

From: Vockrodt, Jeff [e-mail address redacted]
Sent: Wednesday, November 09, 2011 3:10 PM
To: aia_implementation
Subject: Inter partes review

Dear Ms. Gongola:

I would like to offer the following comments regarding the manner of service of papers in connection with rulemaking for the inter partes review and post-grant review proceedings under Section 6 of the America Invents Act. These comments are offered from my own perspective as a practitioner, and former examiner, who now represents numerous requesters and patent owners in inter partes reexaminations before the Office. These comments do not necessarily reflect the views of my firm or its clients.

Under inter partes reexamination rules (37 C.F.R. 1.903), service of papers on the opposing party is provided by 37 C.F.R. 1.248(a)(4), which allows for "[t]ransmission by first class mail" such that "[w]hen service is by mail the date of mailing will be regarded as the date of service." Service by first class mail (standard U.S. Postal mail) is slow relative to express mail or next-day courier services, and has in many cases resulted in week-long delays in service. Further, scanning delays associated with the PAIR system can result in papers not being publicly available from the Patent Office for several days or weeks after filing. Where deadlines are tight, such as the 30-day comment period for inter partes reexamination, parties may choose slow methods of service and filing for purely tactical advantage.

Given the need to expedite post-grant review proceedings while providing due process to the parties involved, the Office should not allow service to occur via standard U.S. Postal mail under 37 C.F.R. 1.248(e). Rather, service on opposing counsel should be required to occur electronically or via a web portal as is specified in recent standing orders of the B.P.A.I. Interference Trial Section. Service by other means such as express mail could still be permitted where electronic service is not possible, as with the filing of an initial petition for review.

Thank you for the opportunity to provide comments in connection with the rulemaking process.

Sincerely,
Jeff B. Vockrodt