

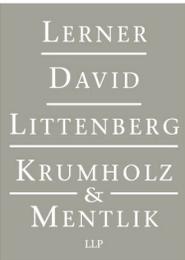
From: Millet, Marcus J
Sent: Wednesday, June 29, 2011 2:12 PM
To: reexamimprovementcomments
Subject: Written Comment-Docket No. PTO-P-2011-0018-Streamlined Patent Reexamination Proceedings

Please see the attached written comments.

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INTELLECTUAL PROPERTY LAW

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June 29, 2011

Via E-Mail (reexamimprovementcomments@uspto.gov)

Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Kenneth M. Schor

Re: Written Comments Concerning Streamlined Patent Reexamination Proceedings;
Notice of Public Meeting
Docket No.: PTO-P-2011-0018

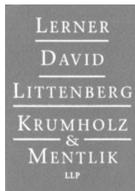
Dear Sir:

Undersigned counsel respectfully submits the following comments concerning the proposals set forth in the above-captioned notice. Undersigned counsel routinely represents both Patent Owners and third-party Requesters in reexamination proceedings.

Many of the proposed changes set forth in the Notice are constructive and useful. Undersigned counsel is in favor of proposals A(1)-A(4) and A(8), as well as B(1), B(2), C(1), and C(2). Some of these eliminate useless steps such as eliminating the right of appeal notice in *inter partes* reexamination and the Patent Owner's statement in *ex parte* reexamination. Others require what is already good practice in drafting reexamination requests, such as requiring explicit application of reference teachings to every claim.

However, it is respectfully submitted that proposal A(6), "Patent Owner's Amendments And Evidence Will Be Mainly Limited To The First Action Response," is unwise, unfair, and unworkable, and will deprive Patent Owners of property rights without due process of law.

Responses to final actions in *ex parte* reexaminations, and to actions closing prosecution in *inter partes* reexaminations, are presently governed by the well-understood practice pursuant to 37 C.F.R. § 1.116, governing responses after final action in *ex parte* prosecution of applications. These standards allow presentation of new evidence and amendment upon a showing that the same are necessary and good reasons why the same were not earlier presented. When fairly administered, these standards strike a reasonable balance between bringing the proceedings to closure and also affording due process to the applicant or Patent Owner. The



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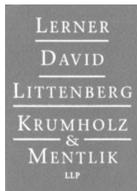
applicant or Patent Owner can introduce new amendments or evidence, but only if the same are truly responsive to something new raised by the examiner in the final action.

This flexibility is absolutely necessary, because examiners can and do raise new technological issues in final actions, even without denominating the rejection a new rejection. For example, in one reexamination where undersigned counsel represented the Patent Owner, the examiner adopted an entirely new scientific theory in an action closing prosecution to show inherency in a reference teaching. Under existing practice, Patent Owner was able to put in an expert declaration and treatises in the art, which demonstrated that the phenomenon postulated in the action closing prosecution could not occur. The examiner then withdrew this contention and made a different rejection. Under the proposal to limit amendments or declaration evidence to "overcoming a new ground of rejection entered in any non-final official action," this evidence would have been excluded. The original rejection, based on a clear error of science, would have been adopted. Patent Owner would have had no ability whatsoever to rebut the examiner's new scientific reasoning with evidence.

The flexibility afforded by Rule 37 C.F.R. § 1.116 is especially necessary in reexamination, where Patent Owner does not have the right to refile or file a request for continued examination. In a reexamination, the Office is dealing with momentous questions with large stakes for investors and with an inventor's work of a lifetime on the line. In these circumstances, making the process more "efficient" by depriving a Patent Owner of a right to a fair hearing on technological points raised by the examiner is simply unacceptable. Moreover, it is not clear how submissions after final action within the scope of existing practice under Rule 116 materially prolong or complicate reexamination proceedings. If the evidence or amendment introduced after final rejection is not persuasive, the case will proceed to appeal with no delay. If it is persuasive, the rejection was wrong, and the "delay" was warranted.

There is an asymmetry between proposal A(5) concerning Requester's evidence and proposal A(6) addressed above. Proposal A(5) suggests that Requester would have the opportunity to introduce evidence, such as declarations, if the same are "rebutting a point made in an examiner's Office action or in a Patent Owner's response," and does not suggest that the same will be cut off after final in the same manner as proposal A(6) concerning Patent Owner's amendments and evidence.

Undersigned counsel also believes that the proposal to limit amendments to those particular amendments necessary to render the claims patentable in light of a substantial new question (proposal A(7)) will be counterproductive. It will only provoke filing of additional reissue applications. This is particularly true in light in the recent Federal Circuit decision in *In re Tanaka* 98 U.S.P.Q.2d 1331, __ F.3d __ (Fed. Cir. Apr. 15, 2011), liberalizing the standards for what constitutes "error" that is correctable by reissue. It is not seen how the Office will gain any advantage by forcing Patent Owners to file reissue applications in order to introduce amendments to the claims other than those specifically required to overcome a



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rejection, or how the Office would prevent Patent Owners from taking all of the opportunities afforded to them by statute to correct the claims of a patent once that patent is involved in review before the Office. Rather, it is respectfully submitted that the interests of the Office and the public would be better served by encouraging Patent Owners to present all new claims in the reexamination proceeding.

It appears likely that H.R. 1249, currently pending in the Congress, will be enacted. This legislation will establish new procedures for review of issued patents. Any attempt to streamline procedures for reexamination should be undertaken as part of the same effort required to implement the provisions of the new legislation. All of the regulations governing reexamination should be harmonized with those governing the new procedures established by the new legislation.

Respectfully submitted,

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