



PATENT PROTECTION FOR HIGH TECHNOLOGY

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

FROM: Schwegman, Lundberg and Woessner, P.A.

DATE: April 10, 2012

RE: Comments to Various Proposed Rules to Implement the America Invents Act

Via Electronic Mail
TPCBMP_Rules@uspto.gov

Dear Under Secretary Kappos:

Below are our comments on the changes to implement the transitional program for covered business method patents in Fed. Reg. 77(28): 7090–95 (February 10, 2012).

§ 42.304 Content of petition.

Topic	Proposed Rule for Post-Grant Review	Comparison with Analogous Requirement in <i>Inter Partes</i> Reexamination	Analysis and Recommendation
Claim construction	<p>The General Practice Rules and Comments should expand upon the intended practice with respect to claim construction. It is understood that a Petitioner will be required to propose an initial claim construction for any claim terms/limitations which the Petitioner asserts are in need of construction. The Owner would then have an opportunity either prior to granting of the Petition, or after a Petition has been granted, to respond to the proposed claim constructions and/or suggest claim constructions of other terms/limitations. The parties and the APJ would then handle initial resolution of any claim construction issues, including the possibility of additional claim constructions necessary for substituted claims by motion practice, with final determination of claim construction taking place as part of the final written opinion.</p>	<p>Parties can argue claim construction throughout the proceeding.</p>	<p>Patent owner should address claim construction if patent owner responds to the petition by the third party requester. Thereby providing the APJ with the patent owner's claim construction prior to the APJ making a decision on the petition. If the APJ's opinion differs from either the patent owner or the third party requester (petitioner) then both parties should have an opportunity to respond after the APJ's decision on the petition. This would be a part of the response to the APJ's first opinion.</p> <p>Thus, the parties should have a separate page limit on their response to the claim construction. That would be consistent with trial procedures as the court treat claim construction briefs separately with no page limits.</p> <p>Further, claim charts should not have page limits, which would be consistent with court practice.</p>
Page limits	<p>The Office considers procedures in federal court to be a useful analogue to PGR petitions when deciding reasonable page limits. The Office should consider that issues are often broken across multiple briefs and negotiations. For example, parties to a litigation negotiate for months on claim construction, invalidity, etc. Moreover, federal courts often do not</p>	<p>No page limits</p>	<p>The Office should abolish, or increase its page limit requirements.</p>

	<p>impose page limits on claim charts. In contrast, a PGR petition must be filed once, and currently has a 50-page limit to discuss all issues related to patentability that often take 100's of pages and months of negotiation to resolve. Furthermore, CRU examiners routinely consider 100's of pages of argument when deciding whether to grant a reexamination in about two months¹, which is less than the three-month requirement for determining whether to institute a PGR.</p>		
	<p>There is no claim construction prior to submitting arguments so each party will need to present its patentability arguments without knowing how the Board will construe claim elements.</p>		<p>As mentioned above, claim construction should be optional for petitioner with a separate page limit. The patent owner should have to make a statement regarding claim construction if the petitioner provides a claim construction.</p>

Very truly yours,

Schwegman, Lundberg and Woessner, P.A.

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 Stephen C. Durant
 Kevin Greenleaf

Tim Bianchi
 Tom Reynolds

Michael Lynch
 Gary Speier

Bradley Forrest
 Robin Chadwick

¹ http://www.uspto.gov/patents/stats/reexamination_operational_statistic_quarter_ending_12_31_2011.pdf