

**From:** Eric P. Mirabel [Y!a U]`UXXfYgg`fYXUMX]

**Sent:** Wednesday, March 28, 2012 1:53 PM

**To:** supplemental\_examination

**Subject:** Emergency request for review of late comments in view of Mayo Collaborative v. Prometheus decision

Dear Sir or Madam:

These matters herein have only come to light since the *Prometheus* decision. I submit them under my own name, after various committees I am involved in at the AIPLA simply did not have time to act before the March 26 submission deadline.

If the ex parte reexamination fees are raised significantly:

Challenges to the numerous diagnostic and biomarker and other patents which were issued by the PTO and which claim or relate to "laws of nature" or "abstract ideas," -- in patents issued before the Supreme Court spoke in *MAYO COLLABORATIVE SERVICES v. PROMETHEUS LABORATORIES, INC.* \_\_\_U.S.\_\_\_ (2012) -- will not be undertaken in the PTO. The fees for ex parte reexamination should remain at current levels so that those legitimately opposing the numerous biomarker and diagnostic patents issued before *Prometheus* can challenge in the PTO, thereby sparing additional burden on the less-well equipped court system to resolve that issue in all those patents.

The *Prometheus* Court noted: "Purely 'conventional or obvious' '[pre]-solution activity' is normally not sufficient to transform an unpatentable law of nature into a patent-eligible application of such a law." *Opinion* at 10. That examination of what is "conventional or obvious" involves review of prior art, and therefore, the inquiry under Section 101 can be reviewed in ex parte reexamination. See 35 USC 301:

(a) IN GENERAL.—Any person at any time may cite to the Office in writing (1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent....

The only other alternative for review under Section 101 of such prior-art related issues would be Post Grant Review. Fees for Post Grant Review are excessive for most clients; and, post grant review is only available during a 9 month window after patent issuance (the client must decide very quickly to spend a lot). Post Grant Review process is likely to get little use.

Note that inter partes review is not available for review of patentability under Section 101, pursuant to the Supreme Court mandate in *Prometheus*, because inter partes review is limited to review of (35 USC 311(b)):

one or more claims of a patent only **on a ground that could be raised under section 102 or 103** and only on the basis of prior art consisting of patents or printed publications.

The fees should remain as is so that there is a lower cost and available forum for challenges under the Supreme Court *Prometheus* decision.

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