
No. 2008-1352

**United States Court of Appeals
for the Federal Circuit**

TRIANTAFYLLOS TAFAS,
Plaintiff-Appellee,

AND

SMITHKLINE BEECHAM CORPORATION (D/B/A
GLAXOSMITHKLINE), SMITHKLINE
BEECHAM PLC, AND GLAXO GROUP LIMITED (D/B/A
GLAXOSMITHKLINE),
Plaintiffs-Appellees,

v.

JON DUDAS, UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK
OFFICE, AND
UNITED STATES PATENT AND TRADEMARK OFFICE,
Defendants-Appellants.

Appeal from the United States District Court for the Eastern District of
Virginia in consolidated case nos. 1:07-CV-846 and 1:07-CV-1008,
Senior District Judge James C. Cacheris

**BRIEF OF *PRO SE AMICUS CURIAE* ROBERT LELKES IN
SUPPORT OF AFFIRMANCE OF THE DECISION BELOW IN
FAVOR OF PLAINTIFFS-APPELLEES**

October 2, 2008

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I. **INTRODUCTION**

The undersigned *pro se Amicus curiae*, Robert Lelkes, is a U.S. patent attorney (U.S. PTO Reg. No. 33, 730), a member of the District of Columbia bar, and a qualified European patent attorney with more than twenty years' experience in international private and corporate patent practice, as well as a former U.S. Patent and Trademark Office ("USPTO") patent examiner. I have no vested interest in the outcome of the above-captioned lawsuit other than as a long-time practitioner and U.S. citizen concerned about U.S. compliance with international law.

II. **IMPLEMENTATION OF 72 FED. REG. 46716-47843 IS
CONTRARY TO THE PATENT COOPERATION TREATY AND,
THEREFORE, CLEARLY NOT AUTHORIZED UNDER U.S. LAW**

On November 26, 1975, the United States of America ratified the Patent Cooperation Treaty ("PCT"), which provides the legal framework for filing international patent applications valid in all PCT member countries, including the U.S.

According to Art. 27(1) PCT:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

If implemented, rule 1.75(b) of 72 Fed. Reg. 46716-47843 would impose on the patent applicant preparation of a so-called Examination Support Document ("ESD") under rule 1.265 of 72 Fed. Reg. 46716-47843 selectively based on the presence of more than 5 independent claims or more than 25 claims

in, *inter alia*, one patent application. The ESD requirement is conditioned on presence of more than 5 independent claims or more than 25 claims in, *inter alia*, one patent application. The number of claims and their characterization as independent or dependent refer to the form and content of the application. The ESD would thus become an additional requirement relating to the form and content of the application.

The U.S. PTO argued in response to the *Amicus curiae* brief filed by the undersigned during the U.S. District Court proceedings that the application of new rule 1.265 via new rule 1.75(b) is sanctioned by Art. 27(6) PCT, which states that national law “may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.” When two provisions of law allegedly result in different outcomes based on the same set of facts, it is advisable to look to the legislative history of the relevant provisions to determine which interpretation should prevail.

Paragraph 9 of WIPO PCT Committee document PCT/CAL/7/2, Proposed Amendments of the PCT Regulations and Modifications of the PCT Administrative Instructions, Relating to the Draft Patent Law Treaty (Oct. 18, 1999), available at:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=3933¹,

and Paragraph 9 of WIPO Assembly document PCT/A/28/2, Proposed Amendments of the PCT Regulations and Modifications of the PCT, Administrative Instructions, Relating to the Draft Patent Law Treaty (Jan. 28, 2000), available at:

http://www.wipo.int/meetings/en/details.jsp?meeting_id=4001²,

¹ This document was cited in footnote 27 of the PTO's brief opposing the *Amicus curiae* brief filed by the undersigned during the U.S. District Court proceedings.

² This document was cited in footnote 27 of the PTO's brief opposing the *Amicus curiae* brief filed by the undersigned during the U.S. District Court proceedings.

state:

As to substantive matters, as distinct from matters of form and contents, Article 27(6) provides: "The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law".

The U.S. PTO has strenuously argued that the new rules are not substantive in nature, but rather relate solely to procedure before the U.S. PTO. If we accept the U.S. PTO's contention, then reliance on Article 27(6) PCT as justification for rule 1.75(b) of 72 Fed. Reg. 46716-47843 is not in accord with the legislative history of this statute and, therefore, inappropriate.

What remains is the question:

Is the ESD requirement different from or additional to the requirements relating to the form and content of the application provided for in the PCT and the PCT Regulations?

Since the PCT and PCT Regulations are public law, judicial notice may be taken that there is no ESD requirement in the PCT or PCT Regulations.

The sole provision relating to the number of claims in a patent application filed under the PCT is Rule 6.1(a) PCT, which states:

(a) The number of claims shall be reasonable in consideration of the nature of the invention claimed.

Reasonableness is determined under Rule 6 PCT on a case-by-case basis in view of the nature of the invention claimed. Since the number of claims in a particular patent application may vary depending on the nature of the invention, the term reasonable cannot be associated with a set number of claims applicable to all patent applications. Such an interpretation would eviscerate the very meaning of the word "reasonable" (to take a reasoned approach).

This is confirmed by Annex A5.42[2] to Part II, Chapter 5, Paragraph 5.42 of the PCT Search and Preliminary Examination Guidelines, which states that what is or is not a reasonable number of claims “depends on the facts and circumstances of each particular case”.

Moreover, one purpose of the PCT is to enable a patent applicant to obtain a centralized patentability search and, if desired, preliminary examination of patentability, for patent applicants residing in a member country of the PCT *prior to entry into the U.S. national phase and subsequent examination of the application under national law*. The patent applicant filing under the PCT pays substantial fees for such a search and preliminary examination, so that they have a vested interest in the international search and examination results upon entry into the U.S. national phase under the PCT have. According to the U.S. PTO’s own statistics, a substantial percentage of those applicants would nevertheless be required to submit an ESD based on an independent search and review of prior art even though they complied with all the provisions of the PCT, including Rule 6 PCT, and already received an officially sanctioned search and review of the prior art under the PCT. That vested interest is particularly compelling when the U.S. PTO was the search and preliminary examination authority.

In view of the foregoing, the new rule under consideration clearly does not fit within the statutory framework of the PCT.

The U.S. government not only ratified the PCT, it enacted substantial legislation implementing the PCT in the U.S. Hundreds of thousands of U.S. citizens and applicants from abroad have relied on framework of the PCT to file more than one million patent applications designating the U.S. As the world leader in utilizing the PCT, the U.S. is one of only a relatively small number of countries authorized to conduct international search and preliminary examination under Articles 16(3) and 32, PCT. It would be shameful if in view

of this history to let the U.S. PTO impose *ad hoc* rules contrary to U.S. obligations under the PCT.

III. **IMPLEMENTATION OF 72 FED. REG. 46716-47843 DOES NOT PROVIDE ANY BENEFIT TO THE PUBLIC**

Do the ends justify the means?

For patent applicants relying on the PCT system to seek patent rights in the U.S., imposition of an ESD after all formalities of the PCT have been complied with would be more than ironic in view of the fact that the same examiner for which the ESD is intended had already searched the prior art and formed an opinion regarding the relevance of the prior art to the claims without the benefit of the ESD. Under those circumstances, the ESD is unnecessary 'make work' for applicants with no foreseeable merit relating to the speed and efficacy of the U.S. PTO.

As long as the U.S. PTO is obligated to conduct its own search and examination of each patent application under 35 U.S.C. §131 and 37 CFR 1.104(3), the patent examiner cannot legitimately consider an ESD prepared by the patent applicant to be a substitute for his/her duty to independently search and examine the prior art. Rather than increase the speed and efficiency of the U.S. PTO, the time required to consider ESD submissions creates an additional burden on examiners which the U.S. PTO claims are already overburdened.

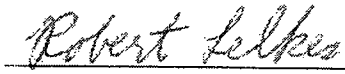
Ultimately, the imposition of an ESD requirement under new rule 1.75(b) does not provide any benefit to the public. On the contrary, that requirement would more than likely increase costs and further reduce the efficacy of the U.S. PTO.

IV. CONCLUDING REMARKS

The judicial branch is responsible for ensuring that the administrative branch of government does not exceed the powers granted to it under the U.S. Constitution and acts in accordance with its duty to serve the public.

I therefore urge this Court to affirm the decision of the U.S. district court to grant a permanent injunction against implementation of 72 Fed. Reg. 46716-47843.

Dated: October 2, 2008



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