From: Rob Sterne [e-mail address redacted]
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To: aia_implementation
Subject: Post grant review

R.G. Sterne - - Comment #1

Disclaimer: The Office has asked for my input on the implementation of the AIA, particularly contested proceedings. I am fortunate to have been on the panels of important CLEs on this topic since September 16th. Additionally, I write and speak extensively on issues involving reexamination and concurrent patent litigation and receive input from multiple sources with varied perspectives. I also enjoy an extensive reexamination practice and have been a registered patent attorney since 1978. With that said, I am providing these comments using the "Swiss Approach" used by the Sedona Conference where both sides of an issue are presented so that a balanced dialogue can occur. The comments presented are not at the request of any client and are provided to help the Office arrive at the best process and procedure for these new proceedings. They do not necessary reflect my views or the views of my firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.

Comment #1 - - More Time Is Essential

The present timeline for Group 2 according to the Office is dictated by the September 16, 2012 deadline. November 6th is the requested input date and November 15th is the cutoff. That is not enough time.

Once the Office submits its proposed rule packages to OMB on November 15th, the proposed provisions "start to lock down" (Office parlance) and it becomes substantially harder to change them despite any public opposition or comment.

The AIA is arguable the most profound and sweeping change to U.S. patent law since the creation of the Federal Circuit in 1982 and perhaps the promulgation of the 1952 Patent Act. The extent of change is breathtaking and it is arguably humanly impossible for a full, fair and comprehensive set of rules and regulations for the multiple packages be put together by November 15th. Public input under the current schedule is essentially denied by the November 6th effective deadline.

The current Office administration is widely viewed as having done an outstanding job in reaching out to all stakeholders in the patent system and engaging in true communication. But the current deadlines undercut all of that and will have fundamental and lasting damaging effect to this communication record and the implementation of these powerful new proceedings.

The Office must provide a period for robust and comprehensive dialogue on these new contested proceedings with all parts of the patent community. Such approach will ensure that the system that is created to implement these new processes is full, fair and comprehensive.

With the new estoppel provisions contained in the PGR and the IPR, they will essentially replace the U.S. District Courts in determinations on the validity of issued patents. Such power is enormous and patent rights must be respected. The rights of patent owners and requesters must also be fully respected, as well as the integrity of the patent system. Thus, the rules and regulations implementing these contested proceedings must be as effective as those of the U.S. District Courts. Anything less detracts from the U.S.PTO process and undermines the U.S. patent system, which is perceived by many as the most effective in the world.

For these reasons, the Office should extend its current implementation process by a sufficient amount of time - - 6 months is a good period - - so that there is ample time to obtain full public input and to properly process and evaluate it. Anything else will fundamentally short-circuit the rulemaking process in violation of the spirit and intent of the APA. The additional 6 months would allow for town meetings and other public forums and debates BEFORE the proposed rules are sent to OMB.

While this would delay activation of these Group 2 proceedings for 6 months, it would protect patent rights and the U.S. patent system, which must be the fundamental objective of this rule making process.

Thank you.

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