

April 6, 2012

Via Electronic Mail
TPCBMP_Rules@uspto.gov

Attention: Lead Judge Michael Tierney
Covered Business Method Patent Review Proposed Rules

IBM Corporation comments in response to “*Changes to Implement Transitional Program for Covered Business Method Patents*,” 77 Fed. Reg. 7080 (February 10, 2012).

IBM thanks the United States Patent and Trademark Office (“Office”) for the opportunity to provide input and comments regarding the proposed rules for implementation of the transitional program for covered business method patents as described in *Changes to Implement Transitional Program for Covered Business Method Patents*.

Our comments below are directed to the specificity of the petition requirements in proposed rule §42.304 as compared with the more generalized petition requirements of post-grant review in 35 USC §312(a)(3), which governs the petition requirements of a covered business method patent review. More specifically, our comments focus on the requirement of a claim construction prior to discovery covered by proposed rule §42.304. Such claim construction is in IBM’s opinion appropriately not prescribed by 35 USC §312(a)(3) and IBM suggests that rule §42.304 explicitly permit alternative claim constructions in the petition, and revised claim constructions subsequently.

IBM respectfully submits that the rule governing the specificity of the petition in a covered business method patent review is unnecessarily restrictive. Section 18(a)(1) of the Leahy-Smith America Invents Act (“AIA”) states: “The transitional proceeding implemented pursuant to this subsection shall be regarded as, and shall employ the standards and procedures of, a post-grant review under chapter 32 of title 35, United States Code.” The petition requirements of a post-grant review are prescribed in 35 USC §312(a)(3) which states: “the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” The rule governing the petition requirements of a covered business method patent review, namely §42.304, goes substantially further and requires that the petition identify “How the challenged claim is to be construed. Where the claim to be construed contains a means-plus function...the construction of the claim must identify the specific portions of the

specification that describe the structure, material, or acts corresponding to each claimed function.”

The proposed rule may result in unnecessarily restricting the petitioner. Even while acknowledging the need to require clear and detailed information from a petitioner to permit expeditious resolution of the matter, the proposed rule may result in the petitioner being unnecessarily restricted in claim construction later in the proceeding. Replies, which are covered in proposed rule §42.23(b), “may only respond to arguments raised in the corresponding opposition;” this may leave open the possibility that a petitioner who realizes (for example in light of discovery, or of claim construction presented by the Patent Owner) that an alternative claim construction needs to be addressed might be precluded from presenting arguments based on such alternative claim construction either because that alternative was not presented in the petition, or because the arguments are deemed “not responsive to arguments” in the Patent Owner’s corresponding paper. For these reasons, IBM respectfully suggests that rule §42.304 explicitly permit alternative claim constructions in the petition, and revised claim constructions subsequently.

Conclusion

IBM thanks the Office for providing the public an opportunity to submit comments regarding the proposed rules regarding implementation of the transitional program for covered business method patents. We look forward to working with the Office on forthcoming regulations and guidance.

Respectfully Submitted,

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