

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

June 26, 2003

Mr. Nicholas P. Godici
Commissioner for Patents
Box Comments - Patents
Washington, D.C. 20231

Re: Notice of Proposed Rulemaking
Changes to Implement the 2002 *Inter Partes* Reexamination
and Other Technical Amendments to the Patent Statute
68 Fed. Reg. 22343 (April 28, 2003)

Dear Commissioner Godici:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the rule and practice changes proposed by the United States Patent and Trademark Office (PTO) in the subject notice.

AIPLA is a national bar association whose more than 14,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

In general, AIPLA supports the proposed changes in the regulations and practice as presently understood. However, we would urge the PTO to reconsider the proposed changes to §§ 1.949 and 1.953 that are allegedly directed to streamlining prosecution in an *inter partes* reexamination by issuing a Right of Appeal Notice (RAN) under § 1.953 as soon as all claims in the proceeding are found patentable. As we understand the motivation for this proposal, the PTO believes there is no reason to issue an unnecessary Action Closing Prosecution (ACP) under § 1.949 because the patent owner would not argue against the allowance of all the claims, and the patent owner would not be expected to comment on any stated reasons for allowance at this point, since the patent owner may do so after a Notice of Intent to Issue a Reexamination Certificate is issued. While it is possible that this assumption will cover most situations, the proposed change appears to eliminate an important safeguard for the patent owner in circumstances where the assumption is not correct. Accordingly, we would urge the PTO to retain the current practice in issuing an Action Closing Prosecution in all cases where the request for *inter partes* reexamination is granted, even after all claims in the proceeding are found patentable.

We support the PTO's goal of streamlining prosecution in an *inter partes* reexamination proceeding, but not at the potential cost of a safeguard that may otherwise be available to the patent owner. For example, where the PTO finds that all claims in the reexamination proceeding are patentable, and would issue a Right of Appeal Notice under the proposed regulations, the patent owner loses the right to propose an amendment under § 1.953(c) because no amendment can be made in response to a Right of Appeal Notice. However, if the PTO would conclude that all claims in the proceeding are patentable and issue an Action Closing Prosecution under § 1.949, the patent owner has an opportunity to provide comments that may include proposed amendments to the claims even though the proposed amendment is subject to the criteria of § 1.116. See 37 C.F.R. § 1.951(a).

A patent owner may decide to propose an amendment at this stage in the prosecution where the examiner provides a statement of reasons for allowance or a statement of claim interpretation with which the patent owner disagrees. While it is true, as the PTO has pointed out in its proposed rulemaking, that a patent owner could wait until after a Notice of Intent to Issue a Reexamination Certificate is issued, this may be too late in the proceeding to have a proposed amendment considered, particularly if the Board of Patent Appeals and Interferences and perhaps the Federal Circuit has considered the patentability of the claims. In addition, it would appear to be in the best interest of streamlined prosecution in an *inter partes* reexamination proceeding to encourage the patent owner to submit comments regarding a statement of reasons for allowance or proposed amendments in an early stage of the reexamination proceeding rather, than after a Notice of Intent to Issue a Reexamination Certificate has been issued by the PTO.

We appreciate the opportunity to provide comments on the notice entitled "Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute," and would be happy to assist in any way we can.

Sincerely,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk
Executive Director