

From: Robin Muthig
Sent: Wednesday, June 29, 2011 4:26 PM
To: reexamimprovementcomments
Cc: Herbert C. Wamsley; Jessica Landacre; Kirsten Zewers
Subject: IPO Comments on Streamlined Patent Reexamination Proceedings

Please see attached comments from Intellectual Property Owners Association.

Best regards,

Robin

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June 29, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Alexandria, VA 22313-1450
Attention: Kenneth M. Schor

Via Email: reexamimprovementcomments@uspto.gov

**RE: Streamlined Patent Reexamination Proceedings, 76 Fed. Reg. 22854
(April 25, 2011)**

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) submits the following comments pursuant to the United States Patent and Trademark Office's (USPTO) request for information on "Streamlined Patent Reexamination Proceedings," published in the Federal Register on April 25, 2011. We thank you for the opportunity to provide our comments.

IPO is a trade association representing companies and individuals in all industries and fields of technology, who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as IPO inventor, author, executive, law firm or attorney members.

Attached to this letter are IPO's comments on the specific issues and questions set forth in the Notice. In considering the public comments in contemplation of making changes in reexamination practice, IPO believes that it is important for the USPTO to keep in mind as an overarching issue the administrative and procedural due process rights of patent owners.

IPO is aware of the statutory "special dispatch" requirement for reexamination proceedings but believes that "special dispatch" should not trump a patent owner's due process rights. IPO urges the USPTO, in reviewing and revising reexamination practice and procedure, to thoroughly consider how existing practice and any proposed changes thereto provide patent owners a full and fair opportunity to protect the valuable patent rights that are at issue. Except when a patent owner files an *ex parte* reexamination request, the patent owner does not ask for its patent to come back before the USPTO for review. A third party requester has, in essence, an unlimited amount of time to prepare its request while the patent owner is confronted with the "special dispatch" requirement once reexamination is granted. IPO recommends that the USPTO provide a reexamination process in which the patent owner has a full and fair opportunity to present its case and respond to the position of the USPTO and any third party requester.

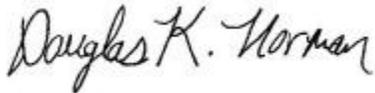
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IPO expresses concern that the concept of “special dispatch” is applied only to the patent owner in a reexamination proceeding and not to the USPTO. It is common that responses to office actions and decisions on petitions take months for the USPTO to issue, yet requests for extensions of time are denied, in part, because of the “special dispatch” requirement. In addition, petitions are denied, in part, because of the “special dispatch” requirement. The “special dispatch” requirement is also invoked to deny entry of amendments and evidence.

The complexity of reexaminations can vary considerably depending on factors, such as the complexity of the technology, the number of claims involved, the amount and nature of the relevant prior art, the number of Substantial New Questions of Patentability (SNQs) requested, and whether the reexamination is *ex parte* or *inter partes*. Thus, the due process which third party requesters and patent owners should be accorded can vary considerably from one reexamination to the next. Patent applications in general present varied complexity. In those cases, the need for a balance of due process and resource demands has been effectively addressed through extensions of time, additional claims, and continued examination.

IPO again thanks the USPTO for this opportunity for public involvement and would welcome any further dialog or opportunity to support the Office on this matter.

Sincerely,

A handwritten signature in black ink that reads "Douglas K. Norman". The signature is written in a cursive, slightly slanted style.

Douglas K. Norman
President

IPO Comments on Specific USPTO Issues and Questions

A. Proposed Changes to Both *Ex Parte* and *Inter Partes* Reexaminations

1. Requester Must Separately Explain How Each SNQ Presented in the Request Is “New” Relative to Other Examinations of the Patent Claims

IPO is in favor of such initiatives that provide clarity to the request for reexamination. IPO suggests that the USPTO provide examples of acceptable and non-acceptable explanations as a guide to practitioners.

2. Requester Must Explain How the References Apply to Every Limitation of Every Claim for Which Reexamination Is Requested

IPO is in favor of such initiatives that provide clarity to the request for reexamination.

3. Requester Must Explain How Multiple SNQs Raised in the Same Request Are Non-Cumulative of Each Other; Cumulative SNQs Will Be Deemed to Constitute a Single SNQ

IPO is in favor of such initiatives that provide clarity to the request for reexamination. Nevertheless, IPO believes that the better practice is not to consolidate SNQs that the agency deems to be cumulative. If the USPTO adopts any proposed SNQ, whether it is believed cumulative or not, the patent owner is still bound to respond. The USPTO should develop a process in which the issue of so-called cumulative SNQs is resolved before the patent owner must respond on the merits.

4. The Examiner May Select One or More Representative Rejections From Among a Group of Adopted Rejections.

IPO believes that an examiner cannot be allowed to select one or more representative rejections from among a group of adopted rejections, because 35 U.S.C. §§ 304 and 313 require the “resolution” of each accepted SNQ. If multiple SNQs are accepted, the rejections based on each SNQ must be resolved according to the statute. Statutory concerns aside, IPO finds it troubling that prosecution essentially starts anew if the patent owner overcomes a “representative rejection,” because the examiner must consider and possibly apply the remaining rejections. In all likelihood, this inefficiency will not lend speed or fairness to the reexamination procedures. Moreover, IPO believes that this provision needs more thought as to whether it actually will “streamline” reexamination practice or simply lead to piecemeal examination. For example, as the notice recognizes, 76 FR 22856, right hand column, the patent owner must appeal from each rejection, not just the representative rejection(s). With that in mind, it is unclear why the patent owner would not want to provide a full response to each rejection from the beginning of the reexamination proceeding. While this proposal may superficially save the USPTO time and resources, it places the patent owner in an untenable position. IPO suggests that the examiner simply refrain from adopting any rejection determined to be cumulative. This would place the parties on an even footing procedurally, as well as provide a written record as to why the USPTO found proposed rejections to be cumulative.

5. Requester's Declaration and Other Evidence Will Be Mainly Limited to the Request

IPO generally believes that this rule will encourage compact prosecution, but the requester should have an opportunity to introduce evidence later in the proceedings if the patent owner or examiner raises one or more issues that were at least reasonably unforeseeable at the time of the original request. The original request cannot possibly include evidence directed to every conceivable issue that might arise during the proceedings. Nevertheless, the requester's right to submit additional evidence should not overshadow the encouragement of compact prosecution.

6. Patent Owner's Amendments and Evidence Will Be Mainly Limited to the First Action Response

IPO believes that this rule is contrary to 35 U.S.C. §§ 304 and 305 which provide patent owners two opportunities to amend their claims during *ex parte* reexaminations. Pursuant to Section 304, the claims may include "any amendment" in the patent owner's optional response, and additional amendments are permissible in later proceedings because Section 305 requires reexaminations to be conducted according to 35 U.S.C. § 132, which allows an applicant "to persist in his claim for a patent, with or without amendment." Section 132 also applies to *inter partes* reexaminations, pursuant to 35 U.S.C. § 314. IPO believes that this rule may be unfair to patent owners because it will be difficult, if not impossible, to anticipate the amendments or evidence necessary to overcome substantive arguments that may not arise until later in the proceedings—a problem that many patent owners will face if they overcome a "representative rejection." IPO asks that any changes the USPTO makes provide a patent owner with a full and fair opportunity to respond to any argument or evidence provided by a third party requester, including the opportunity for the patent owner to provide any amendment or evidence seen as necessary to rebut the third party requester's submission.

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 a SNQ

IPO believes that this rule, if applied in an overly strict manner, will be at odds with the plain language of 35 U.S.C. §§ 304 and 314. Section 304 does not require claim amendments in a patent owner's optional statement to be directed to a SNQ; instead, the patent owner may introduce "any amendment...and new claim or claims he may wish to propose." Similar language in Section 314 allows patent owners to do the same in *inter partes* reexaminations, as long as "no proposed amended or new claim enlarg[es] the scope of the claims." If an amendment does not broaden a claim's scope, the amendment is acceptable under Sections 304 and 314 regardless of whether it addresses a SNQ. Because, however, SNQs are the focus of reexaminations, IPO would be in favor of a rule that prevents the proceedings from becoming a *de facto* reissue. Nevertheless, such a rule must protect the patent owners' statutory right to amend the claims in any non-broadening fashion in order to overcome the rejections. IPO suggests that the USPTO provide examples of non-conclusory statements that would be acceptable.

8. *Petitions Practice Will Be Clearly Defined*

IPO appreciates the much needed clarification. In addition, IPO believes that it would be helpful for the USPTO to explain which petitions are decided by the Central Reexamination Unit (CRU) and which are decided by the Office of Petitions. IPO believes that the USPTO should consider consolidating consideration of all petitions in reexamination proceedings in a single organizational unit, preferably outside of the CRU. The decision of petitions outside of the CRU will provide a check and balance in the process and should eliminate second and third petitions.

IPO also appreciates the helpful examples of petitions filed in reexamination proceedings and the guidance concerning the rules under which each petition should be filed. IPO believes that current petition practice causes undue delays. Telephonic hearings, like those in interference proceedings, could be used to resolve procedural issues (*e.g.*, page or word limits).

Petition practice also delays resolution of the reexamination proceedings on the merits. Petitions should be resolved in a timely manner, and the resolution should include a clear statement of reasoning. It would be helpful if a petition resolution estimate would be included on Patent Application Information Retrieval (PAIR), so that interested parties would have an idea of when a petition decision will be issued.

Finally, it is essential that a petition to transfer jurisdiction to the Office of Patent Legal Administration (OPLA) be made available to both parties. In many instances, OPLA is needed to ensure that reexamination proceedings are done in accordance with proper MPEP rules and procedures, thereby upholding both parties' rights to due process. A dedicated position should be created at OPLA specifically for reexamination with the authority to resolve petitions filed under 37 C.F.R. §§ 1.182 and 1.183. With this solution, petitions would be handled uniformly and in a timely manner.

B. Proposed Changes Specific to *Ex Parte* Reexamination

1. *Make Permanent the Pilot That Allows the Patent Owner to Optionally Waive the Patent Owner's Statement, and*

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 Action*

IPO again urges that patent owners' due process rights be protected. It is especially important that before any office action is made final, there is no shift in the USPTO's position or adoption of a third party requester's argument and/or evidence that warrants a rebuttal by a patent owner by way of amendment and/or evidence. IPO believes that these proposals would force efficiency at the expense of patent owner rights. Additionally, enactment of these proposals would likely be prohibited by statute. Specifically, 35 U.S.C. § 305 states that "after the times for filing the statement and reply ... have expired, reexamination will be conducted. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto." Under the current proposals, reexamination would effectively begin prior to the expiration of the times for filing a statement and a reply. If the

patent owner refuses to waive the statement and does not file a statement in response to the provisional action, the patent owner then would lose the statutory right to propose an amendment, add claims, or introduce evidence in the face of a subsequent final action.

As an alternative solution, the USPTO might consider shortening the statutory response period, for example from two months to one month, when the patent owner refuses the waiver. With such a solution, the patent owner would retain its statutory right to amend and submit evidence and the overall pendency for *ex parte* reexaminations would be shortened.

C. Proposed Changes Specific to *Inter Partes* Reexamination

1. Third Party Requester May Dispute the Examiner's Designation That a Rejection is "Representative" of Other Rejections in the Group

As set forth previously in our comment regarding section A(4) of the notice, IPO has concerns whether this initiative actually will save time and resources or just create another round of correspondence and controversy. As previously described, IPO believes that 35 U.S.C. §§ 303 and 314 prohibit examiners from selecting a "representative rejection." If "representative rejections" are allowed, however, IPO favors any rule, such as this one, that aids the examiner in selecting a rejection that is the most "representative."

2. Final Office Action Closes Prosecution and Triggers Appeal Rights

IPO believes that a patent owner must be provided with a full and fair opportunity to respond to the third party requester's position and any shift in the USPTO's position, including by way of amendment and/or evidence.

3. Third Party Requester's Appellant Brief is Limited To Appealing An Examiner's Decision That a Claim is Patentable; Additional Bases To Cancel A Rejected Claim Can Only Be Argued in a Respondent Brief Following Patent Owner's Appellant Brief

IPO believes 35 U.S.C. § 315(b)(1) is controlling in this situation. The statute authorizes the third party requester to independently appeal "any final decision favorable to the patentability of any original or proposed amended or new claim of the patent." Thus, a third party requester's appellant brief should be limited to challenging a final determination favorable to the patentability of any claim of the patent. Only after a patent owner files an appeal brief arguing against a rejection should a third party requester have the opportunity to argue against the position of the patent owner. Such practice would be consistent with the courts' practice of not permitting cross appeals.

D. Comments on Specific Questions

The USPTO has requested comments on 13 specific questions as follows:

1. *Should the USPTO proceed with any efforts to streamline the procedures governing ex parte and/or inter partes reexamination proceedings?*

Yes, IPO believes the USPTO should proceed with efforts to streamline reexamination proceedings. Nevertheless, these efforts must balance the goal of providing expeditious and efficient reexamination with the due process rights owed to patent owners and the fundamental fairness owed to all parties.

2. *Should the USPTO place word limits on requests for ex parte and/or inter partes reexamination?*

IPO expresses concern that current requests can be quite lengthy, yet not be informative. Proposed rejections are often conclusory statements based upon claim charts and do not provide a well-reasoned statement as to why a given claim is believed to be unpatentable. Such statements of rejection, when adopted by the examiner without any further explanation, place an onerous burden on the patent owner to provide a full response as the precise facts and reasons relied upon in support of the rejection. Nevertheless, because patents may vary in scope and complexity, IPO notes that a universal word limit on requests for reexamination may unfairly restrict a requester's ability to present its SNQ statement(s). IPO suggests that any word limits placed on reexamination requests be based on the number of SNQs presented and/or the number of claims for which reexamination is requested.

3. *Should the USPTO revise its existing page or word limits in inter partes reexamination following the request?*

IPO strongly believes that the USPTO needs to provide a realistic page or word limit in each office action. Office actions can be superficially short because the examiner adopts and incorporates by reference the proposed rejections set forth in the request. Setting realistic limits from the beginning will provide the patent owner with a fairer process and reduce the need for petitions. Submissions by either party in *inter partes* reexamination currently are limited to 50 pages of substantive comment under 37 C.F.R. § 1.943. IPO believes that any revision of this limit to streamline reexamination proceedings must be realistic and ensure fairness to all parties. For example, word or page limits may be based on the number of SNQs presented or the number of claims subject to reexamination.

4. *Should the USPTO place any limitation or criteria on the addition of new claims by a patent owner in reexamination? If so, what kind of limitation or criteria?*

In response to an order for *ex parte* reexamination, a patent owner's statement may contain "any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination." (35 U.S.C. § 304). Similarly, in an *inter partes* reexamination, the patent owner may "propose any amendment to the patent and a new claim or claims." (35 U.S.C. §

314). These statutory provisions are subject only to prohibitions against enlarging the scope of the patent. (35 U.S.C. §§ 305 and 314). Limitations or criteria restricting the addition of new claims, *e.g.*, requiring that new claims be addressed to the prior art cited or the SNQs, may run afoul of the statute. Accordingly, IPO believes that the USPTO should not place additional limitations on the patent owner’s statutory right to present new claims during reexamination.

5. *Should the USPTO change its interpretation of “a substantial new question of patentability” to require something more than “a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable”?* See MPEP §§ 2242, 2642. *If so, how should it be interpreted?*

IPO believes that interpreting “a substantial new question of patentability” to require something more than the current guidelines set forth, such as a showing of *prima facie* unpatentability or materiality as defined in 37 C.F.R. § 1.56, would place an unduly high burden on third party requesters and diminish the value of reexamination proceedings as an alternate avenue for dispute resolution. Elaboration and/or clarification of the guidance provided in MPEP §§ 2242 and 2642 on the meaning and scope of the term “substantial new question of patentability” would provide all parties with clearer expectations for the reexamination process.

6. *How much time should patent owners and third party requesters ordinarily be given to submit a statement, response, or appeal where the time for filing the statement, response, or appeal is set by the USPTO rather than by statute?*

IPO believes that a minimum time of two months is reasonable, provided that extension of time practice is reasonable. Reasonable grounds for an extension of time should include, but not be limited to location of a party overseas, need for translations, need for test data, and mailing date of office action near the December/January holiday season. Additionally, in special cases where a third party requester presents an excessive (greater than five) number of SNQs, the patent owner should be given additional time for response. This is based on the notion that the third party requester has virtually unlimited time to prepare for the filing of a reexamination, and fairness would suggest that the patent owner should be given an increased amount of time for response when presented with an extremely voluminous reexamination proceeding. IPO further suggests that extension of time practice should be reviewed, so that requests for an extension of time are granted or denied in a timely manner.

7. *Under what conditions should the USPTO grant a patent owner’s request for an extension of time under 37 CFR 1.550(c) or 1.956, both of which provide that extensions of time may only be granted for “sufficient cause and for a reasonable time specified”?*

IPO believes that the USPTO should not adopt hard and fast rules in regard to this issue. IPO believes that the USPTO should interpret liberally the “sufficient cause and for a reasonable time specified” standard for granting the patent owner’s request for an extension of time. Pursuant to 37 C.F.R. §§ 1.550(d) and 1.957(b), if the patent owner fails to file a timely response, the prosecution is terminated, and a certificate is issued concluding the reexamination proceeding in accordance with the last action of the Office. A petition to revive the prosecution may be granted if the delay in filing a response is shown to be unavoidable or unintentional. (37 C.F.R.

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§§ 1.550(e) and 1.958). Accordingly, patent owners' due process rights may be at risk if the standard for granting requests for extensions of time is too strictly applied. IPO believes that requests of short extensions when the owner makes a showing of reasonable diligence toward meeting the deadline should rise to the level of "sufficient cause and for a reasonable time specified." Additional factors, such as the number of claims under review, the number of pending rejections and their nature, whether the patent is involved in litigation, and the number of related patents that are concurrently undergoing reexamination, also should be considered in the sufficiency and reasonableness analyses.

8. *Should the USPTO require that any information disclosure statement (IDS) filed by a patent owner in a reexamination comply with provisions analogous to 37 CFR 1.97 and 1.98, and further require that any IDS filed after a Notice of Intent to Issue a Reexamination Certificate (NIRC) or notice of appeal be accompanied by: (1) an explanation of why the information submitted could not have been submitted earlier, and (2) an explanation of the relevance of the information with regard to the claimed invention?*

The parties listed in Section 1.56 continually discover art that may be material and non-cumulative to previously filed applications or issued patents. These references must be disclosed during reexaminations, pursuant to 37 C.F.R. §§ 1.555 and 1.933, and patent owners should not be burdened with explaining the timing or relevance of the submission. To the extent the Office is considering changes to Section 1.56, IPO suggests that the Office consider any changes to rules involving compliance with Section 1.56 in reexamination in conjunction with those changes to Section 1.56 or defer any changes to rules involving compliance with Section 1.56 in reexamination until any change to Section 1.56 is finalized.

9. *Under what conditions should a reexamination proceeding be merged with another reexamination or reissue proceeding?*

IPO is of the opinion that redundant reexamination proceedings should be merged when they present repetitive SNQs. In the alternative, a single reexamination proceeding should be conducted while the other reexamination proceedings are stayed. All merger decisions should be determined by OPLA. The overwhelming policy consideration should be to avoid inconsistent and possibly conflicting resolutions between multiple redundant reexamination proceedings. Additionally, USPTO resources would be conserved when multiple reexaminations may be merged into a single proceeding. In cases in which an *inter partes* reexamination is to be merged with either an *ex parte* reexamination or reissue, it is essential that the rights of the third party requester be preserved in the merged proceeding.

10. *What relief can and should be given to a third party requester that shows that it did not receive a patent owner's statement or response within a certain number of days after the date listed on the patent owner's certificate of service? How many days and what kind of showing should be required?*

Pursuant to 37 C.F.R. § 1.903 and 35 U.S.C. § 314(b)(2), in an *inter partes* reexamination, any response filed by the patent owner must be served on the third party requester which then must file its written comments within 30 days. If the patent owner's response is received by the third

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party requester more than five business days after the date of service stated on the certificate of service, MPEP § 2666.06 provides that the third party requester may submit a verified statement, specifying the date of actual receipt, with his/her written comments. “The date of service will then be deemed by the Office to be the date of actual receipt by the Third Party Requester of the patent owner’s response.” IPO believes that the current delay and showing requirements are fair and reasonable.

11. *Should the USPTO encourage and/or require that all correspondence in reexamination proceedings be conducted electronically (e.g., e-filing parties’ documents, e-mailing notices of Office actions and certificates)?*

IPO believes the USPTO should encourage parties to conduct all correspondence in reexamination proceedings electronically, but not require it. Financial incentives for filing correspondence electronically, such as those provided for electronic trademark application filings in 37 C.F.R. § 2.6, could be implemented.

12. *Should reexamination proceedings remain with the Board in cases where the Board has entered a new ground of rejection on appeal and the patent owner seeks to introduce new evidence and amendments? In particular, is it more efficient for three administrative patent judges or a single examiner to decide issues involving new evidence and amendments?*

IPO is of the opinion that a one size “solution” will not fit all cases. Sometimes, it may be more efficient to go back to the examiner and other times it will not be efficient. Allowing the Board the authority to make the choice whether to stay with Board or send proceeding back to examiner may be a more flexible and manageable solution.

13. *What other changes can and should the USPTO make in order to streamline reexamination proceedings?*

a. Treat *ex parte* and *inter partes* reexaminations as completely separate in any new rules because there are dramatically different estoppel effects and procedural issues between the two types of proceedings.

b. Consider separate rules for *ex parte* reexaminations by the patent owner vs. *ex parte* reexaminations by the third party requester. A good reason for separate rules for the patent owner's requests is that it would permit the USPTO to reuse the best parts of the rules for accelerated examination in handling patent owner initiated reexaminations.