

PUBLIC SUBMISSION

As of: 11/19/20 4:26 PM
Received: November 17, 2020
Status: Posted
Posted: November 18, 2020
Tracking No. 1k4-9k57-rwr7
Comments Due: December 03, 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-2020-0055-0382

Comment from Patrick Buckley

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General Comment

I am an inventor and small business entrepreneur who has experienced first hand the problem of a larger company using IPR and PGR's in an abusive manner and the PTAB being far too permissive with institution decisions. This cost me my business, and I had to shut down my USA based factory and fire over 40 people when an infringing company with far more resources filed IPR's and PGR's against our patents.

Merchsource (owner of the Sharper Image) used alleged prior art that was dated 9 months after we had filed our provisional application and 6 months after we had been in the market selling our product (with over 20,000+ units sold). This company had also come to us, unsolicited, to license our patents just 18 months prior to filing their IPR/PGRs. We had a license in place when they filed their IPR's and yet still the PTAB instituted?

These IPR's were clearly designed to cost my company time and money and the PTAB should have seen this. The IPRs/PGRs filed against my patents were never successful at invalidating

any claims but they were successful in driving me out of business. It was too expensive for us to fight them and I lost everything and I lost all faith in the Patent system. The IPR and PGRs in our case never should have been instituted.

I am an MIT graduate and mechanical engineer with over 9 patents in fields ranging from medical devices to virtual reality but after my experience in the PTAB I have completely abandoned patents until the system is fixed and functions in a way that inventors have a fighting chance at building a business around the time, effort and money we invest in research and development. I support any changes that will do the following at the PTAB....

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.