

# PUBLIC SUBMISSION

<b>As of:</b> 12/4/20 11:17 AM
<b>Received:</b> December 02, 2020
<b>Status:</b> Posted
<b>Posted:</b> December 04, 2020
<b>Tracking No.</b> 1k4-9kfa-qfa5
<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-2020-0055-0752

Comment from Jessica Marks

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## Submitter Information

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## General Comment

I am from Unified Patents, LLC. I write to note that the PTAB provides a critical tool for protecting us from some of the thousands of over-broad patents that get over-asserted or threatened based on the ability to demand less than the cost of litigation in licensing fees. We are deeply concerned about the increased and seemingly politically motivated use by the Patent Trial and Appeal Board ("PTAB") of discretionary denials that leave invalid patents in force to be asserted in litigation. Shielding invalid patents from cancellation on policy grounds is the opposite of what the PTAB was created to do.

Denying challenges for an administration's particular policy goals divorced from the merits means that invalid patents remain in force and must be litigated at significant cost in district court infringement suits. This failure to consider and cancel invalid patents is one of the primary causes of the significant increase in litigation by non-practicing entities in recent months. It is also beyond the statutory authority of the PTAB to craft new rules based on the policy goals of this particular administration. Data shows the USPTO now favors these denials and is increasingly using this rule to deny institution of patent challenges

(<https://www.unifiedpatents.com/insights/2020/10/21/ptabdistrict-court-trial-date-denials-spiraling-upward-ptab-discretionary-denials-third-quarter-report?rq=314>), and the denials primarily benefit litigation-funded NPEs that file in the Eastern or Western Districts of Texas.

Congress and the rest of the federal government should be doing everything within their power to prevent unnecessary and abusive litigation against U.S. companies and employers, NOT inventing new ways to prevent those threatened with suit from preventing needless litigation. These denials favor the interests of speculative litigation by shell company plaintiffs that do not make anything or productively employ anyone to the detriment of the real-world manufacturers and service providers that are the backbone of the U.S. economy. They encourage parties to file first and forum shop for rocket dockets to maximize their financial leverage to settle spurious claims. These actions harm the economy and are contrary to the promise of the America Invents Act ("AIA").

Regarding serial petitions, the Office should decline to enter wholesale regulations denying petitions where the same claims have been presented before the Office and instead should give the Board flexibility in considering the merits of each case. Even if it does promulgate regulations, the Office should NOT adopt proposal 2(b). It is important that the Board have some flexibility in assessing each case based on the merits.

Regarding parallel petitions, the Office should not promulgate rules deciding solely whether to institute more than one petition filed at or about the same time on the same patent. Rather, if the Office does promulgate rules, they should go to consolidating or staying meritorious cases when more than one petition is filed at or about the same time on the same patent. The Office should also decline to adopt proposal 4(b): it would be wrong to altogether decline to institute on more than one petition. Many patents are complex and include many claims, long claims, or means-plus function claims, and more than one petition may be necessary in view of the Office's word limitations, which are fixed independent of the number of claims or the patent.

Regarding proceedings in other tribunals, the Office should adopt proposal 6(a), and disregard other proceedings in district court or the ITC in deciding whether to institute a petition on a patent, at least outside of the scope of other statutory grants of authority to do so, like 35 U.S.C. 315 or 325. Congress has not authorized the Director to deny institution of timely meritorious petitions based on any aspect parallel district court or ITC proceedings outside of particular statutorily enumerated circumstances.

Moreover, the data shows that that PTAB's use of discretionary denials has harmed the economy and integrity of the patent system. The IPR process has consistently benefited U.S. manufacturers (<https://www.unifiedpatents.com/pqi>). When meritorious petitions are denied due to co-pending court proceedings, it hurts the U.S. economy. IPRs provide an efficient means for improving patent quality by bringing cases before the Office's knowledgeable board of administrative law judges.

Thank you very much for taking stakeholder's concerns into consideration,

Jessica L.A. Marks