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Subject: Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board

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General

17. What other changes can and should be made in AIA trial proceedings? For example, should changes be made to the Board's approach to instituting petitions, page limits, or request for rehearing practice?

Comment: During the pre-institution stage of AIA trial proceedings, the Board should permit petitioners to file a limited reply brief contingent upon the submission of a patent owner's preliminary response. The subject matter of the reply brief should be restricted to issues of claim construction raised in the patent owner's preliminary response.

Experience to date indicates a need to provide for a limited petitioner's reply on claim construction during the pre-institution stage. As in other types of adjudicative patent proceedings, claim construction has assumed a pivotal—and often dispositive—role in a large proportion of AIA trial institution decisions. Given the importance of sound claim construction results to achieving sound institution decisions, genuinely contested issues of claim construction should be vetted in the most thorough and comprehensive manner possible within the time-limited AIA trial framework.

The present approach to claim construction, however, often leaves the Board in the undesirable position of having to evaluate one or more claim construction positions raised and discussed for the first time in the patent owner's preliminary response, without the benefit of countervailing argument or evidence from the petitioner. Under current rules, petitioners must endeavor to predict and preemptively respond to every conceivable claim construction position that the patent owner might take in a preliminary response—an impossible task in most cases due to the variety of terms that might be disputed, the range of constructions that might plausibly be asserted for each of those terms, and the strict page limit imposed on petitions imposed under 37 C.F.R. § 42.24(a)(i). The effect is an asymmetric process that provides patent owners a full response to the petitioner's claim construction arguments plus the opportunity to present additional, unrebutted claim construction arguments drawn to the same or additional claim terms.

As an example, a petitioner might request *inter partes* review, filing a petition with proposed constructions of several claim terms and including arguments to refute numerous alternative interpretations. Due to space limitations in the petition, the petitioner must be selective in addressing only the most likely alternative constructions. In turn, the patent owner could file a preliminary response that addresses the petitioner's claim construction arguments

and offers a novel, alternative construction for one or more claim terms that, while at least plausible on the surface, is contradicted by evidence of the record—for example, a statement buried within a lengthy prosecution history. In such cases, the petitioner, being intimately familiar with the patent and the record, is best positioned to discern and point out such inconsistencies. With no opportunity for a response, however, that task falls to the Board. But that is not the Board’s role, nor is it practical for the Board to conduct such a review in every proceeding.

Judicial economy would be best served by allowing the parties to present their best arguments and respond to those of their opponents before institution, at least as to the critical issue of claim construction. Only the parties have the necessary time and proper incentives to bring forth the full record on both sides of every proposed construction, and only with that information can the Board make the best-informed institution decisions possible and do so the first time a petition is filed. Continuing to deny petitioners a chance to respond risks multiplying the filings on the Board’s already crowded docket because petitioners are likely to seek rehearing or file a new petition when institution is denied on a basis substantially contradicted by some aspect of the record.

A short and focused reply to the patent owner’s preliminary response could be accommodated with minimal change to the existing pre-institution schedule. We would suggest permitting a reply of no more than 10 pages, limited to issues of claim construction, to be filed within two weeks of the patent owner’s preliminary response.

Respectfully,

Andrew T. Dufresne
Michael Best & Friedrich LLP

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