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Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board

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Discretion to Institute Trials Before the Patent Trial and Appeal Board

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Comment from Shalom Wertsberger.

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General Comment

I am an inventor, an investor, and a registered patent agent representing primarily small and medium entities from the US and across the world.

Since the America Invent Act became law, I noticed significant reduction in the willingness of small inventors to file patents, and lower level of reliance on patent protection by investors. I also see growing reluctance to count on US patents by international entities.

Some of the reasons given are the unpredictable nature of US patent law and subjective, strong anti-patentee bias. Moreover, the perceived anti-small patentee bias causes inventors pause when considering investment in promising inventions.

Additionally I sense (and share) a strong feeling that initiation of a post-grant review allows endless and numerous harassment, which farther increases the feeling of bias against the small inventor. The present post-grant procedure tilt the playing field even farther in favor of an infringer, especially wealthier one. When a small inventor is faced with the risk of numerous

challenges, the inventor is oftentimes prefer not to pursue their invention, or try practicing their invention without disclosure. The end result of this unclear and biased landscape is that small inventors keep their ideas and inventions to themselves, investors are more reluctant to invest in startup companies, the US economy, the US Patent system integrity, and the constitutional intention behind the patent concept, all suffer.

Therefore, I believe that in order to bring longer term viability to the US Patent System, to maintain the US position as a leader of innovation and as an advancer of innovation worldwide, I advocate the following principles:

Regulations must provide predictability and reasonable certainty prior to filing a petition, by written, clear policy. Thus regulations should favor objective analysis, reject subjectivity and other consideration of individual discretion. The decision-making should be procedural based on clear rules. Well stated discrete factors should be determinative barring unique circumstances. The rules should be clearly published and elaborated.

The rules regarding the real parties of interest should become broader to include each and every entity which benefits from patent invalidation by the PGR, and/or shares ownership, and/or operates under agreement, and or contributes or gain anything of monetary value with the petitioner, directly or indirectly. Failure to disclose such party will cause an automatic termination of the PGR with prejudice, and such members to the real party of interest should be considered equivalent to the petitioner, and prevented from concurrent and/or future challenges. The PTAB should not institute duplicative proceedings. A petition should be denied when the challenged patent is concurrently asserted in a court or the ITC against the petitioner, or any other real party in interest of the petitioner and the court has neither stayed the case nor issued any order that is contingent on institution of review. A petition should be denied when the challenged patent is concurrently asserted in court or the ITC against the petitioner, or any real party in interest with a trial scheduled to occur within 18 months of the filing of the petition. A petition should be denied when the challenged patent has been held not invalid in a final determination of the ITC. A petition should be denied if the challenged patent was determined not invalid in a previous PGR, unless new art clearly and fully anticipates it, or in other extraordinary circumstances.

Duplication of process should be avoided under almost all circumstances. Every petitioner, with ALL parties of interest should not be allowed more than one PGR. The PTAB should not institute proceedings which are duplicative to any cases in front of the ITC or a court barring agreement by both sides.

It is hard to deny that the patent field is very heavily biased against the party with lower financial means. Therefore regulations for institution of a post-grant review should consider the economic impact on a patentee which qualifies as small entity, both in terms of any fees and costs, the added legal representation costs, as well as other related costs, which result from such institution. Such rules should unequivocally consider the inherent disparity between a well-funded petitioner and an entity which lacks the financial breath. Thus the regulations should specifically demand that the institution of post-grant review by a wealthy petitioner on a patent owned with a real party which is a small entity is done in a manner that will allow the trial results to be based on the merits, rather than on the financial might of one side or another.