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BY EMAIL TO: Post_Patent_Provisions@USPTO.gov
And Preissuance_Submissions@USPTO.gov

Mail Stop Comments-Patents
Commissioner for Patents
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Attention Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

And
Nicole D. Haines
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

Re: "Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act," 77(3) Fed. Reg. 442-448 (Jan. 5, 2012)
And
"Changes to Implement the Preissuance Submissions by Third Parties Provisions of the Leahy-Smith America Invents Act," 77(3) Fed. Reg. 448-457
(Jan. 5, 2012)

Dear Sir and Madam:

Please consider these comments with respect to the referenced Federal Register Notices. These comments are being provided by me in my personal capacity. I am not providing these comments as a Vedder Price, PC shareholder, or as adjunct faculty of the Polytechnic Institute of New York University, or with respect to any clients of my firm or as to any other organizations with which I am associated. Please confirm receipt of these comments. Thank you.

1. Proposed 37 CFR § 1.501(a) Continues to
Use a Term NOT Defined In the Rules
And the MPEP Incorrectly Defines the Term

1.1 Present & Proposed Rule 501 IS NOT Limited to Issued Patents

Section 301 of present Title 35 reads in pertinent part: “Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent.” 35 USC § 301. Section 301 of the Patent Act under the America Invents Act (“AIA”) is similarly worded.

Current Rule 501 reads in pertinent part: “At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. ... Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.” 37 CFR § 1.501. Proposed Rules 501(a) and (c) read similarly.

At the outset, it is respectfully submitted that Rule 501, and proposed Rule 501(a) and (c) are inconsistent with Section 301 of the Statute and Section 301 of the Patent Act under the AIA.

For instance, Section 301 of the present Statute (35 USC) and Section 301 of the Patent Act under the AIA do not contain the exceptions to entering submissions into the patent file that are set forth in present Rule 501 and proposed Rules 501(a) and (c) (and 37 CFR §§ 1.502 and 1.902 by reference thereto in present Rule 501 and proposed Rule 501(c)). That is, the language making certain submissions subject to the provisions of Rules 502 and 902 does not have basis in either current Section 301 of the Statute or Section 301 of the Patent Act under the AIA.

Further, Section 301 of the present Statute and Section 301 of the Patent Act under the AIA do not contain the language, “during the period of enforceability of a patent.”

Thus, to the extent that the Office construes the term “period of enforceability” to mean only six years after expiration of a patent (see MPEP § 2204), I likewise submit that Section 301 of the current Statute and Section 301 of the Patent Act under the AIA do not contain that limitation.

For example, if I have prior art consisting of patents or printed publications pertaining to the patentability of a claim of a patent now expired more than six years, the current Statute and the Patent Act under the AIA permit me to file that prior art with the Office and have it become part of the official file of the patent.

Accordingly, since 35 USC § 2 authorizes the Office to establish regulations not inconsistent with the law, and I submit that on its face present Rule 501 and proposed Rules 501(a) and (c) are inconsistent with present Section 301 of the Statute and Section 301 of the Patent Act under the AIA. Therefore, I respectfully submit that for present Rule 501 and the proposed Rules 501(a) and (c) to be lawful, these Rules must be based on more than Section 301 of the Statute. At 77(3) Fed. Reg. 447 (Jan. 5, 2012), the Office cites Section 2(b)(2) of the Patent Act as authority for its proposed Rules 501(a) and (c).

Section 2 of the Statute authorizes the Office to establish regulations that “shall govern the conduct of proceedings in the Office” and “shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched ...”

Because present Rule 501 and proposed Rules 501(a) and (c) are inconsistent with Section 301 of the Statute and Section 301 of the Patent Act under the AIA, present Rule 501 and proposed Rules 501(a) and (c) also have to be promulgated under the Office’s authority to establish regulations concerning the conduct of proceedings in the Office and the processing, including searching, of patent applications.” Initially, therefore, on this basis, I have respectfully interpreted present Rule 501 and proposed Rules 501(a) as not limited to only issued patents.

Indeed, my interpretation of the present and proposed Rules 501 and 501(a)—namely, that these Rules ARE NOT limited to only issued patents because of the Office’s use of the undefined term “period of enforceability”—is wholly consistent with the true meaning of the undefined term, “period of enforceability.”

1.2 The “Period of Enforceability” IS NOT Limited To Post-Grant

The Federal Circuit has made it clear that while the Office is bound by the MPEP, the MPEP is not law, i.e., it is NOT binding on practitioners and parties practicing before the Office. See, e.g., *Regents of the University of New Mexico v. Knight*, 321 F.3d 1111, 1121, 66 USPQ2D 1001 (citing *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995)).

Therefore, it is respectfully submitted that to understand what is the “period of enforceability”, one must look to the Statute (i.e., Title 35 of the United States Code), the Rules (i.e., Title 37 of the Code of Federal Regulations), the Federal Circuit Case Law, and also scholarly literature. To simplify matters, the term, “period of enforceability” is, to my knowledge, NOT defined in the Statute or the Rules.

However, 35 USC § 154(d) provides “the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application ... (A) (i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States;

or (ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and (B) had actual notice of the published patent application ...”

Based upon Section 154(d) of the Statute, I have interpreted the “period of enforceability” as beginning with publication of the patent application, and hence present Rule 501 and proposed Rule 501(a) as not limited to only issued patents. I respectfully submit that this interpretation of the “period of enforceability” is also consistent with Federal Circuit Case Law.

For example, in *Stephens v. Tech Int'l, Inc.*, 393 F.3d 1269, 73 USPQ2d 1369 (Fed. Cir. 2004), the plaintiffs, Stephens and Spectrum Laboratories (collectively “Spectrum”) appealed the District Court Order granting the defendants’ (collectively “Tech’s”) motion for attorney’s fees under 35 USC § 285. The District Court had found the case exceptional, in part, based on Spectrum’s 35 USC § 154(d)(1) notification regarding a separate patent application being litigation misconduct. The Federal Circuit held that it was NOT an error for the District Court to have considered whether Spectrum’s Section 154 notification was litigation misconduct. Accordingly, I have respectfully interpreted the Federal Circuit’s *Stephens* decision—case law that has the force of law (as opposed to the MPEP, see *Regents of the University of New Mexico; Molins*)—as illustrating that the “period of enforceability” begins with publication of a patent application.

I have also researched the scholarly literature and cite Daulton et al, “Examining Provisional Rights: Some Observations Regarding Practice Under 35 USC § 154(d),” available online at www.merchantgould.com/CM/Articles/articles-66.doc. The authors there submit that a patent applicant issuing a Section 154 notification can be subject to liability with respect to the notice, including subject to a Declaratory Judgment action when the Office allows claims of the patent application that is the subject of the Section 154(d) notice because at the time such claims are allowed there is a sufficient case and controversy between the patent applicant and the party upon whom the Section 154(d) notice was served. In that light, I respectfully also submit that a Section 154(d) notice is patent enforcement, and hence the “period of enforceability” begins with when such a notice may be issued; namely, upon publication of a patent application.

Therefore, in view of the foregoing, in my practice, I have interpreted the “period of enforceability” in present Rule 501 as beginning with publication of a patent application. I also believe that the “period of enforceability” in proposed Rule 501(a) can be interpreted as beginning with publication of a patent application. I further respectfully submit that this interpretation has been and will be reasonable in view of a 35 USC § 154(d) notice being patent enforcement under reasonable interpretations of Federal Circuit Case Law and scholarly literature. I yet further respectfully submit that the non-binding MPEP definition of the term, “period of enforceability,” is incorrect. I also submit that if proposed Rule 501(a), by its use of the term, “period of enforceability,” allows for the citation of prior art patents and publications from the publication of an application,

then proposed Rule 501(a) will run counter to 35 USC § 122(e) as amended by the AIA (and the Rules proposed to implement Section 122(e) of the Patent Act under the AIA).

Accordingly, I yet further respectfully submit that in view of how the term, “period of enforceability,” can be interpreted under the law, i.e., as beginning from the publication of a patent application, and in view of the need for the public to cite prior art patents and publications in a post-allowance, pre-grant patent application, the term, “period of enforceability,” should be actually defined in the Rules (and not left to being merely discussed in the non-binding MPEP). I further submit that the term should be defined as beginning with the issuance by the Office of a Notice of Allowance because at that point prosecution on the merits is closed.

1.3 I Have Filed Pre-Grant Rule 501 Submissions

The Electronic Filing System (“EFS”) permits the filing of post-allowance, pre-grant Rule 501 submissions. In good faith, without any intention of engaging in conduct prejudicial to the administration of justice, or conduct adversely reflecting on my fitness to practice, or conduct that constitutes a violation of the provisions of 37 CFR § 10.18, or conduct that is the handling of a legal matter without adequate preparation, I have filed post-allowance, pre-grant Rule 501 submissions.

More in particular, and as an example, in the course of representing patent applicants before the Office, I have filed post-allowance, pre-grant Rule 501 submissions, i.e., in cases where I am the attorney of record I have filed post-allowance, pre-grant Rule 501 submissions. In this regard, I note that I filed a post-allowance, pre-grant Rule 501 submission in US application Serial No. 10/351,938 on March 9, 2010, when I was the attorney of record in that case.

Without commenting specifically on the aforementioned exemplified application where I filed a post-allowance, pre-grant Rule 501 submission, I submit that post-allowance, pre-grant Rule 501 submissions have occurred when it becomes discovered, after allowance, that there is prior art that is not but-for material to the allowed claims but that prior art had been cited more than three months earlier in a corresponding foreign application. In such cases there is a desire to ensure that the prior art is in the public record, e.g., so no one in the future may make the false accusation that there was an intention to hide the foreign-cited prior art. However, in such cases it would also waste the patent applicant’s and the Office’s resources to file an Request for Continued Examination (“RCE”) to have the foreign-cited prior art formally of record. That is, I have filed post-allowance, pre-grant Rule 501 submissions to promote economy and “inform ... the public in general that such patents or printed publications are in existence and should be considered when evaluating the validity of the patent claims” as well as to “ensure consideration thereof during any subsequent reissue or reexamination proceeding” (see MPEP § 2202).

Following from being the attorney of record in the patent application and based on the foregoing interpretation of the “period of enforceability”, the Federal Circuit Case Law, especially under 35 USC § 154(d), and the scholarly literature, also especially as to 35 USC § 154(d), I have filed a Rule 501 submission in a case of a third party, namely, on October 21, 2011 in US application Serial No. 12/360,635.

In that case, following the filing of the Rule 501 submission, the applicant filed an RCE with what appears to me to be an Information Disclosure Statement citing a multitude of documents—in addition to the two documents that I cited in that October 21, 2011 Rule 501 submission (but interestingly not the Rule 501 submission itself). Accordingly, I respectfully submit that my October 21, 2011 Rule 501 submission in US application Serial No. 12/360,635 was entirely accurate (for why else would the applicant have filed the RCE citing, amongst other documents, the two I cited?).

Accordingly, I submit that it is not uncommon for third parties to communicate with the USPTO when the Office issues a Notice of Allowance, and that there should be express accommodation for such communications, as part of Rule 501.

1.4 *Radio Systems Corp. v. Accession, Inc.*, 638 F. 3d 785 (Fed. Cir. 2011)

In *Radio Systems Corp. v. Accession, Inc.*, 638 F. 3d 785 (Fed. Cir. 2011), patent counsel for Accession, after allowance and before grant of Radio Systems’ patent application, engaged in an *ex parte* telephonic communication with the Examiner that resulted in prosecution being re-opened. The Federal Circuit did not even drop a footnote that such conduct was improper, and as reported at <http://www.patentlyo.com/patent/2011/04/ex-parte-contact-with-uspto-examiners.html>, in its brief, Accession rebutted any argument that its attorney had done anything wrong, stating that:

Nothing in the record could establish that the Patent Office considered Accession's contacts to be "wrongful." Indeed, after the first contact, a voicemail left by Accession's counsel with the patent examiner, the Patent Office reached out to Accession's counsel and subsequently took action it believed appropriate. That action did not include sanctions against Accession. There is nothing in this record (or elsewhere) suggesting that the Patent Office found Accession's counsel's actions to have violated any rule, policy, or law. Further, the record demonstrates that the sole purpose of the contacts was to alert the Patent Office to the fact that the Radio Systems pending application was deficient.

Accordingly, under *Radio Systems*, I submit that it is not uncommon for third parties to communicate with the USPTO when the Office issues a Notice of Allowance, and that the Federal Circuit, at least *sub silentio*, has not found there to be any issue with such

post-allowance, pre-grant communications.¹ However, as I believe that such communications should not be telephonic or *ex parte*, I further believe there should be express accommodation for third party post-allowance, pre-grant submissions of prior art patents and publications, as part of Rule 501, consistent with the term, “period of enforceability.”

1.5 Post-Allowance, Pre-Grant Submissions Serve Everyone Well

I believe that third party post-allowance, pre-grant submissions serve everyone—namely, the Office, patent applicants, and third parties—well, and should be explicitly provided for in Rule 501. While I am not proceeding with further post-allowance, pre-grant Rule 501 submissions in pending applications of third parties, until the Rules are clarified, I believe that Rule 501 should explicitly provide for third party post-allowance, pre-grant Rule 501 submissions, and am making this submission to work with the Office on a revised Rule 501 that either clarifies the situation whereby the Rule explicitly prohibits third parties from filing Rule 501 submissions after allowance and before grant, or explicitly permits the filing by third parties of concise Rule 501 submissions after allowance and before grant.

In this regard, I very respectfully submit that explicit permission to file concise Rule 501 submissions post-allowance and pre-grant indeed serves the administration of justice. Such submissions by the patent applicant allow the patent applicant to place into the record prior art that is not but-for material that may have been cited either in the text of the application itself or in the prosecution of a corresponding foreign case, without burdening the Examiner with having to consider such not but-for material prior art, so as to “inform ... the public in general that such patents or printed publications are in existence and should be considered when evaluating the validity of the patent claims” as well as to “ensure consideration thereof during any subsequent reissue or reexamination proceeding” (see MPEP § 2202).

Moreover, such submissions by a third party, as I did in US application Serial No. 12/360,635, allow the patent applicant to consider the patents or printed publications prior to issuance of the patent, and take appropriate action, such as filing an RCE, thereby avoiding costs to the patent applicant and the Office of supplemental examination, reissue or reexamination proceedings, while also “inform[ing] ... the public in general that such patents or printed publications are in existence and should be considered when evaluating the validity of the patent claims” as well as “ensur[ing] consideration thereof during any subsequent reissue or reexamination proceeding” (see MPEP § 2202) or supplemental examination.

¹ I therefore respectfully submit that under *Radio Systems* there also should be no issue with respect to the post-allowance, pre-grant Rule 501 submission I made in a third party application.

Furthermore, I respectfully submit that the foregoing illustrates that a reasonable interpretation of the “period of enforceability” under the Federal Circuit Case Law and the scholarly literature can support the Office accepting concise third party post-allowance, pre-grant Rule 501 submissions.

Further still, after allowance, prosecution on the merits is closed. Accordingly, the Office accepting concise third party post-allowance, pre-grant Rule 501 submissions does NOT place any burden on the Office as the Examiner is NOT obliged to consider such submissions but may if inclined (see, e.g., USPTO OG Notice 22 April 2003 available at <http://www.uspto.gov/web/offices/com/sol/og/2003/week16/og200316.htm> under which the Office is not obliged to consider third party submissions, but may re-open prosecution if information is deemed relevant to patentability; see also <http://www.patentlyo.com/patent/2011/04/third-party-attempts-to-protest-or-otherwise-oppose-the-grant-of-a-published-application.html> (discussing *Radio Systems* and the USPTO OG Notice)).

Therefore, the Office accepting concise third party post-allowance, pre-grant Rule 501 submissions does not place any burden on the Office.

Moreover, the Office accepting concise third party post-allowance, pre-grant Rule 501 submissions does not run afoul of Section 122(e) of the Patent Statute under the AIA (or the present patent statute) because the Examiner is not obliged to consider such third party post-allowance, pre-grant Rule 501 submissions.

Further, everyone—the Office, patent applicants, and the public—benefits from the Office accepting third party concise post-allowance, pre-grant Rule 501 submissions.

The EFS permits patent applicants to make pre-grant Rule 501 submissions in their own applications, and thus the Office is already able to receive pre-grant Rule 501 submissions. (And the Office can treat applicant-submitted and third party submitted post-allowance, pre-grant submissions similarly, i.e., have them in the record, but not consider them unless inclined to so do because the document(s) cited therein are indeed relevant to patentability.)

Thus, as the Office is already able to receive pre-grant Rule 501 submissions, and the Office accepting concise third party post-allowance, pre-grant Rule 501 submissions does not burden the Office, does not run afoul of Section 122(e) of the Patent Statute under the AIA (or the present patent statute), and is in everyone’s best interests, Rule 501 should explicitly define “period of enforceability” and in such a way so as to provide for post-allowance, pre-grant third party submissions.

1.6 Proposed Rule 501(g)

In view of the foregoing, it is respectfully submitted that the Office should include in Rule 501 (37 CFR § 1.501) a subsection (g) which defines the term, “period of

enforceability”—so that there is something from the Office that has the force of law, namely a Rule, that defines this term.

I further respectfully submit that the definition for “period of enforceability”, and hence herein proposed Rule 501(g), should read, “The term ‘period of enforceability’ in subsection (a) (37 CFR § 1.501(a)) begins with allowance or the closing of prosecution on the merits of a pending patent application and continues through grant of the patent therefrom to six years after expiration of the patent.”

This proposed Rule 501(g) will allow the “period of enforceability” to be a term that is defined in the Rules, consistent with the Law as discussed above, and will facilitate the orderly filing of third party post-allowance, pre-grant Rule 501 submissions.

2. Minor Revision to the Proposed Pre-Issuance Submission Rules
And Considering Practical Realities, including the European Experience
Obviates Concerns of Third Party Submissions Being Voluminous or Harassing

2.1 The European Experience

The European Patent Office (“EPO”) has permitted the filing of Third Party Observations, including electronically, and in my experience I am not aware of any issues of such submissions being voluminous or harassing.

Simply, I submit that the reality is that third parties usually do not excessively file observations, i.e., that third party observations are typically not voluminous or harassing. This is because third parties tend to not file excessive or voluminous or harassing observations before the EPO because third parties do not want to prejudice their position in post-grant opposition or litigation proceedings.

I respectfully submit that in the US, third parties will also tend to file pointed Pre-Issuance Submissions because they do not wish for their observations to possibly prejudice future post-grant review or litigation.

Accordingly, I respectfully submit that from the European experience, the concerns of needing to protect applicants that are expressed in the Federal Register Notice, including as to electronic filing, are not based in the realities actually experienced by other patent offices, such as the EPO, that have experience in Third Party Observations.

2.2 Proposed Rule 290(d)(2) Should be Revised

To ensure that third party submissions are not too voluminous and that these submissions are on point, as well as to address the concerns of protecting Applicants, it is suggested that proposed 37 CFR § 1.290(d)(2) include the phrase: “including the but-for materiality of each listed document or the combination(s) of listed documents,” i.e.,

that Rule 290(d)(2) read, “A concise description of the asserted relevance of each listed document, including the but-for materiality of each listed document or the combination(s) of listed documents” (suggested text underlined).

As applicants should comply with “but-for materiality” test of the Federal Circuit’s decision in *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F3d 1276 (Fed. Cir. 2011) in citing art to the Office, and the Court’s desire to eliminate the practice of patent prosecutors disclosing too much of marginal relevance, see, e.g., 76 Fed. Reg. 43631 (July 21, 2011), it follows that third parties making pre-issuance submissions also should be obliged to comply with the but-for materiality test of *Therasense*.²

Obliging third parties making pre-issuance submissions to comply with the but-for materiality test of *Therasense* will ensure that third parties do not cite “everything and the kitchen sink” in Pre-Issuance Submissions. That is, obliging third parties making Pre-Issuance Submissions to comply with the but-for materiality test of *Therasense* will ensure that third party pre-issuance submissions are not too voluminous or harassing.

3. Minor Revision to the Proposed Pre-Issuance Submission Rules Obviates Concerns of the Proposed Rules Being Inconsistent With Rule 56

3.1 Proposed Rule 290(h) Should be Revised

It is suggested that Rule 290(h) (37 CFR § 1.290(h)) should specify: “Nothing in this Rule relieves an applicant and other parties relevant to the application (see 37 CFR § 1.56(c)) from ensuring that they have taken reasonable steps to have the Office consider and make of record but-for material documents and information, and that the claims advanced are patentable over but-for material documents and information.”

While it is understood that the Office wants to make it clear that an applicant has no duty to reply to a third party Pre-Issuance Submission, Rule 290(h) should make it clear that the applicant and persons relevant to the application are not relieved of their duties under Rule 56 (37 CFR § 1.56).

Moreover, the Office is composed of humans who may, from time-to-time, make errors. Assume, for example that a third party makes a submission and the Examiner

² Both patent applicants and third parties should be advised by a US registered agent or attorney as to what is “but-for material” and not rely on the advice of someone not registered to practice before the USPTO, such as a foreign patent agent, so as to preserve privilege as “but-for materiality” is a US issue. See, e.g., *Odome v. Croda International PLC*, 950 F. Supp. 10 (D.DC 1997) (UK patent agent inventorship determination not privileged as patent application filings “touched base” in the US). It is respectfully submitted that the Office should issue a Notice advising the public that it should not seek or receive the advice of persons not registered to practice before the USPTO with respect to US patent issues, including “but-for materiality” and patentability, because of the danger of such advice being non-privileged and subject to discovery in the event of US litigation.

erroneously fails to properly consider that which has been cited by the third party, and erroneously allows a claim over the but-for material document(s) cited by the third party. The applicant and parties relevant to the application should ensure that the claims are indeed patentable, and not possibly try to hide behind the wording of presently proposed Rule 290(h).

In other words, it is respectfully submitted that presently proposed Rule 290(h) may seem to introduce ambiguity into the duties under Rule 56 of the applicant and the persons relevant to the application; and, it is herein proposed that such an ambiguity be clarified by language as suggested above.

* * *

The Office is thanked for its consideration of these personal comments.

Respectfully submitted,

/Thomas J. Kowalski/

Thomas J. Kowalski, Reg. No., 32,147