

From: Lissi Mojica[e-mail address redacted]
Sent: Wednesday, October 26, 2011 04:04 PM
To: Stoll, Robert
Subject:

Commissioner Stoll,

As discussed at AIPLA, please find attached a proposal that identifies a possible workflow for the initiation of inter Partes Review and Post Grant Review.

Please let me know if you have any questions regarding the memo and feel free to contact me any time. Further, if there are any other issues that I may help with I would be happy to do so. As you know I have a unique perspective having been both in the USPTO and now outside for three years.

With my regards,

Lissi Mojica

PROPOSED WORKFLOW PATH FOR INTER PARTES REVIEW AND POST-GRANT REVIEW

INTRODUCTION

The America Invents Act was signed into law on September 16, 2011. Sections 311-319 of Title 35 of the United States Code were amended to create a new “Inter Partes Review” practice to replace the existing Inter Partes Reexamination practice in the USPTO. Sections 321-329 were newly drafted, and establish a new Post-grant review practice. USPTO will have to establish new workflow paths to accommodate each of the two new practices. As discussed below, the language of the amended and new statutory provisions appears to lend itself to practices that are in large part analogous to the way in which the currently existing (and ultimately abolished) interference practice has been conducted within USPTO. It is recommended that the new practices follow the blueprint of workflow in interference practice, and split the work of determining whether an order to conduct an Inter Partes Review or a Post-grant review of an eligible patent is warranted from the work of actually conducting the review proceeding.

PROPOSED INTER PARTES REVIEW WORKFLOW PATH

I. The Statutory Language – Threshold Provisions

The new inter partes review and post-grant review provisions in the America Invents Act are reproduced in tabular form to illustrate that they have virtually identical “threshold provisions” that instruct the USPTO Director to determine whether a review under either provision should be instituted. Consideration of Sections 311 and 321 shows that they are essentially identical as to wording, with each section providing that the Office, (i.e., the USPTO), has the authority to institute a review of an issued patent upon petition requesting a review filed by a person who is not the owner of the patent. Similarly, Sections 314 and 324 each direct the USPTO Director to determine whether to institute a requested review proceeding by reviewing a petition filed by a person who is not the patent owner and to notify the petitioner, patent owner and the public of the decision whether or not to conduct a review. Side-by-side comparison of the language of these sections is facilitated by Table 1, below:

TABLE 1

PROPOSED WORKFLOW PATH FOR INTER PARTES REVIEW AND POST-GRANT REVIEW

INTER PARTES REVIEW	POST-GRANT REVIEW
<p>§ 311. Inter partes review</p> <p>(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.</p>	<p>§ 321. Post-grant review</p> <p>“(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent.</p>
<p>§ 314. Institution of inter partes review</p> <p>(a) THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.</p> <p>(b) TIMING.—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—</p> <p>(1) receiving a preliminary response to the petition under section 313; or</p> <p>(2) if no such preliminary response is filed, the last date on which such response may be filed.</p> <p>(c) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.</p>	<p>§ 324. Institution of post-grant review</p> <p>(a) THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.</p> <p>(b) ADDITIONAL GROUNDS.—The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.</p> <p>(c) TIMING.—The Director shall determine whether to institute a post-grant review under this chapter pursuant to a petition filed under section 321 within 3 months after—</p> <p>(1) receiving a preliminary response to the petition under section 323; or</p> <p>(2) if no such preliminary response is filed, the last date on which such response may be filed.</p> <p>(d) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a) or (b), and shall make such notice available to the public as soon as is practicable</p>

II. The Statutory Language - Conduct of the Reviews

PROPOSED WORKFLOW PATH FOR INTER PARTES REVIEW AND POST-GRANT REVIEW

The manner of conducting the Inter Partes Review is established by 35 U.S.C § 316. Conduct of the post-grant review is established by 35 U.S.C § 326. The provisions of these two sections each direct the USPTO Director to determine whether to institute a properly requested review, to notify the petitioner and patent owner of that determination in writing, and to also make notice to the public to of that determination “as soon as practicable.”

TABLE 2

§ 316. Conduct of inter partes review	§ 326. Conduct of post-grant review
...	...
(a)(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);	(a)(11) requiring that the final determination in any post-grant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c),
...	...
(c) PATENT TRIAL AND APPEAL BOARD.— The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.¹	(c) PATENT TRIAL AND APPEAL BOARD.— The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each post-grant review instituted under this chapter.¹

III. How Inter Partes and Post-Grant Reviews Should be Conducted by USPTO

A common assumption made in many analyses of the above mentioned statutory provisions is the newly re-named Patent Trial and Appeal Board will have sole responsibility for conducting the inter partes review and post-grant review proceedings, including the initial determination whether a request for a review proceeding filed by a person who is not the patent owner provides a basis for ordering the review. However, a consideration of the language in

¹ “Section 6” refers to 35 U.S.C. § 6, wherein subsections (b)(3) and (b)(4) provide that The Patent Trial and Appeal Board shall— ... (3) conduct derivation proceedings pursuant to section 135; and “(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

PROPOSED WORKFLOW PATH FOR INTER PARTES REVIEW AND POST-GRANT REVIEW

Tables 1 and 2 clearly shows that while the Patent Trial and Appeal Board (PTAB) is required to conduct each inter partes review and each post-grant review that is instituted, there is no requirement that the PTAB also determine whether the request for either kind of review satisfies the threshold jurisdictional requirement.

Instead of having one (or more) Administrative Patent Judges decide the threshold jurisdictional question of whether a request for inter partes review or a request for post-grant review demonstrates that the requested review must be “authorized,” it is suggested that the USPTO Director delegate the responsibility for authorizing a requested review to the Central Reexamination Unit (CRU).² Precedent for a proceeding in which there is a threshold determination made by a Primary Patent Examiner that there is a basis upon which to conduct a proceeding followed by a proceeding that is conducted by one or more APJ’s is the currently existing interference practice. In that practice, the Primary Patent Examiner is either informed by an applicant for patent, or discovers on his/her own review, that a given patent application contains claims that are directed to the same patentable invention claimed in another existing patent application, or an issued patent that is not a Section 102(b) bar to that patent application. The Primary Examiner is required to analyze the involved claims and to prepare a Predecisional Memorandum Suggested Interference Referral presenting the Primary Examiner’s analysis to an Administrative Patent Judge from the “Trial Section” of the current Board of Patent Appeals and Interferences. That analysis will explain why one or more claims of a pending patent application that have been determined to be patentable interfere with the claims of another pending application or an issued U.S. patent.³

It is submitted that the newly enacted statutory provisions for inter partes review and post-grant review lend themselves to a similar division of work between the CRU Primary Examiners and/or Supervisors and the APJ’s from the PTAB. The CRU Primary Examiners can

² It is noted that for post-grant review, a basis for authorization of conduct of a post-grant review by the PTAB is that the petition for post-grant review has raised a novel or unsettled legal question that is important to other patents or patent applications. It is submitted that (1) requests on that basis should be relatively rare, and (2), it is possible for the Director to establish by regulation that CRU must consult an Administrative Patent Judge (APJ) from the PTAB in the event that a request is based on existence of a novel or unsettled legal question that is important to other patents.

³ In general, see MPEP §2302.

PROPOSED WORKFLOW PATH FOR INTER PARTES REVIEW AND POST-GRANT REVIEW

be tasked with reviewing petitions for inter partes reviews and post-grant reviews, and to generate appropriate notice to the involved parties and the public regarding whether the petition for review is granted or denied. When the petition is granted, the matter can then be forwarded to the PTAB where the review will be conducted. As noted in footnote 2, the USPTO Director could decide to have a decision whether or not to conduct a post-grant review based in whole or in part on the existence of a novel or unsettled legal question raised by the petition for review made at the PTAB rather than at the CRU.

By dividing the work between the CRU and the PTAB, the USPTO Director will be able to use the resources of each operating unit to insure timely decisions to grant review petitions and to timely conclusions to the reviews. The PTAB, which will continue to be tasked with conducting appeals from patentability determinations in pending patent applications and appeals in reexamination proceedings, will be save the initial time and work involved with granting or denying a petition for review within a three month period. The CRU Primary Examiners and Supervisor will be able to devote adequate time to review the initial petitions for review, conclude currently pending inter partes reexamination proceedings, and to conduct ex parte reexamination proceedings without the additional workload of also conducting the merits of a granted petition for an inter partes review or a post-grant review. As it is clear that this division of the workload with respect to the new review procedures is clearly permitted by the plain language of the above reproduced sections of the AIA, it is respectfully submitted that the USPTO should draft the regulations governing inter partes review and post-grant review to provide that (1) the grant or denial of a petition for such reviews be decided at the CRU, with a possible petition from an adverse decision being available, and (2) the merits of the issues raised in the reviews be decided by a PTAB APJ.