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Sent: Thursday, February 23, 2006 6:31 PM

To: AC2/Comments

Cc: Schor, Kenneth; Spar, Bob

Subject: Clarification of Filing Date for Reexamination

I am responding to the notice on Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings, Docket No.: PTO-P-2006-0007, 71 Fed. Reg. 9260-62 (Feb. 23, 2006).

I support the Interim Rule. But I want to (1) raise one potential difficulty in applying the rule, and suggest that the rule not be interpreted so as to tie an examiner's hands in this area, and (2) point out that the rule goes to more than statutory requirements.

General

The Interim Rule is well-merited for the reasons stated in on pages 9260-61 of the notice. The Office deserves a full 3 months in which to decide whether there is a substantial new question of patentability, and no examiner should be rushed into a decision because the requester failed to comply with the statute or rules.

Potential Problem Applying the Interim Rule

The rule should be easy to apply, with one potential exception -- the statement of the pertinency and manner of applied cited prior art for every claim that is requested. See 35 U.S.C. §§ 302, 311(b)(2); 37 CFR §§ 1.510(b)(1)-(2), 1.915(b)(3). A request may initially appear (on intake) to contain this statement, but closer review (by the examiner) may reveal that the statement is not actually there. Under the Interim Rule, the filing date "is the date on which the request satisfies all the requirements for the request set forth in [the rule]". Thus, one might read the rule as saying that if a filing date is assigned, the Office has decided that the required statement is present, and an examiner may not revisit the issue.

Although this should be a rare problem, it could be very burdensome to the examiner in some cases. Let me illustrate.

The request in c/n 95/000,108 contained a "STATEMENT POINTING OUT THE SUBSTANTIAL NEW QUESTION OF PATENTABILITY". See Third Party Reexamination Request, at 2, c/n 95/000,108 (Aug. 30, 2005). This "Statement" was included a section arguing "The '104 Patent is Not Patentable under §103 in View of Prior Art Patents that Predate the June 5, 2002 Filing Date." See *id.* at 9-10. This section listed 22 US patents and 4 foreign patents as allegedly invalidating references. *Id.* (The "STATEMENT" also included arguments that: (a) the patent had new matter that was not in the parent application, and (b) the patent was invalid because of an on-sale bar.) The assigned filing date was the date of receipt by the OIPE.

The entire argument about the 26 references was:

"These patents demonstrate that using pads or brushes to clean tires is extremely old and has been known in the prior art for decades. While the actual devices that use the pads and brushes have differed significantly over the years, the concept of applying some kind of tire dressing to a tire as it is being washed, and scrubbed into tires with a pad or brush is known to one skilled in the art. These references demonstrate claims 1 - 23 are invalid under an obviousness analysis under §103."

Id. at 10.

The Order Denying Reexamination, at 4 (Oct. 20, 2005), points out that the requester, in fact, failed to comply with the statutory and regulatory requirements of U.S.C. § 311(b) and 37 CFR § 1.915(b)(3). Examiner Stoner therefore denied reexamination without deciding whether some combination of the cited references raised an obviousness question. *Id.* Making such a review would have imposed a substantial, unfair burden on the examiner. For instance, with 26 references, there are 650 possible 2-way combinations. The request gave the examiner no guidance about which of these combinations to consider, or what parts of the references were relevant.

In these situations, the examiner should be able to independently decide that the request fails to comply with the statute and rules. I therefore suggest that the rule be interpreted to allow the examiner to do this.

Non-Statutory Requirements

The Federal Register notice describes the Interim Rule as mandating compliance with "the statutory requirements" before the Office will assign a filing date. See, e.g., 71 Fed. Reg. at 9261 ("The rules now simply clearly recite that the statutory requirements for a request for reexamination must be fulfilled before a filing date will be assigned. See 35 U.S.C. 302 and 35 U.S.C. 311.") But the specific language of the Interim Rule mandates compliance with rules -- 37 CFR §§ 1.510(b) and 1.915(b) -- and does not mention the statute. Those rules include non-statutory requirements, e.g., an inter partes requester's certificate of service on the patent owner, and an inter partes requester's certificate of non-estoppel. See 37 CFR § 1.915(b)(6)-(7). While these rules are sensible and easy to meet, it would be more accurate to describe the Interim Rule as mandating compliance with "statutory and regulatory requirements" before the Office will assign a filing date.

Respectfully submitted,

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