



Krish Gupta
Senior Vice President, IP & Litigation
Dell Inc.
176 South St.
Hopkinton, MA 01748
krish.gupta@dell.com

December 21, 2018

Mail Stop Patent Board
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Acting Deputy Chief Administrative Patent Judge Jacqueline Wright Bonilla
Vice Chief Administrative Patent Judge Michael Tierney

RE: PTAB Request for Comments 2018, Docket No. Docket No. PTO-P-2018-0062

Dear Judges Bonilla and Tierney:

On behalf of Dell Inc. ("Dell"), thank you for the opportunity to submit comments on the Office's proposed pilot program for claim amendments. Dell is a member of the High Tech Inventors' Alliance (HTIA), who has previously submitted comments. We also write separately to emphasize particular points of concern.

Our greatest concern is that under the proposed pilot program, claims will issue with no prior art search, no examination, and no assurance from the Office that the claims are indeed patentable. Never in the modern history of U.S. patent law, outside the AIA amendment process, have utility patent claims issued without independent examination by the patent office. This process will result in the issuance of low-quality claims and will impede, rather than promote, innovation. And the situation will be even worse if unexamined claims are afforded a presumption of validity in litigation.

We understand and appreciate the feedback the Office received relating to the amendment grant rate in AIA trials. But the solution to these issues is not to create a system in which a patentee may amend a claim with no independent examination. Examination is the cornerstone of patent quality and "[p]roviding high-quality, efficient examination of patent applications is paramount to [the] mission at USPTO."¹ Patent examiners are independent experts in their field who provide a necessary independent review of patent claim validity. In short, it is patent examination that ensures patent quality.

It is no answer that a claim amended in an AIA trial must be narrower than the original claim. When new claim elements are added to a claim, a new search is often required. For example, consider an original claim directed generally to a chair. A petitioner may challenge the claim using prior art disclosing a three-legged stool. The patent owner may consequently amend the claims to require four legs. The amended claim is narrower than the original claim (because the amended claim requires four legs), but plainly a new search would be appropriate to determine whether there are other references that disclose furniture with four legs. A new prior art search could uncover a disclosure of a four-legged table, which could then form the basis of an obviousness challenge to the amended claim.

Nor is it appropriate to rely on the petitioner to perform this new prior art search, since the petitioner may have no incentive to locate prior art relevant to an amended claim. Suppose the petitioner is accused of infringement based on its sale of three-legged stools. The petitioner will not search for prior art disclosing four-legged furniture, since it is not concerned about an amended claim with this additional limitation.

¹ U.S. Patent & Trademark Off'c., "Patent Quality," at <https://www.uspto.gov/patent/patent-quality> (last accessed December 6, 2018).

We recognize that, under the pilot program, the Board has the discretion to involve an examiner where no opposition to a motion to amend is filed. But this is insufficient protection for two reasons. First, the pilot program does not require the Board to involve an examiner. Second, examination is critical whether or not a petitioner has opposed a motion to amend. As noted above, a petitioner's prior art search is likely to focus only on the features of interest to the petitioner. Independent examination is essential to ensure that all the new limitations form the subject of a prior art search. Ultimately, patent claim examination is a core function of the Office, and it should fulfill this responsibility regardless of the type of proceeding in which the amended claim is introduced.

It is true that under current practice, no examination is performed on amended claims. But before *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), the Office properly placed the burden on the patent owner to show patentability of the amended claims. Although a flawed solution, this burden-shifting at least tried to address the problem of unexamined claims by requiring the patent owner to prove patentability. *Aqua Products's* invalidation of this burden-shifting approach presents an opportunity for the USPTO to consider alternative solutions that advance the Office's mission—but the pilot program is not such an alternative.

We agree that now is the right time to establish a pilot program for amendments. But the pilot program should be one that addresses, rather than compounds, the problem of unexamined claims in IPR.

Our proposed solution is straightforward. The pilot program should require an examiner to examine any amended claim. A patent owner should have a single opportunity to move to amend, and the patent owner's motion to amend should be due two months after a decision on institution. Three months later, the examiner should file his or her search report and a recommended disposition of the motion to amend, explaining the examiner's view of whether the amended claim recites patentable subject matter. One month after the examiner's recommendation, the petitioner's opposition to the motion to amend should be due, and the patent owner's reply should follow one month later. The Board would decide the motion in the Final Written Decision. Under this approach, the Office would examine every amended claim, and the Board would have the benefit of an independent prior art search.

There is no need for the patent owner to have multiple opportunities to amend claims during AIA trials, and it is impossible to provide this opportunity while giving the Office a chance to conduct a meaningful examination. If the patent owner wishes to engage in a prosecution-like back-and-forth with the Office to obtain the most appropriate claim coverage, then the patent owner may seek reissue or ex parte reexamination after the conclusion of the trial—especially if the Board finds the challenged claims unpatentable. But given the AIA's one-year deadline and the imperative that the Office examine any claim that is to be given the force of a statutory monopoly, there is no reason why multiple opportunities to amend should be afforded to the patent owner within the confines of an AIA trial.

In sum, while we applaud the Office for thinking creatively about claim amendments during AIA trials, the Office's proposed pilot suffers from a fundamental flaw. By permitting unexamined claims to be granted, the proposed amendment process runs afoul of the Office's core mission to ensure and promote patent quality. We respectfully suggest that the Office consider an alternative pilot program that provides for meaningful examination by a trained patent examiner of patent claims amended during AIA trials.

Very truly yours,



Krish Gupta
Senior Vice President, Intellectual Property & Litigation
Dell Inc.