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Sent: Tuesday, November 08, 2011 10:29 PM
To: aia_implementation
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Subject: Post grant review

RGS Comment # 12 (see disclaimer in RGS Comment #1)

Ms. Gongola:

We appreciate the opportunity to provide comments for the Group 2 Proposed Rule Makings. We have reviewed AIA Sec. 6 relating to the - - Post Grant Review - - 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 my individual views or the views of our firm - - Sterne, Kessler, Goldstein & Fox, PLLC - - or its clients.

The PGR proceeding will require a discovery system that will allow the petitioner to obtain the needed information for the available defenses with sufficient time for it to be part of the record used by the PTAB in reaching its decision. Since the AIA requires that the PGR proceeding be completed in one year under most circumstances, the discovery system must be able to be effective within the very short time period that the petitioner and the patent will have to prove its side of the case.

The discovery system for Section 337 investigations in the USITC ("Commission") may provide a good model for the Office to develop a fast-track PGR discovery system. For example, discovery in Section 337 investigations is usually completed within 8-10 months after an investigation is instituted, and typically requires materials be collected and produced from both domestic and international locations (given the importation requirements of Section 337). Section 337 investigations are further presided over by administrative law judges, in compliance with the Administrative Procedures Act, and afford the parties a full, due process, evidentiary hearing. The Office would be well served to consult with the Commission about the strengths and weaknesses of its discovery system, which has been in place for decades.

For instance, a PGR proceeding may well benefit from the following mechanisms, which are used in Section 337 investigations, to ensure that discovery is completed within the expedited time requirements proposed by the Office:

- o Establishment of PGR "adjudication and enforcement" provisions, similar to those used in Section 337 investigations such as 19 C.F.R. § 210 et. seq., to address general applicability, commencement of proceedings, e-filing, confidential treatment of information, pleadings, motions, discovery obligations including e-discovery, enforcement procedures, administrative review, sanctions for failure to comply, etc.;

- o Policy on the adoption of the Federal Rules of Civil Procedure, to the extent consistent with PGR administrative provisions;

- o Creation of a model "procedural schedule" for PGR proceeding events and deadlines;

- o Establishment of model "ground rules" to govern the PGR proceedings, e.g., allowable types of discovery, such as document requests, interrogatories, requests for admission, depositions, subpoenas, and limitations upon them, motions practice, computation of time, deadline extensions, translations, authenticity, protective orders, privileged matter, etc., and authority for PGR presiding administrative patent judges to enforce; and

- o Policy on ex parte contacts with the Office and/or PRG APJs.

It is our belief that by adopting a procedural and discovery mechanism similar to Section 337 investigations before the Commission, PGR proceedings may be carried out in an efficient and effective manner, compliant with the due process requirements of the Administrative Procedures Act.

In devising the discovery system, the Office must stay true to the

fundamental concept that each side of the PGR proceeding must be able to prove or defend the defenses involved in the patentability determination to the same degree they would be able to do in a comparable validity challenge of the patent in the federal courts or the USITC. Otherwise, the PGR system will be skewed and distorted and will act to encourage or discourage the use of PGR in violation of the Congressional intent behind PGR.

Thank you

Robert Greene Sterne and Daniel E. Yonan