

June 15, 2000

Honorable Q. Todd Dickinson
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Department of Commerce
Box Comments - Patents
Washington, D.C. 20231

Attn: Kenneth M. Schor

Re: AIPLA Comments on the Notice of Proposed Rulemaking Entitled
“Rules to Implement Optional Inter Partes Reexamination Proceedings”
65 Fed. Reg. 18154 (April 6, 2000)

Dear Under Secretary Dickinson:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the notice of proposed rulemaking entitled “Rules to Implement Optional Inter Partes Reexamination Proceedings” published in the *Federal Register* on April 6, 2000.

The AIPLA is a national bar association of more than 10,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The USPTO is commended for its prompt and thorough proposals for the handling of the new inter partes reexamination proceeding. Overall, the proposed procedures are clear, practical, and take due account of the interests of the patent owner, the third party requester and the public. We are particularly pleased to note the effort being made to obtain an objective consideration of the issues raised in an inter partes reexamination proceeding by adopting the policy that a different examiner, other than those actually involved in the examination and issuing of the patent, will be assigned to the inter partes reexamination.

The AIPLA would further encourage and support the creation of a special group of legal advisers to assist the patent examiner in an inter partes reexamination proceeding. We would also support the practice being considered of having a panel review of actions to ensure that the actions are complete,

thorough, and comply fully with the applicable procedural and substantive law. While the USPTO is considering a panel review just prior to a decision on the request for reexamination and at the close of prosecution, we would encourage a panel review of each action by the examiner that includes an action on the merits of the claims.

We understand the concerns of the USPTO in proposing, under Rule 1.955, to prohibit any interviews which would discuss the merits of the inter partes proceeding. However, we recognize that since the proposed rule could be waived in appropriate circumstances, this does not amount to an absolute prohibition. We would encourage the USPTO to be flexible and open to possibilities to advance the prosecution through an interview process, particularly if it could be handled through the assistance of a special group of legal advisors that would have training in inter partes hearings. The USPTO may want to consider imposing a rule that any oral or electronic contact with USPTO officials responsible for an inter partes proceeding be handled through a conference call with all relevant parties represented, as is done presently in interference proceedings.

Finally, the USPTO has suggested in Rule 1.991 that in the context of a merged concurrent reissue and inter partes reexamination proceeding, the third party may participate to the extent permitted by the reexamination rules, and limited to issues within the scope of inter partes reexamination. Is this realistic? Is this provision intended to preclude the third party from acting as a protestor (under Rule 1.291) in the reissue application regarding the full scope of issues raised in the merged proceeding? Since it is only the patent owner who can exercise the option of filing a reissue application, why should the third party be excluded from participating as any protestor. A better approach would be to permit the third party to comment on any issue, so long as it was in accord with the procedures adopted for the conduct of the merged proceeding for third parties or protestors.

We appreciate the opportunity to provide comments on the rules for optional inter partes reexamination proceedings. We look forward to working with the USPTO to implement the American Inventors Protection Act in ways that will best serve the patent system while not unnecessarily burdening applicants or their representatives.

Sincerely,

Michael K. Kirk
Executive Director