

March 5, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: post_patent_provisions@uspto.gov

**RE: Comments on Notice of Proposed Rulemaking
Changes to Implement Miscellaneous Post-Patent Provisions
77 Fed. Reg. 442 (January 5, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the Notice of Proposed Rulemaking entitled: “Changes to Implement Miscellaneous Post-Patent Provisions of the Leahy-Smith America Invents Act” as published in the Federal Register (Vol. 77, No. 3, pp. 442-448) on January 5, 2012 (the “Notice”).

AIPLA is a U.S.-based national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property. Our members practice or are otherwise involved in patent law and other intellectual property law in the United States and in jurisdictions throughout the world.

Section 6(g) of the America Invents Act (AIA) amends 35 U.S.C. §301 to expand the information that may be submitted to the file of an issued patent, permitting any person to submit a patent owner’s written statements on claim scope, made before a Federal court or the USPTO, for consideration in a post-grant proceeding. However, the AIA estops petitioners of *inter partes* or post-grant review of a patent claim from bringing an *inter partes* reexamination of that claim based on any ground the petitioner raised or reasonably could have raised during the *inter partes* or post-grant review.

The proposed rules would implement Section 6 of the AIA. Specifically, the proposed rules provide for the submission by third parties of written statements that had been made by a patent owner before a Federal court or the U.S. Patent and Trademark Office (USPTO) regarding the scope of any claim of the patent. Consistent with the AIA, the proposed rules would limit the USPTO's use of such written statements to determining the meaning of a patent claim in *inter partes* reexamination proceedings that have already been ordered and in *inter partes* review and post-grant review proceedings that have been instituted. Any statement or accompanying information must be submitted in redacted form to exclude information subject to an applicable protective order.

The proposed rules would also implement the changes in nomenclature pertaining to the renaming of the Board of Patent Appeals and Interferences as the Patent Trial and Appeal Board, and would replace references to interference proceedings with references to derivation proceedings.

While AIPLA generally supports the direction and procedures proposed in the draft rules, several provisions identified below should be reconsidered and revised to improve both clarity and implementation.

Proposed § 1.501(a)(2) – Statements of the Patent Owner

This proposed section states that information that any person may submit in a patent file may include statements that the patent owner filed in a proceeding before a Federal court or the USPTO in which the patent owner took a position on the scope of any claim of the patent. This proposed section also would require that any such statement must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement.

The USPTO has not provided any guidance on what it will regard as a statement of the patent owner or how it intends to enforce the accompanying documents requirement to ensure that only compliant submissions are entered into the patent file. The USPTO should clarify what it considers would constitute a statement of the patent owner. For example, would it include:

- (a) Statements by an inventor, including an inventor no longer employed by the patent owner at the time the statement was made?
- (b) Statements by experts (technical or legal) or representatives submitted on behalf of the patent owner in a proceeding involving the patent or a related application/patent where the same term is used?
- (c) Statements by an officer or employee/former employee of the patent owner in a deposition?
- (d) Statements by litigation counsel related to the term in a proceeding involving that patent or a related patent?

Will there be a procedure a patent owner could use to have a noncompliant submission, inadvertently entered by the USPTO, redacted or expunged from the file? Guidance on this issue would be very helpful to those who intend to make submissions of the type authorized by the AIA, and to patent owners, regarding the statements that are likely to be admitted to the patent file.

Proposed § 1.501(b) – Explanation

This proposed section would require an explanation (“must explain”) of the pertinence and manner of applying any prior submitted or written statement and accompanying information to at least one claim of the patent. The USPTO has not indicated whether it would enter a reply statement from the patent owner that could address the explanation of relevance submitted by a party other than the patent owner. Proposed § 1.501(b)(2) states that a patent owner submitter may include an explanation of how the claims differ from the items submitted, so it appears that one way a patent owner could make its disagreement a part of the public record in the patent file would be to make its own submission of the same documents with its own interpretation of what the prior art teaches or what the statement means. The USPTO may want to consider viewing its role as administrative in nature, and simply enter compliant submissions without concerning itself with possible duplication of submissions. Clarification is requested.

Proposed § 1.501(e) – Service of the Submission

As proposed, the submission is required to reflect that a copy of the submission has been served on the patent owner “or that an *inter partes* attempt of service was made.” This requirement, as proposed, is not practical because it is highly unlikely that any person making a submission pursuant to § 1.501(a) is going to know whether service is going to be successful or not at the time of making the submission. Does the USPTO mean that if the submitter is notified that service was not successful, the entire submission must be resubmitted with proof of an *inter partes* attempt? Consideration should be given to the procedures proposed by the USPTO in the proposed rules for *inter partes* review proceedings, specifically proposed § 42.105(b). This proposal states that when the person making a submission to the USPTO becomes aware that service on the patent owner was not successful, that person should contact the USPTO to discuss alternative modes of service. Having a uniform system or procedure to address a common problem (failed service) would further reduce the complexity of USPTO regulations in general.

Proposed § 1.510(b)(7) - Real Party in Interest

This proposed section would require that a request for *inter partes* reexamination identify the real party in interest to the extent necessary to determine whether a request for *inter partes* review or post-grant review filed subsequent to a request for *inter partes* reexamination bars a pending *inter partes* reexamination from being maintained as mandated by the new estoppel provisions in 35 U.S.C. §§ 315(e)(1) and 325(e)(1). The absence up until now of such a requirement for *inter partes* reexamination requests has been a feature considered attractive by many users of the *inter partes* reexamination procedure.

The USPTO should consider a procedure of enforcing the required estoppel provisions in a way that would preserve the ability of the requester of an *inter partes* reexamination to remain anonymous. Specifically, it appears that the same result could be achieved by requiring a certification by the requester of *inter partes* reexamination that the real party in interest has not filed a request for either post-grant review or *inter partes* review, and to require requesters in the latter two types of proceedings to certify that they have not filed a request for *inter partes* reexamination on that same patent.

In the alternative, the USPTO should consider maintaining in confidence, upon request, the identity of the real party in interest in an *inter partes* reexamination request so that the USPTO alone could be responsible for enforcing the new estoppel provisions. This alternative is not considered as attractive because it would place an additional burden on the USPTO and create the possibility that confidence would not be maintained.

AIPLA appreciates the opportunity to provide these comments on the subject Notice of Proposed Rulemaking. We would be pleased to answer any questions these comments may raise and look forward to participation in the continuing development of rules appropriate for patent practice and for implementation of the AIA.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber", with a long horizontal flourish extending to the right.

William G. Barber
AIPLA President