

Comments on Federal Register Notice "Changes To Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute" Proposed Rulemaking of United States Patent and Trademark Office (USPTO) [Federal Register, Vol. 68, No. 81, April 28, 2003]

Docket No: 2003-P-001

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From:

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Date: June 27, 2003

Dear Madams/Sirs:

The following are comments on the above captioned Federal Register notice of proposed rulemaking. PatentWatch wishes to thank the USPTO for providing this opportunity for the general public to comment on this matter. PatentWatch is a project of ICTA, a 501(c)(3) bipartisan nonprofit organization dedicated to analyzing the effects of technological innovations and patent law upon society.

PatentWatch is pleased with certain of the proposed changes, and has major concerns with others.

With regards to 37 CFR 1.959, USPTO proposes to add a section (f), which would provide the third party requester in an inter partes reexamination proceeding the opportunity to remedy inadvertent defects. The proposal is reasonable and equitable. USPTO is to be commended for having located this lack of balance in the prevailing rules whereby the Patent Owner can correct defects but the Requester (who is paying the freight for the entirety of the proceedings) cannot.

In like manner, the proposed changes to 37 CFR 1.965, 1.967, and 1.971 are looked upon favorably. The USPTO is requested to stand firm against any others who oppose these proposed changes, who may argue, e.g., for a period shorter than a one month remedy period for correction of inadvertent defects. Such firmness would comport with the stated, verbal desire of representatives of the USPTO to have greater numbers of parties avail themselves of the Inter Partes Reexamination procedure.

In an effort directed towards "streamlining prosecution in an inter partes reexamination", the USPTO proposes changes to Sections 1.949 and 1.953. These changes propose to have the Examiner issue a Right of Appeal Notice (RAN) as soon as all the claims are confirmed to be patentable, instead of first issuing an Action Closing Prosecution (ACP). This change is logical, *except* in one sole circumstance, where it is may not appear to be illogical and fair. That situation is the one where the Office action being issued is a first action on the merits confirming patentability of all the claims.

The undersigned wonders whether the office may have begun a policy where they will, on a regular basis, issue an Order under 35 USC 313 declaring that a SNQ (Substantial New Question of Patentability) exists, warranting Reexamination of the patent; and then, immediately thereafter issue a FAOM (First Action On Merits) confirming patentability of all claims. This has already occurred in the matter of Reexamination Serial Number 95/000,009, where the USPTO has issued an Order declaring the existence of an SNQ and then on even date, issued an Office Action

confirming the patentability of all claims. This does not streamline prosecution; it is respectfully submitted that this eviscerates the prosecution stage altogether. (Note: the undersigned has no connection whatsoever with any of the parties or representatives involved with 95/000,009).

In the '009 case, the Primary Examiner proffered an action confirming patentability of all claims on the same day as the finding of SNQ; his action was initialed by no less than two higher officials of the USPTO who as Special Programs Examiners, carry greater policy weight than a rank and file examiner. The undersigned is puzzled as to how the USPTO can find that a Requester has successfully discharged the burden of raising a substantial new question of patentability of at least one patent claim, while simultaneously confirm patentability of all claims on the same day. The USPTO is given three months under 35 USC 312(a) to evaluate a Request; if a Request does not present prior art printed publications and patents which do not come exceedingly close to making a prima facie case of unpatentability, if not exceed it, then the USPTO should not issue an Order under 35 USC 313.

In the above captioned Federal Register notice, the USPTO states that an ACP (or RAN) can be issued "even though the Office action being issued is the first action on the merits". It states this twice.

What the USPTO should say in its Final Rule, is that "although it is permissible for a RAN to issue in a first action on the merits, this situation shall not occur except in rare circumstances where justice requires it".

This apparent new policy is counterproductive. Representatives of the USPTO have publicly expressed their desire to see more members of the public to avail themselves of the "new reexam"; however, this new policy is going to deter people from filing.

Although the undersigned is unsure of this, this new policy may also be contrary to the letter of the law. According to 35 USC 314(a), "reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." These sections (viz. 132 and 133) are sections directed to prosecution before the Primary Examiner, not the BPAI. Section 132(a) indicates that each interested party shall get two bites at the apple. By analogy to initial examination, section 132(a) should be construed, in the context of inter partes reexamination, to loosely read:

"Whenever, on reexamination, any claim in a patent is confirmed to be patentable, the Director shall notify the Third Party Requester thereof, stating the reasons for such confirmation, together with such information and references as may be useful in judging of the propriety of continuing the Reexamination of the patent; and if after receiving such notice, the Third Party Requester persists, the previously-confirmed patent claim shall be reassessed."

It is only Section 134 which refers to prosecution before the BPAI. Yet, a RAN on FAOM shortcircuits examination before the Primary Examiner, bypassing section 132(a) and sends the case into the jurisdiction of the BPAI. The definition of "conduct of inter partes reexamination proceedings" found in 314(a) makes no mention of Section 134.

It is possible that there is case law indicating that the existence of an SNQ is not to be equated with the existence of a prima facie case of unpatentability. Granted. However, even if so, in the present context the USPTO ought to explain clearly why such case law mandates that a given Request only rises to the level of an SNQ and not a prima facie case of unpatentability. As stated previously, it ought to be rare and shall not occur except in rare circumstances where justice requires it.

Once again, PatentWatch wishes to thank the USPTO for providing this opportunity for comment.

Very respectfully submitted,
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Reg. Patent Agent 47,323