United States Senate

December 3, 2020

The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Dear Director Iancu:

As members of the Senate Judiciary Committee Subcommittee on Intellectual Property, we write to express our support and gratitude for your ongoing efforts to restore reliability, predictability, and balance to our nation's patent system. In particular, we commend the United States Patent and Trademark Office (USPTO) for the numerous administrative reforms made during your tenure to promote fairness and efficiency in the post-grant trial proceedings established by the America Invents Act (AIA). We support formal rulemaking to further ensure that these proceedings embody the cheaper and faster alternative to district court litigation envisioned by Congress.[1]

Robust patent protections and enforcement mechanisms have long fueled our economic success and national security, incentivizing American inventors, entrepreneurs, and businesses to invest the resources and efforts necessary to keep this country on the leading edge of critical emerging technologies and life-saving medical innovations. Strong and enforceable patent rights have proven particularly important for disruptive technologies, as well as biopharmaceutical innovations that require massive capital investments to bring to market.

In recent years, however, several changes in our laws have disrupted the balance of the patent system, threatening this incredible engine of innovation. Restricted access to injunctive relief, uncertainty regarding patent eligible subject matter, and abusive serial attacks on patent validity have made enforcing patents both difficult and expensive, tipping the scales away from the inventors who helped build America and toward infringers who steal the fruits of their labor. For example, while the AIA established post-grant trial proceedings to provide a supposedly fair and efficient alternative to litigating patent validity in federal court, it left in its wake a number of unintended consequences that disproportionately impact patent owners, who frequently find themselves re-litigating the patentability of previously examined and issued claims against multiple challenges at the Patent Trial and Appeal Board (PTAB) and in district court.

[1] We submit this letter in response to the U.S. Patent and Trademark Office's Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board, 85 Fed. Reg. 66502 (Oct. 20, 2020).

That is why we, along with several of our colleagues, introduced the STRONGER Patents Act, which would restore balance to these post-grant proceedings and bring them in line with Congress's original intent. By harmonizing PTAB and district court standards, precluding multiple attacks on the same patent claims, and restoring access to injunctive relief, this legislation would restore balance to our patent system, reclaim its "gold standard" status on the global stage, and harness the incredible ingenuity of the American people.

The AIA granted the USPTO Director significant discretion in instituting post-grant trial proceedings. We are pleased that you have chosen to guide the exercise of this discretion to address many of the same concerns underlying our proposed legislation. By limiting serial and parallel petitions on the same patent claims and by denying petitions likely to extend rather than streamline litigation, the USPTO has respected Congress's intent to provide a fair and efficient alternative to expensive district court litigation. This guidance provides meaningful predictability to stakeholders and helps to ensure that PTAB trials are not weaponized through gamesmanship or mired in redundant challenges.

We understand that you are considering formal rulemaking to promote further certainty regarding the exercise of this discretion, and we fully support this effort. In particular, we encourage the USPTO to promulgate rules to limit institution on previously challenged patent claims, to deter abusive or burdensome parallel petitions, and to discourage institution when the patent's validity is already scheduled for timely resolution in another forum. The resulting certainty will benefit patent owners and challengers alike by decreasing costly duplicative litigation and encouraging parties to put their best foot forward in a single proceeding.

Innovation has defined this country from its very beginning, and strong, reliable, and predictable patent rights will fuel our success going forward. We look forward to continued engagement with the USPTO as we work together to promote balanced intellectual property policy.

Sincerely,

CHRISTOPHER A. COONS
United States Senator

MAZIE K. HIRONO
United States Senator