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March 5, 2012

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
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Attn: Kenneth M. Schor, Sr. Legal Advisor

Re: Comments on Changes to Implement Miscellaneous Post Patent
Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 442
(Jan. 5, 2012)

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 January 5, 2012 (PTO-P-2011-0072). In particular, the Section submits the following comments on the *Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 442 (the "Miscellaneous Post Patent 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.

Duty to Provide Accompanying Information with Statements of the Patent Owner Under 35 U.S.C. § 301

The Section encourages the Office to clarify the scope of the duty of parties to provide "accompanying information" when submitting a patent owner's statement regarding the scope of a patent's claims under 35 U.S.C. § 301(a)(2). An overly broad or vague definition of "accompanying information" is likely to result in voluminous submissions that detract from the usefulness of such submissions for the Office and the public. In addition, the Section encourages the Office to clarify that a

submitter is not under a continuing duty to provide additional “accompanying information” after a submission is made.

The Leahy-Smith America Invents Act amends 35 U.S.C. § 301 to allow any person to submit to the Office “statements of the patent owner filed in a proceeding before a Federal court of the Office in which the patent owner took a position on the scope of any claim of a particular patent.” 35 U.S.C. § 301(a)(2). According to this law, as amended, one who makes such a submission “*shall* include any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement.” *Id.*, § 301(c) (emphasis added).

The Office, by way of the Miscellaneous Post Patent Notice, proposes to amend 37 C.F.R. § 1.501 to include a new section (a)(2), largely tracking the statutory text and reading in pertinent part: “Any statement submitted under this paragraph must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement . . .” Such “other documents, pleading or evidence” are referred to in the proposed rule and herein as “accompanying information.”

The proceeding in which the patent owner made the statement being submitted under this section will typically be a litigation, in which case the volume of accompanying information is potentially very large, depending on how the term “address” is interpreted. The Section encourages the Office to clarify what it means for information to “address” the written statement. The Section further encourages the Office to narrowly interpret “address” so as to avoid routine submission of large amounts of material. For example, this language might be fairly interpreted to mean material that directly refers to the statement or has been used to support or contradict the statement. The Section also encourages the Office to require submission of only those specific portions of documents, pleadings or evidence that are pertinent, along with any surrounding portions needed to provide context.

In addition, the Section encourages the Office to clarify that one who submits a patent owner’s statement under 35 U.S.C. § 301(a)(2) is under no continuing duty to supplement that submission so as to provide later-created information that would otherwise qualify as accompanying information. It should be sufficient for a submitter to provide all accompanying information as of the date of the submission. The submitter should not need to continue to monitor the proceeding in which the patent owner made the statement to see if new accompanying information is created.

Safeguarding Anonymity of *Ex Parte* Reexamination Requesters

The Section encourages the Office to take adequate safeguards to shield from public view the identity of anonymous third parties who request **ex parte** reexamination of a patent.

The Honorable David J. Kappos

March 5, 2012

Page 3

Under the Leahy-Smith America Invents Act, petitioners for *inter partes* or post-grant review will in some circumstances be estopped from later requesting *ex parte* reexamination of the patent under review. 35 U.S.C. §§ 315(e)(1), 325(e)(1). In order to enforce this estoppel against anonymous reexamination requesters, the Office would like to be able to ascertain the identity of the requesters. The Office therefore proposes to amend 37 C.F.R. § 1.510 to include a new subsection (b)(7), which would require that every *ex parte* reexamination request, including anonymously filed ones, include a statement identifying the real party(ies) in interest of the requester.

The Miscellaneous Post Patent Notice outlines a procedure for an anonymous requester to file this statement under seal, but provides little in the way of safeguards against inadvertent disclosure of such information by the Office. Because the consequences of publicly disclosing the identity of an anonymous reexamination requester may be severe for the requester, it is imperative that the Office implement tight safeguards to protect against inadvertent disclosure. The Section therefore urges the Office to implement internal procedures for the handling of sealed submissions under proposed § 1.510(b)(7) so that the likelihood of inadvertently making such submissions public is minimized. If acceptable safeguards are not possible, then the Office should consider omitting the requirement to identify the requester under proposed § 1.510(b)(7) and instead rely on the requester's certification under proposed § 1.510(b)(6) that the requester is not estopped from filing the request.

In closing, the Section recognizes and appreciates the Office's efforts to solicit public opinions regarding rules proposed in the Miscellaneous Post Patent Notice and offers the foregoing comments in an effort to help the Office implement rules that best serve the interests of the users of the patent system and the public.

If you have any questions on our comments or would wish for us to further explain 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,



Robert A. Armitage
Section Chairperson
American Bar Association
Section of Intellectual Property Law