

November 16, 2015

Mail Stop Patent Board
Director of the United States Patent and Trademark Office
Attention: Lead Judge Susan Mitchell, Patent Trial Proposed Rules
P.O. Box 1450
Alexandria, VA 22313-1450

Via email: Trialsrules2015@uspto.gov

**Re: Response to the Request for Comments on
“Amendments to the Rules of Practice for Trials Before the Patent Trial
and Appeal Board”
80 FR 50719
(Aug. 20, 2015)**

Dear Lead Judge Susan Mitchell:

The IP Law Revisions Committee of the Minnesota Intellectual Property Law Association (“MIPLA”)¹ are grateful for the opportunity to comment on the United States Patent and Trademark Office (“Office”) Request for Comments entitled “Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board” as published in the August 20, 2015 issue of the Federal Register, 80 FR 50719 (“Request”).

The Committee supports the Office’s commitment to revisit the rules and practice guide after initial experience with the new AIA trials. In general, the MIPLA Committee is in support of the Office’s continued efforts to improve the rules but does have concerns on some of the specific proposed rules and offers some comments and suggestions outlined below.

The comments submitted herewith reflect the view of the Committee as a whole and have been approved by the MIPLA Board. They do not necessarily reflect the view or opinions of any of the individual members or firms of MIPLA, or any of their clients.

Sincerely,
/s/ Brad Pedersen
Brad Pedersen
Co-chair of the MIPLA Law Revision Committee

/s/ Stuart A. Nelson
Stuart A. Nelson
Co-chair of the MIPLA Law Revision Committee

¹ MIPLA is an independent organization with nearly 700 members representing all aspects of private and corporate intellectual property practice, as well as the academic community, in and around the state of Minnesota. The MIPLA IP Law Revision Committee that submits these comments is doing so on their own authority pursuant to the bylaws of MIPLA.

Comment 1: *Regarding the proposal to allow patent owners to include, with their opposition to a petition to institute a proceeding, new testimonial evidence such as expert declaration.*

The MIPLA Committee is concerned about the implementation of this rule. Some members of the Committee view this as an optional submission, which may be beneficial in some cases and may be unnecessary in others. For that reason, removing the restriction against testimony evidence may provide benefit with little to no downside, when properly considered.

Other members of the committee are concerned that, depending upon how the rule is implemented, it may unnecessarily increase the cost and complexity of post-grant proceedings at the preliminary stage. While the rules state that "evidence concerning disputed material facts will be viewed in the light most favorable to the petitioner," it may be difficult to implement this part of the rule without a response from the petitioner. Although the rules allow the petitioner to seek leave to reply, APJs have indicated during the recent USPTO roadshows that this would not be the default. Accordingly, there is a concern that this procedure could cause petitions to be denied based on evidence without allowing the petitioner a true opportunity to reply.

Accordingly, the MIPLA Committee recommends guarding against granting such evidence undue weight, such as by more liberally allowing some type of limited reply within a short time period.

Comment 2: *Regarding the proposal for a new requirement on practitioners before the PTAB, akin to the Rule 11 requirements in federal courts, to give the USPTO a more robust means with which to police misconduct.*

The MIPLA Committee is concerned that this proposal is overkill. The MIPLA Committee suggests that the legality and ethics of potential improper uses, such as stock manipulation, may be an issue better left for courts and/or other tribunals, allowing the PTAB to focus on validity of challenged patents.

Moreover, the proposed amendments to Rule 42.11 include some important differences from Federal Rule of Civil Procedure 11. First, in contrast to Rule 11, Rule 42.11(c)(3) and (4) omit the ability to plead or aver based on contentions or denials being likely have evidentiary support after a reasonable opportunity for further investigation or discovery. While the rationale for this difference may be that the petition, the patent owner's response, and the petitioner's reply should be based on evidence and not what may be developed during discovery, there may be times when facts or denials still need to be pleaded based on "information and belief." This is especially true for a patent owner's preliminary response.

Comment 3: *Regarding the proposal for changing page limits to word count.*

The MIPLA Committee supports the proposal to replace the page limits with a word count in most documents. The MIPLA Committee believes that this will reduce burden on both the parties and the PTAB for reviewing and complying with existing constraints (font, claim chart limitations, etc.) on preparation of the documents.

***Comment 4:** Regarding the proposal to use the claim construction standard used by district courts for patents that will expire during proceedings and therefore cannot be amended, while using the broadest reasonable interpretation (BRI) for all other cases.*

The MIPLA Committee supports the decision to set a definite cut-off for when the *Phillips* and BRI claim construction standards apply, but does not support the selection of the final written decision (FWD) as the cut-off date. The MIPLA committee recommends that the date should be well after the FWD, and suggests selecting a date certain of either 3 or 4 years after filing of the petition.

If the right to amend the patent claims is anything but illusory, then there must be an opportunity to amend the claims with at least some enforceable life after the proceeding. If the claims are successfully amended, the amended claims can be enforced only after the USPTO issues the Certificate, and that is occurring only after all appeal rights have been exhausted. Therefore, it is not accurate to assert that a patent expiring a month after the final written decision (or even a year afterwards) has a right to amend the claims—because the patent will be expired before the Certificate ever issues after the appeal process and any amendment would never become effective. To amend such claims would be tantamount to simply canceling such claims.

***Comment 5:** Regarding the proposal to develop motions-to-amend practice through the PTAB's own body of decisions.*

The MIPLA Committee requests that changes to the motions-to-amend practice be made to rule promulgation, not simply as part of a continually updated body of decisions. First, such a body of decisions is typically not precedential. Consequently, it can be difficult to know what standards will apply to a given proceeding, and whether those standards will change during the course of a proceeding. Second, it can be difficult for practitioners to search the body of decisions and stay abreast of the most recent changes. This can occur, for example, in situations where a decision comes out just days before (or even days after) a party files a paper. If the standards are set by rule promulgation, however, it is straight forward to consult the actual rules in 37 CFR 42. Third, while some have noted that it can be slow and burdensome to change the rules, there is an advantage to this process of relying on an ongoing body of decisions. Slowly changing rules provides parties and practitioners certainty and an opportunity to be heard on rule changes—which is both valuable and appreciated.

Accordingly, the MIPLA Committee requests that the rules governing the motion-to-amend practice be kept and codified in 37 CFR 42. In cases where the Board wishes to apply rules

to a case that are different than those in 37 CFR 42, a given panel can issue a standing order for the case so that the parties know which rules and which informative decision will apply in that proceeding.