

To: Michael Tierney, Vice Chief Administrative Patent Judge  
Via email: [PTABNPRM2020@uspto.gov](mailto:PTABNPRM2020@uspto.gov)

**Re:** Request for Comments on Discretion To Institute Trials Before the Patent Trial and Appeal Board

The Market Institute is pleased to submit these comments on the above-captioned request for comments on this important issue. We commend the U.S. Patent and Trademark Office (“PTO” or the “Office”) for considering, and proposing to amend, its existing Patent Trial and Appeal Board (“PTAB”) rules. The Market Institute supports this important step and we support the regulatory improvements carried out under the leadership of PTO Director Andrei Iancu.

The Market Institute represents more than 13,000 small inventors, and allied professionals and the economic advantage that a strong reliable Intellectual Property system provides the US economy.

The PTAB has inspired inventors to burn patents on the steps of the USPTO, it has been called a patent Death Panel by well respected judges, and previous directors have used it as a kangaroo court to pursue their own interests.

Director Iancu has worked hard during his tenure as Director to bring order to the PTAB, to quiet title at the PTAB, and restore faith in the US Patent System.

This is all necessary because of the The America Invents Act which was enacted on September 16, 2011 (“AIA”). The AIA established new proceedings at the PTO for challenging the validity of issued patent claims in AIA administrative trials. Such a trial may be an inter partes review (“IPR”), post grant review (“PGR”), and covered business method (“CBM”) patent review. The Director of the PTO is vested with authority to institute such proceedings, including authority to deny petitions for institution, and the decision is “final and nonappealable.” The Director delegated by regulation AIA trial institution decisions to the PTAB, and the PTAB conducts the reviews.

The problem is that patent users have used the PTAB as yet another way to bully, pester, and bankrupt patent owners. They have been able to do this because of the way that AIA was constructed and PTAB was implemented. While we would be happy to see the PTAB go away – and possibly another efficient legal structure created – we are happy and supportive of the changes that Director Iancu has implemented.

Therefore, it would be a good start to adopt the changes to the PTAB that the Director has made, but we believe that even more can be done. The goal of any changes to the PTAB need to focus on predictability, rejecting the opportunity for multiple petitions, limiting the legal exposure of inventors to by confronting multiple petitions (which are against the original intent of the law), and focusing on the economic impact of these decisions.

For these reasons and more the Market Institute supports the PTO’s proposal to amend the PTAB institution rules and to help restore fairness and stability to our nation’s patent system.