

From: Brad Pedersen
Sent: Monday, November 07, 2011 5:25 PM
To: aia_implementation
Cc:
Subject: Inter partes review

MIPLA Suggestions for Group 2 Rulemakings:
Subgroup 6 – Inter Partes Review (IPR) Specific Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings – Subgroup 6 – Inter Partes Review (IPR) Specific Rules.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 6 – IPR Specific Rules, MIPLA has the following suggestions:

6.1 Fees for IPR

We suggest that the Office charge a combined fee (part of fee for review of petition and part of fee for running the proceeding), and then refund the portion of the fee for running the proceeding if an IPR is not initiated.

6.2 Fees Ranges for IPR

While we understand that the Office will need to set fees for an IPR that allow the Office to recover its costs in aggregate, our members would like to see the fees for an IPR be less than \$10,000.

6.3 Allow an IPR to start before 9 month window for non-FTFG cases

We suggest that the Office should promulgate rules that if there is no PGR pending as of the filing of an IPR, or if there is no opportunity to file a PGR proceeding with respect to the patent at issue, then 311(c)(2) does not apply.

Submitted on behalf of MIPLA.

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