

Response to "Request for Comments: Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board," 79 FR 36474 (June 27, 2014)

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Copied below are my comments submitted to the USPTO on AIA proceedings before the PTAB.

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## I. INTRODUCTION

On June 27, 2014, the USPTO solicited comments from the public on "all aspects of the new administrative trial proceedings, including the administrative trial proceeding rules and trial practice guide." 79 FR 36474.

I appreciate the opportunity to comment on this issue. I am patent attorney with a practice that has focused on Board proceedings, formerly before the BPAI, now before the PTAB. Since 2002, I have administered the group site devoted to Board practice, the <https://groups.yahoo.com/neo/groups/PatentInterPartes/info> site. Participants of this site identify relevant PTAB decisions and discuss issues relevant to PTAB practitioners. I have been counsel in a large number of patent interferences and a growing number of PTAB AIA proceedings. My comments herein below are based upon my experience in Board proceedings.

## II. PTAB DECISIONAL TRENDS

I note that there is an appearance, based upon decisions in PTAB AIA proceedings, that when PTAB AIA proceedings first came into effect, the PTAB had a pro petitioner bias. Based upon more recent PTAB decision in AIA proceedings, there is an appearance of a trend away from the perceived pro petitioner bias. For example, in Apple Inc. v. Virnetx Inc., IPR2014-00237, paper 24 (PTAB 6/30/2014) (Opinion by Lead APJ Tierney, for a panel consisting of APJs Tierney, Easthom, and Siu), in addressing earlier decisions in AIA proceedings by the PTAB, the panel stated "Even if it did, we would not be compelled to reach the same result because those cases are not precedential." Moreover, in Zetec, Inc. v. Westinghouse Electric Company, LLC, IPR2014-00384, paper 10 (PTAB 7/23/2014) (Opinion by APJ Benoit, for an expanded panel consisting of Vice Chief APJ Boalick, and APJs Horner, Turner, Benoit, and Powell), an expanded stated "we exercise our discretion and do not institute an *inter partes* review of any claim in the '269 patent for reasons of administrative efficiency." Furthermore, on September 26, 2014, the PTAB posted to its "Informative Opinions" web page seven decision, all of which dealt with the PTAB's discretion under 325(d) to reject petitions, and application of that discretion.

If in fact the PTAB determined that it was too pro petitioner when AIA trials came into

being and has changed its determination, it should announce that fact along with its reasons for change. If the PTAB feels that it should now enforce either the statute or rules differently than it did early in the days of PTAB AIA proceedings, it should announce that fact along with its reasons for change. While informative decisions are helpful, the PTAB should not attempt to announce policy changes inferentially, for example by selectively publishing PTAB decisions as informative decisions.

### III. MOTIONS TO AMEND A PATENT

There is also a belief amongst many PTAB practitioners that the ability obtain grant of a motion to amend a patent is unduly limiting, and that the scope of such a motion is unduly limiting. The PTAB case law has generally restricted the statutory "reasonable number of substitute claims," to one. The PTAB default page limit for a motion to amend generally precludes sufficient showings to have a motion to amend granted. It is not enough, in my view, for the PTAB to point out that one or two such motions have been granted, and it is not enough for the PTAB to explain why those motions were granted. Instead, the PTAB should rethink its limitations on motions to amend in view of the public policy advantage of settling all issues on patentability promptly, and in one proceeding.

### IV. "OFFICE PATENT TRIAL PRACTICE GUIDE; RULE"

The PTO promulgated three sets of rules for PTAB AIA trials; the generally applicable rules; the proceeding type specific rules; and the "Office Patent Trial Practice Guide; Rule" (Herein after "Guide"). The structure and format is confusing because it requires practitioners to reference three separate sources. The least referenced is the Guide. The most burdensome to read is the Guide. Without specific comments, I suggest that any requirement or clarification of rule requirements now contained only in the Guide and not contained in the numbered rules in 37 CFR 42, should be incorporated into the numbered rules. That is, the Guide should be a Guide to practice, and not be the sole source of rule requirements with which PTAB practitioners must comply.

### V. SPECIFIC RULES

I list below in abbreviate form the rules which I think you should consider revising and what the revision should be. Reasons for these proposed revisions are generally well known and therefore not state herein below.

42.6 - Claim charts: You should include a definition of claim charts. You should define claim charts to exclude anything other that claim recitations, citations to non declaratory evidence, and quotations from non declaratory evidence. You should ensure the definition excludes citations to declaratory and deposition evidence.

42.6 - Block quotes: You should allow block quotes to be single spaced.

42.6 Incorporation by reference: You should provide that incorporation by reference requires authorization from the Board, so that you have authorization to allow incorporation by reference in those many situations were the exact same argument is applicable either in the same

proceeding, or in related proceedings.

42.6 - Electronic filing: The "parameters established by the Board" should allow documents to be filed using backup counsel's login credentials.

42.6 - Service: You should provide that service may be made electronically to electronic mail addresses specified in the mandatory notices, instead of "by agreement of the parties".

42.10 - *pro ha vice*: Consider incorporating your case law criteria into a revised rule.

42.20 - Burdens: Change item (c) to refer to both the burdens of proof and persuasion. Also to avoid doubt, change item (c) to refer to the "petitioning or moving" party, instead of just the "moving party."

42.23 - Vagueness: Change "material facts in dispute" to "material facts, contained in a 42.22(c) statement of material facts, in dispute".

42.24(a)(1) - Vagueness: Change "any statement of material facts" to "any statement of material facts pursuant to 42.22(c) and 42.23(a)".

42.24(a)(v) - Motion page limits: Change to "Motions, other than motions to amend: 15 pages. Motions to amend; 60 pages."

42.53(g) - Vagueness: Change "all costs associated with the testimony" to "all costs associated with producing the witness; providing the officer and having the officer record the testimony; and providing the certified transcript of the testimony to all other parties"

42.64 - Objections to evidence: The rules should be changed to provide for filing of objections to evidence as exhibits. Under current practice, there is no record before the Board of the service of objections and therefore a dispute as to timeliness of service can arise.

42.64 - Supplemental evidence: The rules should be changed to provide for filing of supplemental evidence as exhibits. Under current practice, there is no record before the Board of the service of supplemental evidence, and therefore a dispute as to timeliness of service can arise. The Board is unable to determine whether cross-examination of supplemental declaratory evidence, is warranted, because that evidence is not before the Board for evaluation.

42.65(a) - Weak standard: Change "little or no weight" to - - "no weight". A chronic problem with Board proceedings is the battle of the experts. The Board's determination of which expert is correct, should not depend upon the cross-examination skills of the practitioner. Instead, it should depend upon the clarity and factual basis in the record of the expert's opinion. The Board has long failed to appreciate that slick declarations cause tremendous unnecessary additional work for the parties, requiring additional preparation and due diligence in preparing for and taking cross-examination, and in rebutting conclusions in slick declarations with rebuttal evidence. Additional support for this rule change appears in Federal Rule of Evidence 702(b) and (d).

42.104(b)(4) Vagueness: It is not clear from this rule whether it contains one or two requirements. Is the "How the construed claim is unpatentable ..." merely a foundation for "The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon"? Is "How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section" a separate required showing? You should revise to clarify your requirements. For example, by making each sentence a separately identified subsection of (b)(1) if they are indeed separate requirements. If not separate requirements, you should flip the order of the two sentences and clarify that the "How the construed claim" is unpatentable under the statutory grounds in view of the disclosures at the

cited location in the prior art patents or printed publications.

42.121 - Motion to amend in an IPR: Please see my general comments, in section III above.

42.121(b)(1) - Change "The support in the original disclosure of the patent" to "The support in the original disclosure of the application from which the patent issued".

42.204(b)(4) Vagueness: Same issue as for 42.104(b)(4).

42.221 - Motion to amend in a PGR or CBM: Please see my general comments, in section III above.

42.301(b) - "Technological invention" definition: Your definition apparent fails to reflect case law placing the burden to show both factors of this test are satisfied. The rule, as written, merely states that both factors will be considered, not that both factors ("claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art"; and "claimed subject matter as a whole recites a technological feature that ... solves a technical problem using a technical solution") must not exist, for the claim to not define a "technological invention". Cf. GSI Commerce Solutions, INC. v. Lakshmi Arunachalam, CBM2014-00101, paper 10 (PTAB 10/7/2014) (Decision by APJ McNamara, for a panel consisting of APJs Easthom, Saindon, and McNamara)("Therefore, Petitioner has not shown that claim 2 and claims 5–19, which depend from claim 2, qualify for covered business method patent review because Petitioner has not shown that these claims do not recite a technical solution to a technical problem.").

## VI. PRPS

While the USPTO works to replace PRPS with a more robust system, there are some very minor changes that would greatly improve PRPS usefulness.

The PRPS main search interface contains filters identifies as "Party Name"; "Institution Date"; and "Filing Date". However, "Party Name" is mis-descriptive. The only field searched by data entered in to the filter field associated with "Party Name" is the petitioner name.

Change the text "Party Name" to "Petitioner Name" in the filter now named "Party Name".

Add a search filter for Patent Owner named "Patent Owner"

Respectfully,  
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