

From: Thomas A. Ward [e-mail address redacted]
Sent: Wednesday, December 28, 2011 5:00 PM
To: aia_implementation
Subject: Inter Partes Reexamination - Claim Amendments Requiring New Search

Dear Sir/Madam:

To help meet the 12 month deadline for completion of Inter Partes Reexamination (IPR), I recommend that if a claim amendment is made that the PTAB believes requires a new search, that instead of sending the case to an examiner, leave be given to the patent applicant to copy the amended claim into another application, such as a continuation or reissue, and then to cancel the claim from the IPR proceeding. Sending the case to an examiner will likely otherwise push the IPR over 12 months, and since the original claim subject to the IPR has been effectively surrendered with its amendment, the need to continue the IPR process for the original claim has been eliminated anyway.

Reissue is an available procedure that can be initiated during the IPR process currently according to MPEP § 2285 II-C and 37 CFR § 1.565(d). Reissue requires surrender of all the patent claims, but if all claims are amended in the IPR the original patent has been effectively surrendered anyway. So if all claims are amended, leave to proceed in reissue provides a better course than to continue with an examiner searching and examining claims as part of the IPR process.

To enable a Continuation to be an available alternative to returning the case to an examiner during IPR, I recommend that 37 C.F.R. § 114(e)(5), which indicates RCEs are not available for reexamination, be eliminated or Continuation filing be otherwise allowed by the PTAB during IPR. When not all claims are amended in reexamination, forcing the patent applicant to surrender all claims for a reissue or alternatively suffer a long delay for an examiner to search and examine during an IPR for amended claims can discourage applicants from amending and unnecessarily burden the IPR process. Allowing amended claims to be cancelled and the reexamination certificate to issue for other claims while a separate examination of the newly amended claims proceeds in a Continuation will prevent burdening the IPR process with unnecessary delay.

Regards,
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