

April 10, 2012



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Re: Comments on Changes to Implement Post-Grant Review Proceedings, 77 Fed. Reg. 7060-80 (Feb. 10, 2012) (“PGR Rules”)

The following comments are submitted in response to the USPTO’s request for public comments on their proposed rules for implementing the Post Grant Review provision of the Leahy-Smith America Invents Act (AIA)¹.

The Office is to be commended for the diligence and thoroughness reflected in the proposed PGR Rules, particularly in view of the time frame in which the rules were assembled. With the exception of the provision addressed herein, the PGR Rules are well conceived to implement the statutory mandate embodied by this provision of the AIA.

I. Patentees Will Not File Preliminary Responses if Limited to Attorney Argument

A common criticism of current reexamination practice is that Patentees are not given an opportunity to respond to a request for patent reexamination. Rather, they must sit helplessly by and await the determination of the USPTO to grant or deny the request. For this reason, as well as the relatively liberal Substantial New Question (SNQ) threshold that was historically applied in all patent reexamination proceedings (modified on September 16, 2011 for *inter partes* patent reexamination by enactment of the AIA), reexamination grant rates have hovered around 93%.

In order to address the relative inequities between the contesting parties, and perhaps to a lesser extent the high grant rate, the AIA post grant proceedings employ higher threshold standards (*Reasonable Likelihood of Prevailing* (RLP) standard for PR; and the *More Likely Than Not* standard for PGR). In addition, prior to ordering a trial in either of the new proceedings,

¹ These comments were first published on www.PatentsPostGrant.com and constitute the commentary of the authors alone.



Patentees are afforded the option of submitting a “preliminary response”. (Rules 42.107; 42.207)

However, a preliminary response may not include new testimonial evidence (42.107; 42.207). Thus, attorney argument of the Patentee will be often times weighed against the declaration evidence of the challenger. Practically speaking, by including such evidence in their petition, a challenger would be virtually assured of meeting the RLP or MLN standard in the face of the mere attorney argument of the Patentee. Based upon Rule 42.107/207, it seems unlikely that a Patentee would pursue such an otherwise well intentioned preliminary response mechanism, and the intent of Congress to improve the Patentee position relative to current reexamination practices would be undermined.

Recommendation (Allow Limited Declaration Evidence in Rebuttal)

It is acknowledged that the Office prefers to weigh evidence during the actual trial. Yet, some evidentiary rebuttal from a Patentee is necessary to ensure a balanced, fair determination process as contemplated by Congress. For example, such Patentee evidence could be accepted by the Office if responsive to a petition that included declaration evidence. Such a practice would help focus the contested issues in a more cost effective and timely fashion, thereby aiding the Office in meeting its statutorily mandated 12 month trial period for PGR.

II. The Authorization to File Supplemental Information Should Protect Patentees from Gamesmanship

Rule (42.123; 42.223) provides that a petitioner may seek authorization to file supplemental information relevant to a ground for which trial has been instituted. If not properly policed, such supplemental information could allow a third party to further refine their positions based on the preliminary response of the Patentee. If the authorization to file supplemental information is not tightly controlled Patentees will be further discouraged from filing preliminary responses, as doing so would open the door to introduction of further evidence by the petitioner via a supplemental information statement.

Recommendation (Require an Interests of Justice Standard for Authorization)

The need to provide supplemental information to the Office within 6 months of filing a petition should be a rare event; especially given the fact that petitioners may have, in some cases, years to prepare their petition. For this reason, the filing of such supplemental information should be closely scrutinized. It is recommended that the Office adopt an “interests of justice” standard for granting authorization to file supplemental information.



Should you require further clarification or explanation with regard to any of the above, please feel free to contact us.

Very truly yours,

Oblon, Spivak, McClelland,
Maier & Neustadt L.L.P

A handwritten signature in black ink, appearing to read "S. McKeown".

Scott A. McKeown

A handwritten signature in black ink, appearing to read "Stephen G. Kunin".

Stephen G. Kunin

A handwritten signature in black ink, appearing to read "G. Gardella".

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