

Cain, Brigit

From: Bernie Shay <bshay@miramarlabs.com>
Sent: Tuesday, April 10, 2012 7:51 PM
To: Post_Grant_Review
Subject: Proposed new rules to implement the provisions of the Leahy-Smith America Invents Act

April 10th, 2012

Judge Michael Tierney
Administrative Patent Judge
United States Patent and Trademark Office
e-mail: post_grant_review@uspto.gov

Re: Proposed new rules to implement the provisions of the Leahy-Smith America Invents Act, including:

- Changes to Implement Post-Grant Review Proceedings
- Changes To Implement Derivation Proceedings
- Changes to Implement Inter Partes Review Proceedings
- Changes to Implement Transitional Program for Covered Business Method Patents
- Transitional Program for Covered Business Method Patents: Definition of Technological Invention
- Practice Guide for Proposed Trial Rules: Leahy-Smith America Invents Act
- Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions

Dear Judge Tierney,

We, the undersigned, represent a cross section of small commercial and pre-commercial companies developing world class medical devices here in the United States. We are writing to you today to express our appreciation for the well-considered and balanced approach that the Patent Office has taken in drafting these proposed rules.

We would, however, like to take this opportunity to express our concern about the use of the good cause standard in Section 42.224 of the Changes to Implement Post-Grant Review Proceedings for granting additional discovery rather than the interests-of-justice standard that is going to be used for the inter-parties reviews and derivation proceedings. We believe that the higher interests-of-justice standard should be used for the Post-Grant Review Proceeding to avoid potential abusive use of additional discovery by a larger party challenging a smaller party patent owner. Discovery can be a substantial burden on any company and even more so for pre-commercial and early commercial companies such as ours and should only be permitted where it is in the interests of justice to do so.

Please do not hesitate to contact Eb Bright Executive Vice President and General Counsel for ExploraMed (ebright@exploramed.com) for additional background and/or clarification.

Eb Bright
Executive Vice President and General Counsel
ExploraMed Companies

Jeff Granger
Managing Partner
The Foundry, LLC

Jessica Hudak
Senior Manager of Intellectual Property
Baxano, Inc.

Brian Schar
Director of Intellectual Property
Cardica, Inc.

Bernard Shay
General Counsel
Miramar Labs, Inc.