

October 16, 2014

By Electronic Mail: TrialsRFC2014@uspto.gov

The Honorable Michelle K. Lee

Deputy Under Secretary of Commerce for Intellectual Property

and Deputy Director of the United States Patent and Trademark Office

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Alexandria, Virginia 22313

Attn: Scott R. Boalick

Vice Chief Administrative Patent Judge (Acting)

Patent Trial and Appeal Board

U.S. Patent and Trademark Office

RE: Comments in response to “Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board,” 79 Fed. Reg. 36474 (June 27, 2014)

Dear Deputy Director Lee and Judge Boalick:

The undersigned appreciate the opportunity to provide comments in response to Request for Comments on Trial Proceedings Under the America Invents Act (AIA) Before the Patent Trial and Appeal Board.

The opinions and comments expressed in this response are those of the authors and do not necessarily reflect the views of Michael Best & Friedrich LLP, its clients, or any of its or their respective affiliates.

I. Specific Requests For Comments

16. What changes, if any, should be made to the format of the oral hearing?

Our experience at oral hearings is that the technology currently being used is inadequate to participate in hearings from remote locations. Technology glitches during the oral hearings have disrupted the process. The most effective solution to avoid technology glitches would be for the members of the panel to participate in person at the hearings, which would also facilitate a more efficient exchange of information between the panel and the parties' advocates. Requiring in-person attendance at all hearings is, however, not the most convenient or cost effective solution. An alternative to in-person participation is for the members of the panel to travel to the nearest satellite office of the USPTO where more sophisticated video equipment and on-site technical assistance can be made available. Another alternative is to upgrade the technology resources available to the Board and panel members at remote locations.

Another improvement would be to open the hearing room at least 30 minutes before the scheduled time to allow the parties to settle in and to connect any equipment to be used during the hearing.

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?

The Board should simplify the process for entering protective orders. For example, the Board could adopt the approach used by the United States District Court for the Northern District of Illinois in patent case. Under the Local Patent Rules of the Northern District of Illinois, the default protective order is entered automatically, and the parties can file a motion (disputed or uncontested) to modify the default protective order. In AIA trials, the Board could enter the default protective order provided in the Office Patent Trial Practice Guide, 74 F.R. 48756 (Aug. 16, 2012), as a matter of course when it enters the notice according a filing date to the petition. If the parties wish to modify the default protective order, they can request authorization from the Board to file a motion to amend the default protective order.

The Board should provide standard guidance concerning demonstrative exhibits at the oral hearing. This standard guidance should supplement, consolidate, clarify, and supersede the guidance provided in CBS Interactive Inc. v. Helferich Patent Licensing, LLC, IPR2013-00033, Paper 118 (PTAB Oct. 23, 2013) and St. Jude Medical, Cardiology Division, Inc. v. The Bd. of Regents of the Univ. of Michigan, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014). For example, the Board should permit demonstrative exhibits that might be argumentative as long as the arguments and the facts referenced in the demonstrative exhibit include a precise citation to the record.

II. Issues Raised During Roundtables by the Board in 2014

1. Should the Scheduling Order mandate settlement discussions?

The Scheduling Order should not mandate settlement discussions. A blanket requirement frequently requires parties to spend time confirming what they already know, namely, that the AIA proceeding is the most expeditious way of resolving the parties' dispute. Keeping the AIA process on track is the most effective way to force the parties to assess settlement and engage in settlement discussions if they are likely to prove fruitful.

2. Should the Board issue more precedential opinions?

The Board should issue more precedential opinions. This provides more certainty and a better framework for both parties to follow, especially with regards to issues such as claim construction, motions to amend, and discovery.

3. In what ways can the PRPS filing system be enhanced?

The search capabilities could be improved to allow searching based on the names of the parties, patent number, art unit, and status of proceedings.

The user interface can be improved to provide more information to the public. For example, the public should be able to obtain summary information such as the counsel representing the parties, the claims challenged in the petition, the claims upon which trial was instituted, the members of the panel, and similar information without having to download documents to compile the information.

The system should permit users to download multiple documents at a time.

Another feature that would be invaluable is to include a link to the documents in the electronic notices transmitted by electronic mail to the parties.

The PRPS system should also provide a public Representational State Transfer (REST) API that can be used to retrieve information automatically. For example, the REST API could provide for the ability to embed links in the citation to documents in the record.

Given the ubiquity of mobile devices, the PRPS system should provide a mobile-friendly interface.

4. Should the Board publish more statistics?

The Board should offer as many statistics as possible, so as to be transparent and provide guidance to all parties involved or to all parties that are considering becoming involved with the Board through AIA trials. Alternatively, the Board should make available to the public the raw data in an easily downloadable format that can be used to compute statistics.

Respectfully submitted,

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