

**From:** Bryant Young  
**Sent:** Wednesday, June 29, 2011 4:34 PM  
**To:** reexamimprovementcomments  
**Cc:** Lateef Mtima; Steven Jamar  
**Subject:** Comments on Streamlined Patent Reexamination Proceedings.

Attached please find the Comments for the Institute for Intellectual Property and Social Justice submitted in response to the USPTO request for Comments on Streamlined Patent Reexamination Proceedings.

<http://edocket.access.gpo.gov/2011/pdf/2011-9805.pdf>

Respectfully submitted,

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# INSTITUTE FOR INTELLECTUAL PROPERTY & SOCIAL JUSTICE, INC.

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## IIPSJ Comments on Streamlined Patent Reexamination Proceedings

### I. Commentator Information

These comments are submitted by the Institute of Intellectual Property and Social Justice at the Howard University School of Law, by its Director, Prof. Lateef Mtima, its Associate Director, Prof. Steven D. Jamar, and its Scholar in Residence and Chair of Institute Development and Advancement, Bryant L. Young, in response to the United States Patent and Trademark Office's Request for Comments on Streamlined Patent Reexamination Proceedings, as published in the Federal Register, Vol. 76, No. 79, p. 22854-22861 Monday, April 25, 2011 (FR Doc. 2011-9805).

The Institute of Intellectual Property and Social Justice (IIPSJ) was founded in 2002 to address the social justice implications of intellectual property law and practice both domestically and globally. IIPSJ's work ranges broadly and includes scholarly examination of intellectual property law from the social justice perspective; advocacy for social-justice aware interpretation, application, and revision of intellectual property law; efforts to increase the diversity of the those who practice IP law; and programs to empower historically and currently disadvantaged and under-included groups to exploit IP effectively.

### II. Comments on Streamlined Patent Reexamination Proceedings

The United States Patent and Trademark Office (USPTO) proposes "to streamline the procedures governing *ex parte* and *inter partes* reexamination proceedings."<sup>1</sup> This should help the Office "achieve faster, more efficient resolution of the substantial new question of patentability (SNQ) for which reexamination is ordered."<sup>2</sup>

Proposed changes to both *ex parte* and *inter partes* reexamination include that the requester needs to explain how each SNQ is new relative to the other claim examinations, how the references apply to every claim limitation to be reexamined, and how multiple SNQs are non-cumulative of each other (with cumulative SNQs constituting a single SNQ).<sup>3</sup> Other proposed changes include that the examiner may select representative rejection(s) from a group of adopted rejections, the requester's declaration is limited to the request while the patent owner's amendments are limited to the first action response, claim amendments won't be entered unless

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<sup>1</sup> Streamlined Patent Reexamination Proceedings, <http://www.gpo.gov/fdsys/pkg/FR-2011-04-25/pdf/2011-9805.pdf> (Apr. 25, 2011).

<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

an explanation is given as to how the proposed new claim language will make the claims patentable in light of a SNQ, and petitions practice will be better defined.<sup>4</sup>

Through the following comments, IIPSJ encourages the implementation of and compliance with the changes to reexamination proceedings. These comments to the USPTO's proposed changes, corresponding numerically to the questions to consider (p. 22860), address topics pertaining to the social justice perspective.

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

The USPTO should proceed with efforts to streamline the procedures governing *ex parte* and *inter partes* reexaminations. Currently, it takes approximately five years from the filing of a reexamination request to a decision by the Board of Patent Appeals and Interferences.<sup>5</sup> Streamlining the procedures should reduce this long term pendency dramatically. The proposed changes might require more work on the part of the requester, but should lessen the burden on the examiner. Thus, examination efficiency should be improved, since a first action on the merits could be produced more expeditiously. Further, by requiring the requester to explain how each SNQ is new and non-cumulative from what has been previously considered, the reexamination pendency should be reduced while duplicative requests and those sought only to intimidate current patent owners should be filtered out.

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

The USPTO should place word limits on reexamination requests. These limits should force the requester to focus on the facts and make concise arguments as to patentability questions. Quality would then override quantity, such that repetition would be avoided, hopefully encouraging the requester to get straight to the point. Thus, the burden on the examiner would be reduced, as the examiner would have less to read and interpret, such that the challenged patent can be reexamined in a more expeditious manner. Further, the burden should be on the requester, since “any person at any time may file a request for reexamination”.<sup>6</sup>

**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?**

The USPTO should change its interpretation of a substantial new question of patentability. The key word to change is “important” which can be vague, and thus should be replaced with a stronger term, such as “indispensable.” In particular, one

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<sup>4</sup> *Id.*

<sup>5</sup> Scott A. McKeown, *How Long Does Patent Reexamination Really Take?* (July 23, 2010), <http://www.patentspostgrant.com/lang/en/2010/07/how-long-does-patent-reexamination-take>.

<sup>6</sup> 35 U.S.C. 302 (2008).

could vaguely interpret “important” as meaning something “significant;” however, the term “indispensable” clearly signifies something “crucial.” In other words, the prior art patent or printed publication should be “indispensable” in deciding the patentability of claims or otherwise the requester wastes the examiner’s time. Further, requesting unnecessary reexaminations takes time away from examiners in their effort to reduce the current patent application backlog. The patent application backlog as of May 2011 stands at 703,175 applications.<sup>7</sup>

**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?**

Patent owners and third party requesters should be given thirty days to submit a statement, response, or appeal. That amount of time is approximately one month and should be a reasonable amount of time. According to the most recent versions of Chapter 2200 (Citation of Prior Art and *Ex Parte* Reexamination of Patents) and Chapter 2600 (Optional *Inter Partes* Reexamination) of the Manual of Patent Examining Procedure (MPEP), the time for a response is generally two months, which is sometimes shortened to one month (MPEP 2263/2662).<sup>8</sup> Having brief consistent deadlines should assist in facilitating the reexamination process, moving it forward in a more expeditious manner.

**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)?**

The USPTO should encourage, but not require that all correspondence in reexamination proceedings be conducted electronically. Electronic communication is faster and more convenient, and as such should be encouraged. However, it should not be made a requirement since not all individuals have access to a computer and the Internet. In a government survey conducted by the Census Bureau, “30 percent said they have no Internet access at all.”<sup>9</sup> By making e-filing mandatory, some requesters and/or patent owners might be effectively denied the ability to challenge or defend a patent, especially underrepresented minorities and those who are economically disadvantaged.

As reflected in our comments, we support the proposed changes, since they are logical, and most importantly, cost effective. In addition, these should expedite the reexamination process, helping to foster more timely decisions.

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<sup>7</sup> Patent UPR Application Backlog, <http://www.uspto.gov/dashboards/patents/kpis/kpiBacklogDrilldown.kpixmap> (last visited June 23, 2011).

<sup>8</sup> Manual of Patent Examining Procedure (MPEP), <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm> (last modified Jan. 12, 2011).

<sup>9</sup> Lance Whitney, *Survey: 40 percent in U.S. have no broadband* (Feb. 16, 2010), [http://news.cnet.com/8301-1035\\_3-10454133-94.html](http://news.cnet.com/8301-1035_3-10454133-94.html).

We hope that the above comments are taken into consideration.

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