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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

Document: PTO-C-2020-0055-0222

Comment from Tim Pryor

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General Comment

I am an American citizen living in Toledo, Ohio. I graduated from college, served as an Army Officer, and thanks to the GI bill was then able to receive a PhD in Engineering. As a small boy, I was thrilled to read of great American Inventors, and have been inventing things ever since. I started two operating companies in the machine vision and robotics field which performed a great deal of R and D for their size. Two other operating companies were later formed in other fields, also based on patented technology.

Over the years I have been granted approximately 180 US patents and many were instrumental in helping us to obtain financing. It has also been possible to sell or license some of these patents, an effort which unfortunately has been made much more difficult in recent years due to passage of the AIA and associated problems with its implementation.

To improve function of the AIA and the lot of individual inventors and entrepreneurs like myself, 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 should 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.

I feel the America Invents Act (AIA) has acted to stifle innovation (especially the funding thereof) by small inventors and should be improved. America was once the greatest place for inventors in the world, and this situation needs to be restored if we are to fight off increasing challenges from abroad. Today, the current system favors large companies, many of which are the foreign ones we need to compete with.