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Sent: Monday, November 07, 2011 12:20 AM
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Subject: Inter partes review

RGS Comment # 10 (see disclaimer in RGS Comment #1)

Ms. Gongola:

I appreciate the opportunity to provide comments for the Group 2 Proposed Rule Makings. I have reviewed AIA Sec. 6 relating to the - - Post Grant Review - - and would like to provide some comments. These comments are provided in order to raise potential issues for consideration by the USPTO while drafting the rules and regulations, and not to encourage any particular view or outcome. As such, these comments do not necessarily reflect my individual views or the views of my firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.

The question that must be answered in an inter partes review is whether the claimed invention is patentable over the patents and printed publications and the obviousness double patenting issues adopted in the petition that have satisfied the RLP standard. The patent owner must be allowed to present the full story of the invention and the petitioner must be allowed to present why the claimed invention is not patentable over the patents, printed publications and odp issues. Attorney argument does not suffice. Rather there must be full record evidence on each side of the issue. This evidence comes into the record under rule 132 and 131 affidavits or declarations. The people who can present this evidence is a broad group including experts, inventors, objective evidence of non-obviousness declarants and others. The IPR law recognizes this and unlike current ex parte and inter partes reexamination practice allows for depositions of the affiants and declarants. These depositions are important to make sure that the record evidence is truthful and unbiased.

The IPR process must be constructed to allow for this record evidence to be presented and for each side to cross examine the other's evidence through deposition testimony. This must occur before the full hearing on the IPR before the PTAB. With the time requirements for completion of the IPR, the Office must set up a process that allows each side ample opportunity to develop and defend its case.

The petitioner has up to one year after having been sued to bring an IPR on the patent in suit. If not yet sued, the petitioner can bring the IPR as soon as it wants on or after September 16, 2012. Thus, there is an inherent advantage for the petitioner over the patent owner because of this additional time. The Office must allow the patent owner the opportunity to defend against the ordering of the IPR. This means that the patent owner must be given sufficient time to mount this initial defense.

The estoppel provisions force the petitioner to make the election to litigate its patent, printed publication and odp defenses at the Office instead of the federal courts and USITC. In order to encourage the petitioner to use the IPR process, the petitioner must be able to put on a full and complete defense. The patent owner likewise must be allowed to fully defend its patent. This means that the record must be developed for both sides before the PTAB hearing and that the PTAB hearing be sufficient in length (e.g. 4 hours on the average) so that the 3 APJs can ask all of their questions and have all of their concerns addressed by each side. The purported 20 minute PTAB hearing that is being talked up by senior Office officials is not sufficient and will severely prejudice the IPR process. The Federal Circuit, which is the first appellate tribunal above the PTAB, must have a full record for the appeal. Otherwise, the IPR process will be fundamentally flawed.

Thank you

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