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To: [TrialRFC2018Amendments](#)
Subject: FW:
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DEPARTMENT OF COMMERCE

Patent and Trademark Office [Docket No. PTO-P-2018-0062]

Request for Comments on Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board

In response to the Request for Comments, I submit herewith a response to Question #8

Question #8 states:

If a petitioner ceases to participate in an AIA trial and the Board solicits patent examiner assistance regarding a motion to amend, how should the Board weigh an examiner advisory report relative to arguments and evidence provided by a patent owner? What type of assistance or information should a patent examiner provide? Should prior art searches by examiners be limited to those relevant to new limitations added to proposed substitute claims and reasons to combine related to such limitations?

If the Central Reexamination Unit (CRU) examiners were to be tasked with providing assistance to the judges of the Patent Trial and Appeal Board (PTAB), a very simple and flexible process would need to be deployed.

This process, if implemented, would have to allow the PTAB judges considerable latitude in deciding what to request from the CRU and how to utilize the resulting information. Rather than analyze the question of whether this type of program should be implemented in the first place, what I wish to provide are suggestions on how the program could possibly be implemented.

(1) Examiners from the CRU would voluntarily apply for a detail assignment as an “Examiner Advisor” to the PTAB. This would allow the USPTO to initially collect data on the time commitment involved to provide effective assistance to the PTAB. It would also clarify the number of employees needed, the necessary length of the detail and whether or not program could effectively function in the long term. In the event that the program were deemed to be successful, the examiners completing the detail would form the basis for a sub-group of examiners within the CRU who could flexibly rotate to assist the PTAB on an *ad hoc* basis. Such examiners would still remain on permanent assignment to the CRU.

(2) The Examiner Advisor would be assigned to work with a Section Lead Judge, who would have primary responsibility for deciding the scope of the Examiner Advisor’s work.

(3) The Section Lead Judge would decide when and how to implement the services of the Examiner Advisor. For example, the Section Lead Judge could instruct the Examiner Advisor to prepare a search report, prepare a patentability determination with respect to amended claims, or draft a suggested response to a Patent Owner.

The level of involvement would take into account the current status of the case, the number of claim amendments presented and feedback from the panel judges. Ideally, the panel assigned to the proceeding would hold a meeting to outline the desired involvement of the Examiner Advisor and the Section Lead Judge would finalize the nature of the requested work.

- (4) The Examiner Advisor would provide the requested information to the Section Lead Judge in the time frame requested. If the Section Lead Judge determines that the Examiner Advisor's report or determination is sufficiently persuasive, the Section Lead Judge could then instruct the Examiner Advisor to present the report/determination/response to the full panel of Judges, where the information would be discussed.
- (5) The work of the Examiner Advisor would be non-binding and the weight attributed to this work would be purely discretionary to the trial panel judges. In case of disagreements, questions would be resolved by the Section Lead Judge.
- (6) There would be no formal or pre-determined degree of probative value assigned to the Examiner Advisor's work, as it would be purely advisory in nature. The panel judges could freely decide for themselves how to apply or not apply the supplied work.
- (7) The work of the Examiner Advisor would not be published or made of record, by reason that this work would be considered purely advisory in nature, and not a formal position of the Office.

Respectfully Submitted,

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