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The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
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Via e-mail to trialrules2015@uspto.gov

*Re: Comments on Proposed Amendments to the Rules of Practice for Trials
Before the Patent Trial and Appeal Board*

Dear Director Lee:

Oblon, McClelland, Maier & Neustadt L.L.P. (“Oblon”) appreciates the opportunity to comment on the U.S. Patent and Trademark Office’s (“Office”) proposal to amend the Rules of Practice before the Patent Trial and Appeal Board published in the Federal Register on August 20, 2015. 80 F.R. No. 161 at 50720. Overall, Oblon supports the proposed changes and applauds the initiative of the Office to continually refine these critically important alternatives to high-cost patent litigation. The proposed changes are well developed, targeted adjustments that will improve AIA trial practices going forward.

The following specific comments are based on our review and understanding of the proposed rules. Our comments are organized in the order of the discussion of the proposed rules in the Federal Register notice.

Claim Construction Standard

The Office proposed amending the rules to specify that a *Phillips*-type claim construction will be applied for claims of a patent that will expire prior to the issuance of a final decision, partially because such patents “lack any viable opportunity to amend the claims in an AIA proceeding.” 80 F.R. No. 161 at 50722. In view of this proposal, the PTO has invited comments on how to structure guidelines to implement this change.

We propose modifying the guidelines to require petitioners to include a statement in the petition indicating that they have calculated the expected date of expiration of the patent, setting forth their calculations, indicating the date on which they expect the patent to expire, and explaining that the appropriate claim construction standard has been applied. If the petitioner indicates that the expected expiration date is within two years from the filing date of the petition, the petition should apply a *Phillips*-type claim construction. Conversely, if the petitioner indicates that the expected expiration date is more than two years from the filing date of the petition, the petition should apply a broadest reasonable interpretation.¹

Two years is the appropriate amount of time necessary to cover PTAB proceedings. From the time a petition is filed, patent owners have up to three months to file a preliminary response. After expiration of that time period, the PTAB has up to three months to decide whether to institute trial. Trial is statutorily mandated to last twelve months or less. Accordingly, most PTAB proceedings will take approximately eighteen months to complete from the time the petition is filed. However, in certain circumstances a six month extension is possible, and thus calculating patent term with two years from the date of the petition covers both regular proceedings as well as those that may be extended.

A bright-line calculation (two years from the date the petition is filed) and statement of compliance is an efficient, simple solution for petitioners and patent owners addressing this issue. No additional briefing would be required, and parties would not have to make contingency arguments under both standards.

Patent Owner's Motions to Amend

The Office summarized several responses in Comment 4. Commenters suggested that patent owners should not be required to cancel a challenged claim in order to submit a substitute claim. 80 F.R. No. 161 at 50723.

As the Office is aware, cancelling a challenged claim is not required before a substitute claim is submitted. As stated in C.F.R. § 42.221(a)(3), “[a] motion to amend *may* cancel a challenged claim *or* propose a reasonable number of substitute claims” (emphasis added). However, since numerous commenters appear to be unclear about this rule, we suggest additional clarification in the guidelines to aid practitioners in this area. Specifically, guidance on presenting contingent amendments where a patent owner argues for the original claim but also provides arguments directed to a back-up amended version of the claim may be beneficial.

¹ That being said, we believe that in many circumstances, *Phillips*-type claim construction and broadest reasonable interpretation result in the same constructions.

General Topics

Comment 11 – Improvements to PRPS

In the Notice, the Office explained it is working with vendors to improve PRPS and provide additional functionality. 80 F.R. No. 161 at 50739. We look forward to an improved system in the future. Based on our experience with PRPS, we make the following suggestions:

- Improve functionality by including an option to select multiple documents to download;
- Improve functionality by including an option to order/filter documents by filer (Petitioner/Patent Owner/Board);
- Improve functionality by adding an “exhibit list” item to the filing drop down menu, because updated exhibit lists are often concurrently submitted with other filings;
- Improve ease of use by adding the names of the Administrative Patent Judges for each case to the information screen;
- Correct processing problems where documents are occasionally corrupted post-uploading (*i.e.*, PDFs uploaded without problem, and then showing random, greyed out blocks throughout the document).

Comment 19 – Deposition Rules

The Office noted that it believes that the guidance in the Office Patent Trial Practice Guide “strikes the right balance concerning when a party may confer with its witness” and thus proposed no rule changes on the issue of conferring with witnesses. 80 F.R. No. 161 at 50741. Specifically, the Testimony Guidelines state (in part):

6. Once the cross-examination of a witness has commenced, and until cross-examination of the witness has concluded, counsel offering the witness on direct examination shall not: (a) Consult or confer with the witness regarding the substance of the witness’ testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a Board order; or (b) suggest to the witness the manner in which any questions should be answered.

77 F.R. No. 157 at 48772.

Although these guidelines clearly indicate that conferring between a witness and counsel is not permitted for any purposes other than determining privilege, in our experience not all practitioners and panels follow these guidelines strictly. *See, e.g., FLIR Systems, Inc. v. Leak*

Surveys, Inc., IPR2014-00434, Paper 12 (Feb. 10, 2015). Since we strongly believe that the guidelines set forth the appropriate rule, we respectfully request that a more definitive statement prohibiting witness coaching is required. Furthermore, guidelines explaining how parties should address suspected coaching and potential sanctions for such coaching may also be useful.

Additional Comments Not Addressed by the Proposed Rules

Although the Office did not propose rules specifically directed to construing means-plus-function claims or issues of joinder, we provide the following comments based on our experience with these issues and respectfully request they be considered by the Office.

Means-plus-function Claims

If the challenged claims include a means-plus-function or step-plus-function limitation (i.e., § 112, ¶ 6), the petition must identify the portions of the specification that describe the structure, material, or acts corresponding to each claimed function (if any). *See* 37 C.F.R. § 42.104(b)(3). However, the recent Federal Circuit case *Williamson v. Citrix Online, LLC* substantially weakened the presumption of whether or not § 112, ¶ 6 applies. *See* 792 F.3d 1339, 2015 U.S. App. LEXIS 10082 (Fed. Cir. 2015) (*en banc*). *Williamson* held that § 112, ¶ 6 applies if the claim term fails to recite sufficiently definite structure or else requires function without reciting sufficient structure for performing that function. 2015 U.S. App. LEXIS 10082, at *19. This holding indicates there is no bright line rule for determining applicability of § 112, ¶ 6, and petitioners and patent owners are likely to dispute whether or not a particular nonce term invokes § 112, ¶ 6.

We respectfully request that additional guidance should be issued as to when mapping of a means-plus-function claim is necessary. For example, is mapping only required when the nonce word “means” is used? If the parties dispute whether or not § 112, ¶ 6 applies, will it be addressed at trial or by briefing beforehand? Is failing to map a non-means claim term argued by the patent owner in the preliminary response to fall under § 112, ¶ 6 sufficient grounds to deny institution of trial?

Because of the ambiguity created by the *Williamson* case, we suggest that the easiest solution is to remove the mapping requirement set forth in 37 C.F.R. § 42.104(b)(3), while maintaining the requirement that the petition includes claim construction. In that way, parties have an opportunity to address terms they believe to invoke § 112, ¶ 6 without providing a procedural loophole with which to deny petitions.

Joinder Based on Identical Petitions

Under 35 U.S.C. § 315(c), the director may join a party to an *inter partes* review if that party properly files a petition. In many instances, the party seeking to join simply files the *same* petition, as contemplated by Congress:

The Office anticipates that joinder will be allowed as of right—if an *inter partes* review is instituted on the basis of a petition, for example, *a party that files an identical petition will be joined to that proceeding*, and thus allowed to file its own briefs and make its own arguments. If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent.

Comments by Senator Kyl, 157 Cong. Rec. S1376 (emphasis added).

When “copycat” petitions are filed, the patent owner again gets up to three months to file a preliminary response, substantially delaying proceedings and complicating joinder of proceedings. In cases where the petition raises no new challenges or issues, we suggest modifying the rules so that the patent owner is given a default period to respond that is a much shorter period (e.g., 4 weeks) to reduce teleconferences with the Board and unnecessary scheduling disparities.

Very truly yours,

OBLON, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

/Scott A. McKeown/

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