

November 18, 2020

Dear US Patent & Trademark Office,

Thank you for inviting users of the US patent system to comment on proposed rules to the Discretion To Institute Trials Before the PTAB.

Also thank you for inviting myself and members of the Inventors Network of the Capital (INCA) to comment on the America Invents Act at various roundtable discussions and other events before it was passed into law. At one of these events I shared changes to the US patent system must introduce more certainty and less complexity.

As a business owner and product developer who uses the US patent system, I write you today to encourage those same themes, certainty and simplicity, in regard to the function of the PTAB.

In the past I was president of INCA. INCA is an inventor education organization. I served on the board of the United Inventors Association, which focuses on helping inventors bring their products to market. I've also written articles for Inventors Digest magazine. Currently I volunteer with the Fredericksburg Inventors Network.

While volunteering at these organizations I met many inventors who created successful businesses or licensing agreements related to patents they received. Independent inventors at these groups frequently share concerns about the potentially high cost of enforcing or defending their patents. A strong and fair US patent system will help these, and future inventors economically use patents as part of their business and job creation strategy.

In order to encourage a stronger and more fair US patent system 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.

Clear rules, regulations and procedures of the USPTO & PTAB crafted to create fairness and a level playing field for independent inventors, small & large businesses benefit our economy and country.

Sincerely,

Glen Kotapish