

6250 Columbia Pike
Falls Church, VA 22041
31 October 2018

ADCAPJ Jacqueline Wright Bonilla
Patent Trial and Appeal Board

Your Honor:

- (1) In the current proposal, “Before the oral hearing, the patent owner ... may file a reply to an opposition to the revised motion to amend, and the petitioner may file a corresponding sur-reply.” However, “after a patent owner files a motion to amend that proposes substitute claims, and a petitioner files an opposition (if it so chooses) ...,” the patent owner may not file a reply, and the petitioner may not file a corresponding sur-reply. I think that it would be useful to build opportunities for two more such papers into the proceeding. However, I am sensitive to the statutory time pressure under which you labor. Accordingly, I am content to leave the proposal as you have it for now with the thought that experience with the current proposal may well dictate a subsequent refinement to permit the two additional filings.
- (2) The current proposal includes elaborate procedures for the panel, in its discretion, to solicit patent examiner assistance (“e.g., by an examiner in the Central Reexamination Unit”). I think that those procedures are unnecessary and are unlikely to be worth the effort. The examining corps has already provided its input when it allowed the claims present in the patent in issue. So long as the panel decides that the proposed amended claims are subsumed within the originally allowed claims, that should be enough for purposes of the PTAB proceeding. If the panel allows those claims to issue and a third party thinks that they are still too broad, the third party can file its own petition.
- (3) I support rulemaking to allocate the burden of persuasion as set forth in the *Western Digital* order. A common (and, in my opinion, often justified) criticism of the Patent and Trademark Office is that it too often proceeds without following the dictates of the Administrative Procedures Act. I think that it would be salutary for the Office to follow those procedures met meticulously in this high-profile instance.
- (4) In response to Question 4: Yes!
- (5) In response to Question 6: Yes!
- (6) In response to Question 7: Leave it up to the parties to decide whether to rely on declaration testimony, but provide for cross-examination.
- (7) In response to Question 10: They should be non-contingent.
- (8) In response to Question 12: There should be no variations in practice based on party size or whether a party is represented by counsel.
- (9) In response to Question 15: Yes!
- (10) In response to Question 16: I think that the panel should be able to justify findings of unpatentability even when the petition remains in the proceeding, subject only to appellate review.

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703/412-6485