

Patent Trial and Appeal Board,
United States Patent and Trademark Office,
Department of Commerce

RE: Request for Comments on Discretion To Institute Trials Before the Patent
Trial and Appeal Board

I am a long time stakeholder, a named inventor on several dozen patents, those inventions being used throughout the world in professional and consumer television products. These inventions are licensed to every large manufacturer of such products worldwide, and are found in virtually every flat panel consumer television in use today. How did I accomplish this widespread adoption? It is the result of decades of hard work, finding and solving problems that weren't even known by the people who could best benefit from those solutions. Often I discovered that those people didn't even believe they had a problem, or that it could be fixed, when I approached them with my solutions.

How did I protect and benefit from my work? Patents! In years past, some of my patents were subject of reexaminations, brought by deep pockets unscrupulous copyists who would rather try to beat down an independent inventor rather than admit their infringement and take a license. I was able to get fair, honest, impartial and unbiased treatment from the USPTO in those reexaminations and not one of my several patents was lost to reexamination!

Now, we have IPRs and the PTAB. Again, the deep pockets unscrupulous copyists who would rather try to beat down an independent inventor rather than admit their infringement and take a license attacked my patents, using their strong financial resources, anti-patent PTAB rules and regulations, unchecked discovery, depositions and the like, coupled with continued new attacks on my patents in the family, to destroy those patents which protected thousands of hours of work and thousands of dollars of investment.

Did I get fair, honest and unbiased treatment from the PTAB? I don't think so. The rules are set up to favor challengers and disfavor patent owners. The statistics bear out that fact and I would think somebody in the USPTO would be somewhat embarrassed by this issue from one department and invalidate in another business model. Now, there is an opportunity to change the PTAB rules to improve the fairness and impartiality of its operation. I support these changes, point out that they are long overdue and that they will operate to cure some of the worst abuses that currently exist. 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.

Sincerely,

J. Carl Cooper