

**From:** Caitlin Baker  
**Sent:** Wednesday, June 29, 2011 5:05 PM  
**To:** reexamimprovementcomments  
**Subject:** Novak Druce + Quigg comments to Notice Entitled Streamlined Patent Reexamination Proceedings - 76 FR 22854

Attached please find Novak Druce + Quigg LLP's comments regarding "Streamlined Patent Reexamination Proceedings; Notice of Public Meeting-76 FR 22854."

These comments have been forwarded on June 29, 2011. I'd like to please request a delivery receipt and read receipt for this message.

Thank you,  
Caitlin Baker

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**A. Proposed Changes to Both *Ex Parte* and *Inter Partes* Reexamination**

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

**NDQ does not believe that this proposal represents a substantive change in reexamination practice.**

It is not clear why this requirement is considered to be a “change” with respect to existing reexamination practice. Current 37 C.F.R § 1.510(b)(1) requires that in order to be entitled to a filing date, an (*ex parte*) reexamination request must include “[A] statement pointing out each substantial new question of patentability based on prior patents and printed publications. [Emphasis added.] C.F.R. §1.915(b)(3), first clause, provides an identical requirement with respect to a request for *inter partes* reexamination. The Notice at 76 FR 22854 states that USPTO would require, for each proposed SNQ presented in a reexamination request, “a statement of how the technological teaching in the references that support the SNQ is new and non-cumulative of what had been considered in any previous or pending USPTO examination of the patent claims. It is fairly standard practice to discuss how each SNQ is believed to be new and non-cumulative of the teachings considered in previous or pending USPTO examinations of the patent claims.

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

**NDQ does not believe that this proposal represents a substantive change in reexamination practice.**

Current reexamination practice requires that to be entitled to a filing date, a request for reexamination must provide “...a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.” 37 C.F.R. §§ 1.510(b)(2) and 1.915(b)(3), second clause.

As compliance with the appropriate one of these rules is required to obtain a filing date for a reexamination request, current best practice for filing a request for reexamination follows the requirements of the appropriate rule, and it is difficult to ascertain whether the proposed change to the current rules is actually a “change.”

As a practical matter, it might serve USPTO well to limit a reexamination requester’s detailed explanation of the applicability of the cited references to the claims for which reexamination is request to either a textual explanation or claim charts, but not both. It has been the experience of NDQ that some Central Reexamination Unit (CRU) examiners prefer a textual explanation, while others prefer claim charts. NDQ has encountered more than one instance of a CRU examiner actually adopting and stating a proposed claim rejection by reference to a claim chart, rather than by stating the rejection in conventional textual form.

It should also be recognized that many of the reexamination requests that are filed are either involved in co-pending litigation for the requested patent, or will soon be involved in such litigation. Claim charts appear to be a necessary tool for patent infringement/validity litigation, and it is often a requirement of the client (requester) that claim charts be included in a reexamination request. If a reexamination request provides an examiner with textual rejections and claim charts, the examiner can certainly avoid spending a great deal of time be selecting either the textual rejections or the claim charts to supply the required detailed explanation of the cited art to the claims for which reexamination is requested.

If the point is that ALL elements of the claim must be shown in the prior art being currently asserted (a full and complete rejection), as opposed to a possible interpretation in which only the claim elements relevant to the asserted “new teaching” must be shown in the new prior art, we agree.

3. *(Requester Must Explain How (sic, Why?) Multiple SNQs Raised in the Same Request are Non-Cumulative of Each Other; Cumulative SNQs Will Be Deemed to Constitute a Single SNQ)*

**NDQ takes issue with the concept of this proposed change, but would accept a requirement that a brief statement of why “similar” SNQs established by a number of different prior patents/publications are non-cumulative.**

By proposing this “change,” it appears that the USPTO has elevated jurisdictional requirement for providing one or more SNQs above the much more important issue of substantive claim examination and patentability. No patent claim was ever rejected in a reexamination proceeding merely because a prior patent/printed publication established an SNQ for that claim. Claims are rejected in reexamination based on proposed rejections that include one or more prior patents/publications that include at least one SNQ.

A reexamination requester must demonstrate that a particular prior patent/publication presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, or during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. This teaching must also be a teaching that a reasonable examiner would consider important with respect to the patentability of at least one claim of the patent that is the subject of a reexamination request.

In order to be assured that at least one proposed rejection of the requested claims is adopted by the Examiner, a reexamination requester typically seeks to find several prior patents/printed publications that establish a similar SNQ for the same claims, where “similar” simply means that the references each contain the required “new, non-cumulative technical teaching,” but do so in different contexts. For example, a request might present References A, B and C, where A contains teaching X in technology Q, B contains teaching X in technology R and C contains teaching X in technology S. Reference A might be asserted as anticipatory prior art against one or more patent claims, but only if the claims are subject to a very “broad” claim construction that may not strike the examiner as being reasonable. On the other hand, References B and C are each applicable in proposed obviousness rejections, with References B and C each lacking a different claim limitation so that each will be asserted in its own, different obviousness rejection(s).

(A.3. continued)

USPTO’s own reexamination practice guidance, states that none of References A, B and C as described are in fact cumulative, notwithstanding that they contain essentially the same teachings. See: MPEP § 2258.01, which for *ex parte* reexamination, states that:

“[F]or purposes of reexamination, a cumulative reference that is repetitive is one that **substantially reiterates verbatim** the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.” [Emphasis added.]

MPEP § 2660(III) provides, for *inter partes* reexamination, that:

“[I]t is to be noted that the examiner is **not** to refuse to adopt a rejection properly proposed by the requester as being cumulative to other rejections applied. Rather, any such proposed rejection must be adopted to preserve parties’ appeal rights as to such proposed rejections.” [Emphasis added.]

Based on these considerations, it should be at least as rare that plural references establish “cumulative” SNQs as it is rare that rejections based on references that contain similar teachings are “cumulative” teachings. Therefore, while NDQ believes that SNQs are rarely, if ever cumulative, NDQ would understand why the PTO would require a regulation that requires a reexamination requester to provide a brief explanation of why a plurality of SNQs for the same claim(s) are not cumulative to each other. NDQ further believes that if a request presents multiple SNQs for the same claim, it would not be unreasonable for the USPTO to require payment of a modest surcharge for consideration of the second and subsequent SNQ reference, provided that the Examiner is required to explain the basis of any determination that an SNQ is “cumulative” so that a petition for supervisory review may be filed when appropriate.

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

**NDQ takes issue with the concept of this proposed change because it is precluded by statute.**

35 U.S.C. §§ 304 and 313 each require that when the USPTO Director has determined that an SNQ exists, the Director’s determination “will include an order ... for resolution of the question” (§304) or “shall include an order... for resolution of the question” (§313) [Emphasis added.] Accordingly, it is clear that if multiple SNQs are presented and agreed with, then the proposed rejections based on each of them must be “resolved.” There is no authority in the reexamination statute for identifying a “representative” rejection from a group of adopted rejections. Further, there is no assurance that where a “representative” rejection is adopted and a patent owner overcomes the rejection by argument, that other proffered rejections will not still be valid rejections. As the examiner must resolve each SNQ and must explain why each and every rejection that is not accepted by the examiner as proper does not teach the claim limitations, this proposal results in piecemeal prosecution and will in effect, if the questions are properly “resolved,” result in prolonged prosecution, not prosecution with special dispatch. Further, the current practice we have observed by some examiners of applying only one rejection when several have been proffered appears to be an early adoption of this proposal. In practice, this procedure does not provide the third party requester procedural due process, or follow the statutory mandate. This problem is exacerbated when the examiner provides reasons for allowance that do not address in detail why the claim elements that are deemed missing from the applied rejection(s) are not found in the non-adopted rejections associated with the same SNQ. Attention is again directed to MPEP § 2258.01 which indicates that references are rarely “cumulative,” and MPEP § 2660(III) which indicates that in *inter partes* reexamination, “cumulative” rejections must all be adopted to preserve appeal rights.

*5. Requester’s Declaration and Other Evidence Will Be Mainly Limited to the Request*

**NDQ believes this language to be too limiting, but agrees that ALL declarations and evidence should be limited to addressing only those issues presented for determination in the reexamination proceeding, whether by requester or patent owner.**

With respect to *ex parte* reexamination, 35 U.S.C. § 302 provides that a third party requester, (i.e., “any person), may file a request for reexamination. 35 U.S.C. § 304 then provides that a patent owner may file an optional statement after reexamination is ordered. Only if the optional statement is filed, may the requester file a reply to that statement. Thus, requester’s participation on the merits of an *ex parte* reexamination proceeding necessarily ends either after the filing of a reply to an optional patent owner’s statement, or with the filing of the reexamination request itself if that optional statement is not filed. If a patent owner elects not to file a statement, then requester currently has no further opportunity to provide evidence and so there would be no change in practice. If patent owner elects to file a statement, and provides declarations/affidavits or test data as part of that statement, this “change” would permit requester to file appropriate rebuttal evidence in a reply to the statement. However, that is currently the practice.

Accordingly, it is not seen how this proposed “change” will actually change anything for a third party requester in *ex parte* reexamination.

For *inter partes* reexaminations, requester is currently permitted to file rebuttal evidence to address a point made in an Examiner’s non-final office action, or in a patent owner’s response to a non-final Office action. If an Office action is “final,” (i.e., an Action Closing Prosecution), entry of evidence submitted as part of a response to the ACP is not a matter of right for either party because 37 C.F.R. §1.951 makes 37 C.F.R. §§1.113 and 1.116 applicable to *inter partes* reexamination. To the extent that an Office action includes a new position taken by the Examiner that changes the thrust of the Examiner’s previous position on an issue, (*In re Kronig*. 539 F.2d 1300 (CCPA 1976)), that is detrimental to either party, then designation as an ACP would improper. Accordingly evidence filed by requester to address that new position, or to rebut patent owner’s response and/or evidence directed to that new position, should therefore continue to be entered as a matter of right as per current practice.

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

**NDQ does not believe that this proposal represents a substantive change in reexamination practice, but to the extent that it does, NDQ does not agree with the proposed change.**

With respect to *ex parte* reexamination, 35 U.S.C. § 302 provides that a third party requester, (i.e., “any person), may file a request for reexamination. 35 U.S.C. § 304 then provides that a patent owner may file an optional statement after reexamination is ordered, if the optional statement is filed, than the requester may file a reply to a patent owner’s statement. If patent owner elects to file a statement, and provides declarations/affidavits or test data as part of that statement, then such evidence is currently entered as a matter of right, and this “change” would appear to simply do the same thing. This practice is currently the *ex parte* reexamination practice.

Further, to the extent that the USPTO promulgates any non-final action, i.e., a first or subsequent non-final action) in an *ex parte* reexamination proceeding, it appears that 37 C.F.R. §1.111, which is made applicable pursuant to 37 C.F.R. §1.550(a), would necessarily permit entry of the patent owner evidence as a matter of right. To the extent that the proposed change would require that amendments and evidence filed after the second non-final action be limited only to overcoming the new ground of rejection, it seems that any prior submission of evidence that overcame an initial non-final rejection would no longer be necessary if a new, non-final rejection was required after the patent owner’s initial response to the earlier, non-final action.

With respect to *inter partes* reexaminations, 37 C.F.R. §1.111 and 37 C.F.R. §1.937 are applicable to any Office action that is not an ACP (whether it is a first or subsequent Office action). Therefore, patent owner evidence must be entered as a matter of right, as is currently the practice. After an ACP that is “proper,” evidence is not enterable as a matter of right under current practice because 37 CFR §1.951 makes the provisions of 37 C.F.R. §§1.113 and 1.116 applicable to *inter partes* reexaminations. If evidence/argument was submitted directed to a non-final Office action, and the next Office action is a second action that is also non-final, (i.e., not an ACP), there would appear to be no basis for another submission of evidence directed to the grounds of rejection in the previous non-final action.

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(A.6. continued)

To the extent that the Office makes this proposal in support for preventing patent owner presentment of amendments and new argumentation after a first patent owner response has been filed, we view the proposal as an unreasonable mandate when best efforts are to be made to resolve all issues of patentability, even after final.

*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.*

**NDQ does not believe that this proposal represents a substantive change in reexamination practice, but to the extent that it does, NDQ agrees with the concept of the proposed change, however, distinguishment provided by the amendment should be shown relative to the rejection, not an SNQ.**

NDQ agrees that amendments in reexamination proceedings must be made in light of the SNQs raised by the prior art. However, the USPTO should take care to review the decision of the Court in *Cordis Corp. v. Medtronic Ave, Inc.*, 511 F.3d 1157, 1185 (Fed. Cir. 2008) and in particular to note that at page 1185, the Federal Circuit reversed the district court’s decision to invalidate patent claim 44 (which had been obtained during reexamination). As stated in the Federal Circuit’s opinion:

In holding claim 44 invalid, the district court incorrectly interpreted section 305. The portion of section 305 on which the district court relied permits a patentee to add claims (1) that distinguish the invention from the prior art cited under section 301 and (2) that are added in response to an office action adverse to the patentability of a claim. Claims added under either clause must satisfy section 305's substantive limitation, which prevents patent owners from adding new claims that enlarge the scope of the patent's coverage.

Cordis specifically stated that the changes it made in its July 21, 1998, submission to the PTO, including the addition of claims 44 through 59, were "[r]esponsive to" the office action that had rejected all but two of the claims of the '762 patent in light of prior art references. Moreover, Cordis was free to include the new claims even apart from the office action if they were added to distinguish the invention from prior art cited under section 301. Section 305 does not require the patent owner to include an express statement that the new claims distinguish. [Emphasis added.]

In light of the guidance in *Cordis*, a 2008 decision, care should be taken to not misunderstand and misapply the holding of *In re Freeman*, 30 F.3d 1459 (Fed. Cir. 1994). While that decision notes that the addition of claims in reexamination for reasons other than the SNQ art, i.e., to avoid an adverse claim construction, was improper in reexamination, *Freeman* at 1466, and also states that “the ability of a patentee to amend claims during reexamination must be seen in light of the fundamental purpose of reexamination -- the

(A.7. continued)

determination of validity in light of a substantial new question of patentability,” Freeman at 1468, the actual holding in *Freeman* is stated at 1465: “We accordingly agree with the Board that the amendments made during reexamination enlarge the scope of the reissue claims as interpreted by the district court. The issue therefore becomes whether the Board was bound by the interpretation of the reissue claims by the district court, as it held it was.” The issue of whether additional dependent claims can simply be added to depend from an independent claim that was determined to be patentable without amendment, or added to depend from an amended version of an independent claim, appears to be a very arguable point in light of the above-quoted material from *Cordis*.

*8. Petitions Practice Will Be Clearly Defined*

**NDQ agrees with this proposal to the extent that it clearly defines petition practice, but disagrees that a 37 C.F.R. § 1.182 Petition to Transfer Jurisdiction to the Office of Patent Legal Administration should be considered to be an improper petition.**

NDQ believes that the table published at 76 FR 22854, 22858 represents an improvement in reexamination petition practice because it presents petition practice in a single, practical table. However, NDQ disagrees that a petition to transfer jurisdiction of a reexamination proceeding to the Office of Patent Legal Administration (“OPLA”) should not be permitted.

A petition to transfer jurisdiction to the OPLA is filed under 37 C.F.R. § 1.182, a rule that provides relief when no other rule will do so. The failure of the Central Reexamination Unit (“CRU”), or any other USPTO organization, to follow published USPTO procedure in a reexamination proceeding should always be petitionable pursuant to 37 C.F.R. § 1.182. The OPLA is the appropriate deciding authority for a petition filed under Section 1.182 that relates to reexamination practice and procedure.

NDQ has frequently filed such petitions in reexaminations when it became necessary to obtain a ruling from USPTO on a procedural issue that would determine how the Central Reexamination Unit (“CRU”) continues to conduct the reexamination proceeding. An example of this sort of petition is a petition to obtain a ruling on the issue of whether a reexamination certificate submitted for publication could be properly and legally published in light of certain procedural issues that had arisen in the proceeding. Another example is a petition filed when the CRU retains jurisdiction of a reexamination proceeding even though a petition has been filed that would be properly decided by the OPLA.

NDQ takes this opportunity to note that although the active participation of a reexamination requester ends in *ex parte* reexamination with the end of period for filing the optional patent owner’s statement and requester reply thereto, that “active participation” is limited to participation on substantive issues of claim patentability. Requester in *ex parte* reexamination is entitled to procedural due process throughout the life of the proceeding. If published USPTO reexamination procedure and/or regulations are not being followed in an *ex parte* reexamination proceeding, the requester is entitled as a matter of procedural due process to file a petition requesting that UPSTO conduct the *ex parte* proceeding properly.

B. Proposed Changes Specific to *Ex Parte* Reexamination

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

2. *Where the Patent Owner Does Not Waive the Statement, the Order Granting Reexamination Will Include a Provisional FAM, Which May Be Made Final in the Next Action*

**NDQ disagrees that the pilot program should become permanent because the program includes a penalty when the Patent Owner refuses to waive its right to a Patent Owner’s Statement.**

NDQ has chosen to comment on both items 1 and 2 together, because items 1 and 2 are both part of the same pilot program.

A Patent Owner typically elects to not file a Patent Owner’s Statement in response to an Order Granting *Ex Parte* Reexamination because Patent Owner does not want to give the Requester any opportunity to comment in the reexamination proceeding. However, a Patent Owner typically makes the decision to not respond to the Order only after seeing the Order. In a situation in which the Order granting reexamination is issued in a proceeding that appears to have weak proposed rejections, a Patent Owner may well elect to file a Patent Owner Statement to forestall issuance of a first Office action that includes any claim rejections. A number of other factors arising from concurrent litigation may also play into the Patent Owner’s decision to file, or not file, a Patent Owner’s Statement. Although Patent Owners are often interested in expediting the reexamination proceeding, it is unfair to expect a Patent Owner to always, or usually, waive the Patent Owner’s Statement before being able to view the Order for *Ex Parte* Reexamination.

It is even more unfair to create a penalty for exercise by a Patent Owner of the statutory right for the Patent Owner to consider the Order Granting *Ex Parte* Reexamination before deciding whether to waive its right to file a Patent Owner’s Statement. Under the pilot program, refusal to waive the filing of a Patent Owner’s Statement may result in a Provisional FAOM as part of the Order Granting *Ex Parte* Reexamination. However, 35 U.S.C. § 305 quite clearly states that:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. [Emphasis added.]

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(B.1 and B.2 continued)

It appears that issuing a Provisional FAOM as part of an Order Granting *Ex Parte* Reexamination, the USPTO will violate the requirement of 35 U.S.C. § 305 quoted immediately above, which permits an Office action under Sections 132 and 133 to be mailed only after the statutorily set times for filing a Patent Owner’s Statement and the Requester’s Reply that are created by 35 U.S.C. § 304 have expired.

C. Proposed Changes Specific to *Inter Partes* Reexamination

*1. Third Party Requester May Dispute the Examiner’s Designation That a Rejection is “Representative” of Other Rejections in the Group*

**NDQ agrees with this proposal, in that it does not represent a true “change” in practice because (1) current practice does not properly include “representative” claims and (2) references are rarely cumulative of one another. Furthermore, the concept of whether SNQs and references are cumulative has been reasonably defined, applied and understood. A new undefined (and possibly undefinable) concept of “representative” will only result in disagreements that will slow the process and waste resources, as opposed to the goal of their conservation.**

As explained in NDQ’s discussion of Proposed Change A.3, USPTO’s current position as stated in the MPEP is that SNQs for the same claim can rarely be cumulative. Accordingly as explained in NDQ’s discussion of Proposed Change A.4, rejections based on SNQ art can rarely be cumulative and must always be addressed because 35 U.S.C. §§ 304 and 312 of the reexamination statute require that the USPTO Director resolve SNQs that have been raised in a reexamination request. Where SNQs are based on clearly cumulative references, such as patents that are continuations or divisionals of each other, or are related as patent A from a foreign country and patent B from another country that are essentially verbatim duplicates that contain identical disclosure that is relied on to establish an SNQ, only then will rejections based solely on those patents be “cumulative.” For these reasons, it should be unnecessary to provide for review of an Examiner’s designation that a rejection is “representative” of other rejections in the group.

Moreover, a determination that one rejection is representative of another rejection does not raise an issue of claim patentability; instead it raises a strictly procedural issue. Accordingly, to the extent that USPTO adopts this proposed change in some form, a petition right must be established to contest improper determinations that a given rejection is “representative” of other rejections in a group. The proposal that a Requester will have the ability to dispute this designation before the Board is not believed to be legally sustainable, because the issue is procedural in nature and is not a determination of claim patentability.

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

**NDQ disagrees with this proposal.**

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*

**NDQ agrees with this proposal, provided that the page/word limitation governing Third Party Requester’s respondent’s brief is reasonably increased to permit argument sufficient to address the refusal to make any grounds of rejection that the Requester has presented and the Examiner has refused to adopt.**

Initially, NDQ observes that 35 U.S.C. § 315(b)(1) quite clearly and unequivocally states that:

A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; ... [Emphasis added.]

Accordingly, it is quite clear that this statute permits an appeal to be taken by a Third Party Requester in *inter partes* reexamination when a proposed rejection is not adopted by the Examiner. The issue of whether “courts permit cross-appeals” is irrelevant, given that the clear language of the statute reexamination statute permits cross-appeals. NDQ does not consider that there is much of a difference between permitting a Third Party Requester to “appeal” from the refusal to adopt one or more claim rejections, even where at least one rejection for the same claim or claims has been adopted, and permitting the Third Party Requester to argue the refusal to adopt one or more claim rejections in a respondent’s brief, provided that sufficient words/pages to make a cogent argument are permitted by the rules.

It should also be noted that to the extent that new legislation regarding “*inter partes* review” has been passed in both the Senate and the House of Representatives, it is likely that the new review procedure will become law. It is not difficult to envision that a party requesting “*inter partes* review” will propose claim rejections in a manner similar to the current *inter partes* reexamination practice. Where a proposed rejection is not adopted, it should be noted that the appeal provisions of both the Senate and House bills are also broad enough to permit appeals from the refusal of the “Patent Trial and Appeal Board” Administrative Patent Judge to adopt a proposed rejection.

### **NDQ Comments on Additional Proposed Changes and Questions**

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

No. With respect to *inter partes* proceedings, USPTO should concentrate on drafting the rules and guidelines necessary for the new *inter partes* proceedings. Further, USPTO should concentrate on providing sufficient examination resources, even if this necessitates modest fee increases, to meet the expected prosecution timeframes, and to provide the patent community with a lower cost and less lengthy proceeding than is currently provided for most patent infringement/validity litigation. “Special Dispatch” should be viewed as being a less expensive and less time consuming proceeding when compared to patent validity/infringement litigation.

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

No. The Congressional intent was originally to provide a low cost and less time/resource consuming proceeding as an alternative to litigation. While reexamination has ultimately become an adjunct to patent validity/infringement litigation, USPTO should expect that those electing to become or remain customers will do so only if provided with a proceeding that can be viewed as enabling its customers to have a full and fair opportunity to meaningfully prevail in the proceeding.

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

No, except where necessary to provide a Third Party Requester the necessary words/pages to argue the non-adopted rejections in a Respondent’s Brief in accordance with the discussion of issue C.3. above.

*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. Only the limitations mandated by existing case law, e.g. *In re Freeman*, 40 F.3d 1459, (Fed. Cir. 1994), *Cordis Corp. v. Meditronic Ave, Inc.* 511 F.3d 1157 (Fed. Cir. 2008) and *Southwestern Bell Telephone Company v. Collins*, 279 Fed.Appx. 989 (Fed. Cir. 2008) that interprets the existing statutory language should limit the addition of new claims by a Patent Owner in reexamination.

*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?*

No. There are thirty years of precedent, legislative history, regulations and practice guidance on the meaning of “substantial new question of patentability. There is no upside to changing it now.

*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?*

Two months, but with a first one month extension by right, but at a fee of \$1000.00. Any subsequent extensions of time should be according to the current standards and fees.

*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”?*

Subject to the comment above regarding a first one month extension by right, a subsequent extension of time should be granted only when sufficient cause is in fact recited in the request for extension of time, and the appropriate fee is remitted. Additional extensions of time for the same response should require additional showings of good cause. Furthermore, the Office should add an examiner metric of deciding extension requests within two weeks as under current practice, they are often decided after the response has been due.

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

Yes, except that “any” should not include an IDS filed with a Patent Owner request for *ex parte* reexamination.

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

Merger with another reexamination proceeding for the same patent should be undertaken only where (1) Office resources will be conserved; (2) the proceedings are at relatively the same point in prosecution (so that no undue time will be lost in the “older”

proceeding and the rights of all parties to the prospective merged proceeding can be preserved. Merger with a reissue proceeding should not be permitted when the reissue proceeding is a broadening reissue. Merger with a reissue proceeding should not be permitted when the reexamination proceeding is near to a conclusion. Prior art should be shared between the reexamination(s) and the reissue proceeding when merger is not accomplished.

*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?*

A petition that is supported by a verified statement that establishes the non-receipt of a paper served by a Patent Owner is the appropriate vehicle. The relief should be “equitable relief,” i.e., a sufficient number of days to make the Third Party Requester whole should be the standard. As a concurrent practice on this general subject, the Central Reexamination Unit should keep records with respect to service by each party in a reexamination proceeding on the other party in that proceeding, to preclude a party from intentionally engaging in late or inaccurate service in that proceeding.

*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)?*

Encourage – definitely. Require as a default provision, with the proviso that a party file a statement explaining why it cannot engage in e-filing and/or e-mailing of notices of Office actions and certificates.

*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?*

Where the statute and rules governing the existing proceeding require returning the proceeding to the Central Reexamination Unit Examiner, then that is what should happen. Currently, the reexamination statutory provisions are broad enough to permit jurisdiction to remain with the Board, but the rules would appear to require returning jurisdiction to the Examiner following a new ground of rejection if the Patent Owner so desires. See: 37

C.F.R. §§ 41.50(b)(1) and 41.77(b)(1). If and when *inter partes* review is enacted, it is not clear that the Board will be making any new ground of rejection in the proceeding.

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

Increase the resources dedicated to deciding petitions in reexamination proceedings. There are simply enormous time delays in reexamination petition practice.

Consider moderate increases to the reexamination fees to realistic levels in terms of the costs of conducting reexamination. If fees commensurate with the actual costs of conducting reexaminations were charged, more resources would be available to conduct reexaminations.