

**From:** Bruce Burdick [mailto:burdlaw@gmail.com]  
**Sent:** Friday, April 29, 2011 12:54 AM  
**To:** reexamimprovementcomments  
**Subject:** Comments About Proposed Streamlining of Patent Reexamination

First, I take this opportunity to commend the USPTO for seeking to streamline reexamination.

Speeding up the SNQ/NSNQ (substantial new question/no substantial new question) determination would be a major improvement in reexams since many reexams are entirely resolved by an NSNQ decision. For patentees this is normally the desired outcome as it means the patent has been upheld by the USPTO as is, without any need for modification in view of whatever possible grounds was the basis for the reexam request. Most typically the possible grounds is a prior art patent which has been brought to the attention of the patentee, often as merely a stalling tactic by an alleged infringer. The quicker, cheaper and easier the patentee can get this determination, the better for the patentee, so it can be removed as a defense against infringement charges. Since I represent mostly patentees, this is all good. My clients want a quick determination since they find that a large portion of these previously unconsidered prior art patents do not really raise any SNQ, but rather are, as noted above, merely cited for purposes of delay or to raise the cost of the litigation to the patentee.

With that in mind, I proceed to the merits/demerits of the specific proposals:

#### ***A - All Reexams***

##### ***A.1. Requester Must Separately Explain How Each SNQ Presented in the Request Is "New" Relative to Other Examinations of the Patent Claims***

An excellent proposal. This will force the requestor to present the rationale under which the requestor proposed the USPTO find a SNQ. This is much superior to the requestor just stating "Reference A anticipates the claimed invention under 35 USC 102 or, in the alternative, renders the claim obvious under 35 USC 103", which is not informative and which requires the Examiner to then review the reference and seek to find some passage or figure that the Examiner thinks might be the basis for such an assertion. Good communication promotes efficiency, and that is all this proposal really does, promote communication by the requestor of the specific technical and legal basis for the request so the Examiner can get right to the issue without wasting time trying to guess what specifically the requestor has in mind. This favors patentees and disfavors infringers using merit-less re-exams to stall.

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

Excellent. This promotes efficiency. The requestor surely has done this "element by element" or "claim comparison chart" type analysis before submitting the request, as such an analysis is the essence of a competent analysis for either anticipation or infringement,

on the one hand, or novelty or non-infringement, on the other hand (these are essentially the same analysis as that which infringes if later anticipates if earlier). The Examiner will have to make this analysis, so having the benefit of the requester's work on this key analysis will be of immense benefit. Requesters who have a real basis for the request should not fear giving their work product, but rather should relish the chance to frame the issues for the Examiner. This requirement would help quickly weed out those baseless requests interposed for purposes of delay which do not provide such an analysis because the requestor knows there really is no SNQ. So, this requirement promotes efficiency by allowing Examiners to knock out the baseless requests more quickly and concentrate on meritorious requests instead. This will generally favor patentees and make stalling by invention thieves through re-examination harder.

***A.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***

Excellent. This would allow the Examiner to determine each issue just once and then to replicate the determination as to each cumulative SNQ and then to quickly move on to the next non-cumulative SNQ, or if none to make an ultimate determination. Otherwise, as is current practice, the Examiner must take up the next cumulative issue and spend time reaching the determination that it is merely cumulative. On the other hand, if the requester has multiple non-cumulative grounds this will highlight to the Examiner how the issues are non-cumulative. Again, for the requester this allows framing the issues in the most favorable light to the determination the requester seeks, whether it be NSNQ or SNQ. The Examiner would, of course, not be bound by the requester's assertions, such as where a patentee says all issues are considered cumulative in hopes of getting a quick NSNQ decision or where an infringer says all issues are non-cumulative in hopes of getting Examiner to bite on one as a SNQ. This proposal will tend to weed out baseless cumulative assertions so those NSNQ decisions can be reached quicker. So, on balance, this will favor patentees and render patents more certain and thus help deter invention thieves.

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

Good. This is a permissive proposal ("May"), so the question is whether it would be helpful for Examiners to have this option. Yes, certainly it would speed up the process if an Examiner could group rejections in a hierarchy so that when one rejection is overcome all rejections dependent on that one rejection are simultaneously disposed. While a suggestion, it is presumed that this would be taught as best practice and followed in most re-exams as it promotes efficiency through better organization. Making this hierarchy during the initial analysis is the best time for maximum utility and will save significant time later on if the issues have to be revisited months later as they normally will when the patentee's response to the FAOM is being reviewed.

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

## ***Request***

Good. This encourages compact prosecution by forcing a thorough request, but yet allows some discretion ("mainly") which is needed where a rebuttal needs to be supported by additional evidence that would not have needed to be submitted with the original request. The intent must not be to bureaucratically prohibit on non-substantive technicalities submission of obviously relevant and important evidence if such evidence will result in the proper legal ruling on the merits, but this rule will allow some flexibility to the Office where the delayed evidence appears to be deliberately delayed for purposes of dragging out the reexam or where it appears the requester made a calculated decision not to submit evidence which requester had in its possession at the time of the request and then seeks to later submit such evidence, not in rebuttal to new issues or new grounds of rejection, but rather by way of additional evidence on the original issue. On balance it seems this is neutral as regards patentees and infringers and basically punishes sloppy requesters, which seems fair in limited degree, provided suitable exceptions are made for pro se, novice or obviously underrepresented requesters whose evidentiary shortcomings seem more due to a lack of familiarity with reexam procedures than due to deliberately strategically calculated omissions by knowledgeable counsel.

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

Good. This is the quid pro quo for proposal 5. If the requester has to provide essentially all of requester's evidence with the request, the patent owner should have to supply essentially all evidence of patent owner's evidence in the Response to the FAOM. What is good for the goose is good for the gander. This will allow earlier review of the best evidence and discourage, perhaps even punish, late evidence submissions.

### ***A.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 an SNQ***

Excellent. This is only fair and proper courtesy to the Examiner so that Examiner can better understand the proposed new claim language and so that a better record of the reexam can be made in the event of future review so that any later reviewer, such as the Board, will not have to guess why the amendments were thought to render the claims patentable despite the SNQ.

### ***A.8. Petitions Practice Will Be Clearly Defined***

Excellent. Petition is often a lengthy time consuming affair which can significantly delay final resolution of a reexam. The extensive list of typical petitions in the Federal Register notice shows how many different types and ground of petitions are being used by practitioners. "Clearly define" is somewhat vague. If it means "greatly limited", which would mostly just trip up the inexperienced, then that could be a problem of denial of due process, but if "clearly defined" means the Office will more clearly state those types of

petitions that are not proper and those that are, then such "clear definition" will certainly help avoid the filing of improper petitions which nevertheless have to be decided and which needlessly delay all reexams as resources of the Office are needlessly diverted to processing improper petitions. We hope the latter ( educational and informative approach) is the intent and not the former (newly restrictive)and suggest that the table provided is a good educational and informative start to having reexam petition practice "clearly defined."

### ***B. Ex Parte Reexams only***

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

Excellent. If the patent owner sees no need to make a statement either for or against the request, it seems pointless to require one with all the delay that entails. For patent owners who fully expect a SNQ decision, this is good and gives the chance via simple phonecall or email to more quickly get on to the FAOM so the patent owner can get in the amendments to overcome the SNQ. For Examiners, this allows progressing to the FAOM while the case is still freshly in mind and that both promotes efficiency and quality by allowing the examiner to handle the file one less time. This is merely the implementation of a successful pilot program.

#### ***B.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***

Excellent. This will result in a better statement as it will allow the patent owner to make a more focused statement directed to the issues in the Provisional FAOM. Also, it advances the ultimate resolution as the provisional FAOM may reach the conclusion the patent owner desired and the patent owner can then simply concur so the case moves to disposition without needless delay. This provisional FAOM should be done by phone call or e-mail so that the patent owner may respond back while the examiner still has the file and is in a position to dispose of the case should the patent owner concur with the provisional FAOM.

### ***C. Inter Partes Reexams only***

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

Excellent. This only makes sense, provided there is no separate period during which 3PR (3rd Party Requester) is given additional time to do this. 3PR should have to include this argument in 3PR's first filing following the Examiner's indication of representative rejection hierarchy. This is needed to preserve the argument for due consideration by the Board if there is an appeal in the case, as otherwise such argument would seemingly be ignored on appeal.

### ***C.2. Final Office Action Closes Prosecution and Triggers Appeal Rights***

Excellent. This is necessary to move the reexam along so that "final" means "final" and not merely "second". While this seems restrictive, this will force participants to a resolution or appeal. This should generally benefit patent owners more than 3PRs.

### ***C.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***

Good. This resolves the procedural problems arising from an appellant brief by the winning party in the reexam asserting additional grounds of rejection in order to either delay the proceedings or to get the final brief and final oral argument. When the claims are rejected the patent owner should be the only one filing an appellant brief, so this would put that into the rules and prevent strategic non-meritorious 3PR appellant briefs merely designed to "get the last word" in oral argument or to drag out the case.

### ***D. The Additional Questions***

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

Yes. The USPTO should do all it can to become the deciding entity in disputes over anticipation, obviousness, written description, enablement, best mode [and even infringement] which involve technical expertise and familiarity with patent prosecution procedures. Patent examiners decide these issues every day and do it expertly and quickly. Judges are simply not as well equipped to decide these issues because they do not work with them as frequently or intensely and because they frequently do not have the requisite technical expertise or familiarity with patent procedures. Streamlining reexams will encourage use of the PTO on these issues and will do it in a forum where the patent owner has a chance to make amendments rather than be totally knocked out as in a District Court invalidity finding on a grounds that, in a reexam, could have been fairly addressed by an amendment to the claims. This will do the public and patent owners a service by preventing a significant number of cases from ever getting to US District Court where some novice patent judge handles (usually by dismissal on summary on questionable basis) the case summarily just to get it off his docket. This would render patents more, not less, valuable. So, I am strongly in favor of streamlining reexams to encourage their more frequent use. I think the proposals are well-reasoned and work well to accomplish the objective of making reexams a preferred way of resolving invalidity issues. I only wish patentees could also go to the experts at the USPTO to get decisions on infringement, since examiners typically make infringement analyses hundreds of times each day as they look for anticipatory references. (After all, anticipation is really just infringement by prior art which demonstrates that the patent claim seeks to encompass prior art.) Simply put, patent examiners are better qualified than District Judges to be conducting claim interpretations and analyzing for invalidity and infringement. I have

blogged and otherwise commented frequently to that effect for nearly 40 years and my opinion and position have not changed a bit in all that time on the issue, which is unusual since I frequently change position on patent issues.

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

Yes. As one of the world's greatest philosophers (and the world's most famous physicist) said, "If you can't explain it simply, you don't understand it well enough." <http://www.brainyquote.com/quotes/quotes/a/alberteins383803.html#ixzz1Ks9Kj5Ia> There is no reason for participants to ramble, as it is generally counterproductive to do so. Most examiners instinctively follow Mr. Einstein's reasoning and have excellent BS detectors. Being pressed for time, most examiners despise verbosity. So word limits actually do everyone involved a service. I am a proponent of extremely tight word limits. Certainly if Einstein can condense the theory of relativity down to a four symbol equation, reexamination participants might condense down their rambling repetitive documents in the interest of streamlining reexaminations. Word limits also force clarity and organization, which are important in any streamlining process. They have an important part and serve an important purpose, focusing the issues more quickly on what really matters. The word limit might properly be a function of number of claims or number of rejections or number of issues.

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

Yes.

The USPTO should have the ability to do this. In an ex parte re-examination, once the request is filed, the USPTO is in a position to reliably determine the complexity of the issues involved and hence an appropriate word limit for future documents. In an inter partes re-examination, it would seem more appropriate to have both the request and the patent owner's statement, since the patent owner's statement might raise additional issues.

***D.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?***

No. The limits are set by the antecedent basis in the specification. Placing of limits might lead to multiple re-examinations, since the patentee will presumably want to get all of its amendments and even if that means another re-examination. For efficiency, it seems best to handle the easel all-in-one re-examination so that the Office does not have to duplicate the non-substantive portions of the re-examination.

***D.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?***

Yes. I believe the standard should be "a rebuttable prima facie showing that the prior art patent or printed publication renders one or more claims of the patent invalid." I do not believe that it is enough that an examiner might consider a prior art patent or printed publication important in deciding whether or not the claim is patentable absent a prima facie showing of invalidity of a claim. If the re-examiner does not think that the additional art could render the claim unpatentable, it should not be enough that the re-examiner thinks a reasonable examiner would consider it important to that decision. As a practical matter, I think the current standard is interpreted to require a rebuttable prima facie showing of invalidity, so I think this change would be more informational than substantive.

***D.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?***

21 calendar days. That is sufficient to allow someone not to have to cancel a two-week vacation to return so a responsive pleading could be prepared and filed in a timely manner. These times should be very short as the issues are normally relatively clear and well-defined and explaining them to a patent examiner is not nearly so difficult as explaining them to a District Court judge. indeed, while important, most patent examiners are relatively unaffected by responsive pleadings, anyway, as they have independent technical and procedural expertise and generally do not need any input beyond the prior art document itself from Patent Owners or Third-Party Requester's to make a well-informed decision.

***D.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"?***

Generally, conditions that (1) are not under the control of the Patent Owner, (2) would seriously jeopardize the ability a reasonably prepared participant to timely take the action for which extension is requested, and (3) are considered by the examiner or Board to have any reasonable likelihood of affecting the ultimate decision in the proceeding.

***D.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***

Yes.

***, 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*

Yes for an ex parte re-examination a showing should be required as to why this art could not have been submitted during the re-examination. It should be sufficient for such a showing to provide a Declaration that the art was not known by Patent Owner during the time of the re-examination. No for an inter partes re-examination not at the request of Patent Owner, . Where the Patent Owner is forced into the re-examination by a third-party requester, it seems appropriate and most efficient to allow the Re-Examination to stand and complete on the issues raised by the third-party requester and then allow the Patent Owner to proceed with an ex parte re-examination as to any additional prior art, without requiring a "why it could not have been earlier submitted" explanation. In such an ex parte late submission, it would, however, seem reasonable to require the Patent Owner to notify the Third-Party Requester of the submission so that the Third-Party Requester would have an opportunity to submit arguments as to why this late submission relates to the issues raised during the inter partes examination and thus should have been made during the inter partes re-examination, and to allow the Third-party requester to convert the ex parte to and inter parties re-examination. The possibility of such conversion should prevent strategic game-playing by Patent Owners.

***(2) an explanation of the relevance of the information with regard to the claimed invention?***

Yes for all kinds of re-examinations so that the Office can determine if the re-examination should be reopened. In the case seven inter partes re-examination there should be the possibility of assessing additional costs against a late submitting party absent a showing of just cause for not earlier submitting any such art in the IDS that is deemed relevant to the prior re-examination proceeding. this would enable the Office to penalize any inappropriate shenanigans regarding a late-filed IDS.

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

If (a) they have common issues or common art, (b) relate to a common patent, and (c) the Office determines that efficiency of operations will be promoted or significant reduction of time or cost to the parties is reasonably expected to be realized by such consolidation.

***D.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?***

In view of the advances in electronic communications, a Third Party Requester should be notified of the deadline for submission of a Patent Owner's and be charged with the responsibility for contacting the office within seven days of such deadline if the Third-Party Requester has not received a Patent Owner's statement by such time. With such a requirement, there would be no need for relief.

***D.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)?***

YES. The US PTO should require electronic communications in all proceedings. The advantages of electronic filing are recognized by all and are increasingly being adopted as a mandatory requirement by trial courts and administrative agencies throughout the country. The advantages of going paperless and the resultant speed of communications and improved file integrity are well-known and well-documented. No streamlining of re-examinations would be complete without this change. While the office is making changes in re-examination procedures, that is the appropriate time to make the change to electronic filing in re-examinations for maximum streamlining and maximum effect. As with most trial courts, exceptions would have to be provided for pro se participants, should the pro se participant desire paper documents. In my experience dealing with small inventors they currently, without exception, desire and prefer electronic communications. At a time when the US PTO is realizing significant benefits from EFS and TEAS in a huge preponderance of initial filings, this is a no-brainer.

***D.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?***

I think this depends on the facts and issues in the individual case. I believe the Board should have the option to go either way on this, but should be required to affirmatively state that it believes reasonably that the ultimate time to resolution will be decreased by such a remand to the examiner. Perhaps there could be a middle ground on this where the Patent Owner is provided the opportunity to keep the case with the Board by submitting a response within 14 days or some other short period of time, which is sufficiently short to assure that the Board would surely still have the issues freshly in mind. After a certain amount of time it would seem that efficiency would always be improved by remanding the case to a single examiner since after such time either the Board or the examiner would have to take time to regain familiarity with the case and it would then be more efficient to have one person instead of three. space another option would be to allow the case to remain with the Award but the Board to designate one of the three members to address the issue alone.

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

I think the key change would be to go paperless and make the re-examination always be conducted electronically. This would have the added benefit of allowing for PDF exhibits, Web conferencing, and electronic service to reduce travel and document preparation costs,

particularly to the parties, but also to the examiners and Board. Going paperless would significantly reduce correspondence times since the three extra days for each document to pass through the US postal system would no exist. That in itself would eliminate a significant amount of currently wasted time communication time.

Thank you for the opportunity to submit my comments.

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*Bruce Burdick*

BURDICK LAW FIRM, 3656 Western Ave., Alton, IL 62002

[beb@burdlaw.com](mailto:beb@burdlaw.com) [www.burdlaw.com](http://www.burdlaw.com) 618-4

62-3450 Fax 618-208-1712

My email policy is posted at [www.burdlaw.com/webwarn.htm](http://www.burdlaw.com/webwarn.htm)