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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-2020-0055-0100

Comment from Mark Goodson.

Submitter Information

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General Comment

My name is Mark Goodson. I have been allowed 22 patents, but "lost" two of them to the PTAB. I am a member of the PPAC, serving the Agency from 2014 up until now; my next and final PPAC meeting is next week. I am intimately familiar with the operations of the PTAB, through personal experience and through the PPAC.

My two lost patents have cost me dearly; I could deal with it if I thought the PTAB was the equivalent of an Article III Judge. The first issue is that the PTAB judges are NOT experts in the technology for which they are rendering opinions. One of the judges on my panel was a cancer researcher / attorney by background. The other two MAY have had some electrical background, but not as evidenced by their Curriculum Vitae or findings; the examiners are far more qualified to understand the technology. The PTAB was recently borrowing MEs to serve on EE panels; this is just not acceptable practice. You need PTAB judges who are intimately familiar with the area they provide services on!

NO process can sustain itself with a rate of 85% rejection on re-exam via IPR. The problem is

not weak patents - the problem is the IPR process which examines in minutia patents which examiners found to be lawfully allowed. I believe that almost every patent allowed by the office would fail the IPR process if the defendant in an infringement lawsuit was funding the IPRs. The examiners at the office are THE experts - not the PTAB judges.

In terms of \$\$, the process has cost me close to \$500,000.00 This is money I will never receive or recover.

I know Director Iancu personally - he wants to do right in this matter. The recommended solution:

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.

In the end, though, there is the absolute issue of credibility. The USPTO is issuing patents that the same USPTO is declaring invalid. This is no way to run a railroad.