

Discretion to Institute Trials Before the Patent Trial and Appeal Board

To: Patent and Trademark Office
ID PTO-C-2020-0055-0001

Serial Petitions

1. The issue of case specific analysis as described in General Plastic is ambiguous and provides no basis for future declaration of serial petitions. No regulatory body should have such discretion, a mandate should be a mandate with discoverable, discernable evidence and sustenance basis on the ruling. Innovation and creativity were the purpose of intellectual property and adapting such, 'discretions' jeopardizes the value of ingenuity it sought to promote.
2. In decision of instituting a petition, the disregard based on previous challenge does not provide for a fair review nor does it allow for introduction of new information. In such a scenario without a middle ground the disregard would need to be whether a challenge was filed or not. This provides the opportunity for change in defense of the petition. If an alternative to extremes exist, the most efficient scenario would be to exclude cases where the challenge is has already been denied and is unchanged or allow for amendments to previous challenges. These amendments would be for inclusion of new information to prior challenge by previous challenger. This change in filing process or form would save the committee review time. It would not be necessary to go through each entry to determine previous filing status or compare information received.

Parallel Petitions

3. There should be no need to submit multiple petitions. It is especially detrimental to the petition for the filing date to change based on the AIA First to File process. With the adoption of this new regulation, everything should be done to circumvent any such scenario that would require a petitioner to file additional petitions.
4. If a petitioner files additional petitions, it should be regarded as the primary petition and the previous one disregarded and removed from its whatever stage or progress made in its process. No more than one of similar or same petitions should be instituted at the same or around similar timeframes. Proceedings in Other

Tribunals

5. In regard to other case proceedings, there should be a case specific analysis. The purpose for the institution of the AIA was, saving on regulation and hearings cost. There are situations where the outside court's decision can determine if the US PTO will return for hearings in challenges. Those decisions can heavily impact the cost and time of the Patent and Trade Office.
6. Decision on a patent which has undergone ITC review should absolutely be considered. If the International Trade Commission has decided to permanently stay the action, then the patent may be considered for approved petition.

Other Considerations

7. The goal of the United States Patent and Trade Office upon its creation and stated by its current mission. To more innovation with stronger intellectual property protections, those protections need to be streamlined. Discretions and case scenarios ring full of ambiguity, nepotism, favoritism, payor favor and other potential illegal dealings which compromise the integrity of the PTO. In order to maintain the PTO's integrity and send a message to inventors, current and future, that they will have a fair chance in pursuing their ideas. Allow inventors to know that they have an office by their side which cannot be compromised of its scruples, an office that values deviation from the norm, that encourages out of the box thinking and rewards it with time for completion in the form of patent protection. If this office moves into the direction of executive's discretion, these morals and standards become obsolete. If the United States intends to remain competitive and a source of innovation in technology and a resource of knowledge the PTO needs to protect our idea.