From: Rob Sterne [e-mail address redacted]
Sent: Thursday, November 03, 2011 4:27 PM
To: aia_implementation
Cc: [e-mail address redacted]
Subject: Post grant review; inter partes review

Rob Sterne Comment # 6 (see disclaimer in RGS Comment #1)
Ms. Gongola:
My colleague Jon Wright and I appreciate the opportunity to provide comments for the Group 2 Proposed Rule Makings. We have reviewed AIA Sec. 6 - - Post-Grant - - 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 our individual views or the views of our firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.
Duty of Disclosure: Post grant review (PGR) and inter partes review (IPR) are not examinational proceedings. Rather, they are adjudicative proceedings on issued patents. As such, the duty of disclosure that currently plagues inter partes and ex parte reexaminations should be eliminated from PRG and IPR proceedings. The PTAB will likely not have the resources to consider information disclosure statements. And the Patent Owner’s resources are much better spent addressing the merits of the petition rather than preparing information disclosure statements that the PTAB will not consider in any event. The Office should therefore strongly consider an affirmative rule stating that the Rule 56 duty of disclosure does not apply in PGR and IPR proceedings. Of course, this will have no impact at all on every practitioner’s (Patent Owners and Petitioners) obligation to deal with the Office in good faith under Rule 11.18 and others.
Thank you
Robert Greene Sterne and Jon E. Wright