

July 15, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**Re: Comments on Streamlined Patent Reexamination Proceedings
76 Fed. Reg. 22854 (Apr. 25, 2011)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the proposed changes to the rules and procedures governing *ex parte* and *inter partes* reexamination practice before the Patent and Trademark Office (PTO), which were published in the *Federal Register* on April 25, 2011, in conjunction with the notice of public meeting entitled “Streamlined Patent Reexamination Proceedings.” Our comments are attached to this letter.

AIPLA is a national bar association with approximately 16,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

In general, AIPLA supports and applauds the PTO’s initiative to reduce pendency and improve efficiency in reexamination proceedings. Of special concern is the extraordinary length of reexamination proceedings under current practice, because long pendency deprives litigants and the courts of what could otherwise be an alternative to resolving patent validity issues in district court litigation. But AIPLA is concerned that some of the proposed changes conflict with mandates of the Patent Act, particularly the proposed changes that permit an examiner to address only certain of the adopted rejections on the merits as well as the proposed changes further limiting patent owners’ ability to amend claims.

Furthermore, AIPLA firmly believes that changes to reexamination practice must balance the goal of providing expeditious and efficient reexamination with the due process and fundamental fairness owed to both patent owners and third-party requesters. Third-party requesters are entitled to have all of their arguments heard, and patent owners must have a full and fair opportunity to respond to third-party requesters’ positions. That opportunity is currently curtailed by, for example, unreasonably low page limits in briefs.

AIPLA appreciates the opportunity to provide these comments and would be pleased to answer any questions these comments may raise. We thank you in advance for considering these views.

Sincerely,



Q. Todd Dickinson
Executive Director

AIPLA Comments Concerning USPTO Proposals for Streamlining Reexamination Proceedings

July 2011

A. Proposed Changes to Both *Ex parte* and *Inter partes* Reexaminations

AIPLA is in favor of initiatives intended to clarify the rules and procedures applied to prosecution and examination of requests for reexamination.

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

AIPLA observes that Proposed Change A.1 is consistent with existing reexamination practice.

Current 37 C.F.R. § 1.510(b)(1) requires that an *ex parte* reexamination request must, in order to be entitled to a filing date, include “[a] statement pointing out each substantial new question of patentability based on prior patents and printed publications.” (Emphasis added.)

The first clause of 37 C.F.R. §1.915(b)(3) imposes an identical requirement with respect to a request for *inter partes* reexamination. The Notice (at 76 FR 22854) states that the 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 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.

AIPLA suggests revisiting the reexamination guidelines posted by the USPTO to ensure consistency with any Rule change implementing Proposed Change A.1.

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

AIPLA agrees that Proposed Change A.2 is consistent with 37 C.F.R. §§ 1.510(b)(2) and 1.915(b)(3), second clause, which require a reexamination request to provide “a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.”

AIPLA suggests revisiting the reexamination guidelines posted by the USPTO to ensure consistency with any Rule change implementing Proposed Change A.2.

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.*

AIPLA believes that SNQs are rarely, if ever, cumulative. However, AIPLA would not oppose the adoption of rules requiring a reexamination requester to provide a brief explanation why multiple SNQs for the same claims(s) are not cumulative. AIPLA suggests 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 SNQs, provided that the Examiner is, in turn, required to explain the basis for any determination that an SNQ is cumulative. Such a framework would permit the requester to file a petition for supervisory review when appropriate.

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

AIPLA is concerned that Proposed Change A.4 may conflict with the statutory requirements of 35 U.S.C. §§ 304 and 313. Each of these sections requires 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.) Clearly, if multiple SNQs are presented and accepted as sufficient bases for reexamination, 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, where a representative rejection is adopted, and a patent owner then overcomes the rejection by argument, other proffered rejections will then have to be addressed. By statute, the Examiner must resolve each SNQ and must explain why each and every rejection proposed but not accepted does not establish unpatentability. Therefore, implementation of Proposed Change A.4 would result in piecemeal prosecution. Indeed, if all SNQs are not properly resolved, the result will be prolonged prosecution, not prosecution with special dispatch.

Further, the current practice of some examiners of applying only one rejection when several have been proffered appears to be an early *de facto* adoption of this Proposed Change. The resulting procedure neither provides the third party requester procedural due process nor follows the statutory mandate. This problem is exacerbated when the Examiner provides reasons for allowance that fail to address in detail why the insufficiency of each applied rejection is not remedied by other rejections associated with the same SNQ that are proposed but not adopted.

This current practice, moreover, does not measure up to even the proposed rule change. For, as stated in the Notice (76 FR 22856, right-hand column), the patent owner would be required to appeal from each rejection, not just representative rejections. Accordingly, the patent owner should have the opportunity to provide a full response to each rejection from the beginning of the reexamination proceeding, and the actual or proposed practice of the Examiner providing only one rejection places the patent owner in an untenable position.

In that context, AIPLA directs the USPTO's attention to MPEP § 2258.01, which indicates that references are rarely cumulative, and to MPEP § 2660(III), pertaining to *inter partes* reexamination, which states as follows:

“[T]he 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.”

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

AIPLA generally believes that Proposed Change A.5 will encourage compact prosecution. As the text of 37 CFR § 1.948 suggests, the requester may provide additional evidence when the patent owner or examiner raises one or more issues that were at least reasonably unforeseeable at the time of the original request.

Evidence or claim amendments will rarely be entered after a final rejection or ACP. For *ex parte* reexamination, the requester is out of the picture by the time of a final rejection. For *inter partes* reexamination, both parties are subject to 37 CFR §§ 1.113 and 1.116, which greatly restrict entry of amendments and/or evidence after the ACP.

The patent owner does not, however, have the option of filing a Request for Continued Examination. And in the absence of that option, AIPLA believes that the USPTO should be more flexible in permitting entry of additional evidence when it is clear that such evidence would bring the prosecution to an end, conserve USPTO and patent-owner resources, and provide for special dispatch.

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

AIPLA believes that Proposed Change A.6 conflicts with 35 U.S.C. §§ 304 and 305, which provide patent owners two opportunities to amend their claims during *ex parte* reexaminations. Pursuant to § 304, the claims may include “any amendment” in the patent owners' optional response. Additional amendments are permitted in later proceedings because § 305 requires reexaminations to be conducted according to 35 U.S.C. § 132, which allows an applicant “to persist in his claim for a patent, with or without amendment.” Section 132 also applies to *inter partes* reexaminations, pursuant to 35 U.S.C. § 314. AIPLA believes that Proposed Change A.6 may be unfair to patent owners because it will be difficult, if not impossible, to anticipate the amendments or evidence necessary to overcome substantive arguments that may not arise until later in the proceedings—a problem many patent owners will face if they overcome a “representative rejection.”

The USPTO should consider the fact that the patent owner does not have any time prior to the reexamination to review and reflect on any claim amendments in view of the prior art cited by the third-party requester. Thus, AIPLA strongly believes that any streamlined process must provide a patent owner with a full and fair opportunity to respond to any argument or evidence provided by a third-party requester, including the opportunity for the patent owner to provide any amendment or evidence seen as necessary to rebut the third-party requester's submission.

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.*

AIPLA believes that Proposed Change A.7, if applied in an unreasonable manner, will be at odds with the plain language of 35 U.S.C. §§ 304 and 314. Section 304 does not restrict claim amendments in a patent owner's optional statement to those directed to an SNQ. Instead, the patent owner may introduce "any amendment . . . and new claim or claims he may wish to propose." Similarly, Section 314 allows a patent owner to do the same in *inter partes* reexaminations, as long as "no proposed amended or new claim enlarg[es] the scope of the claims." If a proposed amendment does not broaden the claims, it is permitted under both sections, regardless of whether it addresses an SNQ. Because, however, SNQs are the focus of reexaminations, AIPLA favors process changes that prevent the proceedings from becoming a *de facto* reissue. Yet, any such changes must protect the patent owner's statutory right to amend the claims in any non-broadening fashion in order to overcome rejections.

AIPLA suggests that the USPTO reconsider Proposed Change A.7 in view of the statutory language of 35 U.S.C. §§ 304 and 314.

8. *Petitions Practice Will Be Clearly Defined.*

AIPLA appreciates the much-needed clarification in the USPTO's reexamination-petition practice. Even more helpful would be further clarification of where each type of petition is to be decided, namely, the Central Reexamination Unit (CRU) or the Office of Patent Legal Administration (OPLA).

AIPLA believes that the USPTO should consider consolidating the authority for deciding petitions in reexamination proceedings in a single organizational unit, preferably outside of the CRU. This unit should be separate from OPLA, but have the limited authority to act on those §§ 1.183 and 1.182 petitions that arise from reexamination proceedings. The decision of petitions outside of the CRU will provide a check and balance in the process and should eliminate second and third petitions.

AIPLA also appreciates the helpful examples of petitions filed in reexamination proceedings and the guidance concerning the rules under which each petition should be filed. AIPLA believes that current petition practice causes undue delays. Telephonic hearings, like those currently in use in interference proceedings, could and should be used to resolve procedural issues (*e.g.*, page or word limits).

Current delays in the petition process delay resolution of the merits of reexamination proceedings. Thus, adequate resources need to be devoted to petitions in reexamination proceedings. Petitions should be resolved in a timely manner, and the resolution should include a clear statement of reasoning. It would be helpful if a petition-resolution date estimate were included on the Patent Application Information Retrieval (PAIR) sites, so that interested parties would have an idea of when a petition decision will be issued.

Finally, it is essential that a petition to transfer jurisdiction to the OPLA be made available to both parties. In many instances, the OPLA's involvement is needed to ensure that reexamination proceedings are conducted in accordance with proper MPEP rules and procedures, thereby upholding both parties' rights to due process. AIPLA recommends that a dedicated position be created at the OPLA, specifically for reexamination, with the authority to resolve petitions filed under 37 C.F.R. §§ 1.182 and 1.183. With this solution, petitions would be decided more uniformly and in a timelier manner.

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, and***
- 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.***

AIPLA again urges that the Proposed Changes should not come at the expense of patent owners' due-process rights. It is especially important that before any Office action is made final, there is no shift in the USPTO's position or adoption of a third-party requester's argument or evidence that would warrant a rebuttal by a patent owner by way of amendment or evidence.

AIPLA believes that Proposed Changes B.1 and B.2 would elevate efficiency over patent-owner rights. Additionally, adoption of these Proposed Changes would likely be prohibited by statute. Specifically, 35 U.S.C. § 305 states that "after the times for filing the statement and reply . . . have expired, reexamination will be conducted. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto." Under the current Proposed Changes, reexamination would effectively begin prior to the expiration of the times for filing a statement and a reply. Thus, it appears that implementing this Proposed Change would be contrary to the statute, as the time for filing the reply would not have expired.

Further, if the patent owner refuses to waive the statement, and does not file a statement in response to the provisional action, the patent owner would then lose the statutory right to propose an amendment, add claims, or introduce evidence to overcome a subsequent final action.

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.*

As explained in AIPLA's discussion of Proposed Change A.3, the USPTO's current position, stated in the MPEP, is that SNQs for the same claim are rarely cumulative. Accordingly, as further explained in AIPLA's discussion of Proposed Change A.4, rejections based on art that poses an SNQ can rarely be cumulative and must always be addressed (see MPEP §2660(III) quoted *supra*), because 35 U.S.C. §§ 304 and 312 require that the Director resolve SNQs that have been raised in a reexamination request. Only where SNQs are based on clearly cumulative references—such as patents that are continuations or divisionals of each other, or publications of the same disclosure in different languages—will rejections based solely on those patents be truly 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 the USPTO adopts this Proposed Change in some form, it must also establish a right to petition in order to permit challenges to determinations that a given rejection is "representative" of other rejections in a group. The USPTO's observation that, according to the Proposed Change, a requester will have the ability to dispute this designation before the Board is not well-founded, 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.*

AIPLA believes that a patent owner must be given a full and fair opportunity to respond to a third-party requester's position and any shift in the USPTO's position, including by way of amendment or evidence.

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 the Patent Owner's Appellant Brief.*

AIPLA believes that 35 U.S.C. § 315(b)(1) controls this situation. It is fairly clear that the USPTO cannot by rule preclude a requester from challenging an Examiner's refusal to adopt one or more rejections for a given claim in the requester's appellant brief or cross-appellant brief. The Examiner's refusal is a final decision that is favorable to claim patentability, and the statute provides a right to appeal the Examiner's decision not to adopt such rejection(s).

D. Comments on Specific Questions

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

AIPLA believes the USPTO should proceed with efforts to streamline reexamination proceedings. Currently, the sluggish pace of reexamination has a negative impact on litigation. In other words, the slowness of reexamination neither streamlines nor offers a substitute for litigation of validity issues. More specifically, courts often refuse to stay reexamination because delay due to reexamination can be prolonged and indefinite, and the date of issue a first Office Action is unknown. For these courts, standardization of reexamination timelines could provide a convincing reason to await the USPTO's expertise on issues of patent validity. Nevertheless, efforts to streamline reexamination must balance the goal of providing expeditious and efficient reexamination with the due-process rights of patent owners and third-party requesters and the fundamental fairness owed to all parties.

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

AIPLA believes that a universal word limit on requests for reexamination may unfairly restrict a requester's ability to present its SNQ statement(s). If any word limits are to be placed on reexamination requests, they should be based on the number of SNQs presented and/or the number of claims for which reexamination is requested.

AIPLA recommends that a fee should be attached to an excessive number of SNQs for each claim. Thus, for example, if there are more than 3 SNQs for each claim, a surcharge can be imposed that graduates with each additional SNQ. That would discourage suggestions of great numbers of SNQs while maintaining fairness and efficiency.

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

AIPLA believes that any revision of page limits in *inter partes* reexamination proceedings must be reasonable and ensure fairness to all parties. Page limits should not deprive parties of due process. In particular, the thirty-page limit for appellant briefs and the fifteen-page limit for respondent briefs under 37 C.F.R. § 1.948 can be particularly harsh (even citations to the record count against page limits). The page limits for appellants and respondents should be equal as a matter of fairness. Additionally, citations to the record could be included as endnotes, which would not be counted towards the word or page limit. A more objective method of determining, word or page limits could be based on the number of SNQs presented or the number of claims subject to reexamination.

Alternatively, AIPLA suggests that a fee be placed on a per-page increase, thereby reducing the number of petitions addressing only that issue. For example, a petition might be required only if the requested page limit is greater than 75 pages, and this petition should rarely be granted.

Further, AIPLA suggests making the per-page fee \$100 for each extra page. Thus, an additional 25 pages will cost each party \$2,500. This increase would discourage parties from filing lengthy papers.

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?*

In response to an order for *ex parte* reexamination, a patent owner's statement may contain "any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination." (35 U.S.C. § 304.)

Similarly, in an *inter partes* reexamination, the patent owner may "propose any amendment to the patent and a new claim or claims." (35 U.S.C. § 314.) These statutory provisions are subject only to prohibitions against enlarging the scope of the patent. (35 U.S.C. §§ 305 and 314.) Limitations or criteria restricting new claims, *e.g.*, requiring that new claims be addressed to the prior art cited or the SNQs, may run afoul of the statute. Accordingly, AIPLA believes that the USPTO should not place additional limitations on the patent owner's statutory right to present new claims during 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?*

AIPLA believes that interpreting "a substantial new question of patentability" to require something more than the current guidelines set forth, such as a showing of prima facie unpatentability or materiality as defined in 37 C.F.R. § 1.56, would place an unduly high burden on third-party requesters and diminish the value of reexamination proceedings as an alternative avenue for dispute resolution. Elaboration and/or clarification of the guidance provided in MPEP §§ 2242 and 2642 on the meaning and scope of the term "substantial new question of patentability" would provide all parties with clearer expectations for the reexamination process.

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?*

AIPLA believes that a minimum time of two months is reasonable, provided that the extension-of-time practice is reasonable.

7. *Under what conditions should the USPTO grant a patent owner's request for an extension of time under 37 C.F.R. § 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"?*

AIPLA believes that the USPTO should interpret liberally the "sufficient cause and for a reasonable time specified" standard for granting the patent owner's request for an extension of time. Pursuant to 37 C.F.R. §§ 1.550(d) and 1.957(b), if the patent owner fails to file a timely response, the prosecution is terminated, and a certificate is issued concluding the reexamination proceeding in accordance with the last Office action. A petition to revive the prosecution may be granted if the delay in filing a response is shown to be unavoidable or unintentional. (37 C.F.R. §§ 1.550(e) and 1.958.)

Accordingly, a patent owner's due-process rights may be at risk if the standard for granting requests for extensions of time is unreasonably applied. AIPLA believes that requests for short extensions of time, when the owner makes a showing of reasonable diligence toward meeting the deadline, should rise to the level of "sufficient cause and for a reasonable time specified." Additional factors, such as the number of claims under review, the number of pending rejections and their nature, whether the patent is involved in litigation, and the number of related patents that are concurrently undergoing reexamination, should also be considered in the sufficiency-and-reasonableness analyses.

Furthermore, if the patent owner submits the request for extension of time at least one month prior to the due date, the USPTO should ensure that extension requests are decided within two weeks, as under current practice they are often delayed and decided only after, or immediately before, a response is 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 C.F.R. §§ 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?*

The parties listed in 37 C.F.R. § 1.56 continually discover art that may be material and non-cumulative to previously filed applications or issued patents. These references must be disclosed during reexaminations, pursuant to 37 C.F.R. §§ 1.555 and 1.933, and patent owners should not be burdened with explaining the timing or relevance of the submission. To the extent the USPTO is considering changes to § 1.56, AIPLA suggests that the USPTO either consider any changes to rules involving compliance with § 1.56 in reexamination in conjunction with those changes to § 1.56 or defer any changes to rules involving compliance with § 1.56 in reexamination until any change to § 1.56 is finalized.

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

AIPLA believes that USPTO resources would be conserved if multiple reexaminations are merged into a single proceeding. In cases in which an *inter partes* reexamination is to be merged with either an *ex parte* reexamination or a reissue, it is essential that the rights of the third-party requester be preserved in the merged proceeding.

However, when a first proceeding is so far along that merger would significantly delay the first proceeding (a common delay tactic used by third-party requesters), the proceedings should not be merged. Thus generally, if the first proceeding has not progressed to a final Office action or ACP, then the proceedings should be merged. Merger at any time later in prosecution generally should be avoided, as it would significantly delay the proceedings.

Even so, a flexible approach must be taken. If, for example, it is clear to the Examiner in a later-filed proceeding that an error has occurred in the first proceeding, then the proceedings should be merged to clarify the record, even if the first proceeding has progressed toward a conclusion.

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?*

Pursuant to 37 C.F.R. § 1.903 and 35 U.S.C. § 314(b)(2), in an *inter partes* reexamination, any response filed by the patent owner must be served on the third-party requester, who then must file written comments within 30 days. If the patent owner's response is received by the third-party requester more than five business days after the date of service stated on the certificate of service, MPEP § 2666.06 provides that the third-party requester may submit a verified statement, specifying the date of actual receipt along with written comments. "The date of service will then be deemed by the Office to be the date of actual receipt by the Third Party Requester of the patent owner's response." AIPLA believes that the current provisions governing delay are fair and reasonable.

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)?*

AIPLA believes that electronically conducted prosecution should be encouraged. AIPLA supports electronic prosecution as the default and suggests that the USPTO require a statement from a party explaining why it cannot engage in e-filing or e-mailing 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?***

AIPLA believes the Office should follow the statute and the rules with regard to returning the proceeding to the Examiner. The current rules and procedure clearly specify when the Board should retain jurisdiction and when jurisdiction should return to the examiner. AIPLA further notes that, like the Board, the CRU has a three-person panel that reviews any action taken in a reexamination.

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

AIPLA suggests the following changes:

- Increase the resources dedicated to deciding petitions in reexamination proceedings. There are enormous time delays in reexamination petition practice.
- Consider moderate increases to the reexamination fees to realistic levels in terms of the costs of conducting reexaminations. If the USPTO charged fees commensurate with the actual costs of conducting reexaminations, more resources would be available to conduct reexaminations.