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March 5, 2012

Hon. David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
600 Dulany Street
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Submitted via: post_patent_provisions@uspto.gov

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

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments to the U.S. Patent and Trademark Office in response to the proposed Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act published in the Federal Register on January 5, 2012 (Notice).

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members.

IPO applauds the USPTO’s continuing efforts to reach out to the patent community as a whole in its efforts to improve the quality of issued patents, particularly with respect to its efforts to implement the provisions of the Leahy-Smith America Invents Act (AIA). Moreover, we are pleased that the proposed rules have addressed numerous issues IPO identified in our preliminary comments to the Group 2 Rulemakings. There are aspects of the proposed rules, however, that IPO believes need reconsideration. Accordingly, we request the USPTO to consider the following comments.

A. Proposed 37 CFR § 1.501 – Citation of Statements of the Patent Owner and Prior Art in Patent Files

1. Definition of “Federal Court”

Rule 1.501(a)(2) permits statements of the patent owner filed in a proceedings before a federal court or the Office. The Notice indicates that the term federal court includes the United States Court of International Trade. Because the International Trade Commission

(ITC) is a frequently used forum for patent enforcement, IPO suggests including proceedings before the ITC in the meaning of federal court.

2. “Outside” Statements by Patent Owner

Although proposed rule 1.501(a)(2) permits statements of the patent owner filed in a proceeding before a federal court or the Office, it prohibits patent owner statements made outside of federal court or Office proceeding. The proposed rule prohibits such statements even if they are later submitted for inclusion in the record of a federal court or Office proceeding. This is inconsistent with the plain language of the statute. Section 301(a)(2) was amended to provide:

Any person at any time may cite to the Office in writing ... statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

(Emphasis added.) Thus, any patent owner statements, wherever made, that are filed and made part of the record are permissible under the statute. Proposed rule 1.501(a)(2) should be amended accordingly.

3. Submission of Patent Owner Statements and Prior Art

The Notice describes information the submitting party *should* consider providing in connection with any patent owner statement including (1) the forum in which the statement was made; (2) federal court case number; (3) the status of the proceeding in which the statement was made; and (4) the relationship of the proceeding to the patent for which the submission is being made. Providing this information appears to be optional. IPO suggests amending the proposed rules to *require* such information, which will permit the USPTO and others to quickly identify and verify the source and relevance of the statement.

In addition to the patent owner statements, proposed rule 1.501(a)(1) permits submission of prior art including patents and printed publications. Proposed rule 1.501(b) requires an explanation of the pertinence of any submission. IPO suggests expressly providing for the submission of supplemental affidavits or declarations explaining the contents of a submission under 1.501(a)(1) and (2), as is currently allowed for patent or printed publication submissions under M.P.E.P. §2205¹.

¹ “Affidavits or declarations or other written evidence relating to the prior art documents submitted may accompany the citation to explain the contents or pertinent dates in more detail. A commercial success affidavit tied in with a particular prior art document may also be acceptable. For example, the patent owner may wish to cite a patent or printed publication which raises the issue of obviousness of at least one patent claim. Together with the cited art, the patent owner may file (A) an affidavit of commercial success or other evidence of nonobviousness, or (B) an affidavit which questions the enablement of the teachings of the cited prior art.”

4. Patent Owner Period for Reply

In accordance with amended sections 301(a) and (b), proposed rule 1.501(a) provides that any person at any time may cite prior art or patent owner statements to the Office for inclusion in the official patent file. Any person includes, of course, the patent owner, and any time includes after a third party submission. Proposed rule 1.501(b)(2) recognizes this by permitting the patent owner to explain how the claims differ from any third party submission. The proposed rules should be amended to clarify, unambiguously, that there is no time during the period of enforceability of the patent that the patent owner would not be permitted to respond to a third party submission that is entered in the official patent file.

B. Proposed Rule 1.510(b)(6)-(7) – Request for Ex Parte Reexamination

Proposed rule 1.510(b)(6) requires that each request for *ex parte* reexamination include a certification that the statutory estoppel provisions related to *inter partes* review (IPR) and post grant review (PGR) do not prohibit the request. Proposed rule 1.510(b)(7) requires a statement identifying the real parties in interest. The Notice explains:

The estoppel provisions of *inter partes* review and post grant review are provided in new 35 U.S.C. 315(e)(1) and 325(e)(1), respectively. These estoppel provisions bar a request for *ex parte* reexamination (or maintenance of an *ex parte* reexamination) by a third party requester ... where the requester petitioned for an *inter partes* review or post grant review of a claim in the patent that resulted in a final written decision with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review or post grant review.

While this helps explain the proposed rule requiring the *ex parte* requester's certification, it fails to explain why identification of the requester would be necessary. Although the Notice indicates that an *ex parte* requester has the option to remain anonymous by submitting the information under seal, there is no statutory authority for requiring this information. In fact, by definition, after requesting reexamination and complying with its certification obligations, the third party has no involvement in the proceeding. Therefore, IPO urges the USPTO to delete proposed rule 1.510(7).

IPO thanks the USPTO for considering these comments and would welcome any further dialogue or opportunity to support the USPTO in implementing the Post Patent Provisions of the AIA.

Sincerely,



Richard F. Phillips
President