

October 3, 2011

*Via Electronic Mail*  
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Mail Stop Comments – Patents, Commissioner for Patents  
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Attn:  
Hiram H. Bernstein, Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Re: Comments on *Revision of the Materiality to Patentability Standard for the Duty to Disclose Information in Patent Applications*, 76 Fed. Reg., Vol. 76, 43631 (July 21, 2011)

Mr. Bernstein:

These comments are provided in response to the USPTO Notice of Proposed Rulemaking entitled, *Revision of the Materiality to Patentability Standard for the Duty to Disclose Information in Patent Applications*. 76 Fed. Reg., Vol. 140 (July 21, 2011, hereinafter “Notice”).

The Post Grant Practice Group of Oblon Spivak has represented numerous Patent Holders and Third Party Requesters in patent reexamination proceedings before the USPTO. Over the past several years, Oblon Spivak has successfully concluded more patent reexamination proceedings for U.S. based innovators than any other. In the process, the Firm has developed an unparalleled insight and expertise in navigating these very important administrative proceedings, often times concurrent with parallel district court and/or ITC litigation. Further background on the Firm’s practice group can be found at [www.PatentsPostGrant.com](http://www.PatentsPostGrant.com), the leading legal blog on post grant practice before the USPTO.

Since creation of the Central Reexamination Unit in 2005, the USPTO has transformed patent reexamination practice by reducing pendency and improving examination quality. As the USPTO recognizes patent reexamination filings continue to surge as the public recognizes the value and quality of the CRU’s work. Indeed, the recently enacted America Invents Act (AIA) builds upon this successful foundation to provide further post grant options for Patent Holders and Third Parties alike.

The Notice proposes to amend part (b) of Rules 37 C.F.R §1.56 and 37 C.F.R. § 1.555 to incorporate the “but-for” standard of materiality pronounced in *Therasense*. Under the “but-for” standard non-cumulative information would be material to patentability, if under a broadest

reasonable claim construction and applying a preponderance of evidence standard of proof, at least one claim of the original or reexamined patent would have not issued in its original form taking into consideration any patent applicant or owner rebuttal evidence.

Below please find our comments on the proposed changes to Rule 555<sup>1</sup>.

**Proper Claim Construction in Patent Reexamination is a Broadest Reasonable Interpretation that is Consistent with the Specification**

Rule 555 as proposed (as well as Rule 56) adopts the shorthand notation of the CAFC in referring to USPTO claim analysis, namely “broadest reasonable construction.” Notably, the full standard, *broadest reasonable interpretation that is consistent with the specification* was recited in the previous version of rule 555. It is imperative that the full standard be reinforced upon examiners as often times it is the second half of the standard that is overlooked by the Office in performing the necessary analysis.

For example, this very issue was recently pointed out by the CAFC in reversing a rejection of the BPAI in patent reexamination, “[t]he claims of a patent are **always** to be read or interpreted in light of its specification.” (emphasis added) *In re Suitco Surface, Inc.* (Fed. Cir. 2010).

Accordingly, it is suggested that the full standard be recited in both of Rules 56 and 555.

**Types of Information Appropriate for Consideration in Patent Reexamination**

The proposed changes to Rule 555(b)(2) delete the previous language of Rule 555(b) that helped focus patent reexamination on limited types of information, namely, patents and printed publications. The current rule also compliments Rule 565 with respect to the Duty of Candor (typically, parallel litigation material tending to demonstrate an inconsistency or disparity in positions being advanced before the Office).

Specifically, Rule 555(b) previously recited:

b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

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<sup>1</sup> As *inter partes* patent reexamination is being replaced under the AIA, 37 C.F.R. § 1.555 (“Rule 555”) will very quickly apply only to *ex parte* patent reexamination. However, it is expected that this Rule will be used as a model for the new post grant proceedings of the AIA.

**(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or**

**(2) It refutes, or is inconsistent with, a position the patent owner takes in:**

**(i) Opposing an argument of unpatentability relied on by the Office, or**

**(ii) Asserting an argument of patentability.**

(bolded language suggested to remain in new rule)

While it is appreciated that the “prima facie” unpatentability standard, but not non-cumulativeness must necessarily change under *Therasense*, it is respectfully submitted that changes to Rule 555 should not be identical to that of Rule 56. When it comes to patent applications and patent reexamination, one size does not fit all.

Third Parties may interpret the deletion of the reference to noncumulative (1) patents and printed publications (see bolded language of Rule 555 above) as an invitation for arguments on topics that may not be appropriately considered in patent reexamination.

Likewise, the deletion of the components of (2) (see bolded language of Rule 555 above) would seem to undermine MPEP 2282, Rule 565(a), and the Duty of Candor. Often times, Patentees overlook the requirement to submit non-art based materials in patent reexamination.

It is recommended that the above noted aspects of the current language of 1.555(b) be maintained to help clarify the types of information that may be submitted by third parties in patent reexamination. Whether or not this limited scope of information appropriate for patent reexamination rises to the level of materiality is a question to be decided by the new “but for” standard, however, ***Therasense* does not change the types of information** that are of potential interest in patent reexamination.

### **The USPTO Does not Consider Inequitable Conduct in Patent Reexamination**

Third Party requesters in patent reexamination may interpret the “plus” aspect of Rule 555 as license to argue a lack of candor with respect to previous Patent Holder submissions to the Office. Under the proposed rule, such information could be argued to provide a “new light” as to the materiality of previously considered art.

Surely, the “but for plus” test is an accurate statement as to the **holding** of *Therasense*. Yet, since the Office does not police the “plus” aspect, inclusion of this provision in Rule 555 invites potential Third Party abuse and confusion.

Indeed, Section (c) of Rule 1.555 provides that:

The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c). (emphasis added)

In view of the language of 1.555(c), which remains unchanged by the Notice, it is clear that submissions by a Third Party in patent reexamination of matters of compliance with Rule 555 cannot be considered *in the reexamination proceeding*. Furthermore, MPEP 2216 cautions that conduct of parties should not be included in a Request for reexamination as such will not be considered.

Accordingly, we recommend striking 1.555 (b)(2) as unnecessary, and potentially exposing the Office to unintended consequences.

Should you require further clarification or explanation with regard to any of the above, please feel free to contact us.

Very truly yours,

Oblon, Spivak, McClelland,  
Maier & Neustadt L.L.P



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