

**From:** Robert Asher  
**Sent:** Wednesday, June 29, 2011 3:55 PM  
**To:** reexamimprovementcomments  
**Subject:** Patent Reexamination Proceedings

Dear Mr. Schor:

With regard to Proposed Changes to Both Ex Parte and Inter Partes Reexaminations A.2., it is unwise to place the following restrictions on reexamination requests. "In all cases, a limitation-by-limitation explanation of the manner of applying the references must be presented in the form of a claim chart or narrative explanation, but not both, as providing both tends to lengthen the request and may result in inconsistencies between the two explanations."

A claim chart should perform the function of a very useful reference guide for an examiner handling a reexamination. Especially in ex parte reexamination when further assistance from the requester is unavailable, an examiner can address the obviousness of a new or amended claim by reviewing the chart to locate references containing the limitations recited in the new or amended claim. The chart should be much easier to use as a reference than reading through textual explanations.

A textual explanation is very useful for explaining inherency or a rationale for combining references to demonstrate obviousness. A chart is inappropriate for persuasive explanations of such subtle points.

A requester should be permitted to present an explanation of obviousness in text while at the same time providing the examiner with a useful claim chart. The conduct of further prosecution in an ex parte reexamination cannot be predicted and the examiner should have the claim chart as a reference for dealing with new or amended claims.

A requester may be uncomfortable with submitting only a chart for an anticipatory reference. It is unknown a priori whether the examiner will agree with the limitation-by-limitation analysis. Explanation of the correspondence between a claim element and a feature in the prior art may be necessary for the examiner to see the requester's point of view. The explanation might be needed for inherency. A further ground of rejection on the basis of obviousness may be needed in case the examiner disagrees with the anticipation. Thus, even when a chart is used for anticipation, explanations can be needed because the requester cannot predict an examiner's reaction.

As an alternative to the proposed limitation to only one of an explanation or a chart, the Office could consider making clear that only one is required and will be given full consideration without the need for both.

If length and inconsistency is such a concern for the Office, requesters should be allowed to use their judgment with regard to presenting arguments with alternatives. It seems unnecessary to require so much repetition in reexamination requests. An argument that a reference anticipates might require just a few additional sentences to establish that even if the examiner finds a certain limitation missing, the limitation is common knowledge or would have been obvious to one of ordinary skill. A separate complete explanation seems unduly burdensome and leads to the extra long requests. A rejection over A in view of B, C or D has sometimes been permitted in reexamination and sometimes sent back for separate explanations. Allowing the requester to determine when repetition is more effective than a more economical explanation would result in shorter more efficient briefing. The Office's current practice encourages the repetitive presentation of arguments because requesters seek to avoid having their papers kicked

back. The form over substance refusal to accept papers contributes to the length problem. More compact presentations can be made, if the Office is willing to fully and fairly consider them.

Thank you for giving consideration to my views. I wish you well in your attempts to streamline reexamination practice. I agree that faster more efficient resolution of reexaminations is critical to the patent system.

**Robert M. Asher**, Partner  
**Sunstein Kann Murphy & Timbers LLP**  
125 Summer Street | Boston, MA 02110-1618  
617.443.9292 main | 617.443.0004 fax  
[rasher@sunsteinlaw.com](mailto:rasher@sunsteinlaw.com) | [www.sunsteinlaw.com](http://www.sunsteinlaw.com)  
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