Comments on

Proposed Rules for Inter Partes Review

77 Fed. Reg. 7041, February 10, 2012

Proposed Rules for Post Grant Review

77 Fed. Reg. 7060, February 10, 2012

Julie Goldemberg
Student Fellow, Center for Technology, Innovation, and Competition
University of Pennsylvania Law School

R. Polk Wagner
Professor of Law
University of Pennsylvania Law School

April 10, 2012

Comment 1:

The Patentee Does not Have Enough Time to Prepare a Merits Response

In the current version of the rules, the patentee has two months from the institution of the inter-partes or post-grant review proceedings to file her merits response including her affidavits and other supporting evidence.[1] This is not enough time to craft a complete defense of an important patent.

Of the 14 district courts that have established local rules regarding time schedules, all but three (the Western District of Pennsylvania, the Northern District of Illinois, and the Northern District of Georgia) allow always for more than four months between when the complaint is filed and when a *Markman* hearing occurs.[2] Many only start ticking the clock once the parties have exchanged terms that they want to be construed. The chart below summarizes these local rules. It should be noted that the times in the table identify the shortest possible time allowed; many of the local rules allow the judges to grant more time when necessary for scheduling or for meritorious requests.

District	Time	From when to when
Southern District of Texas (rules available here)	At 5.25 months	From preliminary invalidity contentions to claim construction hearing
Northern District of California (rules available here)	At least 4.5 months	From the parties simultaneously exchanging a list of claim terms to be construed and elements that should be governed by 35 U.S.C. § 112 ¶ 6 to claim construction hearing
District of	At least 4.75 months	From preliminary disclosure

[1] We acknowledge that it is possible that the patentee will have more than two months warning concerning the merits response due date — although the patentee will not be certain of the need for a merits response. The merits response is due two months after the institution of proceedings which, coupled with the two month period to respond to the initial petition, gives the patentee a minimum of four (and likely more) months of warning that a merits response might be required. See 77 Fed. Reg. at 7060 (inter-partes), 77 Fed. Reg at 7080 (post-grant). Indeed, this "pre-warning" of the possibility of a merits response may place patentees in the difficult position of choosing to expend resources to prepare for the merits response prior to the notice of proceedings — when in many cases these expenditures will be unnecessary.

[2] Although these three districts' rules make it feasible that less than four months pass between when the complaint is filed and when a *Markman* hearing occurs, such a quick schedule is unlikely, and all the districts allow the parties to take more time when necessary.

Massachusetts (rules available here)		to claim construction
District of New Jersey (rules available here)	At least 7 months	From exchanging initial lists of claim terms that they dispute to date when parties *propose Markman* hearing schedule
Western District of Pennsylvania (rules available here)	At least 3 months	From when the parties first simultaneously exchange a list of claim terms to be construed and claim elements which the parties contend should be governed by 35 U.S.C. § 112 ¶ 6 to the *Markman*
Eastern District of North Carolina (rules available here)	At least 6.25 months	From service of the Preliminary Non-Infringement to Invalidity Contentions
Northern District of Georgia (rules available here)	At least 3.75 months	From when the parties first simultaneously exchange a list of claim terms to be construed and claim elements which the parties contend should be governed by 35 U.S.C. § 112 ¶ 6 and claim construction ruling; if, after the Court issues its claim construction ruling, there are fewer than 30 days left in the discovery schedule, the parties will receive 45 days in which to take discovery after the Court files its claim construction ruling.
Western District of Washington (rules available here)	At least 7.75 months	From when the parties first simultaneously exchange a list of claim terms to be construed and claim elements which the parties contend should be governed by 35 U.S.C. § 112 ¶ 6 to claim construction hearing
District of Minnesota (rules available here)	No defined time schedule	

Southern District of California (rules available here)	At least 4.5 months	From service of preliminary invalidity contentions to claim construction hearing
Northern District of Illinois (rules available here)	At least 4 months	From when the parties first simultaneously exchange lists of claim terms to be construed as well as proposed constructions, elements that should be governed by 35 U.S.C. § 112 ¶ 6, and the function and structure/acts/materials corresponding to such 112 ¶ 6 elements to when the court issues an order describing the schedule and procedures for the *Markman* hearing
Eastern District of Texas (rules available here)	At least 5 months	From when the parties simultaneously exchange a list of claim terms to be construed and elements that should be governed by 35 U.S.C. § 112 ¶ 6 to a claim construction hearing
District of Maryland (rules available here)	At least 5.25 months	From the date of the Scheduling Order to when parties file and serve any responsive brief and supporting evidence directly rebutting their opponents supporting evidence and identifying any additional proposed Claim Construction Hearing witnesses.
Western District of Tennessee (rules available here)	At least 5.25 months	From when the Responsive Pleading is filed to the *Markman* Hearing
Central District of California (rules available here)	At least 4.5 months	Adopted the Northern District of California's Rules

The proposed rules, however, allow significantly less time for this process to occur. Patentees will struggle to find the appropriate experts, take affidavits, and prepare evidence in such a short

time. It could decrease the quality of submissions of evidence and deprive patentees of their ability to defend otherwise valid patents.

Comment 2:

The Proposed Rules Provide No Information About Claim Construction

Perhaps most troublingly, the proposed rules fail to provide any guidance for the claim construction process. Patent litigation practice has revealed that claim construction will necessarily set the stage for all aspects of the validity dispute — including, for example, the scope of the prior art and the relevance of arguments under 35 USC § 112.[3]

As noted above, most district courts with local patent rules have found it to be more efficient to conduct claim construction hearings in advance of the actual patent infringement suit. Indeed, most of the timing rules are explicitly linked to the date of the claim construction. However, the proposed rules are silent on this aspect of patent law, which raises several questions:

- Will the notification of the initiation of inter-partes / post-grant review include a claim construction analysis by the Board?
- Does the patentee's merits response include a responsive or proposed claim construction analysis?
- Will claim construction be handled via supplemental information filings?
- What will be the timing of such a claim construction analysis?

In our view, the procedural and timing aspects of claim construction must be addressed in the proposed rules. Claim construction is fundamental to the evaluation of patentability, and the determination of the scope of a patent claim is of enormous public benefit beyond the scope of the party or parties involved in these review proceedings.

---

[3] *See, e.g., Albemarle Corp. v. Chemtura Corp.*, 2006 WL 5865766 (M.D.La. Feb. 13, 2006) ("Without an earlier Markman hearing, critical for analyzing both infringement and invalidity, the parties will be forced to expend tremendous time and expense in litigating a case all the way through discovery, without the benefit of not only preparing for the Markman hearing and appreciating, early on, the significance of every claim term, but also the benefit of briefing, arguing and eventually receiving the actual Markman claim construction decision.").