

PUBLIC SUBMISSION

As of: 11/10/20 6:37 PM
Received: November 10, 2020
Status: Posted
Posted: November 10, 2020
Tracking No. 1k4-9k0i-usjd
Comments Due: November 19, 2020
Submission Type: API

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-2020-0055-0036

Comment from ADM Tronics.

Submitter Information

Name: Andre DiMino

Address:

224S Pegasus Avenue
Northvale, NJ, 07647

Email: andre@admtronics.com

Phone: 201-767-6040

Submitter's Representative: Andre DiMino

Organization: ADM Tronics

General Comment

My name is Andre DiMino, and I am the President and majority shareholder of ADM Tronics. We are a small 32 person technology development company that develops and manufactures medical electronic devices and other technologies. I currently have 27 issued patents and 18 patent applications. My late father, who founded our company, was also the developer of a number of patented innovative medical technologies and industrial developments. We are proud to be able to create technologies that help so many people improve their health and also improve the lives of industrial workers and the general environment. We have invested our time, efforts and especially financial resources to research and develop these technologies. It is vitally important to me, the livelihood of all my employees, and to the health of many people that our developments help that the value of our patents is not diminished. Our patents are a crucial foundation to our business. We must support the value and importance of patents to small companies, like ours, to continue to incentivize our work. Please help small companies maintain the desire to research and develop new technologies. Don't allow the PTAB to be used as a weapon against small companies. To that end, I submit the following:

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) 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.