

To: Lead Judge Susan Mitchell
From: Nancy J. Linck (former APJ and Solicitor)
Subject: Comments re Amendments to the Rules of Practice for Trials Before the PTAB (published 80 Fed. Reg. 50720 (Aug. 20, 2015))
Date: Oct. 26, 2015

I offer the following comments and suggestions in my personal capacity, as a former Solicitor and APJ who has great interest in the success of the Office, and not as a representative of my firm.

I applaud the Office's efforts to improve trial practice before the PTAB. In spite of my initial skepticism and my continuing concern about the extremely high percent of issued claims that are being held unpatentable, the Office's ongoing efforts to make the practice fairer and more consistently administered deserve commendation.

I offer the following:

Testimonial Support for Patent Owner's Preliminary Response (amendments to 37 CFR 42.107 and 42.207): I wholeheartedly support permitting patent owners to submit testimonial evidence with their preliminary response. By doing so, the Office will "level the playing field" at this early stage in the proceeding thereby likely avoiding instituting trials that should not be instituted. This is the stage of the proceeding at which the APJs have no preconceived notion as to which party should prevail. Once a trial is instituted, that is no longer the case. I further agree with the Office that depositions of experts should be postponed until after trial is instituted, just as is the case today.

I disagree that the Office should resolve factual disputes at this point in favor of the petitioner. As a substitute for district court litigation to attack the validity of an issued claim, factual disputes should be resolved in the patent owner's favor. What is the rationale for doing otherwise?

Likewise, I do not understand the need for a petitioner's reply at this stage. The petitioner has significant time available to it (and in most cases the benefit of an ongoing litigation) to prepare the petition. Thus, the petitioner can anticipate the patent owner's response in most cases. Why should permitting the patent owner the ability to support its arguments change present practice which does not permit a petitioner's reply? With respect to a petitioner's reply at this stage, present practice should be maintained.

Motions to Amend: Trials are not examination-like proceedings. Thus, I echo the comment that claim amendments during post-grant trials should be eliminated, coupled with several other changes. Given that the primary purpose of post-grant reviews is to provide "a speedy alternative to district court litigation" rather than a reexamination of issued claims, it would make sense to eliminate claim amendments, along with recognizing the presumption of validity given to issued claims and construing the claims

in the same manner as the district court does. Elimination of amendments would avoid issuing claims that have not been examined by the USPTO and would expedite post-grant trials. I understand that eliminating amendments would require a statutory change, as would giving claims a presumption of validity. With that said, the Office has great influence with Congress and can propose changes to the statutes that impact practice before the PTAB.

Rule 11-Type Sanctions: As former Solicitor responsible for overseeing the Office of Enrollment and Discipline during my tenure, I recommend the Office move very cautiously before instituting such sanctions. Such institution and prosecution are extremely time-consuming and can have devastating and unexpected consequences for those targeted. Recall the many years of attempting to enforce Rule 56 before finally admitting doing so was beyond the Office's capability. Is there sufficient justification at this point in developing AIA practices to warrant imposing such sanctions? Has it been determined that the loss of credibility before the PTAB is not adequate to deter improper action before the PTAB?