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Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board

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Discretion to Institute Trials Before the Patent Trial and Appeal Board

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Comment from James Beach-Drummond

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General Comment

I always wanted to be an inventor and entrepreneur.

During my middle and high school years I entered (and won) several science fairs. I enjoyed focusing on real world problems, then working to invent viable solutions applying scientific method and principles. Some of my early scientific "discoveries" carried me into my earliest business ventures. I've built and sold several business over the years, based on intellectual properties that I've been awarded. Each venture growing larger than the previous one, with IP suites becoming more and more complex.

For instance, I invented a water safety device designed to save the lives of children and adults, which has won many commercial awards (US 9,139,271 -among others), and I've designed business methods that allow retailers to more efficiently serve customers that need assistance, through the use of intelligent delivery systems (US 9,741,011 -among others).

At 48 years old, I firmly realize what I've been able to achieve as a successful business owner,

has not been built solely on my ability and passion to create inventive solutions, but also my ability to protect my novel concepts through the constitutional right of the patent bargain. There's no doubt the exclusive rights granted in my patents have allowed me to transform thoughts and hard work, into successful business ventures.

But now, as many of my inventions are primed for broad-scale adoption in the commercial sector, I couldn't be more worried about the current state of the USPTO, and the rights I've been granted by the United States to commercialize my inventions.

I urge adoption of regulations to govern the discretion to institute PTAB trials consistent with the following principles.

I: PREDICTABILITY

Regulations must provide predictability. Stakeholders must be able to know in advance whether a petition is to be permitted or denied for policy reasons. The decision-making should be procedural based on clear rules. Presence or absence of discrete factors should be determinative.

II: MULTIPLE PETITIONS

- a) A petitioner, real party in interest, and privy of the petitioner should be jointly limited to one petition per patent.
- b) Each patent should be subject to no more than one instituted AIA trial.
- c) A petitioner seeking to challenge a patent under the AIA should be required to file their petition within 90 days of an earlier petition against that patent (i.e., prior to a preliminary response). Petitions filed more than 90 days after an earlier petition should be denied.
- d) Petitioners filing within 90 days of a first petition against the same patent should be permitted to join an instituted trial.

III: PROCEEDINGS IN OTHER TRIBUNALS

- a) The PTAB should not institute duplicative proceedings.
- b) A petition should be denied when the challenged patent is concurrently asserted in a district court against the petitioner, real party in interest, or privy of the petitioner and the court has not stayed the case.
- c) A petition should be denied when the challenged patent is concurrently asserted in a district court against the petitioner, real party in interest, or privy of the petitioner with a trial is scheduled to occur within 18 months of the filing date of the petition.
- d) A petition should be denied when the challenged patent has been held not invalid in a final determination of the ITC involving the petitioner, real party in interest, or privy of the petitioner.

IV: PRIVY

a) An entity who benefits from invalidation of a patent and pays money to a petitioner challenging that patent should be considered a privy subject to the estoppel provisions of the AIA.

b) Privy should be interpreted to include a party to an agreement with the petitioner or real party of interest related to the validity or infringement of the patent where at least one of the parties to the agreement would benefit from a finding of unpatentability.

V: ECONOMIC IMPACT

Regulations should account for the proportionally greater harm to independent inventors and small businesses posed by institution of an AIA trial, to the extent it harms the economy and integrity of the patent system, including their financial resources and access to effective legal representation.

I greatly enjoy being an inventor, and the entire process of invention, design, and commercialization. But now in the prime of my career I fear for the financial wellbeing of my family. I fear that the patent awards that I fought and paid for could be stripped away from me by large corporations with the sole intent of squashing independent inventors, instead of "partnering" with them. I fear the damage already created by the PTAB's current policies may never be fully realized. But I'm hopeful that the greatest country in the world, has the ability to correct its course, and stand up a system that can once again inspire future inventors...enough to dedicate their lives to improving the world and bettering our society.