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**Subject:** Intellectual Ventures--Comments on Streamlined Patent Reexamination Proceedings published at 76 Fed. Reg. 22854-61 (April 25, 2011)

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 - Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Attention:* Kenneth M. Schor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Under Secretary Kappos,

The attached Comments by Intellectual Ventures, LLC are submitted in response to the Request for Comments relating to *Streamlined Patent Reexamination Proceedings* published at 76 Fed. Reg. No. 22854-61 on April 25, 2011.

Very truly yours,

David Dutcher

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**In re: Docket No. PTO-P-2011-0018**

**76 Fed. Reg. 22854  
(April 25, 2011)**

***Comments by Intellectual Ventures, LLC on Proposed Streamlined  
Patent Reexamination Proceedings***

**Attention:**

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 - Commissioner for Patents  
P.O. Box 1450  
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emphasizes quality and efficiency while minimizing cost. For more information about the business model and work of Intellectual Ventures, please visit our website:

<http://www.intellectualventures.com/inventors.aspx>.

The Request explains that the USPTO proposals are “intended to reduce pendency while maintaining quality in *ex parte* and *inter partes* reexamination proceedings.”<sup>3</sup> Although the USPTO has seen improvements in reexamination pendency through operational and organizational initiatives, the Request states that streamlining reexamination procedures, “including those governing the practices of the Patent Owner and Third Party Requester, will be necessary if a more significant reduction in pendency is to be achieved.”<sup>4</sup> The Request offers a variety of proposals that address numerous aspects of *ex parte* and *inter partes* reexamination procedures.

We support the USPTO’s efforts to reduce pendency and improve efficiency with respect to reexamination proceedings. Reexamination is a corrective procedure that, when properly used, increases public confidence in the quality of issued patents. In many instances, reexamination proceedings arise after the value of a particular patent has been identified and a patentee has made some attempt to realize that value through licensing and/or enforcement activities. Thus, patents in reexamination tend to be those for which a quick, clear, and fair outcome benefits both patentees and the public. Conversely, to the extent that the reexamination procedure is hampered by improperly ordered proceedings or administrative delays, the resulting uncertainty harms both patentees and the public. We appreciate and applaud the USPTO’s efforts to date in reducing reexamination pendency and improving quality through, for example, creation of the Central Reexamination Unit (CRU).

We are concerned, however, that some of the proposals included in the Request emphasize pendency at too high a cost: they are contrary to controlling law, they may actually increase pendency or have other unintended consequences, or they inordinately disadvantage patentees. We agree that it is important to control reexamination pendency because increased pendency increases uncertainty for patentees, third parties, and the public at large. However, pendency is not the sole consideration in reexamination; improvements in pendency that come at the expense of reexamination quality or fairness to any party represent an empty bargain.

## **II. Comments on particular reexamination proposals presented in the Request**

In summary, we recommend that the USPTO withdraw the proposals concerning limiting the Patent Owner’s presentation of amendments or evidence (A.6), requiring amendments to be accompanied by a statement explaining the amendments relative to a substantial new question of patentability (SNQ) (A.7), and implementing a “provisional” first Office action on the merits (FAOM) practice (B.2). We believe that each of these proposals does not follow controlling law, and several of these proposals may actually increase pendency or lead to other undesirable re-

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<sup>3</sup> Request at 22855.

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

sults (discussed below). We additionally recommend that the USPTO adopt procedures to reduce the need for petitions and to improve pendency by facilitating conversion of *inter partes* proceedings to *ex parte* proceedings following withdrawal of the Third Party Requester. Finally, we recommend that the USPTO reduce the likelihood of improvidently granting reexamination of means-plus-function claims by requiring Third Party Requesters to specifically identify corresponding structure when requesting reexamination of such claims.

A. The USPTO should not limit Patent Owners' presentations of amendments and evidence in the manner proposed in the Request.

In section A.6 of the Request, the USPTO proposes that in order to “encourage compact prosecution” through the early presentation of a Patent Owner’s amendments and evidence, submission of such amendments and evidence should be limited to the earlier of (1) the Patent Owner’s optional statement under 35 U.S.C. § 304 (if not waived), or (2) the Patent Owner’s response to an FAOM.<sup>5</sup> The Request indicates that later amendments or evidence would be permitted only to overcome a new ground of rejection presented in a non-final Office Action.<sup>6</sup>

We believe that this proposal to strictly limit the presentation of amendments or evidence has several problems, namely that: it is contrary to statute; it may have the unintended consequence of increasing pendency; and by failing to accommodate the practical and procedural realities of reexamination practice, it unfairly disadvantages patentees. We propose an alternative procedure that would still encourage the presentation of amendments and evidence early in reexamination proceedings while permitting patentees to receive a full and fair hearing with respect to their original patent claims.

*1. The proposed limitation is contrary to statute, which specifically provides opportunities for amendment that would be foreclosed by the proposal.*

By statute, patent reexamination is to be conducted according to the procedures established for initial examination of patent applications:

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. 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, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent.<sup>7</sup>

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<sup>5</sup> *Id.* at 22857.

<sup>6</sup> *Id.*

<sup>7</sup> 35 U.S.C. § 305.

Section 132, incorporated into reexamination proceedings by Section 305, provides that

[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.<sup>8</sup>

Thus, two statutory provisions independently provide patentees in reexamination proceedings the right to amend claims in response to a rejection or “decision adverse to the patentability of a claim.” The initial order granting reexamination is not itself such a “decision,” in that it merely alleges the existence of an SNQ as to one or more claims.

Under the patent statute, patentees are entitled to at least one opportunity to amend claims, as a matter of right, after examination on the merits. Because the initial reexamination order does not constitute examination on the merits, the Request’s proposal to limit further amendments if a Patent Owner chooses to submit an amendment with the optional statement would be inconsistent with the statute.

Moreover, Congress did not specifically limit a Patent Owner’s right to amend by requiring that such an amendment be submitted in response to the first “decision adverse to ... patentability” in a reexamination proceeding. We note that in initial examination, USPTO rules allow an applicant to have a later amendment entered as a matter of right through submission of a Request for Continued Examination (RCE).<sup>9</sup> A comparable procedure for reexamination proceedings, such as we propose below in subsection II.A.4, would be consistent with Section 305, and would support Congress’s intent that reexamination proceedings be conducted in the manner prescribed for initial examination.

*2. The proposed limitation may have the unintended consequence of increasing examination effort and pendency due to submission of additional claims.*

As noted above, the rationale offered in the Request for requiring early presentation of amendments and evidence is to “encourage compact prosecution,” apparently in order to reduce pendency. However, the proposal may actually have the opposite effect. If, as proposed, patentees are limited to a single amendment as a matter of right immediately following an FAOM, they will have little choice but to submit numerous new claims in order to anticipate rejections or positions that have not yet been developed. This may increase examiner workload—and thus

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<sup>8</sup> 35 U.S.C. § 132(a).

<sup>9</sup> 37 C.F.R. § 1.114.

pendency—beyond what might have occurred if patentees were not forced to address all contingencies in the initial response.

In other words, the proposal would force patentees to submit claims that attempt to anticipate possible issues, in the hopes that at least some subset of these claims will be found allowable. Each such claim must be considered on its merits, requiring time and effort to review. Even though an extra round of correspondence might be required when applicants are entitled to amend claims after their initial response to the FAOM, we believe that the number of issues raised (and thus the effort required to consider them) will be substantially smaller, leading to more efficient use of USPTO resources – i.e., that allowing the additional amendment will actually lead to more compact prosecution and reduce pendency.

*3. The proposed limitation fails to acknowledge the role of intervening rights considerations in reexamination prosecution strategy.*

Patents undergoing reexamination often have significant potential economic value. However, unlike in original application proceedings, claim amendments made during reexamination may create an intervening rights defense.<sup>10</sup> As a result, a patentee who amends claims during reexamination may effectively surrender years of past damages, even if a party infringes both the original and amended claims.

Correspondingly, it is frequently imperative that a patentee attempt to overcome rejections through the use of good faith arguments and/or declaration evidence under 37 C.F.R. §§ 1.131-1.132, submitting claim amendments only when needed. However, the proposal in the Request essentially forces patentees to submit amendments before they have had a full and fair hearing of their positions with respect to rejections of the patented claims.

Although requiring early amendments might ultimately reduce the overall pendency of reexamination, it does so at the risk of depriving patentees of the opportunity to make their best defense of their patented claims and to have that defense fully considered. Given the significant cost of claim amendments arising from intervening rights issues, it is essential that patentees in reexamination be offered every reasonable opportunity to overcome rejections without being forced to prematurely amend claims.<sup>11</sup>

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<sup>10</sup> See 35 U.S.C. §§ 307, 316 (incorporating the intervening rights provisions of 35 U.S.C. § 252 into *ex parte* and *inter partes* reexaminations).

<sup>11</sup> We note that a patentee could pursue the parallel strategy of producing arguments/evidence *and* submitting new claims. However, as discussed in the previous section, encouraging this approach risks the unintended consequence of *increasing* reexamination workload and pendency rather than decreasing it, owing to the multiplication of issues requiring examiner consideration.

4. *Introduction of amendments and evidence can be limited in a manner that preserves a patentee's opportunity to fully defend original patent claims.*

Reexamination proceedings are subject to a fundamental statutory tension: they must be conducted with “special dispatch within the Office,”<sup>12</sup> yet they must also be conducted “according to the procedures established for initial examination under the provisions of sections 132 and 133.”<sup>13</sup> We note that RCE practice in initial examination provides applicants with the opportunity to have new amendments or evidence considered in an application as a matter of right. We believe that as a matter of fairness to patentees and of properly balancing the statutory requirements for reexamination noted above, the USPTO should adopt a limited Request for Continued Reexamination (RCR) practice as discussed below.

RCR practice is not a novel proposal. In 2005, the USPTO proposed rules to implement RCR practice that would provide for entry of amendments and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding.<sup>14</sup> However, this proposal remains unimplemented. Accordingly, Patent Owners who wish to pursue continued reexamination must either: (1) file a petition under 37 C.F.R. 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding; or (2) file a petition under 37 CFR 1.182 to seek relief (i.e., an RCR) that is not currently provided by an existing rule. Because such petitions are decided by the Office of Patent Legal Administration, which currently experiences a 3-4 month petition backlog, it can easily happen that a patentee will have a petition decided before the deadline for filing an appeal.

We propose that the USPTO revise the rules to provide for a single Request for Continued Reexamination as a matter of right in the limited circumstance in which a patentee has amended claims in response to a rejection, but the amended claims stand rejected on new grounds in a subsequent final rejection in an *ex parte* proceeding or in an action closing prosecution (ACP) in an *inter partes* proceeding.

To a limited extent, our RCR proposal parallels the RCE option available to an applicant facing similar circumstances during initial examination. For example, an applicant may make a good-faith attempt to distinguish over the prior art through amendment, but the amended claims may then be rejected on new grounds, and this rejection may be made final owing to the amendment. In this situation, the applicant can submit an RCE to have a new amendment considered as

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<sup>12</sup> 35 U.S.C. §§ 305, 314.

<sup>13</sup> *Id.*

<sup>14</sup> Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending, 1292 Off. Gaz. Pat. Office 20 (March 1, 2005).

a matter of right. However, when faced with similar facts, the patentee in reexamination currently has no recourse other than to pursue an appeal or possibly to seek reissue.

We feel that permitting a single RCR for a patentee facing a final rejection (or ACP) of amended claims based on new grounds is fair to the patentee, does not disadvantage the public, and would in fact reduce pendency while enabling more efficient use of USPTO resources. As to the first two factors, we note that under these circumstances, the patentee has already made a good-faith effort to narrow the patent in order to avoid prior art. The public benefits from this corrective action and would not be harmed by the patentee making a further amendment in view of new grounds of rejection in order to secure a more limited patent right.

As to the question of pendency and resources, it is reasonable to assume that most patentees would ordinarily choose to appeal under these circumstances, thus substantially lengthening reexamination pendency. Permitting an RCR in order to enter an after-final amendment would potentially allow a significant number of these reexaminations to terminate without appeal, which would directly reduce both reexamination pendency and the burden of the Board of Patent Appeals and Interferences.

**B. The USPTO should not require amendments during reexamination to be accompanied by a statement explaining the amendments relative to an existing SNQ.**

In section A.7 of the Request, the USPTO proposes to require a patentee to “submit a statement indicating how proposed claim language renders the claims patentable over the references raising an SNQ.”<sup>15</sup> As a basis for this proposal, the Request relies on the Federal Circuit’s decision in *In re Freeman*.<sup>16</sup> However, we believe this proposal is contrary to statute as well as Federal Circuit law, and is inconsistent with the quality-improving purpose of reexamination proceedings. We recommend that it be withdrawn.

First, we note that the reexamination statute affirmatively grants a patentee the right to propose “any amendment to his patent and a new claim or claims thereto . . . in response to a decision adverse to the patentability of a claim of a patent.”<sup>17</sup> Had Congress intended to limit amendments only to those relating to an existing SNQ, it could have done so. Instead, it deliberately chose open-ended language in permitting patentees to propose “any” amendment.

*Freeman* does not hold otherwise. As repeatedly noted during the June 1, 2011 public meeting held to discuss the Request, the language of *Freeman* cited in the Request is not controlling, but rather is dicta that is inessential to *Freeman*’s two holdings: that claims cannot be broadened during reexamination, and that issue preclusion prevented the patentee from advancing a different claim construction in reexamination than the construction determined by the district court.

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<sup>15</sup> Request at 22857.

<sup>16</sup> 30 F.3d 1459, 1468 (Fed. Cir. 1994).

<sup>17</sup> 35 U.S.C. § 305.

For example, *Freeman* correctly observes that a patentee may amend claims during reexamination to comply with 35 U.S.C. § 112.<sup>18</sup> Because compliance with § 112 is not a permissible issue for a third party requester to raise in a reexamination request, it cannot form the basis of an SNQ, and thus cannot be supported by a “statement” of the sort proposed in the Request.<sup>19</sup>

More recently, the Federal Circuit has explicitly clarified that § 305 does not require any express statement regarding an SNQ by the patentee who offers an amendment:

Section 305 does not require the patent owner to include an express statement that the new claims distinguish the prior art or remarks indicating how the new claims distinguish the prior art references. If the claims fail to distinguish the prior art, the claims will be rejected on the appropriate grounds; for that reason, it may frequently be in the patent owner’s interest to include such remarks, but they are not necessary to satisfy section 305.<sup>20</sup>

Beyond the question of the proposal’s inconsistency with controlling authorities, it further appears to be inconsistent with the goal of improving patent quality that undergirds reexamination proceedings. If adopted, the Request’s proposal would seem to prevent patentees from addressing typographical errors, antecedent basis issues, or other matters unrelated to an SNQ, all of which bear on patent quality. For at least these reasons, we believe this proposal should be withdrawn.

C. The USPTO should not implement a “provisional” FAOM which, if the Patent Owner does not file an optional Patent Owner’s statement, would be treated as an actual FAOM for purposes of determining finality of a subsequent Office Action.

In section B.2 of the Request, the USPTO proposes that if a patentee does not waive the optional Patent Owner’s statement, the USPTO will send a “provisional” FAOM along with an order granting reexamination.<sup>21</sup> If the patentee does not file a statement at all, or files a statement that fails to overcome all provisional rejections, the “provisional” FAOM will be treated as an actual FAOM for the purpose of determining the finality of a subsequent action.<sup>22</sup> We believe that the proposed “provisional” FAOM is contrary to statute. The proposal would also have the unintended consequence of increasing reexamination pendency due to increased Third Party Requester participation, and would improperly expand the role of the Third Party Requester in *ex parte* reexamination. We believe this proposal should be withdrawn.

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<sup>18</sup> *Freeman*, 30 F.3d at 27 n.5.

<sup>19</sup> *See, e.g.*, 35 U.S.C. §§ 301-303 (limiting the reexamination request and determination of an SNQ to patents and printed publications).

<sup>20</sup> *Cordis Corp. v. Medtronic AVE, Inc.* 511 F.3d 1157, 1184-85 (C.A.F.C. 2006).

<sup>21</sup> Request at 22859. We take no position on the USPTO’s companion proposal in section B1 to make permanent the pilot allowing the Patent Owner to optionally waive the Patent Owner’s statement.

<sup>22</sup> *Id.*

1. *The proposed “provisional” FAOM is contrary to statutory reexamination procedures.*

The procedures for conducting reexamination are specifically established by statute:

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. 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, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent.<sup>23</sup>

That is, the reexamination statute specifically provides an opportunity for a Patent Owner’s statement and a reply by the Third Party Requester, subsequent to which substantive reexamination on the merits begins. Moreover, the patentee is statutorily guaranteed at least two opportunities for amendment: first, in the Patent Owner’s statement (if not waived),<sup>24</sup> and secondly, in response to an action on the merits that is adverse to the patentability of a claim as noted above.

The proposed “provisional” FAOM appears to be inconsistent with the reexamination statute in both of these respects. First, it attempts to consolidate the statement/reply procedure and substantive reexamination on the merits, while the statute specifically treats these as distinct and sequential procedures.

Of greater concern, however, is the fact that the proposal would effectively strip both statutorily guaranteed opportunities for amendment from the patentee whenever the patentee elects not to amend in the Patent Owner’s statement. That is, if the patentee elects not to respond to the “provisional” FAOM with a Patent Owner’s statement, and the subsequent FAOM is made final, the patentee will have no opportunity to submit an amendment as a matter of right. This result is inconsistent with the statutory requirements noted above.

2. *The proposal invites increased Third Party Requester participation in a manner that would increase pendency and amount to a de facto inter partes procedure without the policy safeguards that apply to inter partes reexamination.*

Under present USPTO rules, if a patentee submits a Patent Owner’s statement, the Third Party Requester is given an additional two months to reply to the statement.<sup>25</sup> If the “provisional” FAOM were adopted as proposed, the result would be a significant increase in the filings of Patent Owner’s statements, as patentees are unlikely to risk losing the opportunity to amend if they fail to submit a statement and the next action is made final. The pendency of such proceedings

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<sup>23</sup> 35 U.S.C. § 305.

<sup>24</sup> 35 U.S.C. § 304.

<sup>25</sup> 37 C.F.R. 1.535.

can thus be expected to increase by the additional two months accorded to the Third Party Requester for reply.

Moreover, by effectively forcing patentees to comment on substantive rejections in the Patent Owner's statement, the "provisional" FAOM procedure expands the scope of the Third Party Requester's participation in a manner that is inconsistent with the nature of *ex parte* reexamination. Under current procedures, the participation of the Third Party Requester ends with the filing of a reply to the Patent Owner's statement; thus, if no statement is submitted, the Third Party Requester's participation ends with the submission of the reexamination request. Because substantive reexamination does not presently begin until after the statement and reply, unless the patentee submits an amendment with the statement, the statement and reply are typically confined to issues surrounding the existence of an SNQ.

By advancing the timing of the "provisional" FAOM, the proposal would routinely allow the Third Party Requester to take positions on the patentee's substantive arguments, evidence, and amendments submitted in response to the "provisional" FAOM, because the Third Party Requester would still be accorded the opportunity to reply to the patentee's submissions at this stage of reexamination. This would have the effect of transforming the initial, and often most critical, substantive phase of *ex parte* reexamination into a *de facto inter partes* procedure.

However, unlike formal *inter partes* reexamination,<sup>26</sup> the Third Party Requester in *ex parte* proceedings is not limited by any type of estoppel. Moreover, Third Party Requesters are precluded from making additional requests for *inter partes* reexamination while a first such proceeding is pending, whereas no comparable restriction exists in *ex parte* proceedings. From a policy perspective, these aspects of *inter partes* proceedings play an important role in ensuring judicial economy and fairness to patentees. That is, they effectively require Third Party Requesters to advance their best argument in their chosen forum, which is appropriate for administrative and judicial efficiency, and fair to the patentee. Moreover, they inhibit Third Party Requesters from attempting to harass patentees with multiple concurrent or consecutive proceedings.

Absent these limitations, there is little to prevent Third Party Requesters from attempting to serially and repeatedly raise questions of patentability in multiple forums, or from attempting to initiate multiple reexamination proceedings with respect to the same patent. We believe that the limitations on *inter partes* proceedings are an important check on the expanded role of Third Party Requesters in such proceedings. Because the proposed "provisional" FAOM expands the role of the Third Party Requester in *ex parte* proceedings without corresponding safeguards against misuse, we believe it is unfair to patentees and represents unsound policy.

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<sup>26</sup> See 35 U.S.C. § 317(b) (precluding a Third Party Requester, following an adverse final decision in a civil action or prior *inter partes* reexamination, from requesting *inter partes* reexamination on an issue that it "raised or could have raised" in the prior proceeding).

D. The USPTO should reduce the need for petitions by facilitating the conversion of *inter partes* reexamination proceedings to *ex parte* proceedings following withdrawal of the Third Party Requester from the proceedings.

In section A.8 of the Request, the USPTO proposes to clarify petitions practice in order to “specify when, how, and by whom any petition under 37 CFR 1.181 – 1.183, and any opposition thereto, may be filed in reexamination proceedings.”<sup>27</sup> In order to reduce petition filings and improve reexamination pendency, we propose that the USPTO adopt procedures to facilitate the conversion of an *inter partes* reexamination to an *ex parte* reexamination after a Third Party Requester has withdrawn from the *inter partes* proceeding.

It is fairly common for a Third Party Requester in *inter partes* reexamination to discontinue its participation, for example pursuant to a settlement agreement in a concurrent patent litigation. Typically, the Third Party Requester will file a statement in the record of the reexamination memorializing its discontinuation. At this point, the proceeding is effectively an *ex parte* proceeding. However, the USPTO presently maintains the proceeding as an *inter partes* proceeding despite the absence of the Third Party Requester.

Because examiner interviews are prohibited in *inter partes* reexamination by 37 C.F.R. § 1.955, even if a Third Party Requester discontinues its participation, a patentee must nevertheless petition under 37 C.F.R. § 1.183 to waive Rule 1.955 in order to obtain an interview. So long as such petitions present a detailed agenda demonstrating how the proposed interview will accelerate prosecution, they are routinely granted by the Office of Patent Legal Administration. However, because interviews are not a matter of right under these circumstances, each interview requires a petition, creating unnecessary burdens for patentees as well as the USPTO.

Moreover, in the event that all claims are confirmed or allowed, a Right of Appeal Notice (RAN) is still issued even in the circumstance where the Third Party Requester has withdrawn, despite the fact that there is no party to the proceeding that would appeal under these circumstances. This increases pendency, because the time for responding to the RAN must nevertheless toll before a reexamination certificate may issue.

To reduce unnecessary petitions and delays, we propose that the USPTO institute a procedure through which a Third Party Requester may formally waive further participation in an *inter partes* reexamination, and through which a patentee may subsequently request that the *inter partes* proceeding be formally converted to an *ex parte* reexamination. Such a procedure would permit what is a de facto *ex parte* proceeding to continue as an actual *ex parte* proceeding for the purpose of applying the USPTO’s rules governing interviews and other procedures. Following such a conversion, patentees would be entitled to interviews as a matter of right, which would eliminate the need for petitions discussed above. Moreover, the procedural delays associated with a moot RAN would be avoided, reducing the pendency of the proceeding.

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<sup>27</sup> Request at 22858.

E. The USPTO should require Third Party Requesters to identify corresponding structure for means-plus-function claim elements by mapping such elements to the specification when requesting reexamination.

Beyond the specific proposals presented in the Request, the USPTO invited comments as to “other changes . . . the USPTO [should] make in order to streamline reexamination proceedings.”<sup>28</sup> In order to ensure that claim language is properly construed when considering whether to grant a reexamination request, we propose that the USPTO require Third Party Requesters to map means-plus-function claim elements to the specification. The USPTO should refuse to grant a reexamination request with respect to means-plus-function claims for which this correspondence is not demonstrated.

It is well established that when applying the “broadest reasonable interpretation” (BRI) claim construction standard that ordinarily applies during examination, the USPTO may not disregard corresponding structure when construing means-plus-function claims that fall under the purview of 35 U.S.C. § 112, para. 6.<sup>29</sup> That is, the USPTO may not consider only the “function” element of a means-plus-function claim when determining the relationship of the claim to prior art. Instead, the USPTO must also consider the disclosed structure that corresponds to the recited function. It is only this corresponding structure and its “equivalents” that fall within the scope of the claim.<sup>30</sup> That is, a means-plus-function claim does not cover every possible implementation of the recited function.

Determining the existence of an SNQ first requires that the claim language be correctly interpreted. Thus, an SNQ cannot be established with respect to a means-plus-function claim without evaluating the corresponding structure disclosed in the specification. However, the USPTO does not presently require Third Party Requesters to identify corresponding structure, and without this, the basis of the proposed SNQ may not be clear. Currently, it appears that the USPTO grants reexamination of means-plus-function claims based upon evidence relating to the recited function, without considering corresponding structure.

Reexamination is a costly procedure for patentees and the USPTO that is intended to benefit the public by improving patent quality. However, none of these parties benefits from an improvidently granted reexamination. Current procedures with respect to means-plus-function claims create an unacceptable risk that reexamination will be ordered in situations where no SNQ actually exists, because the prior art produced in the reexamination request has been compared against incorrectly construed claims. In such cases, a patentee must defend such claims—often to appeal—despite the fact that the reexamination of these claims was improperly founded.

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<sup>28</sup> Request at 22860.

<sup>29</sup> M.P.E.P. 2181 (citing *In re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994)).

<sup>30</sup> See 35 U.S.C. § 112, para. 6 (“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”).

We note that concerns regarding correct construction of means-plus-function claims are sufficiently important to the Board of Patent Appeals and Interferences that it requires appellants to explicitly identify corresponding structure within the appeal brief.<sup>31</sup> The USPTO should not accept a reexamination request that, for want of identifying corresponding structure, would be dismissed as non-compliant if it were part of an appeal brief.

In the interests of efficient use of USPTO resources and fairness to patentees, we urge the USPTO to construe means-plus-function claims according to the correct standard when considering whether there exists an SNQ, and to require Third Party Requesters to provide evidence of corresponding structure when requesting reexamination of means-plus-function claims.

### III. Conclusion

In summary, we appreciate and support the Office's efforts to improve reexamination pendency, although we caution that such improvements should not come at the expense of other important aspects of reexamination, such as quality and fairness. To that end, we have identified several proposals that we believe should be withdrawn, either because they are contrary to controlling law, present unintended consequences, or achieve reduced pendency at the expense of fairness to patentees. Additionally, we have offered several proposals for the Office's consideration that we believe would improve the reexamination process.

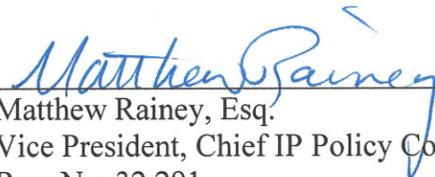
We appreciate the opportunity to comment, and look forward to continuing to work with the USPTO to improve patent examination for the benefit of applicants and the public.

Consideration of the above comments is respectfully requested.

Respectfully submitted,  
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<sup>31</sup> See CFR 41.37(c)(1)(v) ("every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.").