

Proposed New Reexamination Rules

65 Federal Register 67, April 6, 2000, pp. 18154-18186

Notice of proposed rulemaking entitled: "**Rules to Implement Optional Inter Partes Reexamination Proceedings**"

Comment deadline: June 12, 2000 - no public hearing.

Requested comments: by e-mail to the attention of Kenneth M. Schor, Senior Legal Advisor, at reexam.rules@uspto.gov and titled "Inter Partes Reexamination."

General Comment:

Although entitled "*inter partes*", in fact this new statutory alternative reexamination system bears little resemblance to a true *inter partes* proceedings. There is no examiner interviewing, no discovery, no testimony, no cross-examination, no oral argument (except at a Board final hearing) and extremely limited scope written-only participation with short and non-extendible time periods. Furthermore, the *inter partes* reexamination statute has two very broad and fully fatal "estoppel" provisions, against both the *inter partes* reexamination requester and its "privies."

This important statutory term "privies" is not defined in either the statute or these proposed rules, and is dangerously ambiguous without a definition.

To all of these and other effective barriers to the *intended* use of *inter partes* reexamination (to provide a viable alternative to the great cost and uncertainty of patent litigation), there will now also be added by these rule proposals an **\$8800**. PTO fee, per **Section 1.20(c)(2)**.

Furthermore, *inter partes* reexamination will only be applicable to the reexamination of a patent that issues from an original application filed in the U.S. on or after November 29, 1999.

Accordingly, it seems clear that the finally adopted *inter partes* reexamination system is of very limited value and interest. Thus, I have only a few comments on these proposed rules.

Proposed **37 CFR §1.971** keys the date for filing a “rebuttal brief” by either appellant (the patent owner or the third party requestor) in an *inter partes* reexamination appeal to “within one month of the examiner's answer”. However, the second line of the proceeding **Section 1.969(a)**, with the word “may”, makes the examiner's answer OPTIONAL. Therefore, an examiner's answer may not be filed. That seems to create a rule problem in tying one deadline date to another date for an event that may never occur?

Furthermore, re that same **Section 1.969(a)** language, *should* an examiner's answer be optional? Shouldn't it be mandatory when only the patent owner is filing an appeal to the Board in the reexamination? [A Board appeal by the third party requestor is optional, not mandatory.]

Additional comment: One proposed rule change here which would seem to be quite beneficial to the *requestor* in an *inter partes* reexamination is the prohibition against any examiner interviews. However, a countervailing problem for Office, as well as the patent owner, will be an increase in examiner confusion on complex technology issues. Without any interviews, complex technologies can no longer be easily illustrated or explained to the Examiner. It will also no longer be possible for the patent owner to get a clue as to what the Examiner does or does not understand. [Examiners rarely admit that they don't understand the technology in any of their written papers, and rarely ask for technical background explanations either.] Thus, the prohibition of any examiner interviews in *ex parte* reexaminations is going to have some unintended consequences, and would seem to

be a “mixed bag”. Perhaps a new MPEP section on how to deal with this, with examples of appropriate examiner written questions, would be appropriate?

As another general comment, the above-noted failure to obtain an effective *inter partes* reexamination statute is all the more reason that the "*ex parte*" reexamination system needs rule improvements to remove its present “completely blind” examiner provisions, which were not required by, or intended by, the original reexamination statute, as discussed herein and previously. It is unfortunate that the PTO is reinstating here only a very slightly modified version of the previous *ex parte* reexamination rules without seriously reconsidering any of the previous public comments that have been provided to the PTO on those rules. In particular, the refusal of the PTO to allow any entry or consideration of any further prior art, no matter how relevant to the validity of a patent, during the *ex parte* reexamination, even where that prior art was unavailable to the requestor at the time of the reexamination request, or only known to another member of the public. The examiner is not even allowed to see it. It is respectfully submitted that this is inconsistent with the duty of the PTO not to issue or re-issue invalid patents. The PTO is already being publicly criticized for ignoring relevant prior art as to issued patents even where that prior art is widely publicized on the Internet and other media. It is not seen how the present practice of not allowing anyone to bring any prior art to an examiner's attention in a reexamination, even for a litigated patent, benefits either the PTO or the public, especially since the file is otherwise open to the public. The present reexamination system, as implemented by the PTO, requires paying a \$2210 fee, filing another *ex parte* reexamination, and requesting its combination with the first reexamination. This is a cumbersome, burdensome and time-delaying system as compared to, for example, simply providing for one more reexamination office action and response for additionally cited prior art found to be relevant.

The rule proposal for better review of the (single) examiner’s decision in a reexamination is appreciated.

These purely personal comments are respectfully submitted by:

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