

From: Brad Pedersen OY! aUj` ` UXXFYgg' fYXUWYXQ
Sent: Monday, November 07, 2011 5:24 PM
To: ai_a_implementation
Subject: Inter partes review

MIPLA Suggestions for Group 2 Rulemakings:
Subgroup 5 – Umbrella Rules Package for Trial Section Review Proceedings

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 5 – Umbrella Rules Package for Trial Section Review Proceedings.

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 5 – Umbrella Rules Package for Trial Section Review Proceedings, MIPLA has the following suggestions:

5.1 Motion Based Rules Model

While there was a significant number of our members who suggested using an ITC/litigation open discovery based model for the Umbrella Rules package for Trial Section Review Proceedings, MIPLA urges the Office to propose an umbrella rules package based on some combination of the current rules for contested matters and trademark oppositions that utilize a motion practice based model.

5.2 Require Electronic Filing

We suggest that the Office require the use of electronic filing and electronic service for any review proceedings.

5.3 Use a Standing Order

We suggest that the Office use a Standing Order, similar to the current interference practice, for establishing detailed scheduling and procedural matters that are not specifically handled by the umbrella rules package.

5.4 Use an APJ to Determine Whether to Initiate a Review

While there was a significant number of our members who suggested using the Central Reexamination Unit (CRU) to make a determination for the director on whether to initiate a IPR/PGR/BMR proceeding, MIPLA urges the Office to delegate the authority of the Director determine whether to initiate a review proceeding to an Administrative Patent Judge (APJ) designated to run the review, and to possibly initially consider the use of the CRU to prepare an initial recommendation for review and final approval by the APJ.

5.5 Allow for a Supervisory Petition Review for Denial of a Review

Although a denial of a review petition is not appealable, MIPLA urges the Office to allow for supervisory review of that determination by petition to the Director, similar to the current practice of using a 1.181(a)(3) petition for supervisory review before a final agency action is established for the denial of a

review petition.

5.6. Scope of Review

We suggest that the Office promulgate rules that place the entire patent under the review jurisdiction once a review is initiated, regardless of which claims or references are found to meet the requirements for initiating a review. While current practice in reexamination permits partial reexaminations, it is believed that placing the entire patent under the jurisdiction of the PTAB for purposes of the review will simplify the proceedings and eliminate the current complexities of petition versus appeal, as well as issues of with respect to the impact of estoppel.

5.7 New Proposed Grounds of Rejection

We suggest that the Office allow a petitioner to propose new grounds of rejection in response to an amendment of the claims by the patent owner, although there was not a consensus as to whether this should be an unrestricted right or a right pursuant to motion.

5.8 Claim Construction in Reviews

We suggest that the Office establish rules that provide for the option of a separate claim construction process as part of the umbrella rules package, with a preference for claim construction to be a standard part of the procedures, or alternatively for claim construction to be authorized by motion practice.

5.9 Live Testimony at Final Hearing

We suggest that the Office establish rules that provide for the option for live testimony at the final hearing at least by motion practice as part of the umbrella rules package.

5.10 Rebuttal Evidence Prior to Final Hearing

We suggest that the Office establish rules that provide for the option for rebuttal evidence being presented up to the final hearing at least by motion practice as part of the umbrella rules package.

5.11 Page/Word Count Limits

We suggest that the Office establish rules that provide for reasonable page/word count limits on briefings and motion that can be adjusted as necessary, although there was no consensus on whether such adjustments should be made by motion or by payment of extra fees.

5.12 Settlement Window

We suggest that the Office interpret the settlement window for a Trial Section review proceeding as being consistent with the estoppel provision so as to provide the longest opportunity for the parties in considering settlement up to the final written decision by the PTAB.

Submitted on behalf of MIPLA.

Brad Pedersen
Patent Practice Chair

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P. A.
4800 IDS Center, 80 South 8th Street
Minneapolis, MN 55402-2100