

From: Thomas A. Ward [e-mail address redacted]
Sent: Tuesday, December 27, 2011 2:22 PM
To: ai_a_implementation
Subject: Inter Partes Reexamination - Submitted Art

Dear Sir/Madam:

To help meet the 12 month deadline for completion of Inter Partes Reexamination (IPR), I recommend that only art from the IPR request be considered by the PTAB. Many of the IPR proceedings will occur during litigation. A significant number of new art references obtained during discovery will, therefore, likely be submitted during the IPR by the respondent to meet duties under Rule 56. The PTAB may then need to send the case to an examiner to consider the newly submitted art. The examination process conducted by the examiner will likely push the IPR well beyond the 12 month deadline.

Provisions can be implemented to enable the parties to consider the new art themselves. Rule provisions can be put into place to enable the requester to amend the IPR request to have new art considered. Alternatively if continually amended IPR requests could result in significant delays, provisions can allow the IPR requester to file a new IPR request to have the art considered. In any case, provisions should be available to enable the parties involved to complete the IPR procedure before the PTAB without the need to return the case to an examiner for further examination.

Regards,
Thomas Ward
Fiesler Meyer LLP
650 California Street, 14th Floor
San Francisco, CA 94108