

From: Winkler, Michael
Sent: Friday, July 22, 2011 12:08 PM
To: reexamimprovementcomments
Cc: Schor, Kenneth
Subject: Comments from ABA Section of Intellectual Property Law on reexamination proceedings

Please find attached comments from the ABA Section of Intellectual Property Law on Streamlined Patent Reexamination Proceedings, 76 Fed. Reg., Vol. 79, 22854 (April 25, 2011).

Please feel free to contact us if there are any questions.

Thank you.

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July 25, 2011

Via Electronic Mail
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The Honorable David J. 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
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Attn: Kenneth M. Schor, Streamline Reexamination Proposals
Re: Comments on Streamlined Patent Reexamination Proceedings,
76 Fed. Reg., Vol. 79, 22854 (April 25, 2011)

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request of the United States Patent and Trademark Office ("the Office") published in the Federal Register on April 25, 2011 (PTO-P-2011-0018). In particular, the Section submits the following comments on the *Streamlined Patent Reexamination Proceedings*, 76 Fed. Reg., Vol. 79, 22854 (the "Streamline Notice"). These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

Petition Practice Management in *Inter Partes* Reexamination

The Section recognizes and appreciates the Office's efforts to solicit public opinion regarding proposed changes and questions relating to streamlined patent reexamination proceedings. The Section supports, in principle, enhancements to reexamination that improve patent quality without creating unreasonable costs and delays. The Section takes no position for, or against, the published proposals of the Streamline Notice. Instead, the Section responds to the Office's request for recommended changes to petition practice in patent reexamination (Streamline Notice at Sec. A8). As the

Office is well aware, petition practice has exploded as a result of the increased use of *inter partes* patent reexamination.¹

The Streamline Notice has provided a very helpful list of common petitions, and indicated when they may be appropriately opposed. Likewise, the Office alludes to internal controls that have improved petition tracking (Streamline Notice at 22855). While these efforts are greatly appreciated, and quite helpful, the Section resolves to encourage further efforts to stem the tide of petition filings to the Office and to simplify the review of petitions that address routine, procedural issues.

The Section resolves to recommend the following petition practice management initiative to the Office for the purpose of addressing the growing petition backlog. The initiative would not require significant additional expenditure or resources, but instead, would build upon existing Office infrastructure and well established patent interference resources.²

Procedural Motions Clerk

Many *inter partes* reexamination petition filings are directed to procedural issues only, such as waiver of page limits, untimely responses (e.g., late mail service), the striking of improper filings, etc. The Office would be best served disposing of these petitions by involving a procedural clerk that is available by telephone. A similar Ombudsman Pilot Program has been successfully employed in application prosecution.

Like the Ombudsman Pilot Program, a procedural motions clerk would be available for teleconference. All parties to the proceeding (both petitioner and non-petitioner) would be entitled to participate in the teleconference. Unlike the application ombudsman, the procedural motions clerk would be making decisions as to procedural rights of Patent Holders and Third Party Requesters in patent reexamination. As such, it may be appropriate for a decision maker of the Board of Patent Appeals & Interferences (BPAI) to be tasked with this duty. The Section suggests that the decision making authority be in the smallest possible group for consistent results. Following the teleconference, the procedural motions clerk would place a paper in the file which memorializes the call in detail and states the clerk's decision.

¹ See the June 1, 2011 Public Meeting presentation of Mr. Scott A. McKeown "Streamlined Patent Reexamination, Proceedings: Petition Practice Management" (citing the Office of Patent Legal Administration's (OPLA) statistics on the current petition backlog).

² Due to the continual decrease in declared patent interferences, it is expected that such resources will be available for reallocation in the near term, especially in view of the pending "first inventor to file" proposal currently before Congress.

By enabling timely teleconferences between parties and the clerk, procedural disputes can be resolved quickly, without the need for petition. Seasonable resolution of such disputes would greatly enhance the public's confidence in patent reexamination and help avoid administrative complication of petition practice, which tend to aggravate overall pendency.

While there would certainly be some cost associated with implementing this program within the Office, the Section believes this cost would be easily recouped through increased efficiency and decreased workload in OPLA.

Electronic Filing in Reexamination Proceedings

Questions 11 and 13 posed in the Streamline Notice relate to electronic filing and generally to other changes that the Office can and should make in order to streamline reexamination proceedings. (Streamline Notice at 22860). The Section responds to these questions as follows.

For efficiency and fairness, the Section supports Office regulations which encourage that all correspondence in both *inter partes* and *ex parte* reexamination proceedings be conducted electronically.

With respect to *inter partes* reexamination, the statutory 30 day response period accorded to Third Party Requesters begins to run upon deposit of a Patent Owner response with first class mail of the U.S. Postal Service thus prejudicing Third Party Requesters by late mail/service of Patent Owner Responses. The use of electronic communication in reexamination proceedings promotes fairness as mail can be delayed for several days over weekend/holiday periods while valuable time is lost to Third Party Requesters. Accordingly, the Section proposes the use of an electronic platform for the filing and issuance of papers in patent reexamination.

Currently, the Office utilizes a web portal for filing all papers in a patent interference. Once filed the papers are electronically served by operation of the portal. The Section recommends use of this platform or a similar platform for patent reexamination proceeding communications.

Timing of Third Party Requester Response

Question 6 posed in the Streamline Notice asks how much time Patent Owners and Third Party Requesters should ordinarily be given to submit a statement, response or appeal where the time for filing is set by the Office rather than by statute. The Section responds to this question as follows.

The Section supports, in principle, enhancements to reexamination that improve patent quality without creating unreasonable costs and delays. Accordingly, the Section

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suggests that Third Party Requester time limits for filing a statement or response be retained at 30 days to expedite the proceeding where time for filing the statement or response is set by the Office rather than statute.

* * *

In closing, the Section recognizes and appreciates the Office's efforts to solicit public opinion regarding proposed changes and questions relating to streamlined patent reexamination proceedings. The Section supports in principle, enhancements to reexamination that improve patent quality without creating unreasonable costs and delays. Accordingly, the Section proposes the implementation of a Procedural Motions Clerk pilot program, that the time for filing of statements or responses for Third Party Requesters remain at 30 days, and implementation of a platform and regulations which encourage all correspondence in reexamination proceedings to be conducted electronically.

If you have any questions regarding our comments or would wish for us to explain further any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

A handwritten signature in black ink, appearing to read "Marylee Jenkins", written over a horizontal line.

Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law