

March 23, 2011

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**RE: AIPLA Resolution Concerning USPTO Solicitor Amicus Participation in Court
Reviews of USPTO Board Decisions in Interferences**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) would like to call your attention to a matter of interest to practitioners in the area of patent interferences and to all concerned with the institutional interests of the U.S. Patent and Trademark Office. Specifically, we wish to report an AIPLA resolution that urges a procedure to facilitate the participation of the USPTO as *amicus curiae* when a court reviews an interference decision by the Board of Patent Appeals and Interferences (BPAI) where such participation is warranted by the institutional interests of the Office.

AIPLA is a national bar association with approximately 16,000 members who are primarily intellectual property lawyers and other patent practitioners in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Its members represent both owners and users of intellectual property.

In particular, the resolution approved by the AIPLA Board of Directors favors amending ¶8.3 of the Board's Standing Order, entitled "Notice of judicial review," to require that each party to a court review of a BPAI interference decision serve on the USPTO Solicitor copies of all substantive papers filed in the court (subject to protective orders) on the same date that such papers are filed in court. The procedure would apply both to Federal Circuit and district court review of interference decisions. This resolution arises out of a concern that presently there does not exist a practical opportunity for the Office to be heard when an interference party raises an argument in court that could have a dramatic institutional impact on the agency.

The most recent example of this problem occurred in the case of *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366 (Fed. Cir. 2009), which refused to apply 37 C.F.C. §41.200(b) to decide which party's specification controls claim construction in an interference. That provision stated that "[a] claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears."

Instead, the *Agilent* court held as follows: “[W]hen a party challenges written description support for an interference count or the copied claim in an interference, the originating disclosure provides the meaning of the pertinent claim language.” *Agilent*, 567 F.3d at 1375. The ruling was reiterated in *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1335 (Fed. Cir. 2010), and is reflected in the subsequent removal of Section 41.200(b). *See* 75 Fed. Reg. 19558, April 15, 2010.

This example illustrates how an Office regulation that has been subject to public notice and comment and that has provided a legal basis for decision making for years can be put at risk in proceedings to which the Office is not a party. Section 41.200(b), which received a thorough explanation and justification in *Robertson v. Timmermans*, 90 USPQ2d 1898, 1902 (PTOBPAI 2008), provided a sensible analytical procedure (for both the government and the disputing parties) which has now been replaced by a confusing and uncertain approach to claim construction that turns on the theory of unpatentability being asserted.

The text of the resolution approved by the AIPLA Board is as follows:

RESOLVED, that the American Intellectual Property Law Association (hereinafter referred to as “AIPLA”) favors, in principle, the participation of the Solicitor’s Office as an *amicus curiae* in the court review of any decision by the Board of Patent Appeals and Interferences (hereinafter referred to as “the Board”) in an interference where the decision of the court is likely to affect the institutional interests of the Patent and Trademark Office (“the PTO”); and

Specifically, AIPLA favors the amendment of the Board’s Standing Order to provide that each party to court review under either 35 USC § 141 or 35 USC § 146 of a decision by the Board in a patent interference must serve on the Solicitor copies of all substantive papers, subject to any protective orders, that it files in the court on the same date that it files those papers, and AIPLA favors participation of the Solicitor’s Office as an *amicus curiae* in that court review whenever the decision of the court is likely to affect the institutional interests of the PTO.

The recommended procedure would allow some advance notice for the Office to be heard when there arise in private party litigation important questions of institutional interest to both the government and the bar. We hope you agree that the goal of increasing the opportunity for the government to participate in such situations would be a positive development.

Thank you for your kind consideration.

Sincerely



Q. Todd Dickinson
Executive Director