

From: 5REHJW/HDM [e-mail address redacted]
Sent: Monday, March 05, 2012 7:13 PM
To: post_patent_provisions
Subject: Submission of comments

Dear Madam, dear Sir,

My name is Robert Lelkes. I am a registered US patent attorney and former US patent examiner with more than 25 years' experience in the patent field. My career spans two continents and includes experience in both private practice and as in-house patent counsel for a Fortune 50 company. I am also the author of the AIA Monitor (www.aiamonitor.com), a blog tracking implementation of the AIA.

The undersigned requests consideration of the following comments.

Service certification should not be required under proposed amended 37 CFR §1.501

Under proposed amended 37 CFR §1.501, the USPTO proposes that the third-party submitter serve the information on the patent owner. This may discourage the making of such submissions by anonymous third-parties due to the risk of compromising anonymity and the additional expense of service.

Since the apparent intent of Congress in amending 35 USC §301 is to encourage third-party submissions, the service requirement seems to be somewhat contrary to that intent. An alternative would be for the USPTO to send out a notification to the patent owner of record that a submission has been made, advising that the details may be found in the electronic file history of the patent.

Explanation for 37 CFR §1.501(a)(2) statements should not be required for an ex parte reexamination request in proposed amended 37 CFR §1.510(b)(2)

The USPTO proposes to amend 37 CFR §1.510(b)(2) to require an explanation of any claim scope statements by patentee submitted under 37 CFR §1.501 in a request for *ex parte* reexamination.

On the other hand, the USPTO proposes to amend 37 CFR 1.515 to make clear that any statement regarding claim scope submitted under 37 CFR §1.501(a)(2) will not be considered until after ex parte reexamination has been initiated. This amendment is complemented by the proposed amendment to 37 CFR §1.552 in which the USPTO states that such statements may be relied upon once ex parte reexamination proceedings have been initiated.

It does not seem to make sense to require submission of that statement under proposed amended 37 CFR §1.510(b)(2) only to have it ignored at the request stage. The requirement that the requestor express a position with regard to claim interpretation appears to be premature. If the examiner decides not to initiate proceedings, compliance with this requirement was wasted, which appears to be contrary to the Paperwork Reduction Act.

This requirement should be removed or changed to a voluntary option at the request stage.

The combination of a certification in (6) and identification of the real party in interest in (7) of proposed amended 37 CFR §1.510(b) is duplicative and unnecessary

New 35 U.S.C. 315(e)(1) and 325(e)(1) under the AIA include estoppel provisions which bar a request for *ex parte* reexamination (or maintenance of an *ex parte* reexamination) by a third-party requester, the requester's real party(ies) in interest, or a privy, 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. The USPTO proposes to amend 37 CFR §1.510(b) to add subparagraph (6) requiring certification that the request for *ex parte* reexamination does not violate the foregoing estoppel requirement and subparagraph (7) requiring submission of identifying information regarding the real party in interest to allow the USPTO to check whether estoppel requirements are being met. Identification of the real party in interest under subparagraph (7) seems to be unnecessary if the USPTO intends to rely on the certification under subparagraph (6).

Respectfully submitted,
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