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April 9, 2012

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Re: Proposed Changes to Implement Post-Grant Review Proceedings, in  
Response to Request for Comments at 77 Fed. Reg. 7060 (February 10, 2012)

Hon. Lead Administrative Judge Tierney:

The Boston Patent Law Association (BPLA) thanks the US Patent and Trademark Office (USPTO) for the opportunity to comment on the proposed rules to implement the post-grant review provisions of the America Invents Act (AIA). The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws in the Boston area. These comments were prepared with the assistance of the Patent Office Practice Committee of the BPLA. These comments are submitted solely by the BPLA as its consensus view. They are not the views of any individual member, any firm, or any client.

We appreciate the USPTO's efforts to further patent reform by implementing the AIA, and offer the comments presented below in attempt to assist the USPTO in these efforts. Our comments are organized by section of the proposed rules, as set forth in the Federal Register Notice on Changes to Implement Post-Grant Review Proceedings, 77 Fed. Reg. 7060 (February 10, 2012) (Federal Register Notice).

## **I. Proposed Rule 42.200(b)**

We suggest that the USPTO consider applying claim construction principles as applied by the courts in interpreting claims for purposes of post-grant review, rather than applying the "broadest reasonable construction" standard traditionally used in patent examination. The Federal Register Notice states that, "[a]s explained in *Yamamoto*, a party's ability to amend claims to avoid prior art distinguishes Office proceedings from district court proceedings and justifies the difficult standard for claim interpretation." 77 Fed. Reg. 7064. However, the claim construction standard originating in *In re Yamamoto* may not be applicable to post-grant review, which was not available at the time of the *Yamamoto* decision. Moreover, in view of the very limited opportunity for amendment in post-grant review proceedings,



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the rationale underlying *Yamamoto* does not clearly extend to post-grant review. Further distinctions between post-grant review and traditional examination before the USPTO suggest that the “broadest reasonable interpretation” standard may not be appropriate. For example, post-grant review proceedings are trials, not prosecution before an examiner, which affords the opportunity for examiner interviews to discuss claim language, followed by multiple opportunities to amend *after* gaining an understanding of the examiner’s position. The very limited opportunity for amendment in post-grant review occurs *before* there is any ability to understand the decision maker’s views with respect to the claims, other than the fact that the proceeding has been instituted.

## II. Proposed Rule 42.202(b)

The proposed rule provides that the Director may limit the number of post-grant reviews instituted during each of the first four one-year periods. However, the Federal Register Notice indicates that the USPTO does not expect to limit the number of post-grant review petitions. 77 Fed. Reg. 7064. We support this expectation and are in favor of not limiting the number of post-grant review petitions over a given calendar year. Providing such an arbitrary limit could result in some patents that the statute subjects to a post-grant review period being effectively unchallengeable, based on the timing of their issuance compared to the imposition of a quota on post-grant review proceedings.

## III. Proposed Rule 42.206

We suggest that the rules provide for a petition to be granted a filing date as soon as the minimum statutory requirements under 35 USC § 322 have been met. Delaying the granting of a filing date until additional USPTO requirements, *e.g.*, under proposed Rule 42.204, have been satisfied could result in a timely filed post-grant review petition being barred by statute. For example, the right to post-grant review could be lost where a minor procedural defect (*e.g.*, failure to identify an exhibit number under proposed Rule 42.204(b)(5)) was not identified by the USPTO until after the statutory deadline had passed, leaving no opportunity for correction. We urge the USPTO to grant a filing date as soon as a post-grant petition meets the minimum statutory requirements, and then require correction of other defects before considering the petition on its merits.

## IV. Proposed Rule 42.220

Proposed Rule 42.220(b) provides a two-month period for the patent owner to respond after institution of the post-grant review. We believe that two months often will not be sufficient time for the patent owner to prepare a complete response, for example, when the patent owner must prepare expert declarations and/or generate experimental data to rebut arguments put forward by the petitioner. The Federal Register Notice indicates that the patent owner would actually have more than two months to prepare a response, considering the additional time allotted for a preliminary patent owner response prior to institution of post-grant review. 77 Fed. Reg. 7066. However, the patent owner should not be expected to incur the costs of preparing a complete response, including generating data and preparing expert declarations, before even knowing whether the post-grant review will be instituted. Therefore, we believe that the rules should provide the patentee the ability to seek an extension of time for response for good cause. This provision for the patentee to have sufficient time to properly defend the patent should be able to be



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accommodated by the statutory time limit to complete the review, which may be extended up to six months for good cause. 35 USC § 326(a)(11).

## V. Proposed Rule 42.221

Proposed Rule 42.221 states that “[a] patent owner may file one motion to amend a patent but only after conferring with the Board. Any additional motions to amend may not be filed without Board authorization.” However, the statute appears to give the patentee the right to one motion to amend, with entry of subsequent amendments within the PTAB’s discretion. In view of 35 USC § 326 (d)(1), providing that “[d]uring a post-grant review ... the patent owner may file 1 motion to amend the patent...,” it is suggested that the rules provide that the patentee’s first motion to amend be by right, with subsequent motions to amend at the discretion of the PTAB. It would also be helpful for the rule to describe the standard the PTAB will apply in determining whether to exercise its discretion to allow additional motions to amend. 35 USC § 326 (d)(2) contemplates that additional motions to amend may be permitted to materially advance settlement or for good cause shown by the patent owner. If the PTAB expects to place additional limits on such permissive amendments, it would be helpful for the rules to identify those limits.

## VI. Proposed Rule 42.224

It is suggested that the standard for additional discovery in post-grant review be the same as in *inter partes* review. Under the proposed rule 42.224, “[r]equests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed.” This standard for additional discovery is contrasted with the standard for additional discovery in *inter partes* review under proposed rule 42.51: “[e]xcept in post-grant reviews, the moving party must show that such additional discovery is in the interests of justice.” The Federal Register Notice indicates that the “interests of justice” standard is higher than the “good cause” standard. 77 Fed. Reg. 7066.

Of particular concern for small entity patentees, additional discovery increases costs and brings the post-grant review proceeding one step closer to the expansive discovery model of district court litigation. The ability to obtain a decision on issues of validity without incurring the full scope and cost of litigation is an advantage of post-grant review that should be fostered. Furthermore, the interests of small (and large) entity patentees in obtaining and preserving patent coverage at reasonable cost should be protected. Therefore, we suggest that the standard for additional discovery in post-grant review should be the “interests of justice” standard.



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## VII. Conclusion

The BPLA appreciates the opportunity to comment on the USPTO's proposed Changes to Implement Post-Grant Review Proceedings. Thank you for your consideration of our comments.

Sincerely,

Boston Patent Law Association

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