From: R Alan Burnett [e-mail address redacted]
Sent: Wednesday, December 28, 2011 11:02 PM
To: aia_implementation
Subject: Inter Partes Reexamination Threshold (Response to Final Rules/Guidance)

Hello,

The proposed rule change regarding the threshold standard for granting an Inter Partes Reexamination is a good first step to help reign in the current abuse of Inter Partes Reexamination. However, the way the rules are written are somewhat vague, particularly considering a "reasonable likelihood that a requester will prevail with respect to at least one challenged claim in the request" is a vague standard by definition, since there is no way to codify the meaning of "reasonable likelihood of prevailing."

The most important participant in determining the reasonable likelihood that a requester will prevail is the examiner. However, there is lack of skill in many art areas with respect to examiners that are participating in many of today's Inters Partes reexaminations. A fundamental criteria (in my view) is that Inter Parties reexamination should employ examiners with the most skill available from among the examiner pool at the USPTO. However, in reviewing a number of Inter parties reexamination file histories and being involved in current Inter Partes reexaminations, it is my opinion that the examiners performing the reexaminations are not sufficiently skilled in the art to recognize when assertions made by a requesting party are clearly erroneous. At present, there is no Federal Rule 11 (as relates to frivolous litigation) equivalent applied to requesting parties. What I mean by this, is that a requesting party can make any assertion they want in a reexamination request support document without any repercussions if the assertions are blatantly false. If the examiner was skilled in the art (more particularly, of sufficient skill in the art during the relevant priority period), the examiner should immediately recognize assertions that are clearly erroneous. Although this will, of course, vary by examiner, it appears the current standard process taken by examiners is to merely parrot what is in a reexamination request support materials without questioning the validity of such assertions. Thus, a result of a 95% reexamination request grant rate is not surprising at all. I recognize this isn't universal, but some of the asserted positions are so preposterous that they should immediately be recognized as such by someone of even a minimal level of skill in the applicable art. This isn't happening, and thus creates such a low bar to grant an Inter Partes request that the use of Inter Partes reexamination is frequently abused, costing companies and individuals hundreds of thousands of dollars or more.

One significant problem with Inter Partes reexamination is a combination of the 50 page limit for a response and the lack of being able to present evidence in to an examiner in person. Of course, these provisions were hardly fought for by lobbyists for the infringers' lobby, and thus their inclusion was clearly not by mistake. However, these provisions do not coincide with the purpose of Inter Partes reexamination in the first place (as a viable cost and time-saving alternative to litigation that is also fair to both parties). Today's implementation of Inter Partes reexamination by the USPTO is an infringer's dream.

Although not related to the Inter Partes Reexamination Threshold issue itself, there are structural deficiencies in the USPTO rules and practices that prevent an appropriate level of reexamination from being performed. This is particularly true in the Software and Computer arts. One huge deficiency is that current USPTO rules do not provide any mechanism for disclosing source code to an examiner in a reasonable manner (creating PDFs of hundreds of modules is not a viable option for either the patent holder's or requester's submission, nor for an examiner's review). Rather, there needs to be a mechanism for disclosing source code in an IDS or the like. Several years back the USPTO recognized that microfiche was a ridiculous way to submit source code and allowed for submission of source code in electronic form ... by the applicant at the time an application was filed, and only for source code corresponding to embodiments of the invention. There is no provision to enable an applicant or challenger to submit source code relating to a third party application

for the purpose of supporting patentability or obviousness. Worse yet, in some cases actual applications are readily available for testing to verify how such applications actually work, as opposed to some press release or paper that contains a description that is not clear with respect to what the application actually accomplishes or overstates what an application can actually do.

Under an Ex-parte reexamination this is not as much of an issue, as it is possible to demonstrate operation of software applications to an examiner during an examiner interview. However, since there is no ex-parte communication available under the current Inter Partes rules, this option is not available. This provides a huge advantage to the requester, which is well know in patent litigation circles.

Finally, the new rules need to address serial reexamination abuses. Under current practice, it is very easy to tie up a patent holder for years and years through serial reexaminations. As stated previously, the bar for granting an Inter Partes reexamination request is much too low. Hopefully the new threshold standard for granting an Inter Partes reexamination request will curtail some of the current abuses.

Very truly yours,

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