



PATENT PROTECTION FOR HIGH TECHNOLOGY

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

FROM: Schwegman, Lundberg and Woessner, P.A.

DATE: March 6, 2010

RE: Comments to Various Proposed Rules to Implement the America Invents Act

Via Electronic Mail

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Dear Under Secretary Kappos:

We have reviewed the proposed rules and associated commentary and would like to provide comments on the following rules packages:

- Preissuance Submissions by Third Parties Provision Fed. Reg. 77(3): 448-457
- Implement the Miscellaneous Post Patent Provisions Fed. Reg. 77(3): 442-448
- Changes to Implement the Inventor's Oath or Declaration Provisions Fed. Reg. 77(4): 982-1003

Our comments are as follows:

I. CHANGES TO IMPLEMENT PREISSUANCE SUBMISSIONS BY THIRD PARTIES PROVISION FED. REG. 77(3): 448-457 (JAN. 5, 2012).

1. The rules are unclear whether an examiner can request submission of additional information beyond the original submission under 37 C.F.R. § 1.105.
 - a. If the Office does request information, it should be the submitter's option to respond. There should be no effect on the original submission if the submitter does not comply.
 - b. The Office should be able to objectively corroborate submitted documents.
 - i. If the submission cannot be corroborated, then the examiner has ability to ignore it.
 - ii. The Office should entertain challenges to the accuracy of third-party statements that are not objectively verifiable. For example, a journal article is verifiable, and a marketing pamphlet might be less so.
 - iii. The Office should not just blindly accept that submissions are true and accurate.

- c. The Office should consider requiring that the submitter must have a reg. number to give OED jurisdiction when misconduct is found.
2. The fee schedule is good as it will encourage participation and increase patent quality.
3. The Office should more thoroughly consider requests to revive applications that were abandoned during the period that preissuance submissions are allowed. Applicants could seek to discourage submissions by abandoning applications during this period, only to later request revival.
4. The file history will identify whether the examiner considered a submission. This information should be copied to the face of the patent to help later fact-finders determine whether submissions were considered.

II. CHANGES TO IMPLEMENT THE MISCELLANEOUS POST PATENT PROVISIONS FED. REG. 77(3): 442-448 (JAN. 5, 2012).

1. The Office should clarify what the “proper meaning” of a claim is.
2. Consider identification of the real party in interest in an *ex parte* reexamination only after a PGR or IPR results in a final written determination. This would encourage filing of *ex parte* requests for those wary of the new identification procedures.
3. A conflict exists between the current *ex parte* statute and the new IPR and PGR statutes:
 - a. 35 U.S.C. § 311 states that “[a]ny person at any time may file a request for reexamination.”
 - b. 35 U.S.C. §§ 315(e) and 325(e) state that a petitioner “may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that [IPR or PGR].”

The Office should address this conflict.

4. Do not require that a real party in interest identify itself. The *ex parte* statute specifically states that “[a]ny person at any time may file a request for reexamination.” Thus, it is clear that a real party in interest should not be estopped from filing an *ex parte* request. Further, the risk of the Office mishandling the confidential paper identifying the real party in interest is too great irrespective of their involvement in an IPR or PGR.
5. 35 U.S.C. §§ 315(e) and 325(e) estop the petitioner from filing another Office proceeding, but this cannot mean *ex parte* requests because that would conflict with the statutes above.
6. Final written decisions in an IPR or PGR should not stop an *ex parte* reexamination that is already in progress. 35 U.S.C. § 311 requires “resolution” of each SNQ that the Office finds. Therefore, even if the Office interprets § 325(e) to estop petitioners from filing *ex parte* requests, ongoing reexaminations should be able to complete to meet the statutory requirement that SNQs are resolved.
7. Furthermore, *ex parte* reexamination requesters cannot participate in proceedings that have been initiated, therefore requests pending at the time of a final written decision should be maintained.

8. IPR and PGR are evaluated on a claim-by-claim basis and *ex parte* reexamination is evaluated on a reference basis. Thus, it would be difficult for a real party in interest to parse out the conflict due to the different standards governing the two proceedings: the showing to establish an SNQ and the showing of a reasonable likelihood of prevailing on at least one claim. Thus, our recommendation is that rule 1.510(b)(6) be eliminated for at least the reason that it conflicts with the *ex parte* statute (§ 311).
9. In the interest of special dispatch, if an *ex parte* reexamination is filed, the Office should not merge the *ex parte* request with an IPR and a PGR. Not merging the two proceedings would allow for special dispatch of each proceeding.

III. CHANGES TO IMPLEMENT THE INVENTOR'S OATH OR DECLARATION PROVISIONS FED. REG. 77(4): 982-1003 (JAN. 6, 2012).

1. With respect to the proposed rules regarding the oath / declaration, proposed section 1.47 (inventor refuses to sign) in subsection (a) allows others (*e.g.*, the assignee) to sign the oath / declaration. However, section 1.47 (c) states: (c) Any oath or declaration executed pursuant to this section must comply with the requirements of § 1.63(a), but 1.63(a)(5) states that the oath / declaration must “[s]tate that the application was made or was authorized to be made by the inventor.” Thus, sections 1.47 and 1.63 appear to conflict.

IV. CONCLUSION

In closing, Schwegman appreciates the opportunity to comment on the proposed rules and commends the Office’s outreach efforts including the AIA microsite and nationwide road shows.

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 Schwegman’s leadership will respond to any inquiry.

Very truly yours,

Schwegman, Lundberg and Woessner, P.A.

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