

**From:** Garetto, Janet  
**Sent:** Wednesday, June 29, 2011 12:27 PM  
**To:** reexamimprovementcomments  
**Subject:** Intellectual Property Law Association of Chicago's (IPLAC) Comments re: "Streamlined Patent Reexamination Proceedings; Notice of Public Meeting," 76 F.R. 22854-22861, April 25, 2011

Dear Mr. Schor,

Attached is a letter containing the Intellectual Property Law Association of Chicago's (IPLAC) Comments re: "Streamlined Patent Reexamination Proceedings; Notice of Public Meeting," 76 F.R. 22854-22861, April 25, 2011.

Best Regards,

Janet M. Garetto,  
President of IPLAC, 2011-12

## **Janet Garetto**

**Partner**

**NIXON PEABODY**<sup>LLP</sup>  
ATTORNEYS AT LAW

300 S. Riverside Plaza

16th Floor

Chicago, IL 60606-6613

P (312) 425-8514

C (312) 351-2378

F (866) 568-1033

[jgaretto@nixonpeabody.com](mailto:jgaretto@nixonpeabody.com)

[www.nixonpeabody.com](http://www.nixonpeabody.com)



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*INTELLECTUAL PROPERTY LAW  
ASSOCIATION OF CHICAGO*

P.O. Box 472 • Chicago, Illinois 60690-0472  
312-987-1416

June 29, 2011

*reexamimprovementcomments@uspto.gov*  
Mail Stop Comments-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450,  
Attn: Kenneth M. Schor

**Re:** Streamlined Patent Reexamination  
Proceedings; Notice of Public Meeting  
76 Fed. Reg. 22854 (April 25, 2011)

Dear Mr. Schor:

I am the President of the Intellectual Property Law Association of Chicago (IPLAC), one of the largest intellectual property law associations in the United States. Established in 1884, IPLAC is the nation's oldest bar association focused on patent law. The Association's founding members declared their original purpose to include "aiding reforms in the administration of the Patent Office," and "discussing such other matters hereafter to arise as may be of common interest . . ." Today, one such common interest is the maintenance and development of the Patent system.

The purpose of this letter is to provide IPLAC's comments on the points raised in "Streamlined Patent Reexamination Proceedings; Notice of Public Meeting," 76 F.R. 22854-22861, April 25, 2011 ("the Notice"). These comments were drafted by our U.S. Patents Committee, taking into consideration both the views of those who request reexamination and those who defend patents in reexamination. The comments were submitted to all members of IPLAC for review and any further comments, then reviewed and approved by IPLAC's Board of Managers – its governing board. We are submitting these comments on or before the deadline of June 29, 2011.

The following table sets forth in the left column proposed changes to reexamination practice and questions the USPTO has requested commenters to address.

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These are quoted from the Notice, and pinpoint cites are provided for convenient reference. The right column provides the comments of the Intellectual Property Law Association of Chicago (IPLAC) respecting these proposed changes and questions.

<b>Excerpts of requests for comments and questions from the Notice</b>	<b>IPLAC Comments</b>
76 F.R. at 22855 – <b>“A. USPTO Proposed Changes to Both <i>Ex Parte</i> and <i>Inter Partes</i> Reexaminations”</b>	
76 F.R. at 22855 - <b>“1. Requester Must Separately Explain How Each SNQ Presented in the Request Is “New” Relative to Other Examinations of the Patent Claims”</b>	IPLAC agrees in principle with this proposal.  It is believed that this proposed change would be fair to both parties, and would improve efficiency. Requesters are already encouraged to do this, and the more thoroughly and clearly the substantial new questions (SNQs) are explained, the more persuasive they are likely to be for the Requester, yet the more easily the Patent Owner can respond at the first opportunity.
76 F.R. at 22855 - <b>“2. Requester Must Explain How the References Apply to Every Limitation of Every Claim for Which Reexamination Is Requested”</b>	IPLAC agrees in principle with this proposal.  It is believed that this proposed change would be fair to both parties, and would improve efficiency, for the reasons stated in response to Point 1.
76 F.R. at 22856 - <b>“3. Requester Must Explain How Multiple SNQs Raised in the Same Request Are Non-Cumulative of Each Other; Cumulative SNQs Will Be Deemed to Constitute a Single SNQ”</b>	IPLAC agrees in principle with this proposal.  It is believed that this proposed change would be fair to both parties, and would improve efficiency, for the reasons stated in response to Point 1.

76 F.R. at 22856 -

“4. The Examiner May Select One or More Representative Rejections From Among a Group of Adopted Rejections.

“ \* \* \* A proposed rejection is “adopted” if the examiner determines that it establishes a prima facie case of unpatentability.

“For any rejection within the group which is not designated as a representative rejection, the examiner may simply state, to the extent the examiner agrees with the Requester, that the rejection is adopted for the reasons set forth in the request, and incorporate by reference the Requester’s limitation-by-limitation explanation of the manner of applying the references (see Part A.2).

“ \* \* \* no claim will be confirmed as patentable without having received due consideration of all rejections within the group.

“ \* \* \* For this reason, it is advisable for the Patent Owner to explain, in its response to the FAOM, why the Patent Owner’s arguments against any representative rejection would likewise overcome all other rejections within the group.”

IPLAC respectfully disagrees with this proposal.

The apparent purpose for this proposal is to allow the Examiner to prepare the first Office action on the merits (FAOM) more quickly by initially raising representative rejections, instead of every available rejection, and adopting the remaining proposed rejections from the request.

This proposal is not believed to contribute to efficiency going forward, and it will in some cases cause prejudice to patent owners and third party requesters.

First, providing representative rejections and debating their designation adds another level of complexity to reexamination procedure, and is not likely to improve efficiency.

Additionally, this proposal reflects existing practice of the USPTO, since in practice Examiners often process long reexamination requests by adopting extensive material from the Request, instead of fully digesting the proposed rejections and using only rejections the Examiner finds persuasive after full analysis. Adopting this existing practice as a rule will not increase efficiency going forward.

Third, this procedure does not give the parties an adequate opportunity to understand the Office position as recited in the FAOM (first Office action on the merits). The FAOM should address all issues thoroughly, as it is potentially the last unrestricted opportunity for the Patent Owner to respond (with arguments, evidence, and claim amendments) and a third party requester to reply. Later replies have more restrictions. Given these restrictions, it is essential for the first Office action on the merits to be comprehensive, as the rules expressly require even in ordinary prosecution. See e.g. 37 CFR 1.104(a), (b), (c).

The Notice would allow the Examiner to write less than a full first Office action on the merits, adopting proposed rejections from the request summarily instead of setting forth only rejections and reasoning

	<p>the Examiner believes are appropriate or persuasive.</p> <p>Nonetheless, the parties still have only one clear chance to amend claims or introduce evidence in response to the first Office action. The Notice makes clear that the parties would be wise to respond fully to adopted rejections, as well as those fully set out. “* * * no claim will be confirmed as patentable without having received due consideration of all rejections within the group. * * * For this reason, it is advisable for the Patent Owner to explain, in its response to the FAOM, why the Patent Owner’s arguments against any representative rejection would likewise overcome all other rejections within the group.” Of course, it would also be in the Requester’s best interest to address these less-well-developed rejections in its reply as well.</p> <p>So a serious problem perceived with The Notice is that the Examiner would not need to fully set out all rejections in the FAOM, but the parties would need to fully respond to all rejections in response to the FAOM, without the benefit of a full explanation of all bases for rejection. Moreover, the parties have page limits, and extensive adoption of grounds of rejection requires a longer response with the same page limit, absent a petition.</p>
<p>76 F.R. at 22856 - “5. Requester’s Declaration and Other Evidence Will Be Mainly Limited to the Request”</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>This is the status quo in ex parte reexamination, and would be more efficient in inter partes reexamination as well. Requiring both parties to present evidence as early as possible is the most efficient way to proceed, in the absence of special considerations such as the Requester’s need to present additional evidence to counter a new, not reasonably anticipated showing by the Patent Owner.</p>

<p>76 F.R. at 22857 –          “6. Patent Owner’s Amendments and Evidence Will Be Mainly Limited to the First Action Response”</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>This is the status quo in ex parte reexamination, and will be the situation if the current practice in inter partes reexamination is amended to provide a single, final Office action instead of an Action Closing Prosecution followed by a Right of Appeal Notice.</p>
<p>76 F.R. at 22857 –          “7. Claim Amendments Will Not Be Entered Unless Accompanied by a Statement Explaining How the Proposed New Claim Language Renders the Claims Patentable in Light of an SNQ”</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>The Patent Owner normally is motivated to fully explain how its amendments are advancing prosecution anyway, so making it a rule should not be a substantial issue. This proposal will require Patent Owners to make more of a written record than would ordinarily be required during ordinary prosecution (where they can try to make a sparse record at first, and provide additional discussion if unsuccessful at first). But the Patent Owner is generally forced to make an extensive written record early in a reexamination, as the rules do not allow many second chances and is subject to a mandate that reexamination must be conducted with special dispatch.</p>
<p>76 F.R. at 22858-          “8. Petitions Practice Will Be Clearly Defined (This page of the Federal Register includes a table of appropriate petitions, indicating which are properly opposable according to USPTO practice.)”</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>Too much of petition practice has been “insider information” only known to former USPTO employees, not generally available. Just clarifying and publicizing the USPTO petition policy in the Manual of Patent Examining Procedure should accomplish a lot of good, so parties will know what petitions can be made and what petitions can be opposed.</p>
<p>76 F.R. at 22858-  <b>“B. Proposed Changes Specific to Ex Parte Reexamination”</b></p>	<p style="text-align: center;"><b>IPLAC Comments</b></p>
<p>76 F.R. at 22858-          “1. Make Permanent the Pilot That Allows the Patent Owner to Optionally Waive the Patent Owner’s Statement”</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>It is believed that this proposal will increase the efficiency of reexamination, and will be fair. Because responding to a reexamination order in ex parte reexamination is optional, and opens the door for additional comments from the requester, almost no patent owners file a patent owner’s statement, and</p>

	many patent owners attempt to waive the patent owner's statement quickly (successfully, under the pilot program). Allowing quick waiver of a seldom exercised statutory right should be a painless way to improve efficiency considerably.
76 F.R. at 22859 "2. Where the Patent Owner Does Not Waive the Statement, the Order Granting Reexamination Will Include a Provisional FAOM, Which May Be Made Final in the Next Action"	IPLAC agrees in principle with this proposal.  This proposal is believed to promote examiner efficiency (encouraging the Examiner to do most of the work of preparing the first Office action while the Examiner's initial study is fresh in his or her mind) and to give maximum notice to the Patent Owner of the rejections it faces, while expediting prosecution.
76 F.R. at 22859 <b>C. Proposed Changes Specific to Inter Partes Reexamination</b>	<b>IPLAC Comments</b>
76 F.R. at 22859 "1. Third Party Requester May Dispute the Examiner's Designation That a Rejection is "Representative" of Other Rejections in the Group"	IPLAC respectfully disagrees in principle with this proposal.  Providing representative rejections and debating their designation adds another level of complexity to reexamination procedure, withholds vital information from the FAOM, and is not likely to improve efficiency. This was addressed above.
76 F.R. at 22859 "2. Final Office Action Closes Prosecution and Triggers Appeal Rights This proposed change is intended to reduce delays in inter partes reexaminations by consolidating the action closing prosecution under 37 CFR 1.949 and the right of appeal notice under 37 CFR 1.953, and replacing them with one final Office action."	IPLAC agrees in principle with this proposal.  This proposal can be expected to be more efficient, by removing the interval between the action closing prosecution and the right of appeal notice, as well as the time for considering a response and reply to the first before preparing the second. Current practice has considerably elongated the proceeding, since the procedure would go back to square one (a non-final Office action) if the Requester made any new persuasive argument against patentability or if the Patent Owner made any new persuasive argument for patentability. The other proposals made are intended to flush out all these arguments earlier, so there is no need for a waiting period between an action closing prosecution action and a right of appeal notice.
76 F.R. at 22859 "3. Third Party Requester's	IPLAC agrees in principle with this proposal.

<p>Appellant Brief is Limited To Appealing An Examiner's Decision That a Claim is Patentable; Additional Bases To Cancel A Rejected Claim Can Only Be Argued in a Respondent Brief Following Patent Owner's Appellant Brief?"</p>	<p>The statute only states that the Requester can appeal findings of patentability on appeal. The Requester already has an opportunity to propose any desired rejection in the request. If the Examiner does not adopt one or more rejections, it is fair and will make the proceeding more concise to limit this type of reargument to a respondent brief.</p>
<p>76 F.R. at 22860 –  <b>Comments are invited ... to the questions below:</b></p>	<p style="text-align: center;"><b>IPLAC Comments</b></p>
<p>76 F.R. at 22860 –      "1. Should the USPTO proceed with any efforts to streamline the procedures governing ex parte and/or inter partes reexamination proceedings?"</p>	<p>IPLAC agrees in principle with this proposal.</p> <p>Appropriate and fair rules that streamline reexamination procedure will allow the USPTO to better accomplish its mission. The average time for a reexamination is too long, particularly if one looks at the statistics only for recently filed reexaminations or highly contested reexaminations that proceed through appeals, instead of averaging all reexaminations since the beginning.</p> <p>IPLAC does not believe that the USPTO should wait to streamline reexamination, based on speculation that the system will be changed by legislation. The legislation currently in Congress proposing a new post grant opposition might never be passed.</p> <p>Finally, even if an opposition proceeding is created by new legislation, finding efficient solutions to the current problems will provide feedback allowing the Office to make more efficient rules for the conduct of any type of reexamination or opposition.</p>
<p>76 F.R. at 22860 –      "2. Should the USPTO place word limits on requests for ex parte and/or inter partes reexamination?"</p>	<p>IPLAC agrees in principle with this proposal, providing the page limits for requests and for the Patent Owner's response to the FAOM are equal.</p> <p>Ex parte and inter partes reexamination are separately discussed below respecting this point.</p> <p><b>Ex Parte Reexamination</b>      Regarding ex parte reexamination, there currently are no page limits for either the patent owner or the third party. Evenhanded page limits as explained below</p>

could be imposed.

Equal page limits on the request for reexamination and the Patent Owner's response to the FAOM would be appropriate, providing petitions to extend page limits are allowed to adjust for exceptional circumstances (as they are for inter partes reexamination).

The same page limits could be adopted for further responses by the Patent Owner.

#### **Inter Partes Reexamination**

A fundamental problem with the present inter partes reexamination practice is that the Requester has no page limit in its initial request, but the patent owner is always subject to a page limit (absent the grant of a petition to file a longer response). The requester can elaborate at great length on many proposed rejections in the request, creating a library of information, useful visual aids (like claim charts, Figures from the prior art, and extensive use of quotations from the prior art), declaration evidence, and so forth from which the Examiner and the Requester can withdraw material during the proceeding. Likewise, the Examiner has no page limit, so if the Examiner agrees with many proposed grounds of rejection, and expounds on them at length, the Patent Owner must respond at length to adequately protect its rights. Examiners often do not have time to weed out many non-meritorious proposed rejections from a voluminous request, and face pressure to take the shortcut of adopting most or all of what the requester has provided, without full consideration on the merits.

The patent owner in inter partes reexamination, however, has a page limit in responding to the FAOM and in every other substantive response, and if there are many rejections or an extensive response is needed, the patent owner will have difficulty putting together a thorough response to all rejections.

Filing a very long reexamination request – hundreds of pages long, in some instances – is a strategy used by some Requesters to slow down the reexamination and unfairly improve the Requester's odds of

success. A long request requires more time for the Examiner to evaluate and to prepare a first Office action, and this delay propagates throughout the proceeding.

Some accused infringers file an extremely long request with many proposed rejections as a conscious strategy to obtain the maximum possible stay of litigation after the accused infringer is sued for infringement. A long request also increases the odds that the patent will be held invalid, simply because the Examiner does not have the time or resources to fully consider and in some case discount the grounds for invalidity, and the Patent Owner does not have the number of pages or other resources necessary to effectively rebut the resulting rejections.

The patent owner can request an expansion of its page limit by petition, but cannot expect to be allowed as much space as the Requester has used in the request, and cannot count on the petition being granted. Current practice has been to require the Patent Owner to file a complete response with a petition to extend the page limit to match the response. The procedure thus requires a discretionary petition with complex facts to be considered by the Office, and substantive reexamination is interrupted in the meantime. The Office then either grants the petition and prosecution on the merits continues, or it denies the petition and the Patent Owner is given time to shorten its response to the length deemed appropriate. This is a second interruption to substantive reexamination, and at the same time causes prejudice to the Patent Owner that cannot present all the rebuttal material it prepared.

As suggested in the Notice, one possible solution is to impose a page limit on the request. This will certainly improve efficiency, to the extent the request would otherwise be longer than the page limit.

An argument can be made on the one hand that a page limit is unfair to a Requester that has many legitimate grounds to attack the patent, just as a page limit is unfair to a patent owner that has many legitimate defenses. This issue is particularly acute

	<p>in inter partes prosecution, where the requester is precluded by statute from again challenging the same patent on grounds that could have been set forth in the original request, but were omitted due to the need to meet a page limit.</p> <p>On the other hand, it can be argued that a page limit on the Request is both fair, because it mirrors the limitation imposed on the Patent Owner, and efficient, because it simply requires the Requester to limit itself to its best arguments that are most likely to succeed, and to state them succinctly.</p> <p>If a page limit on the Request is not adopted as discussed in this section, then the Patent Owner should be given more latitude in its response to the first Office action as discussed in the next section, and vice versa.</p>
<p>76 F.R. at 22860 – “3. Should the USPTO revise its existing page or word limits in inter partes reexamination following the request?”</p>	<p>IPLAC suggests that there might be no need to revise the existing page limits in inter partes reexamination following the request.</p> <p>As pointed out above, the rules <u>do</u> need to be changed so the page limit for a request is equal to the page limit for the Patent Owner’s response to the FAOM. If that problem is addressed, IPLAC suggests that there might be no need to change the other page limits. Some guidance might be in order for later responses as well, however, such as a rule of thumb that each Patent Owner response can be as long as the corresponding Office action, and each reply by the Requester can be as long as the Patent Owner’s response. This might allow petition practice to be streamlined considerably.</p>

<p>76 F.R. at 22860 – “4. Should the USPTO place any limitation or criteria on the addition of new claims by a Patent Owner in reexamination? If so, what kind of limitation or criteria?”</p>	<p>IPLAC respectfully disagrees in principle with any proposal to further limit the addition of new claims by the Patent Owner. Given the above proposal requiring the patent owner to explain how any amended claims overcome the rejections of record, the statutory proscription prohibiting broadening, and the usual restrictions on after-final practice, we do not believe any further limit should be placed on the number or type of amended claims the patent owner submits and is willing to pay for.</p> <p>When a patent is reexamined, particularly as requested by a third party, the Patent Owner is clearly on notice that additional measures, such as presenting claims more finely graduated between the broadest and narrowest claims and additional combinations of separately claimed features, might be needed to make the patent (if any) that remains after reexamination as strong as possible. The Patent Owner should not be denied the opportunity to make its patent more resistant to attack, as by adding fallback positions.</p>
<p>76 F.R. at 22860 – “5. Should the USPTO change its interpretation of “a substantial new question of patentability” to require something more than “a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable”? See MPEP §§ 2242, 2642. If so, how should it be interpreted?”</p>	<p>IPLAC is split on this proposal, between those who have a more significant practice representing patent owners (“Patent Owners’ counsel”) and those who are more likely to represent third-party Requesters (“Requesters’ counsel”). Their respective positions are addressed separately below.</p> <p><b>Patent Owners’ Counsel</b> Patent Owners’ counsel submit that the USPTO should change its interpretation of “a substantial new question of patentability” to require a prima facie showing of unpatentability of a claim before reexamination can be ordered for that claim.</p> <p>The Patent Owners’ counsel submit that the statutory requirement that the Request must be found by the Examiner to state a substantial new question of patentability, before the patent owner is required to respond, has not been administered as intended by Congress. The purpose of this threshold requirement was to prevent harassment of and an undue burden on the patent owner, to the extent the request stated insubstantial or “old” grounds (already addressed during original prosecution) for revoking the patent.</p>

In practice, however, almost all requests for reexamination are granted, and even requests offering no information beyond what was available during original prosecution (perhaps recombining prior art the Examiner considered) are rarely curtailed. Both what is "substantial" and what is "new" are broadly construed to the detriment of the patent owner. The gate has not been kept; it has been left almost entirely open.

This question directly addresses what questions are to be considered "substantial." The Patent Owners' counsel submit that a higher standard of substantiality, properly administered, would help to restore the gate keeping function. The Patent Owners' counsel submit that a more appropriate, easily administered standard is whether the Request states a prima facie case of unpatentability for each claim for which the reexamination goes forward. In short, the same standard would apply as is used to reject claims – a prima facie case of unpatentability. A uniform standard will be more easily and uniformly administered, promoting efficiency.

The Patent Owners' counsel submit that a particular basis for improved efficiency is that the Request and Office actions will not need to separately address what is a substantial question and which of those questions further rise to the level of a prima facie basis for rejection.

The Patent Owners' counsel also submit that the standard for what questions are new should also be raised. A new question should not be found unless the requester relies on evidence or prior art not previously cited by the Examiner and not relied upon by the Examiner in any rejection.

For example, assume the Examiner made two rejections during initial prosecution -- one rejection of claim 1 based on Jones in view of Smith for obviousness, and another rejection of claim 6 based on Jameson in view of Johnson for obviousness. Assume further that during prosecution the applicant cited additional references A through Z in an Information Disclosure Statement, but none of these references was ever applied by the Examiner in a

	<p>rejection.</p> <p>The Patent Owners' counsel also submit that, in this situation no new question should be established respecting any claim by merely applying a different combination or selection among Jones, Smith, Jameson, and Johnson, unless new declaration evidence or the like is presented showing that the Examiner did not understand the true value of the reference as a reference against patentability – perhaps based on undisclosed but inherent properties.</p> <p><b>Requesters' Counsel</b></p> <p>The attorneys who largely represent third-party Requesters (the “Requesters’ counsel”), on the other hand, submit that the standard for a substantial new question should not be raised.</p> <p>First addressing what is a substantial question, the Requesters’ counsel submit that the current standard – what a reasonable examiner would consider important – is strict enough to accomplish its intended purpose, as there are few instances in which a substantial new question is found to exist under the current standard, so reexamination is ordered, yet the Examiner is unable to make a prima facie rejection of the claims under reexamination. A higher standard of what is a substantial question, requiring a prima facie case of unpatentability to be made out in the request as well as the first Office action, thus would not substantially change the number of instances in which reexamination is ordered, and would not promote efficiency.</p> <p>Requesters’ counsel further submit that if a raised standard for a substantial question of patentability did reduce the number of requests that were granted, the result would be to reduce the degree to which courts and accused infringers involved with current or imminent litigation of a patent would be able to rely on consideration of new questions of patentability in the first instance by the USPTO. This would be a detriment to the public.</p> <p>Now addressing whether to increase the burden on the requester to establish that a question of patentability is new, Requesters’ counsel submit that</p>
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	<p>this proposal has already been rejected by Congress, which liberalized the standard for a substantial new question by amending 35 U.S.C. 303 subsequent to <i>In re Portola Packaging Inc.</i>, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), to more inclusively define what is new.</p> <p>Finally, addressing both what is substantial and what is new, Requesters' counsel submit that this amendment of 35 U.S.C. 303 can be taken as an indication by Congress that public policy favors relatively easy access to reexamination by requesters. The USPTO should not contradict this public policy by raising the standard for a substantial new question.</p>
<p>76 F.R. at 22860 – “6. How much time should Patent Owners and Third Party Requesters ordinarily be given to submit a statement, response, or appeal where the time for filing the statement, response, or appeal is set by the USPTO rather than by statute?”</p>	<p>IPLAC agrees in principle with the current time limits for responses.</p> <p>The usual deadlines are understood to be two months for a patent owner response under ordinary circumstances and one month in special circumstances (such as during litigation of the same patent), and one month for a third party requester in all instances (inter partes only).</p> <p>IPLAC respectfully disagrees in principle with further shortening the deadlines, which would be a burden on the parties. Reexamination responses require much more effort and time to prepare than responses in ordinary litigation.</p>
<p>76 F.R. at 22860 – “7. Under what conditions should the USPTO grant a Patent Owner's request for an extension of time under 37 CFR 1.550(c) or 1.956, both of which provide that extensions of time may only be granted for 'sufficient cause and for a reasonable time specified?'”</p>	<p>IPLAC agrees with the current statement of the standard for obtaining an extension of time, “for sufficient cause and for a reasonable time specified,” but submits that the standard is too strictly administered in practice.</p> <p>In particular, the USPTO is too strict in its application of the standard for a total extension of no more than one month. Extensions should only be allowed for cause, but the USPTO should be more liberal in granting proper requests for extension of time for a first month. One-month extension practice could be for standard grounds on a standardized form that could be granted automatically if proper. This would then increase efficiency by reducing the burden to examine petitions for short extensions of time.</p>

<p>76 F.R. at 22860 – “8. Should the USPTO require that any information disclosure statement (IDS) filed by a Patent Owner in a reexamination comply with provisions analogous to 37 CFR 1.97 and 1.98, and further require that any IDS filed after a Notice of Intent to Issue a Reexamination Certificate (NIRC) or notice of appeal be accompanied by: (1) an explanation of why the information submitted could not have been submitted earlier, and (2) an explanation of the relevance of the information with regard to the claimed invention?”</p>	<p>IPLAC respectfully disagrees in principle with this proposal.</p> <p>It is not clear why IDSs by the Patent Owner should be a significant cause of delay, since the USPTO does not search for or examine any prior art beyond the prior art mentioned in the Request. Also, the Patent Owner cannot use the “escape valve” provided in ordinary prosecution by the option to file a Request for Continued Examination (RCE). Therefore, the 37 CFR 1.97 and 1.98 rules limiting opportunities to submit an IDS should not be applied in reexamination at all. At the same time, since the Examiner will not use the new prior art that is submitted by the Patent Owner, the Examiner should be excused from reviewing the prior art or IDS, and the prior art should not be listed on the reexamination certificate as having been considered. It should be available in the file for use by any member of the public.</p>
<p>76 F.R. at 22860 – “9. Under what conditions should a reexamination proceeding be merged with another reexamination or reissue proceeding?”</p>	<p>IPLAC agrees in principle that a second (reexamination or reissue) proceeding should be merged with a pending reexamination of the same patent, but only under the following circumstances (absent a showing of extraordinary circumstances):</p> <ol style="list-style-type: none"><li>1. The merger is requested before prosecution is closed by a final Office action (in ex parte reexamination) or an Action Closing Prosecution (in inter partes reexamination); AND</li><li>2. The second proceeding is not filed by the requester or privies for the first reexamination.</li></ol> <p>The first requirement is needed to prevent disruption in the proceeding, but it should be a bright line rule. Bright line rules are easier to manage because eligibility can be determined easily and quickly. One problem with merger practice today is that it requires a petition decision involving the exercise of discretion, and requires too much time during which the merits of the proceeding are not being addressed.</p> <p>The second requirement is needed because requesters will often file additional requests for reexamination, while a current reexamination is in progress (in</p>

	<p>particular, an ex parte reexamination), to delay resolution of the patentability of the patent at issue. This is an abuse that should not be allowed, as it often delays the patent owner's enforcement of a patent involved or intended to be involved in litigation. At the same time, other parties, including the patent owner, should have the opportunity to start a later proceeding and have it merged with the earlier proceeding. The patent owner generally does not have a motivation to delay, as it is eating into its patent term if the original claims are not maintained (due to intervening rights). Third parties, if not in privity with a previous requester, should have the opportunity to present their own arguments against the patent.</p>
<p>76 F.R. at 22860 – “10. What relief can and should be given to a Third Party Requester that shows that it did not receive a Patent Owner's statement or response within a certain number of days after the date listed on the Patent Owner's certificate of service? How many days and what kind of showing should be required?”</p>	<p>IPLAC proposes that this problem is largely the result of service by first class mail, and can best be addressed by eliminating service by first class mail as an option.</p> <p>First class mail is slow, requires an uncertain and often long amount of time, and does not provide direct, uninterested third-party evidence of mailing or delivery. Instead of giving relief for late first class delivery, we suggest elimination of first class delivery in favor of Express Mail service or electronic delivery (as by an e-mail attachment). These forms of delivery are quicker, the likely date of delivery is usually known, and there is independent evidence corroborating the facts of sending and delivery.</p> <p>If one of those forms of delivery fails and the sender becomes aware of this, the fact of non-delivery and date of successful subsequent delivery should be documented to the USPTO and should extend the time for reply by the third party requester.</p> <p>Another suggestion to improve the reliability of service on the counterparty would be to require the party making service to indicate the expected date of service in the certificate of service, then place a telephone call to the party served, no later than the day after a document is served by mail or electronically (since the serving party might be serving after the normal close of business at the recipient), to advise that a paper is being served and</p>

	<p>when it is expected to arrive. Then the third party will quickly know if the paper does not arrive or is not usable (like a PDF that cannot be read) and must be re-served. A standardized petition can then be filed by the recipient if the recipient can prove that the date of actual receipt is later than the date of delivery indicated in the certificate of service.</p>
<p>76 F.R. at 22860 – “11. Should the USPTO encourage and/or require that all correspondence in reexamination proceedings be conducted electronically (e.g., e-filing parties’ documents, e-mailing notices of Office actions and certificates)?”</p>	<p>IPLAC agrees in principle that e-filing should be encouraged, but respectfully disagrees in principle with requiring e-filing.</p> <p>E-filing should be encouraged, as it generally is more efficient.</p> <p>E-filing should not be required, since sometimes e-filing systems and equipment fail and cannot be corrected before a deadline. Also, e-filing is not always practical for voluminous submissions, such as large IDSs with many non-patent references. Further, there are still a few unsophisticated practitioners, unrepresented parties, and Far West parties (such as those located in Hawaii, many time zones away from the USPTO) that would have difficulty with mandatory e-filing.</p>
<p>76 F.R. at 22860 – “12. Should reexamination proceedings remain with the Board in cases where the Board has entered a new ground of rejection on appeal and the Patent Owner seeks to introduce new evidence and amendments? In particular, is it more efficient for three administrative patent judges or a single examiner to decide issues involving new evidence and amendments?”</p>	<p>IPLAC respectfully disagrees in principle with this proposal.</p> <p>The consideration of a new ground of rejection should continue to be, as chosen by the patent owner, either by requesting reconsideration by the Board or by returning the application to the Examiner for prosecution. It is not regarded as efficient use of the Board to have it write a first and a final Office action. If the patent owner is facing a new ground of rejection, the patent owner has a right to receive a first Office action, a final Office action, and an opportunity to amend claims and present new evidence. Amendments and new evidence are best prosecuted before the Examination Corps in the first instance.</p>

<p>76 F.R. at 22860 – “13. What other changes can and should the USPTO make in order to streamline reexamination proceedings?”</p>	<p>IPLAC has the following additional suggestion to streamline reexamination proceedings.</p> <p>The USPTO should modify its current rule in reexamination proceedings limiting the responses that can be made after final action. A lot of the petitions and other complications of reexaminations revolve around the fact that no continued prosecution is available and limited amendments and evidence can be presented after final action, but an action stating a new ground of rejection can be made final if responsive to an amendment made by the applicant. We suggest that a more efficient way to proceed would be to allow the Examiner to make the second action final whether or not new rejections are made, but to allow the applicant to introduce evidence and claim amendments at least one time after final action, and require the Examiner to consider it fully, without regard to the considerations of Rule 1.116. This might seem to elongate the procedure, but in fact would often shorten it, since it would remove petitionable issues.</p>
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The Office is respectfully requested to take these comments into account when considering any proposed changes to the reexamination rules.

Sincerely,

Intellectual Property Law Association of Chicago

By:



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Ms. Janet M. Garetto, President