

# PUBLIC SUBMISSION

<b>As of:</b> 11/19/20 3:48 PM
<b>Received:</b> November 16, 2020
<b>Status:</b> Posted
<b>Posted:</b> November 17, 2020
<b>Tracking No.</b> khk-rx5s-7ksq
<b>Comments Due:</b> December 03, 2020
<b>Submission Type:</b> Web

**Docket:** PTO-C-2020-0055

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

**Comment On:** PTO-C-2020-0055-0001

Discretion to Institute Trials Before the Patent Trial and Appeal Board

**Document:** PTO-C-2020-0055-0339

Comment from Domenique Tufariello.

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## General Comment

My comment is in connection to the Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board, 85 Fed. Reg. 66502, published on October 20th, 2020. I am a law student who was a Summer Extern at the USPTO for Summer 2020 and I intend to one day be a practitioner before the USPTO.

Serial Petitions

With regard to deciding whether the Office should promulgate a rule codifying factors for determining whether to institute a petition for IPR, I believe it would benefit all parties to have a standardized regulation regarding PTAB proceedings. Congress's intent in passing the AIA was for the proceedings before the PTAB to be a "quick and cost effective alternative[] to litigation" H.R. Rep. No. 112-98, pt. 1, at 48 (2011). By implementing a rule regarding factors, it would provide improved notice for parties and standardize proceedings.

When specifically discussing the General Plastic factors, I believe that it would be in the interest of all patent holders and inventors, especially individuals and small companies, for the factors instituted to be as strict as possible as to limit IPR petitions. While IPR proceedings may be less expensive than litigation, they do not provide the due process awarded an inventor that

exists in the federal courts. Because of this, they can be abused by individuals or entities who seek to harass patent holders and quickly, at low cost, invalidate patents on mass.

As the General Plastic factors stand, I believe they are too forgiving of trolls. Petitioners should only get one metaphorical bite at the apple per patent. All complaints they have against all claims should be addressed in short order. There is no statute of limitation or laches defense, thus they have all the time in the world to make the best case they can before the PTAB. In the interest of maintaining the reputation of the USPTO and the incentives for inventors to disclose, I believe that a clear rule should be available, but one that would limit IPR petitions.

#### Parallel Petitions

As I stated above, the Office should promulgate a rule for the same reasons. Likewise, as I expressed above, and somewhat similarly stated in the Consolidated Trial Practice Guide, petitioners should only get one bite at the apple. Because a single petition can only challenge 20 claims, a fair rule would be to allow only the number of petitions required to address all the claims of a particular patent. For example, a patent with 20 or fewer claims can only be challenged by a single petition. Similarly, a patent with 45 claims could be challenged in a maximum of three petitions.

#### Proceedings in Other Tribunals

I do not believe the current factors which the PTAB considers before instituting a parallel proceeding should be codified as they stand. If proceedings have begun in other tribunals, especially U.S. District Courts or the ITC, the best use of a petition is for a defendant to invalidate the plaintiff's patent without the due process that should be afforded the plaintiff in the proceedings in progress.

The only considerations that should be made is whether the petitioner and the defendant in the parallel proceeding are the same party and whether the issues before the PTAB and the other tribunal are overlapping. If these factors go against petitioner, the proceedings before the PTAB should be stayed until the conclusion of the already active proceedings.

#### Other Considerations

Whatever decision the USPTO decides regarding the promulgation of these rules, I implore the Director to be mindful of the examiners on the ground. Most of examiners I interacted with in my time at the USPTO were not lawyers. Despite that, they did their best and succeeded at explaining in depth, complicated legal issues and how they impacted our work. If the Office decides to promulgate rules, I would ask that they take their time in developing the trainings for the examiners as well as providing additional resources to them. They already have a lot on their plates and additional burdens would make their jobs even harder.