

PUBLIC SUBMISSION

As of: 11/13/20 6:48 PM
Received: November 11, 2020
Status: Posted
Posted: November 13, 2020
Tracking No. 1k4-9k19-jx0e
Comments Due: November 19, 2020
Submission Type: API

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-2020-0055-0105

Comment from RPost.

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General Comment

Our company, RPost, and its technology staff have been granted over 50 patents (www.rpost.com/patents) over the last two decades, in the secure and authenticated electronic messaging field. Our teams commercialized these patents, having created world class software services -- the RMail, RSign, and Registered Email services. These services have been used and relied upon in the United States and internationally, by individuals and business and government organizations of all sizes.

We have been involved in the PTAB process numerous times as an inventor and patent owner, successfully defending our patents' validity. Despite our success in defending our patents validity, we believe it came at great overall economic cost and wholeheartedly agree with the positions noted below.

Additionally, we believe when exercising its discretion whether to institute AIA trials, the Office should considering the overall Economic Impact; the Office should consider the totality of the added cost and complexity that not only the PTAB processes have created, but also other changes that occurred in recent years associated with re-interpretation of the patent laws (which we could describe in detail if asked). These, taken together, have had a compounding negative economic affect, shifting the cost and complexity balance out of favor (and for many, out of reach) for inventor and smaller business patent owners. This has ultimately caused (likely for many irreparable) harm to inventors and smaller businesses across America.

While this will not solve all of the newfound patent-related issues impacting smaller business and individual inventors, we urge at the very least, 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. To this end regulations should favor objective analysis and eschew subjectivity, balancing, weighing, holistic viewing, and individual discretion. The decision-making should be procedural based on clear rules. Presence or absence of discrete factors should be determinative, at least in ordinary circumstances. If compounded or weighted factors are absolutely necessary, the number of possible combinations must be minimized and the rubric must be published in the Code of Federal Regulations.

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.
- e) These provisions should govern all petitions absent a showing of extraordinary circumstances approved by the Director, Commissioner, and Chief Judge.

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 neither stayed the case nor issued any order that is contingent on institution of review.
- 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.