

From: Brad Pedersen
Sent: Monday, November 07, 2011 5:35 PM
To: ai_implementation
Subject: Post grant review

Patterson Thuent e Suggestions for Group 2 Rulemakings:
Subgroup 7 – Post Grant Review (PGR) Specific Rules

The law firm of Patterson Thuent e Christensen Pedersen (“Patterson Thuent e”) appreciates the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings – Subgroup 7 –Post Grant Review (PGR) Specific Rules.

Patterson Thuent e is a firm with significant experience in the areas of ex parte reexamination, inter partes reexamination and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuent e represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of Patterson Thuent e and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuent e understands that the USPTO will not directly respond to these suggestions, and Patterson Thuent e reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 7 – PGR Specific Rules, Patterson Thuent e has the following suggestions:

7.1 Fees for PGR

We suggest that the Office charge a combined fee (part of fee for review of petition and part of fee for running the proceeding), and then refund the portion of the fee for running the proceeding if a PGR is not initiated.

7.2 Fees Ranges for PGR

While we understand that the Office will need to set fees for a PGR that allow the Office to recover its costs in aggregate, we would like to see the fees for a PGR be more than fees for an IPR due to the increased cost potential associated with the expanded grounds for review, but still be preferably less than \$30,000 for a large entity.

7.3 Promulgate Standards for Validity Challenges on Ground Other than Prior Art

We suggest that the Office should promulgate different standards for how a showing of sufficient grounds can be satisfied for ground of invalidity other than prior art under new Section 102.

We would also reference our comments on the umbrella rules package – subgroup 5 – that were submitted under separate email.

Brad Pedersen
Patent Practice Chair

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