

February 12, 2004  
United States Patent and Trademark Office  
Office of Congressional Relations  
Room 902  
2121 Crystal Drive  
Arlington, VA 22202

ATTN: Anggie Reilly, Inter Partes Reexam

Dear Sir/Madam:

I have studied and written about inter partes reexamination. Unfortunately, the round table meeting regarding this topic is scheduled for school vacation week and I will be unable to attend. Here are my written comments.

Before considering whether inter partes reexamination is inequitable to one party or the other, a proper understanding of the desired objectives for inter partes reexamination is needed. The USPTO notice suggests that inter partes reexamination was designed to reduce lawsuits and to allow parties to argue invalidity at the USPTO. A lawsuit is certainly avoided when a patent's claims are cancelled in reexamination. Lawsuits may also be discouraged when claims are narrowed by amendment during reexamination. The primary function of reexaminations, however, is to produce better quality patents. Patents that survive reexamination may discourage lawsuits by persuading potential defendants of the need to abide by the patent's terms.

Inter partes reexamination is not a forum for arguing invalidity of issued patent claims. The dispute-ending determination of invalidity available in the court system is rarely achievable in reexamination. The reason is that in reexamination the patentee can amend the claims to overcome rejections and thereby reemerge with an enforceable patent even when the originally issued claims would have been invalid. Moreover, a court and the USPTO in reexamination are looking at very different standards when deciding whether to accept a challenge to a patent. A court assumes the claims were properly granted and defers to the USPTO decision to issue the patent but will invalidate that patent if presented with clear and convincing evidence. A reexamination considers whether the claims, without deference to any prior actions, are patentable over newly considered issues of anticipation or obviousness in view of prior art. The claims are more vulnerable to challenge in reexamination because the claims are given their broadest reasonable interpretation whereas a court construes the claims with a presumption of validity in mind.

Is inter partes reexamination fair to the opposing parties? I consider the possible situations one at a time.

1) The patent claims are neither anticipated by nor made obvious from the prior art publications or patents.

The patentee can be unfairly burdened by reexamination in this situation. Patentee should be entitled to enforce its patent in court. Instead, if a substantial new question of patentability is raised, requester can subject patentee to a delay of many years before getting back into court. The patent examiner can allow all the claims and requester can appeal to the Board of Appeals and then to the Federal Circuit. The statute provides for a stay of court proceedings during inter partes reexamination. Thus, a defendant can use inter partes reexamination and the appeal process to obtain several years of **delay** so long as a substantial new question of patentability is raised.

This inequity can be addressed by an interpretation of "substantial new question of patentability" that at least imposes the requirement that the prior art merit a rejection of one or more claims. First action allowances should not be permitted in inter partes reexaminations. Even with an initial rejection the patentee is burdened in this situation if there are significant delays. Therefore, it is necessary that the handling of an inter partes reexamination and the appeals therefrom be carried out expeditiously.

2) There are patent claims that should be properly upheld as valid in court, but in the absence of a presumption of validity and given a broadest reasonable interpretation are properly rejected by the USPTO in reexamination.

Inter partes reexamination and prosecution history estoppel put patentee in an awkward undesirable position in this scenario. Is it unfair? The patent could have been subjected to this more careful examination in the original prosecution, but no amount of USPTO resources will ensure a perfect examination. The examination and rejection is a problem for patentee, but it could have rightfully been presented as a problem in the original prosecution. The delay is unfortunate but unavoidable.

The inequity I see the patentee being faced with is that unlike during the original prosecution, the patentee in inter partes reexamination **is not entitled to conduct an oral interview** with the examiner and there are no continuation applications. To overcome this inequity the USPTO rules do permit patentee to file a reissue application. As I read rule 1.991, the reissue application even if merged with the reexamination will be conducted pursuant to reissue rules. I would expect interviews to be permitted and the USPTO should clarify whether this is the case. Furthermore, it would seem that patentee could file the reissue at any time prior to issuance of a reexamination certificate causing merger of the proceedings and allowing patentee to seek amended claims after unsuccessfully defending the issued claims. The USPTO should clarify if patentee has this flexibility. While requester may feel this is unfair, the inventor gets no more than a patent of valid scope and requester receives the protection from the intervening rights statute.

3) The patent claims should be invalidated over prior art publications or patents.

The third party requester is fairly treated in reexamination. Requester has the opportunity to comment on every response submitted by the patentee. The examiner is applying a broad interpretation to the claims and is assisted in rejecting the claims by the requester's comments. If the examiner improperly allows the claims, the requester can appeal to the Board and then to the Federal Circuit, if necessary. Presumably, the Federal Circuit will recognize the propriety of a rejection. If not, there is little reason to believe invalidity would have been achieved in court where the presumption of validity would have made the showing even more difficult.

The downside for the requester is patentee's potential for seeking amended claims in the reexamination or through filing a reissue application. While this may be of concern to the requester, as a matter of public policy, it is appropriate that an inventor be allowed to receive a patent of valid scope. The requester has the protection offered by the intervening rights statute with regard to new and amended claims. Presumably, the amended claims will be easier to design around.

Patentee with invalid claims is not harmed by reexamination. Indeed, patentee benefits from a procedure that is less expensive than litigation, and from the ability to seek amended or new claims.

I would welcome the opportunity to comment on additional issues raised at the roundtable.

Very truly yours,

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