



March 5, 2012

**IMPLEMENTATION OF THE AMERICA INVENTS ACT**

**Comments on Proposed USPTO Rules and Guidance on  
Submissions of Written Statements Made by Patent Owners  
Regarding Claim Scope under the amended 35 U.S.C. 301  
(77 Fed. Reg. 442 (Jan. 5, 2012))**

*SUBMITTED BY THE INNOVATION ALLIANCE*

The Innovation Alliance (IA) is pleased to submit the following comments on proposed regulations to implement the amended 35 U.S.C. 301. The Innovation Alliance represents innovators, patent owners, and stakeholders from diverse industries. Innovation Alliance members believe in the critical importance of maintaining a strong patent system that supports innovative enterprises across the country, helping to fuel the innovation pipeline and drive the 21st century economy.

The amended 35 U.S.C. 301(a)(2) permits “any person” to file with the USPTO “statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.” Section 301(d) further provides that “a written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324.”

The USPTO has interpreted 35 U.S.C. 301(d) to limit the Office’s use of claim construction statements filed pursuant to section 301(a)(2) to post-grant proceedings that have already been ordered or instituted: “The provision limits the Office’s use of such written statements to determining the meaning of a patent claim in ex parte reexamination proceedings that have already been ordered and in inter partes review (IPR) and post grant review (PGR) proceedings that have been instituted.” The Office further interprets 35 U.S.C. 301(d) as

“prohibiting it from considering a §1.501(a)(2) written statement when making the determination of whether to order ex parte reexamination under 35 U.S.C. 303.”

These statements suggest that a similar prohibition may extend to IPR and PGR proceedings (instituted under sections 314 and 324 respectively). Such a prohibition would preclude the Office from considering written statements filed under section 301(a)(2) (or implementing regulation §1.501(a)(2)) to determine whether a petitioner has satisfied the threshold standard for instituting an IPR or PGR proceeding. This prohibition, however, could lead to incongruous results if it precludes parties from directly introducing previous statements made by the patent owner as part of the normal IPR and PGR petition process, or prevents the Office from considering such statements in deciding whether to institute an IPR or PGR proceeding (under proposed implementing regulations §42.108(c) and §42.208(c)).

In creating a more robust petition process with a heightened evidentiary threshold, Congress sought to enhance the fairness and efficiency of post-grant proceedings. By compelling petitioners to submit their best evidence at the outset of the proceeding, the higher threshold guards against ill supported challenges and better enables the Office to complete the proceedings within the 12-month statutory timeframe.

These objectives would be undermined if the Office were to interpret section 301(d) (and its implementing regulation) in a manner that broadly precludes it from considering a patent owner’s previous statements on the scope of its claims in determining whether to institute an IPR or PGR proceeding, even though such statements are introduced directly by the petitioner or patent owner as part of the petition process. As a technical matter, such statements should fall outside section 301(a)(2) (and implementing regulation §1.501(a)(2)) since they enter the record through the petition filing under section 312(a)(3) or 322(a)(3), or the patent owner’s response to the petition under section 313 or 323. However, the USPTO’s guidance on 35 U.S.C. 301, quoted above, creates doubt as to whether the Office would, under any circumstances, consider such statements in deciding whether to institute a post-grant proceeding.

To avoid any further confusion on this issue, IA requests that the Office clarify in writing that, in deciding whether to institute an IPR or PGR proceeding, it will consider any evidence properly submitted by a party in connection with the petition process, including relevant statements on claim construction previously filed by the patent owner in a proceeding with the Office or a Federal court. However, if the Office is of the view that section 301(d) precludes, in all circumstances, consideration of such statements before an IPR or PGR proceeding is instituted – i.e., even if the statements are introduced as part of the petition process – the Office should permit patent owners to file a motion to dismiss the proceeding shortly after it commences if the Office’s earlier consideration of the claim construction statement might have caused it to deny the petition in the first place. In other words, if the statement might have caused the Office to conclude that the petition failed to satisfy the relevant threshold standard, the Office should be willing to entertain a motion to dismiss the proceeding for lack of sufficient evidence. Similarly, patent owners should be permitted to request termination of ex parte reexamination proceedings based upon such claim construction statements.

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Thank you for considering the views of the Innovation Alliance on this important issue.

Sincerely,



Brian Pomper, Executive Director  
The Innovation Alliance