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Delivered via email: PTABNPRM2020@uspto.gov

Re: Comments for 37 FR 31728

Dear Director Iancu,

I write on behalf of the IP Clinic at Lincoln Law School ("IP Clinic") to provide comments in relation to the "PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence."[1] The views expressed herein are the views of the IP Clinic. In particular, they have not been approved by the Board of Directors or by the Dean of the Law School, and accordingly should not be construed as representing the position of the Law School.

The IP Clinic appreciates the Office's continued efforts to improve the AIA trial proceedings before the Patent Trial and Appeal Board ("Board") and appreciates the opportunity to comment on the Proposed Rules. The IP Clinic generally supports the Proposed Rules.

In particular, the IP Clinic does not feel strongly about the proposed changes to 37 CFR 42.23(a) (relating to incorporating sur-reply briefs); 37 CFR 42.23(b), 42.120, and 42.220 (relating to Addressing the Institution Decision in Responsive Briefs); and 37 CFR 42.24(c) (relating to Word Limits for Sur-Replies).

[1] 85 FR 31728 (May 27, 2020), available at https://www.federalregister.gov/documents/2020/05/27/2020-10131/ptab-rules-of-practice-for-instituting-on-all-challenged-patent-claims-and-all-grounds-and.

With respect to "Instituting on All Challenged Patent Claims and All Grounds," the IP Clinic agrees with the proposed changes to 37 CFR 42.108(a)-(b) and 42.2028(a)-(b). As required by the SAS Institute Inc. v. Iancu decision, the PTAB is already instituting on all challenges raised in petitions. Thus, these proposed changes systematize IPR and PGR rules in accordance with practice that has been in place since April 2018.

With respect to "Removing the Presumption Favoring Petitioners on Genuine Issues of Material Fact Based on Testimonial Evidence," the IP Clinic strongly agrees with the proposed changes to 37 CFR 42.108(c) and 42.208(c), which reverse the 2016 provision that allowed the patent owner's preliminary response to include testimonial evidence, but stipulated that "a genuine issue of material fact created by [the patent owner's] testimonial evidence will be viewed in the light most favorable to the petitioner."[2] Prior to this provision, it had been argued that because AIA trial petitions included testimonial evidence, the patent owner's inability to respond in kind caused an unfair advantage for the petitioner. The IP Clinic agrees with initial permission of such testimonial evidence. However, the presumption (as found in the 2016 provision) in favor of petitioners may not serve to level the playing field. For example, given the temporal and monetary costs associated with inter partes and post grant proceedings, all evidence should be presented upfront so that PTAB decisions (such as to institute) are made based on a thorough presentation of information. Based on the language of the 2016 provision, the existing presumption may discourage patent owners from providing relevant testimonial evidence. Thus, the proposed changes would help in fact to level the playing field more between the petitioner and the patent owner, as well as serve the interests of the PTAB in having accurate and thorough information presented upfront.

[2] *See, e.g.,* 37 CFR Part 42, [Docket No. PTO–P–2015–0053], RIN 0651–AD01, Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, released April 1, 2016, available at https://www.uspto.gov/sites/default/files/documents/81%20FR%2018750.pdf.

The IP Clinic thanks the USPTO for the opportunity to submit these comments. We would be pleased to further discuss these comments with the USPTO and others as appropriate.

Best regards,

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