

From: Robert Lelkes [e-mail address redacted]
Sent: Monday, March 05, 2012 5:32 PM
To: preissuance_submissions
Subject: Comments on the proposed amendments to the rules

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.

37 CFR §1.291 is *ultra vires*

The AIA amends 35 USC §122 by adding subparagraph (e) effective 16 September 2012. Subparagraph (e) will permit anonymous third-party submissions of printed publications to the USPTO for the examiner's consideration together with comments regarding the relevance of each publication. Current 37 CFR §1.291 allows third parties to submit information other than printed publications, such as evidence concerning inequitable conduct before the USPTO (see 37 CFR §1.291(e)).

As amended, 37 CFR §1.291 continues to include submission of evidence concerning inequitable conduct before the USPTO. 35 USC §122 as amended under the AIA refers solely to submission of printed publications. Since evidence of inequitable conduct is not necessarily (actually rarely) a printed publication, 37 CFR §1.291 goes beyond the scope of 35 USC §122 as amended under the AIA. Pre-issuance submission of evidence concerning inequitable conduct is therefore not statutorily authorized.

37 CFR §1.291 imposes obligations that conflict with those under 37 CFR §1.290

Another problem with proposed amended 37 CFR §1.291 is that it imposes a set of obligations that are in conflict with proposed new 37 CFR §1.290. What happens when a third-party plans to submit a printed publication with comments in a time frame compatible with both 37 CFR §§1.290 and 291? Can the third-party arbitrarily choose which rule applies? Or must the third-party comply with both rules (which may not comply with the Paperwork Reduction Act)? What would be the purpose of having two rules governing the same activity?

One difference between proposed new rule 37 CFR §290 and proposed amended rule 37 CFR §291 is that third-party comments after publication of the application may be accepted in the former without the applicant's consent, but not under the latter. The prohibition against third-party comments in the former and proposed amended 37 CFR §1.291 was based on 35 USC §122(c), which requires the USPTO to establish appropriate procedures "to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express consent of the applicant."

New subparagraph (e) of amended 35 USC §122 will require a third-party statement of relevance regardless of whether or not the application has been published even though subparagraph (c) still does not allow post-publication protests without the applicant's consent. Continuing to define a protest as any third-party submission with comments seems no longer appropriate. To determine legislative intent, a definition for the word "protest" must be found that is in harmony with subparagraphs (c) and (e).

Subparagraph (c) of 35 USC §122 refers to a protest "or other form of pre-issuance opposition". This seems to suggest an equivalence between the term "protest" and the term "opposition". An opposition implies a contested matter in which the third-party becomes a party to the proceedings before the Office with ensuing rights to participate in those proceedings and appeal against adverse decisions. It seems quite plausible that Congress did not want to allow participation during examination to the point that the third-party could become a party to the proceedings.

The fact that the AIA places authority for conducting post grant review and *inter partes* review proceedings with the TTAB and not with the examining corps. (as is currently the case with inter partes reexamination) also suggests a desire to limit the participation of third parties during the pre-grant phase to the initial submission.

This objective seems to already be achieved by proposed new 37 CFR §1.290, which does not provide for third-party participation.

In view of the foregoing, proposed amended 37 CFR §1.291 appears to be unnecessary, duplicative, and contrary to Congressional intent, so that it may be best to remove that rule in its entirety together with the proposed removal of 37 CFR §§1.99 and 292.

Respectfully submitted,
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