

Comments Submitted by Robert M. Asher

To: Michelle Lee
Under Secretary of Commerce for Intellectual Property and Director of the United States
Patent and Trademark Office
Alexandria, Virginia

Via email: PTABTrialPilot@uspto.gov

The PTAB should continue to assign three judges to the important question of whether and on what grounds a post-grant proceeding will be instituted. Since institution decisions are non-appealable, they should be made by a panel of three judges who can probe and sift each other's ideas as to whether a proceeding should go forward or not. It is hazardous to place such decisions, given their significance and non-reviewability, in the hands of a single administrative patent judge. Doing so would diminish the indispensable appearance of fairness and careful deliberation that should accompany all decisions made by the Board.

It has long been felt that a strong United States economy depends upon strong protection of intellectual property rights around the globe. The United States has been pressing developing nations to improve their legal systems to better protect holders of intellectual property rights. It is of utmost importance in this context that our system be rightly perceived as strong and fair. Publicity surrounding the new post-grant proceedings and its role in invalidating patents without regard to proper claim construction or to a presumption of validity threatens that perception. The inability to appeal institution decisions further impairs the perception of fairness and due process.

The use of three judges should continue to be the norm for making an institution decision. If this decision is made conscientiously, it is reasonable to expect that patents undergoing an AIA trial will be invalidated more often than not. That does not mean that the three-judge panel is predisposed toward invalidation. It is just a natural result of limiting trials to those petitions already having a reasonable likelihood for success. No doubt, patent owners will want a different panel who might not have instituted and who might be more likely to rule in their favor

at the trial. But due process does not require offering litigants an opportunity to switch to judges who might be more favorable to their position. Sticking with the three judges who were assigned from the start is a fair and reasonable system.

Conserve judicial resources by reducing the number of judges on conference calls, if necessary, but do not detract any further from the credibility of the process. Any cost-saving realized from committing critical decisions to a single judge will, I anticipate, be more than offset by the undermining of public confidence in post-grant proceedings.

Respectfully submitted,

A handwritten signature in blue ink that reads "Robert M. Asher". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert M. Asher
Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston, MA 02110
rasher@sunsteinlaw.com