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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

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Comment from Jack Stuart.

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General Comment

I strongly recommend adoption of better rules to govern institution of PTAB trials, the overall goal being to ensure PTAB decision-making is based on clear procedural rules and to remove the thumb on the scales currently weighted against inventors.

STANDING AND EFFICIENCY

As to standing and proceeding efficiency, the petitioner should be a real-party-in-interest, and the petitioner should be limited to one petition per patent not many, as is the current state. Each patent should be subject to no more than one PTAB trial, instead of being subject to many bites at the apple, as is currently allowed. Petitioners should also be required to file their petitions within 90 days of an earlier-filed petition against the same patent (that is, prior to a preliminary response), and those meeting that deadline should be permitted to join the instituted PTAB trial. Those petitions filed more than 90 days after an earlier petition should be denied. Third, the PTAB should not be permitted to institute duplicative proceedings, including institution of a proceeding when a 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.

MULTIPLE PROCEEDING RESOLUTION

Further promoting the fundamental juridical tenet of efficiency, a petition should be denied when: 1) 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; 2) 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. Any entity benefiting from invalidation of a patent and paying money to a petitioner challenging that patent should be considered a privy, subject to the estoppel provisions of the AIA. Privy should be interpreted to include a party to an agreement with the petitioner or a real-party-in-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.

DUE CONSIDERATION FOR INVENTORS AND BURDEN-OF-PROOF

Finally, the PTABs rules 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. One good step in that direction would be to impose the same burden of proof at the PTAB as that required in a federal district court: Clear and convincing evidence of invalidity. Issued patents which have already been subject to rigorous scrutiny before issuance under the USPTOs patent examination process should enjoy a presumption of validity, not the threat of invalidation under a 50-50-coin-toss, burden-of-proof standard.