

From: Rob Sterne O! aU` ` UXXfYgg' fYXUWYXQ  
Sent: Monday, November 07, 2011 12:13 AM  
To: aia\_implementation  
Cc: O! aU` ` UXXfYgg' fYXUWYXQ  
Subject: Inter partes review

RGS Comment # 9 (see disclaimer in RGS Comment #1)

Ms. Gongola:

I appreciate the opportunity to provide comments for the Group 2 Proposed Rule Makings. I have reviewed AIA Sec. 6 relating to the - - Post Grant Review and Inter Partes Review - - and would like to provide some comments. These comments are provided in order to raise potential issues for consideration by the USPTO while drafting the rules and regulations, and not to encourage any particular view or outcome. As such, these comments do not necessarily reflect my individual views or the views of my firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.

The Office should not limit the number of inter partes reviews regardless of the number of filings during the first four years after September 16, 2012. Third party petitioners must have the option of filing a bona fide inter partes review regardless of whether they have been sued on the patent for which the review is requested. The Office should not exercise the right to limit the total number of inter partes reviews because third party petitioners will be denied their right of review of an issued patent. If the Office were to limit the number of inter partes reviews then third party petitioners would be forced to litigate the issues covered by review in the federal courts and would not be able to plan effectively their strategy for defense. This inability to plan would wreak havoc on the decision making process and skew the U.S. patent system back to the federal courts. While Congress did allow the Office to impose limitations on the number of inter partes reviews to allow for scale up of the PTAB and associated systems, the Office owes the patent community the option of a third party review regardless of the number that are filed.

Thank you

Robert Greene Sterne