

From: Robert Lelkes <Y!a Uj` UXXfYgg fYXUMX>
Sent: Monday, March 26, 2012 11:23 AM
To: supplemental_examination
Subject: Comments regarding the rules proposed for implementing supplemental examination

Dear Madam, dear Sir,

My name is Robert Lelkes. I am a registered US patent attorney and former US patent examiner with more than 25 years' experience in the patent field. My career spans two continents and includes experience in both private practice and as in-house patent counsel for a Fortune 50 company. I am also the author of the AIA Monitor (www.aiamonitor.com), a blog tracking implementation of the AIA.

The undersigned requests consideration of the following comments and suggestions.

37 CFR §1.605(d)

Proposed rule 605(d) states that a discussion of a "combination" of one item of information with another item of information will be counted toward the maximum number of items of information specified in proposed rule 1.605(a). Such a provision will inevitably create a disincentive for identifying potential rejections under 35 USC §103 based on combinations of references to avoid having to file multiple requests for supplemental examination.

This proposed rule is also unworkable due to the malleability with which the term "item" may be interpreted and the arbitrariness with which combinations may be counted when more than two items are combined. If four documents are cited under 35 USC §103, proposed rule 1.605(d) may result in a total of six combinations (1+2, 1+3, 1+4, 2+3, 2+4, and 3+4). If the number of combinations would be added to the total number of documents under proposed rule 1.605(b), addressing just one issue with four documents may result in a total of 10 items, leaving no room to discuss additional issues. Proposed rule 1.605 would also potentially preclude consideration of more than 4 documents under 35 USC §103 in a single request.

Since counting "combinations" is expected to take considerable staff time, lead to disputes with patentees regarding the amount of fees due, increase the cost of preparing the request for supplemental examination and create an incentive to minimize disclosure regarding combinations, paragraph (d) of proposed rule 1.605 appears to create more problems than it solves.

It is suggested that paragraph (d) of proposed rule 1.605 be deleted.

Proposed 37 CFR §1.610(b)

Subparagraphs (5) and (9) of proposed rule 1.610(b) require submission of information already in the possession of the USPTO. Requirements for submission of duplicative information is inherently noncompliant with the Paperwork Reduction Act.

It is suggested that subparagraphs (5) and (9) of proposed rule 1.610(b) be deleted.

Subparagraph (8) makes a detailed explanation of each potential ground for a substantial question of patentability mandatory for acceptance of the request for supplemental examination. In effect, this subparagraph requires the patentee to speculate as to the position the USPTO may take with respect to the information presented, which could

unfairly be used against the patentee as “admissions against interest”. Given the very substantial fee proposed for supplemental examination, determination of the ultimate conclusions to be drawn from the items presented in the request should be allocated to the ultimate decision-maker, namely the USPTO.

It is suggested that subparagraph (8) of proposed rule 1.610(b) be deleted or made optional by moving that subparagraph under paragraph (c) of proposed rule 1.610 as an optional means for discussing whether or not the submitted information raises a substantial new question of patentability.

Subparagraph (11) requires the patentee to submit a summary of the relevant portions of documents having more than 50 pages. It is questionable whether a summary provides any benefit to the USPTO when the patentee is required to explain why consideration of the document is requested. Such an explanation must invariably refer to the relevant portions of cited documents, including documents having more than 50 pages. The burden of providing a summary may discourage patentees from seeking supplementary examination due to the enhanced risk of error leading to a new danger of being accused of failing to comply with the duty of candor to the USPTO.

It is suggested that subparagraph (11) of proposed rule 1.610(b) be deleted.

Proposed 37 CFR §1.610(e)

Proposed rule 1.610(e) states that a filing date for the request for supplemental examination will not be granted if the specified formal requirements are not met. If this information is made available in the public file history, a third party may prevent supplemental examination by challenging the enforceability of the patent based on information submitted by the patentee. This is likely to be seen as an abuse of a system designed to cure patents of potential defects.

It is suggested that rule 1.610(e) be revised to include a provision that the request for supplemental examination will not be made available to the public or third parties until the USPTO has granted a filing date for the request.

Proposed 37 CFR §1.20(k)(1)

According to Table 4 at page 12 of the calculations in support of the fees for supplemental examination posted at http://www.uspto.gov/aia_implementation/cost_calc_supplemental_exam.pdf, the fee for supplemental examination proposed under 37 CFR §1.20(k)(1) was calculated by multiplying the unit cost per refused request for *ex parte* reexamination by a factor of 1.2. According to the USPTO’s own statistics for the year 2011 published at http://www.uspto.gov/patents/stats/reexamination_operational_statistic_quarter_ending_12_31_2011.pdf, only 88 out of 759 requests for *ex parte* reexamination (12%) were refused. In the previous year, only 7% were refused. The USPTO’s calculations fail to take into consideration the cost of granting a request for *ex parte* reexamination, which is a far more common event than refusal (i.e., denial).

Since there may be many requests that easily meet the substantial new question of patentability threshold, the cost of reviewing requests meeting that threshold may be far less than the cost of reviewing borderline requests that ultimately fail to meet this threshold, particularly since each denial needs to be justified in case the requester petitions for reconsideration. For this reason alone, the calculation of the cost of conducting supplemental examination appears to be flawed.

Without conceding the accuracy of the USPTO’s calculation of the unit cost per refused request for *ex parte* reexamination, the calculations apparently fail to take into consideration the 10 item maximum imposed on each request for supplemental examination under proposed rule 1.605(a), which does not apply to the *ex parte* reexaminations used to calculate the unit cost per refused request for *ex parte* reexamination. The calculations are therefore also inherently flawed for this reason.

Since the USPTO apparently proposes the 10 item maximum to control the cost per supplemental examination, taking the 10 item maximum into consideration is likely to have a substantial lowering effect on the unit cost per refused

request for *ex parte* reexamination, which in turn would result in a lower than estimated cost for conducting supplemental examination.

According to Table 5 at page 15 of the calculations in support of the fees for *ex parte* reexamination based on a request for supplemental examination in the document cited above, the calculations again fail to take into consideration the 10 item maximum imposed on each request for supplemental examination under proposed rule 1.605(a), which inherently carries through to *ex parte* reexaminations based on the request for supplemental examination. Since the 10 item limit is not taken into consideration in those calculations, those calculations are also inherently flawed and may, in fact, substantially overestimate the cost of such reexaminations.

Since the calculations provided by the USPTO are interdependent, the calculations are subject to propagation of errors. When errors in each calculation overestimate cost as in this case, the tendency to overestimate is greatly enhanced.

The new fee for supplemental examination and the fee increase for *ex parte* reexamination should not be approved by OMB until these errors are corrected.

Respectfully submitted,
/Robert Lelkes/
Registered US patent attorney (33,730)

Geigenbergerstr. 3
81477 Munich
Germany