fawcett, Susan

From: Thomas H. Jackson [tjackson@pctlg.com]
Sent: Monday, August 24, 2009 10:47 AM
To: Fawcett, Susan
Subject: 74 FR 39916 - Time required to prepare reexam request and transmittal

Dear Susan:

The time of 18 minutes to prepare either a PTO/SB/57 or 58 does not encompass the entire time required to sufficiently prepare a request for Ex Parte or Inter Partes reexamination because it cannot possibly include the time required to research the status of the patent to be reexamined, including its prior file wrapper history, any litigation the patent has been involved in, the prior art search and research required to determine potential 102 and 103 rejections for a typical patent having at least two independent claims and 15 claims total and their permutations and combinations.

Similarly, once the file wrapper history has been studied, any newly uncovered prior art has to be studied in terms of its cumulative or merely redundant impact on the validity of each claim and its possible combination with prior art already uncovered during the prior prosecution history.

Also, the durations of 40 and 90 hours respectively lose site of the extensive research required to prepare and file claim charts for each patent whose validity is to be challenged based on what combinations of prior art, newly and formerly uncovered. Once the claim chart is prepared, there must be some organization and presentation of coherent arguments made for unpatentability. These supplement the claim charts and provide guidance for the reexamination Examiner.

Prior litigation, foreign prosecution of the patent under potential reexamination and examples of actual predecessor products embodying the patent claims and product literature, existing drawings and specifications for these products must be examined for their potential as written descriptions of the reexamined patent claims. Of course, this product research is more typical in a setting where an accused infringer has relied upon its own products or those of a competitor for taking a position of invalidity.

In one lawsuit involving ex parte examination of six related patents and thirty claims, an expenditure of over six hundred hours was required at all levels of the law firm to prepare the six reexamination requests – or approximately 100 hours each for each ex partes reexamination request. This would have been greater had the six patents under reexamination were not related as continuation and continuation-in-part.

I hope these comments are useful to you. Please do not hesitate to contact us if you require specifics.

Tom

Thomas H. Jackson

PCT Law Group

Main: 202 293 3555

T: 202 293 3559

F: 202 280 1393

Cell: 301 908 3156

Thomas H. Jackson

818 Connecticut Ave. NW | Suite 700 | Washington, DC 20006

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WWW.PCTLG.COM

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