From: Brad Pedersen
Sent: Monday, November 07, 2011 5:34 PM
To: aia_implementation
Subject: Inter partes review

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

The law firm of Patterson Thuente Christensen Pedersen ("Patterson Thuente") appreciates 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.

Patterson Thuente is a firm with significant experience in the areas of ex parte reexamination, inter partes reexamination and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuente represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of Patterson Thuente and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuente understands that the USPTO will not directly respond to these suggestions, and Patterson Thuente 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, Patterson Thuente 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, we would like to see the fees for an IPR be less than fees for a PGR, and preferably less than $20,000 for a large entity.

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.

We would also reference our comments on the umbrella rules package – subgroup 5 – that were submitted under separate email.

Brad Pedersen
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