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October 13, 2015

VIA EMAIL: trialrules2015@uspto.gov

Hon. Susan Mitchell

Lead Judge, Patent Trial Proposed Rules

Mail Stop Patent Board

Director of the United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Re: Public Comment by FCBA on USPTO Trial Practice
Proposed Rule, 37 CFR 42.11(b)-(d)

Dear Lead Judge Mitchell:

The Federal Circuit Bar Association ("FCBA") appreciates the opportunity to comment on the USPTO's proposed rule amending the existing rules relating to the USPTO trial practice. We offer comment on only Proposed Rule, 37 CFR 42.11(b)-(d), regarding the duty of candor in PTAB trial proceedings.

The FCBA, a national bar association, unites the different interests drawn before the Court of Appeals for the Federal Circuit (CAFC) and the tribunals which it reviews. Congress conferred on the Federal Circuit national appellate jurisdiction in a number of complex litigation areas, including matters involving intellectual property. The FCBA seeks to serve the administration of justice in the CAFC by maintaining and raising the standards of proficiency, integrity, and ethics in the practice of law before the Federal Circuit. In the context of this letter, we speak on behalf of our private sector members. Given their own roles, government members have not participated in the preparation or submission of this letter.

PROPOSED RULE

One of the new rules proposed by the USPTO for PTAB trial proceedings is modeled, in part, on Fed. R. Civ. P. 11 governing civil litigations. It is found at new sub-sections (b)-(d) of 37 CFR 42.11 ("signing papers; representations to the Board; sanctions.") This proposed rule addresses the duty of candor in PTAB trial proceedings and the Board's ability to sanction violations thereof. This is the only proposed rule we address.

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The notice of this proposed rulemaking has relatively little discussion of this proposed change to Rule 42.11. The most substantive discussion is the following:

In addition, in order to further attempt to prevent any misuse of the AIA proceedings, the Office proposes to amend 37 CFR 42.11 (which prescribes the duty of candor owed to the Office in these proceedings) to include a Federal Rule of Civil Procedure Rule 11-type certification for all papers filed with the Board in these proceedings, including a provision for sanctions for misconduct in connection with such papers. If appropriate, such misconduct in the course of AIA proceedings might also be reported to the Office of Enrollment and Discipline.

(Notice p. 8.)

SUMMARY OF COMMENT

We recommend that the USPTO modify its proposed rule 37 CFR 42.11(b)-(d), per the below markup of the rule, including the following changes:

1. Limit the certifications triggered by a signature on a paper presented to the PTAB, by dropping (c) (2)-(4).
2. Limit those subject to sanctions by removing “law firm” from (d)(1).
3. Require more of a party asserting an alleged violation by requiring that it serve its draft motion, as required by Fed. R. Civ. P. Rule 11, not merely a notice of the basis for the motion.
4. Clarify the nature of sanctions available to the Board, in two respects:
 - a. In § 42.11(d)(4), limit the requirement of consistency with § 42.12, to sanctions on a party.
 - b. For sanctions on others, require the Board to consider sanctions that likely would be imposed by federal courts for comparable conduct.

We offer no comment on the remaining proposed rule changes.

Our specific recommended proposed revisions, summarized above, are found in the following markup of the published proposed rule:

§ 42.11 Duty of candor; signing papers; representations to the Board; sanctions.

(a) Duty of candor. Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

(b) Signature. Every petition, response, written motion, and other paper filed in a

proceeding must be signed by at least lead counsel or designated backup counsel under § 42.10 in the attorney's or registered practitioner's name—or by a party personally if the party is unrepresented. The Board may expunge any unsigned submission unless the omission is promptly corrected after being called to the counsel's or party's attention.

(c) Representations to the Board. By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

(1) It is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of the proceeding;

~~(2) The claims, defenses, and other legal contentions are warranted by existing law or by a non-frivolous argument for extending, modifying, or reversing existing law or for establishing new law;~~

~~(3) The factual contentions have evidentiary support; and~~

~~(4) The denials of factual contentions are warranted on the evidence.~~

(d) Sanctions—

(1) In general. If, after notice and a reasonable opportunity to respond, the Board determines that paragraph (c) of this section has been violated, the Board may impose an appropriate sanction on any attorney, registered practitioner, ~~law firm~~, patent agent, or party that violated the rule or is responsible for the violation. ~~Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate, or employee.~~

(2) Motion for sanctions. A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates paragraph (c) of this section. The motion must be authorized by the Board under 42.20. At least 21 days prior to seeking authorization to file a motion for sanctions, the moving party must serve ~~provide written notice to~~ the other party with ~~of the basis for~~ the proposed motion. A motion for sanctions must not be filed or be presented to the Board if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service of such motion ~~notice~~ or within another time the Board sets. If warranted, the Board may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

(3) On the Board's initiative. On its own, the Board may order an attorney, registered practitioner, ~~law firm~~, or party to show cause why conduct specifically described in the order has not violated paragraph (c) of this section, and why a specific sanction identified by the Board should not be imposed.

(4) Nature of a sanction. A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated. A sanction imposed under this rule on a party and should be consistent with § 42.12. A sanction imposed under this rule should consider the sanction the Board determines likely would be imposed by a U.S. district court under comparable circumstances.

(5) Requirements for an order. An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.

(e) Inapplicability to discovery. This rule does not apply to disclosures and discovery requests, responses, and objections.

DISCUSSION

In the Background section following this section, for convenience we provide the text of some related statutes and regulations, and juxtapose the text of the proposed rule with that of Fed. R. Civ. P. 11.

The Goal Is Worthy

We, of course, share the goal that PTAB proceedings be conducted with the highest professional standards. But, we also share the USPTO's goal to conduct trial proceedings efficiently. Specifically, the creation of USPTO trials in the AIA in large part is a response to the inefficiencies found in civil court patent litigation. Our comments below are motivated by concerns for the important latter goal not a disregard for the important former goal.

Introduction

We below discuss some concerns leading us to suggest the modifications noted above. No one concern in isolation may justify the proposed modifications. Rather, we submit that their combined weight recommends the limitations we propose.

Is There a Substantial Problem To Be Solved?

We wonder whether USPTO trials presently suffer from a lack of candor by the parties, to a significant degree, and, if so, whether that cannot be solved using current rules and

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mechanisms, including current Rules 42.11 and 42.12 and the USPTO's OED.

This impression is based in part on the absence of public complaints. Most of the adverse commentary regarding PTAB proceedings has concerned perceived unfairness to patent owners. The commentary regarding "abuse" of PTAB proceedings in part has concerned the motives for petitioning for review, *see, e.g.*, Case IPR2015-01092 (*Celgene Corp.*), not alleged violations of a duty of candor. We recognize, however, that the Board is best positioned to understand the extent of any lack of candor in USPTO trials to date.

The above perception of an absence of a problem is one reason for our recommending that the following provisions be dropped (other reasons are discussed below):

~~(2) The claims, defenses, and other legal contentions are warranted by existing law or by a non-frivolous argument for extending, modifying, or reversing existing law or for establishing new law;~~

~~(3) The factual contentions have evidentiary support; and~~

~~(4) The denials of factual contentions are warranted on the evidence.~~

Uncertainty As To Meaning And Authority

One advantage of PTAB trials over most court civil litigation is the greater focus on the substantive merits. That advantage would lessen were the USPTO to adopt procedures or rules that are unclear, or whose statutory authority is unclear. The proposed rule risks such uncertainty, we submit, in at least the following respects:

- 1) Uncertain statutory authority
 - a) It is uncertain whether the USPTO is authorized by statute to sanction pre-institution actions such as petitions. *Cf. Intellectual Ventures II LLC v. JPMorgan Chase & Co.* (Fed. Cir. April 1, 2015) ("Because the language of the statutory scheme consistently defines 'proceeding' as beginning when the PTAB institutes review, we adopt that interpretation."); 35 U.S.C. § 316(a)(6) ("prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding.")) We are not asserting that the USPTO lacks such authority; only that the answer is uncertain. (We also note that existing Rule 42.11(a)'s imposition of a duty of candor on those "involved in the proceeding," if applied to pre-institution activities, may be argued to exceed the scope of authority granted in 35 U.S.C. § 316(a), but do not address whether our

sources of such authority suffice.)

- b) It is unclear whether the USPTO has the statutory authority to issue sanctions for behavior other than an improper use of the proceeding, but the proposed rule may extend beyond that. 35 U.S.C. § 316(a)(6), for example, authorizes USPTO regulations “prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding.” That unquestionably authorizes the proposed rule sanctioning violation of a certification that a paper “is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of the proceeding. *See* Proposed Rule 42.11(c)(1). But the same cannot be said for Proposed Rule 42.11(c)(2)-(4) requiring certifications that contentions are warranted by existing evidence and otherwise. These proposed provisions may be authorized by the statute but it is not certain that they are. (We recognize that current Rule 42.12 extends similarly. But, it is limited to sanctions against parties so it does not present the identical concerns.)
- c) It is uncertain whether the USPTO is authorized by statute to sanction a law firm. (Even if the level of that uncertainty were modest it still would seem to outweigh any increased deterrence from threatening to sanction law firms versus sanctioning parties and individual attorneys.)

2) Unclear Provisions

- a) It is unclear—in the context of sanctioning an attorney or a law firm—what it means to limit sanctions to those “consistent with” Rule 42.12. That rule mostly is limited to restrictions on a party’s submissions in the proceeding, although it does include an attorneys’ fees provision.
- b) More generally, while looking to Rule 11 as a model is understandable and beneficial in some respects, the effort to track the language of Rule 11 risks uncertainty in the context of PTAB proceedings. For example, Rule 11’s references to “claims, defenses” is clear in the context of district court litigation, but less clear in the context of PTAB proceedings, yet the language is copied into the proposed rule.

Inefficiency

If adopted as proposed, this new rule risks at the least the following inefficiencies:

- 3) The proposed rule may induce some parties to threaten or file unjustified sanction motions, in part to side-step other rules restricting the number and timing of motions.
- 4) The proposed rule may spawn distracting disputes over whether the notice of the basis for the motion was sufficient.
- 5) Even filing of non-frivolous sanctions motions will add expense to the proceeding.

Unreasonably Strict

The proposed rule is stricter than Rule 11 by, apparently, threatening sanctions for assertions that are not presently supported by evidence but that in good faith are believed likely to be supported by future evidence (e.g., deposition of an adverse party's expert). It is unclear that a problem currently exists that calls for any rule that is stricter than Rule 11. In particular, if a party has a good faith belief that future evidence (e.g., an admission of the other party) is likely to support a position, that party ought not to be sanctioned so long as the party does not overstate the state of the evidence (e.g., "Petitioner is not expected to deny that") This is part of the reasoning for recommending that the below provisions be dropped:

~~(2) The claims, defenses, and other legal contentions are warranted by existing law or by a non-frivolous argument for extending, modifying, or reversing existing law or for establishing new law;~~

~~(3) The factual contentions have evidentiary support; and~~

~~(4) The denials of factual contentions are warranted on the evidence.~~

Due Process Concerns

Given the sheer number of different panels, is there a greater risk of inconsistent enforcement? Our proposed additional language, "A sanction imposed under this rule should consider the sanction the Board determines likely would be imposed by a U.S. district court under comparable circumstances," is intended to cabin the discretion of panels somewhat, to provide greater notice to those risking sanctions.

BACKGROUND: RELATED STATUTES AND RULES

Pertinent Statutes:

- 35 USC 316(a): [also 326(a)]

(a) REGULATIONS.—The Director shall prescribe regulations—

(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

- 35 USC 257(f):

(f) RULE OF CONSTRUCTION.—Nothing in this section shall be construed—

(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1001(a) of title 18, the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition);

(2) to limit the authority of the Director to investigate issues of possible misconduct and impose sanctions for misconduct in connection with matters or proceedings before the Office; or

(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by representatives practicing before the Office.

Existing Regulations:

The existing rules of practice and procedure for PTAB proceedings, 37 CFR Part 42, include two provisions governing candor and sanctions, 37 CFR 42.11 and 42.12.

- § 42.11 Duty of candor.

Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

- § 42.12 Sanctions.

(a) The Board may impose a sanction against a party for misconduct, including:

(1) Failure to comply with an applicable rule or order in the proceeding;

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(2) Advancing a misleading or frivolous argument or request for relief;

(3) Misrepresentation of a fact;

(4) Engaging in dilatory tactics;

(5) Abuse of discovery;

(6) Abuse of process; or

(7) Any other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

(b) Sanctions include entry of one or more of the following:

(1) An order holding facts to have been established in the proceeding;

(2) An order expunging or precluding a party from filing a paper;

(3) An order precluding a party from presenting or contesting a particular issue;

(4) An order precluding a party from requesting, obtaining, or opposing discovery;

(5) An order excluding evidence;

(6) An order providing for compensatory expenses, including attorney fees;

(7) An order requiring terminal disclaimer of patent term; or

(8) Judgment in the trial or dismissal of the petition.

Other relevant rules include the following:

- 37 CFR 10.130:

§10.130 REPRIMAND, SUSPENSION OR EXCLUSION.

(a) The Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.

(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

- 37 CFR 41.128:

§41.128 Sanctions.

(a) The Board may impose a sanction against a party for misconduct, including:

- (1) Failure to comply with an applicable rule or order in the proceeding;
- (2) Advancing a misleading or frivolous request for relief or argument; or
- (3) Engaging in dilatory tactics.

(b) Sanctions include entry of:

- (1) An order holding certain facts to have been established in the proceeding;
- (2) An order expunging, or precluding a party from filing, a paper;
- (3) An order precluding a party from presenting or contesting a particular issue;
- (4) An order precluding a party from requesting, obtaining, or opposing discovery;
- (5) An order excluding evidence;
- (6) An order awarding compensatory expenses, including attorney fees;
- (7) An order requiring terminal disclaimer of patent term; or
- (8) Judgment in the contested case.

BACKGROUND: COMPARISON TO FED. R. CIV. P. 11

Below is the text of proposed Rule 42.11 juxtaposed with Fed. R. Civ. P. 11.

Proposed Rule 42.11 vs. *Rule 11*

§ 42.11 Duty of candor; signing papers; representations to the Board; sanctions.

(a) Duty of candor. Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

(b) Signature. Every petition, response, written motion, and other paper filed in a proceeding must be signed by at least lead counsel or designated backup counsel under § 42.10 in the attorney's or registered practitioner's name—or by a party personally if the party is unrepresented. The Board may expunge any unsigned submission unless the omission is promptly corrected after being called to the counsel's or party's attention.

FRCP 11 (a) SIGNATURE. Every pleading, written motion, and other paper must be signed by at least one attorney of record in the attorney's name—or by a party personally if the party is unrepresented. The paper must state the signer's address, e-mail address, and telephone number. Unless a rule or statute specifically states otherwise, a pleading need not be verified or accompanied by an affidavit. The court must strike an unsigned paper unless the omission is promptly corrected after being called to the attorney's or party's attention.

(c) Representations to the Board. By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

FRCP 11 (b) REPRESENTATIONS TO THE COURT. By presenting to the court a pleading, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

(1) It is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of the proceeding;

FRCP 11(b)(1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;

(2) The claims, defenses, and other legal contentions are warranted by existing law or by a non-frivolous argument for extending, modifying, or reversing existing law or for establishing new law;

FRCP 11(b)(2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;

(3) The factual contentions have evidentiary support; and

FRCP 11(b)(3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(4) The denials of factual contentions are warranted on the evidence.

FRCP 11(b)(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

(d) Sanctions--(1) In general. If, after notice and a reasonable opportunity to respond, the Board determines that paragraph (c) of this section has been violated, the Board may impose an appropriate sanction on any attorney, registered practitioner, law firm, patent agent, or party that violated the rule or is responsible for the violation. Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate, or employee.

FRCP 11(c) SANCTIONS.

FRCP 11(c)(1) In General. If, after notice and a reasonable opportunity to respond, the court determines that Rule 11(b) has been violated, the court may impose an appropriate sanction on any attorney, law firm, or party that violated the rule or is responsible for the violation. Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate, or employee.

(2) Motion for sanctions. A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates paragraph (c) of this section. The motion must be authorized by the Board under § 42.20. Prior to seeking authorization to file a motion for sanctions, the moving party must provide written notice to the other party of the basis for the proposed motion. A motion for sanctions must not be filed or be presented to the Board if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service of such notice or within another time the Board sets. If warranted, the Board may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

FRCP 11(c)(2) Motion for Sanctions. A motion for sanctions must be made separately from any other

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motion and must describe the specific conduct that allegedly violates Rule 11(b). The motion must be served under Rule 5, but it must not be filed or be presented to the court if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service or within another time the court sets. If warranted, the court may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

(3) On the Board's initiative. On its own, the Board may order an attorney, registered practitioner, law firm, or party to show cause why conduct specifically described in the order has not violated paragraph (c) of this section.

FRCP 11(c)(3) On the Court's Initiative. On its own, the court may order an attorney, law firm, or party to show cause why conduct specifically described in the order has not violated Rule 11(b).

(4) Nature of a sanction. A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated and should be consistent with § 42.12.

FRCP 11(c)(4) Nature of a Sanction. A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated. The sanction may include nonmonetary directives; an order to pay a penalty into court; or, if imposed on motion and warranted for effective deterrence, an order directing payment to the movant of part or all of the reasonable attorney's fees and other expenses directly resulting from the violation.

FRCP 11(c)(5) Limitations on Monetary Sanctions. The court must not impose a monetary sanction:

FRCP 11(c)(5)(A) against a represented party for violating Rule 11(b)(2); or

FRCP 11(c)(5)(B) on its own, unless it issued the show-cause order under Rule 11(c)(3) before voluntary dismissal or settlement of the claims made by or against the party that is, or whose attorneys are, to be sanctioned.

(5) Requirements for an order. An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.

FRCP 11(c)(6) Requirements for an Order. An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.

(e) Inapplicability to discovery. This rule does not apply to disclosures and discovery

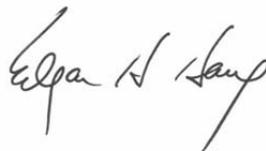
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requests, responses, and objections.

FRCP 11(d) INAPPLICABILITY TO DISCOVERY. This rule does not apply to disclosures and discovery requests, responses, objections, and motions under Rules 26 through 37.

In closing, we recommend that the USPTO modify its proposed rule 37 CFR 42.11(b)-(d) as discussed above. If we can provide further information, please contact James E. Brookshire, Executive Director, Federal Circuit Bar Association. Brookshire1@fedcirbar.org. Again, thank you for the opportunity to offer these comments.

Sincerely,



Edgar H. Haug
President