

**From:** Pham, Tam  
**Sent:** Wednesday, June 29, 2011 2:40 PM  
**To:** reexamimprovementcomments  
**Cc:** Springer, Colby  
**Subject:** Comments on Streamlined Patent Reexamination Proceedings

Please see attached comments on the proposed changes to streamline patent reexamination proceedings described in 76 Fed. Reg. 22854.

Best regards,  
Tam

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June 29, 2011

via electronic mail to  
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The Honorable David Kappos  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
Mail Stop Comments – Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Kenneth M. Schor, Office of Patent Legal Administration  
Re: Comments on *Streamlined Patent Reexamination Proceedings*, 76 Fed. Reg. 22854  
(April 25, 2011)

Dear Under Secretary Kappos:

On behalf of the Ruckus Wireless, Inc. (“Ruckus”), we are writing to offer comments regarding the changes proposed by the United States Patent and Trademark Office (the “Office”) published in the Federal Register on April 25, 2011 (PTO-P-2011-0018) entitled, *Streamlined Patent Reexamination Proceedings; Notice of Public Meeting* (the “Notice”).

Ruckus is a pioneer in the field of Wi-Fi technology with over 100 patents granted or pending worldwide. After years of diligent scientific research, product development, and market education, the groundbreaking innovations of Ruckus’ intelligent antenna and wireless technology have been recognized by numerous industry awards. Ruckus’ innovations were recently recognized, for example, as the GSMA 2011 Mobile World Congress’ “Best Mobile Broadband Technology.”

Ruckus’ technology has also become widely adopted around the world, improving the reliability and performance of Wi-Fi for millions of users. Because the technological breakthroughs achieved by Ruckus have proven to be so valuable to so many, industry competitors have attempted to copy and misappropriate Ruckus’ intellectual property. Accordingly, Ruckus has found that such entities are currently incentivized to abuse reexamination proceedings in order to delay and vitiate patent owners’ intellectual property rights. The consequential delay prevents patent owners from having their cases heard in court,

permits evidence to become stale or lost, and permits patent infringement to continue in the interim with no redress for the loss of patent term.

Ruckus therefore commends the Office for seeking to improve and expedite reexamination proceedings such that patent owners' rights are not held indefinitely in abeyance. Specific comments on the proposed changes are provided below.

#### **A. PROPOSED CHANGES TO BOTH EX PARTE AND INTER PARTES REEXAMINATIONS**

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

Ruckus agrees with the Office that any request for reexamination must include "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." Ruckus would clarify that mere conclusory statements that an SNQ is new and non-cumulative are not sufficient. Ruckus would further clarify that "what had been considered in any previous or pending USPTO examination of the patent claims" includes at least the references listed on the face of the patent.

Ruckus would further propose that the required statement include an identification of all the technological teachings supporting the SNQ ("SNQ teachings") and for each SNQ teaching, an identification of where the SNQ teaching is disclosed in the references that have already been considered in examination of the patent claims. The required statement should additionally include a detailed explanation of how each SNQ teaching is not disclosed by any of the previously considered references, either alone or in combination. Such a process would be analogous to the analysis an examiner uses when analyzing relevant prior art references and determining whether or not the reference contains a limitation. Such a process is also analogous to the analysis required to accelerate examination of a patent application.

The additional changes proposed by Ruckus would allow the Office to quickly determine whether the technological teachings supporting an SNQ are actually new and non-cumulative over the teachings of the references already considered in examination of the patent claims.

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

Ruckus agrees with the Office that the Requester must provide a proposed rejection with "a limitation-by-limitation explanation" for each claim. Ruckus notes, however, that claim

interpretation is crucial in determining whether a reference actually apply to a limitation. Where a limitation is taken out of context or an erroneous definition is attributed to a claim term, for example, even a “limitation-by-limitation explanation” may not be sufficient to support a rejection.

Ruckus would therefore suggest that the proposed rejection include a support statement as to how the rejection interprets each claim limitation consistently with the context of the claim and the written description of the specification. See MPEP § 2111 (requiring that “[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach”); see also *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (finding that the meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”).

In this regard, Ruckus proposes that the Requester additionally provide an explanation of how each limitation of the claims finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification. If applicable, the showing must also identify: (1) Each means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112, Section 6; and (2) the structure, material, or acts in the specification that correspond to each means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112(6). The Requester should further specify where in the specification each limitation of the claim finds support.

The additional changes proposed by Ruckus would allow the Office to quickly determine whether the proposed rejection is based on an interpretation of the claim limitations that satisfies long-established standards for claim interpretation.

### **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**

Ruckus supports the proposal to require the Requester to explain “how each SNQ is substantially different from all other SNQs that are being asserted against the same claims in the same request.” Ruckus would further suggest that where the Requester asserts multiple SNQs, the Requester should not only provide the identification of each SNQ teaching present in references that have already been considered, as described in Section A.1. In addition, the Requester should further identify where each SNQ teaching may be found in each other reference being relied on by the Requester to support the SNQs (“SNQ references”).

Ruckus further proposes that the statement additionally include a detailed explanation of how each SNQ teaching is not disclosed by any of the previously considered references OR any of the other SNQ references relied on by the Requester, either alone or in combination.

The additional changes proposed by Ruckus would allow the Office to quickly determine whether the SNQs being raised are actually non-cumulative of each other and references already considered in examination.

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

Ruckus supports the proposal to have the Examiner identify each of the Requester's proposed rejections as either being "adopted" or "not adopted" according to the procedures set forth as follows:

In deciding which rejections to designate as representative, the examiner will apply the guidance set forth in MPEP § 706.02(I), quoted below:

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

- (A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;
- (B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or
- (C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

To aid the Examiner's review, Ruckus would further require the Requester to explain for each SNQ reference presented in the Request, why that SNQ reference is the best available art or alternatively, how the SNQ reference satisfies one or more of the exceptions enumerated above. Such an explanation would allow the Office to quickly determine that the best available art is being relied upon to support the proposed rejection.

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

Ruckus agrees with the proposal to "requir[e] the Requester to submit all necessary evidence in the initial request and thereby reduce the need for later submissions." Ruckus also supports the proposal to require "[i]n all cases, when submitting new evidence, the Third Party Requester must identify the specific point to be rebutted and explain how the new evidence rebuts it."

Ruckus would further clarify that mere pretexts to submit new evidence are not sufficient. Where the specific point being rebutted had been presented in any previous or pending USPTO examination of the patent claims, the Requester would have had the opportunity to submit the evidence in the Request. Any submissions at a later point in time should therefore be refused and returned to the Requester.

To guide the Office in determining whether such a standard is met, Ruckus would propose that the Requester explain how the specific point being rebutted is new and non-cumulative of any point already presented in any previous or pending USPTO examination and further, why the new evidence being submitted could not have been submitted in the Request.

The changes proposed by Ruckus would allow the Office to quickly determine whether the new evidence submitted by the Requester is actually being submitted for rebuttal purposes.

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

Ruckus agrees with the goal of encouraging compact prosecution. Ruckus notes, however, the proposal would not allow for after-final amendments that remove issues for appeal or in some other way require only a cursory review by the examiner in accordance with 37 CFR § 1.116(b). Such amendments do not have a significant impact on the compactness (or lack thereof) of prosecution. Forcing the patent owner to petition to have such minor amendments entered would add, rather than eliminate, delay from reexamination proceedings. As such, Ruckus would modify the proposal to be consistent with the standards presently articulated in Rule 116(b) of the Code of Federal Regulations.

#### **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**

As with Section A.6, Ruckus would modify this proposal to be consistent with at least 37 CFR § 1.116.

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

Ruckus shares the USPTO's hopes of "reduc[ing] the number of improper or duplicative petitions that are currently filed." Ruckus understands that some technologies and the process of patent examination may be, in some cases, very complex and involve large numbers of references. In that regard, Ruckus believes it would be helpful to the Office to hear from a

knowledgeable party (*e.g.*, the patent owner) concerning the individual facts and circumstances surrounding the examination of patent claims.

Examples of situations where the Office may benefit from such knowledge include petitions for review of refusal to grant *ex parte* and *inter partes* reexamination and requests to review a finding of an SNQ in an order granting *ex parte* or *inter partes* reexamination. As such, Ruckus would propose to allow for opposition of petitions for review of refusal to grant *ex parte* and *inter partes* reexamination and to allow for submission of petitions to review a finding of an SNQ in an order granting *ex parte* or *inter partes* reexamination. Ruckus believes that the correction of any misunderstandings, inaccuracies, or baseless assumptions present in the Request should be brought to the attention of the Office at an early stage of reexamination. Ruckus believes that preventing such misunderstandings, inaccuracies, or baseless assumptions from tainting later stages of reexamination would result in more compact proceedings overall.

To further streamline reexamination proceedings, Ruckus would propose that where a Request is denied in part, reexamination should proceed with special dispatch as to the patent claims for which reexamination is granted. Reexamination proceedings should not be delayed -- and the status of all the patent claims at issue should not be suspended indefinitely -- by unjustified and improper petitions practice pertaining only to a few claims. As such, Ruckus proposes that the decision to deny in part should not be reviewable. The Requester may have the option of filing a new Request for a new and separate reexamination proceeding as to the patent claims for which reexamination was denied. If the new Request is granted, reexamination proceedings may be merged upon a showing that the SNQ(s) are substantially the same. The changes proposed by Ruckus would eliminate the delay caused by petitions pertaining to only a portion of the patent claims at issue.

## **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**

Ruckus supports the Office proposal to make permanent the pilot program allowing patent owners to optionally waive the patent owner's statement. Ruckus agrees that allowing the patent owner to waive the statement and barring the Requester from further submissions would serve to make prosecution more compact.

To further streamline reexamination proceedings, Ruckus would propose that where the patent owner does submit a patent owner's statement, any reply by Requester should be limited to the issues raised in the patent owner's statement. Where a Requester addresses an issue not raised

by the patent owner, the Requester must explain why the issue is new and non-cumulative of the issues already addressed in previous or pending examination proceedings and further, why the issue could not have been presented in the Request

## **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**

Ruckus notes that under current practice, where a patent owner waives the patent owner's statement, a third party Requester in an ex parte reexamination proceeding may not file a reply or any further submission. By treating the patent owner's statement as a response to the provisional first action on the merits, the proposed change would effectively allow the Requester to participate in examination by way of reply to the patent owner's statement, thereby introducing additional delay into the ex parte reexamination proceedings. If the Requester wishes to participate in examination, the Requester may file a request for inter partes reexamination. Ruckus would therefore recommend that if this proposal is adopted (Section B.2), that the Requester be barred from making any further submissions.

Alternatively, Ruckus would modify the proposal to allow reexamination proceedings to continue whether or not a reply is filed by the Requester. In other words, the Examiner is not required to wait for the reply before proceeding with reexamination of the patent claims at issue. If the Requester does submit a timely and compliant reply, the Examiner may optionally consider at the Examiner's discretion.

## **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**

Ruckus would modify the proposal to ensure that mere conclusory statements would not be sufficient to overcome the Examiner's designation of a representative rejection. Ruckus therefore proposes that the Requester be required to provide an explanation as to why the rejection is not representative of other rejections in the group. For each proposed rejection that the Requester argues is separate and different from the representative rejection, the Requester should identify the specific teachings in the references relied upon for the proposed rejection and identify where those teachings are present in the references relied upon for the representative rejection. The Requester should further explain in detail how each teaching related to the proposed rejection is not disclosed by any teaching related to the representative rejection. A similar evidentiary standard should apply on appeal.

The additional modifications proposed by Ruckus would allow the Office to more quickly determine whether a rejection is representative of the rejections proposed by the Requester.

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

Ruckus agrees with the Office that consolidating multiple communications into one action would reduce delay. Ruckus further proposes that the Notice of Intent to Issue Inter Partes Reexamination Certificate be consolidated with the final office action, where appropriate.

## **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**

Ruckus supports the Office proposal to prohibit Requesters from appealing the disposition of any claim that is finally rejected on at least one ground. Where the Requester is submitting a respondent brief, Ruckus would add that the arguments to support additional proposed rejections must comply with the evidentiary standards described by Ruckus in Section C.1.

### **C. ADDITIONAL COMMENTS BY RUCKUS**

#### **1. Word/Page Limits**

While Ruckus sympathizes with the desire to reduce the amount of duplicative and unnecessary filings, placing an arbitrary limit as to words or pages may prevent the parties from fully briefing the issues related to the patent claims at issue. Technologies, prosecution histories, and arguments may vary in complexity, and Ruckus believes that the Office should have the benefit of being fully briefed where necessary to aid understanding of such technologies, prosecution histories, and arguments. As such, Ruckus would propose any word or page limit apply to an arguments section alone and that appendices (*e.g.*, providing claim listings, prosecution histories) should not be counted toward the word or page limit.

#### **2. Criteria on Addition of New Claims**

The present limitations on adding new claims already bar the patent owner from enlarging scope or adding new matter. As such, Ruckus believes that the current rules of practice already strike the appropriate balance and that further limitations may improperly restrict that which the patent owner is entitled to claim.

### 3. Substantial New Question of Patentability

Ruckus believes that the current standard is too vague, subjective, and provides too little guidance to the Office, patent owners, and third party requesters. Ruckus notes that the present standard (“substantial likelihood that a reasonable examiner would consider it important in deciding whether or not the claim is patentable”) generally tracks the language regarding materiality recited by 37 CFR § 1.56 prior to 1992:

[I]nformation is material where there is a **substantial likelihood that a reasonable examiner would consider it important** in deciding whether to allow the application to issue as a patent.

Rule 56 was amended in 1992 to make the standard more objective:

- b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
  - (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
  - (2) It refutes, or is inconsistent with, a position the applicant takes in:
    - (i) Opposing an argument of unpatentability relied on by the Office, or
    - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

With the added caveat that the information must also be “new,” Ruckus believes that foregoing language provides clearer and more objective standards by which to determine whether there is a substantial new question of patentability. As such, Ruckus proposes that the standard be amended to conform to that currently articulated in 37 CFR § 1.56 (post-1992).

Ruckus further believes that certain information is crucial to determining whether a substantial new question of patentability exists. By requiring that any Request comply with the

requirements and standards proposed by Ruckus in Section A.1, the Office can ensure that such information would be provided.

#### **4. Pre-Appeal Brief Request for Review**

The Office asks whether it is more efficient for three administrative patent judges or a single examiner to decide issues involving new evidence and amendments. Ruckus proposes a third option by which the patent owner may seek review with express dispatch: a “pre-appeal brief request for review” option.

The Office presently conducts a six-year-old pilot program that offers a patent applicant an avenue to request a review of the legal and factual bases of the rejections in his or her patent application prior to the filing of an appeal brief. Within 45 days after submission, the pre-appeal brief request is reviewed and decided by a panel including the Examiner of record, a supervisor, and 1-2 other examiners. Ruckus believes such a program may quickly dispose of the more obvious issues and reduce the number of groundless appeals, thereby providing much-needed efficiency to reexamination proceedings

#### **5. Patent Term Extensions**

Because Ruckus has found that certain parties are currently incentivized to abuse reexamination proceedings in order to misappropriate patented technology, Ruckus proposes that such incentives may be reduced by granting patent term extensions where delaying tactics are employed by third party Requesters. Where a petition or appeal submitted by a Requester is found to wholly lack merit, for example, the patent owner should be granted a patent term extension for each day the petition or appeal is pending.

Additionally, while Ruckus sympathizes with Examiners who have large and unwieldy dockets, reexamination proceedings are required by statute to be conducted with special dispatch. See 35 USC §§ 305, 315. Ruckus therefore further proposes that patent owners be granted patent term extensions for each day of Examiner delay beyond the time periods provided for in MPEP § 2261 (*e.g.*, requiring that “[m]ailing of the first action should occur within 6 WEEKS after the appropriate filing or due date of any statement and any reply thereto”).

**D. CONCLUSION**

Ruckus appreciates the Office asking for input in response to the Notice and if there are any questions or further explanation required concerning any of the comments provided above, please do not hesitate to contact the undersigned.

Sincerely,  
RUCKUS WIRELESS, INC.



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