

Robert Lelkes
U.S. Patent Attorney
Reg. No. 33,730
Geigenbergerstr. 3
81477 Munich, Germany

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Hon. Michael Tierney
United States Patent & Trademark Office
Alexandria, Virginia

Your Honor:

The purpose of this letter is to comment on the proposed rules for inter partes review, post grant review and covered business method patent review before the new Patent Trial and Appeal Board. I am commenting in my capacity as a registered private practitioner before the U.S. PTO who has been in practice more than twenty years, as a former U.S. patent examiner in the 1980s (Group 1200), and as a U.S. citizen. I am the author of the AIA Monitor blog (www.aiamonitor.com) and I was an invited speaker at the U.S. Patent Reform 2012 conference in Munich, Germany, last week.

Like many of my colleagues, I would like to commend you and your colleagues for the thorough work you and your colleagues have done preparing implementing regulations for these new procedures. It is an impressive work product.

Also, like some of my colleagues, I would like to submit a proposed modification to the proposed rules to address an issue that may cause unintended consequences.

According to proposed 37 CFR §§42.107(b) and 42.207(b), the patent owner has “no more than” two months within which it may respond to a petition for IPR and PGR. The expression “no more than” suggests that the PTAB will not grant extensions of time for just cause under 37 CFR §42.5(c)(2) of the proposed rules for practice before the PTAB despite the fact that the two month term is not prescribed by the AIA.

While an overly long delay in obtaining review of a petition for *inter partes* review, post grant review or covered business method patent review may be seen as potentially prejudicial to the interest of the patent challenger in a speedy determination, circumstances are likely to develop in which the two month term for the patent owner’s preliminary response will be considered unjust. A patent owner who’s inventors have died or are no longer employed by the company, a patent owner that requires a translation of the petition into a foreign language, and a patent owner inventor who is a lay person not

currently represented by patent counsel may justifiably need additional time to assess the situation and take appropriate action.

It is suggested that the above-cited rule be modify to state that a written notification shall be sent to the patent owner advising the patent owner that the petition has been granted a filing due date and setting a three-month term for submitting a preliminary response, which term may be extended for just cause by filing a motion under 37 CFR §42.5(c)(2) of the proposed rules for practice before the PTAB with an explanation of the reason for the extension of time. The three-month term is suggested to reduce the frequency with which the PTAB would need to consider a motion for an extension of time.

It is respectfully requested that the above suggestion be given due consideration.

Sincerely,

/Robert S. Lelkes/
Robert S. Lelkes
Reg. No. 33,730