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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-2020-0055-0270
Comment from Pavel Levin.

Submitter Information

Name: Pavel Levin
Address:
1270 East 19th St., Apt. 2M
Brooklyn, NY, 11230-5407
Email: levinpavel@yahoo.com
Phone: 7186459366
Organization: Vaposun Inc.

General Comment

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. 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) Petitions filed 90 days after an earlier petition against that patent (i.e., after a preliminary response due time) should be stayed until PTAB issues decision on the earlier petition. Petitions filed after the PTAB institutes a trial against the same patent should be denied.

d) If the PTAB institutes a trial against a patent, petitioners filed after an earlier petition against that patent but before the PTAB decision should be permitted to join the instituted trial, at that petitioners filed more than 90 days after the earlier petition should be permitted to join the instituted trial without adding new claims.

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

III: 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.

IV: 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'm an applicant (micro entity) and inventor of 3 US patents/patent applications. Its startling that only 16% of patents survive the PTAB! The prospect of multiple PTAB trials has negatively impacted the incentive to file patent applications, especially by small and micro entities.