

Response to Request for Comments

Dear Director Iancu:

On October 20, 2020, the USPTO published a Request for Comments on Discretion To Institute Trials Before the Patent Trial and Appeal Board, 85 Fed. Reg. 66502. I am a registered patent practitioner and provide the following comments in response. While I am affiliated with Emerson Thomson Bennett, LLC, the comments represent my individual views.

General

While the Board has previously implemented its institution discretion approach through precedential decisions, I support codifying the approach through notice-and-comment rules. Doing so will provide advance notice of any proposed changes, will allow interested persons to submit feedback, and will allow the USPTO to have the benefit of such feedback when implementing any changes.

Serial Petitions

With regard to the *General Plastic* factors, I only wish to touch on a few of them. Regarding the first factor (whether the same petitioner previously filed a petition directed to the same claims of the same patent), *Valve I* explained that this factor is not limited to multiple petitions filed by the same petitioner but rather considers the relationship between different petitioners. While I agree that the relationship (if any) between petitioners should be considered, I propose that unless the different petitioners are real parties-in-interest or privies, this factor *not* favor declining institution. Any lesser relationship seems to penalize a party by precluding it from seeking an IPR (that will simply not get instituted).

Regarding the third factor (whether, at the time of filing of the second petition, the petitioner had already received a patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition), I respectfully disagree that this aspect should be a factor. This factor appears to penalize a petitioner from utilizing a patent owner's preliminary response or the Board's institution decision. A patent owner's preliminary response is part of the prosecution history of a patent and can fairly be considered in subsequent litigations or proceedings involving that patent. Also, statements by the patent owner in previous court litigations can be subsequently used in, e.g., reexaminations before the USPTO. *See* 37 C.F.R. §1.501(a)(2). Thus, it seems inconsistent to allow the use of some patent owner statements but to discourage others. The better approach, in my opinion, would be to not hold against the petitioner a patent owner's preliminary response.

As far as the Board's institution decision, the concern appears to be using that decision as a "roadmap." But again, I respectfully disagree that using the Board's decision as a roadmap is somehow wrong or deserving of deterrence. If a court were to issue a decision on claim construction or summary judgment, for example, there seems to be nothing improper with allowing a subsequent litigant – or even the same one – to use that decision to fine-tune one's

case. The same ought to be true of the Board's institution decision. Thus, I respectfully suggest that this consideration not factor into the Board's decision whether to institute an IPR.

Regarding the fourth factor (length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition), I respectfully suggest that this factor is adequately addressed by 35 U.S.C. §315(b) and §321(c). This factor appears to encourage haste in filing a petition once its supporting prior art has been located. But the above-cited statute sections already address this concern, and a further reduction is not necessary, in my opinion.

Efficient Administration of the Office

I agree with the Board's ability to decline institution if the standards for institution have been met in only a small subset of the instituted claims. To be clear, I suggest that this subset truly be a small one. For example, if the Board believes that the institution standard has been met for 18 out of 20 challenged claims, I think the Board should institute. Declining institution might be warranted if, e.g., less than half of the challenged claims met the institution standard.

Unfortunately, under the current interpretation of the estoppel provisions (§315(e) and §325(e)), a denial of institution leaves the petitioner free to challenge those claims again (whether in court or before the USPTO). So after wasting the patent owner's and Board's time and resources through institution, the petitioner is free to try again. Therefore an alternative approach might be to institute the IPR and let it reach a final written decision that is unfavorable to petitioner, which will trigger estoppel and prevent wasteful relitigation elsewhere. At very least, this will encourage the petitioner to prepare a good and thorough petition, or else risk permanent estoppel on the challenged grounds.

Parallel Petitions

I agree with the statement that multiple petitions may be necessary, e.g., where a patent owner has asserted a large number of claims in litigation. Because a single petition is contemplated to challenge up to 20 claims (see 37 C.F.R. §42.15(a)(3)-(4)), (b)(3)-(4)), perhaps a good rule of thumb (from an institution-discretion standpoint) would be to allow a separate petition for each 20 claims (or portion thereof) challenged in one patent.

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Thank you for considering my comments.

/Sergey Vernyuk/