



Scott C. Weidenfeller
Vice Chief Administrative Patent Judge
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22314

Re: Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board. Docket No. PTO–C–2020–0055.

Dear Judge Weidenfeller,

The Trade Alliance to Promote Prosperity (TAPP) asks that you consider these comments on the above-captioned Request for Comments published in 85 Fed. Reg. 66502 (October 20, 2020), (“RFC”). TAPP is a longstanding advocate of intellectual property protections and recently signed on with a coalition of more than 20 trade organizations in support of Director Iancu’s reforms.

I: SERIAL AND PARALLEL PETITIONS

TAPP supports USPTO promulgating rules with case-specific analysis, such as those generally outlined in the Consolidated Trial Practice Guide and *General Plastic* and its progeny. Such a rule will formalize the guidance of precedential decisions where serial and parallel petitions are filed much more effectively than providing no rule at all.

TAPP urges the USPTO against altogether disregarding the number of petitions filed at or about the same time as well as whether claims have previously been challenged in another petition and disregarding the number of petitions filed.

Adopting this framework will align USPTO practices with the Consolidated Trial Practice Guide and *General Plastic*; thereby remedying concerns of clarity, predictability, and curb the abusive practices of serial and parallel petitions.

II: PROCEEDINGS IN OTHER TRIBUNALS

Inter-Partes Reviews (IPR) should not duplicate ongoing proceedings in other tribunals. By duplicating these trials, IPRs do not meet their intended purpose of being quicker and cheaper than district court litigation. Rather, duplicate cases simply present the petitioner another shot at the patent holder.





TAPP supports USPTO promulgating a rule with case-specific analysis, such as that generally outlined in *Fintiv* and its progeny. Such a rule will formalize the guidance of precedential decisions where other proceedings are pending much more effectively than providing no rule at all. TAPP further urges the USPTO against altogether disregarding pending district court and ITC proceedings.

III: OTHER CONSIDERATIONS

TAPP proposes that the USPTO promulgates a rule which dictates petitioners who are not accused infringers of a challenged patent in either parallel or serial litigation by the patent owner or otherwise, be required to submit a certification and explanation of their reasoning in seeking the cancellation of the patent owner's claims.

Without this restriction, petitioners are not required to have standing when filing claims. This standard of practice has created an environment in which large companies are able to file endless petitions without providing a reason. This practice almost exclusively threatens small businesses by straining their limited capacity to fight litigation.

TAPP thanks the USPTO for the opportunity to contribute to the Office and its mission of strengthening patent rights and moving American innovation forward.

Sincerely,

Kent Kaiser
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