

Re: Discretion To Institute Trials Before the Patent Trial and Appeal Board

Dear Director Iancu,

I work in-house developing the patent portfolio for SoundHound, a 300-person tech company creating speech recognition and natural language understanding software. The likely infringers of our patents are the top tech companies. On the other hand, we have grown into a target of occasional assertions from patent assertion entities. We currently have no post-grant proceedings before the PTAB. However, we are likely to be involved in future IPRs with about equal likelihood as owner and petitioner. This letter only expresses my own opinion.

Thank you for highlighting fairness as a present goal of the USPTO and a goal of Congress at the time of enacting the AIA. The United States is well-served by a legal system that values fairness over expedience.

Reducing uncertainty was not a goal of Congress in creating the IPR and PGR processes. Reducing uncertainty should not be a goal of the USPTO, lest we arrive at one of the two certain policies of instituting all or denying all petitions. Anybody contemplating AIA review proceedings can increase their certainty of the outcome by performing a prior art search. Artificial intelligence technologies have improved the cost and accuracy of doing so.

Rules remove discretion. Promulgating rules for exercising discretion seem counterintuitive. Therefore, I suggest that the answer should be **“no” to questions 1-6** of the request for comment.

However, if you do promulgate rules or redirect the PTAB’s exercise of discretion, please consider the following guidelines to address some of the issues you raised in the request for comment.

### Checking petitioners

Naturally, for the efficient administration of the Office, you should not institute a later petition with art or arguments that are identical or cumulative to ones considered in a completed prior trial. Similarly, you should deny the institution of multiple petitions on the same claims by the same petitioner. Otherwise, gamesmanship by petitioners is possible.

### Checking patent owners

However, you should not deny considering the case of a later petitioner because of a different challenge poorly presented by an earlier petitioner. Furthermore, since courts consider validity and infringement on a per-claim basis, not a per-patent basis, you should institute multiple petitions for a single patent if the petitions address substantially different claims. Otherwise, gamesmanship by patent owners is possible.

Finally, inter partes reviews and post-grant reviews are reviews. Though inexpeditious at times, reviews can only help, not hurt, fairness. Therefore, it serves the public good to institute close calls.

Thank you for your kind attention.

Sincerely,

/ Jonah Probell /

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