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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-2020-0055-0413

Comment from Steven Caruso Research & Development LLC

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General Comment

My name is Steven Caruso. My company is Steven Caruso Research & Development.

I am currently named on over 40 patents.

I have been in the business of creating new inventions and bringing them to the industry for commercialization for over 30 years.

I can proudly say that my work has resulted in the generation of truly new business for our country and our economy.

However, things have certainly changed since the implementation of the AIA and the PTAB.

Having the prospect and reality of patents easily being invalidated has changed and is continuing to change the landscape of invention and innovation in this country.

Patents are no longer a reliable and predictable asset.

This is, from a business perspective, debilitating.

The trickle-down is extensive.

Even the word invention, which often represents years of work, is now often replaced with the dismissive word ideas at many major companies.

This has made the value of the inventors work, the engineers and designers work, and also the manufacturers work, worth less and less. trending towards worthless, as it is easier to just copy and steal and not be a leader in invention and innovation, but instead, just ride on the coattails of others.

Of course, ultimately, this leads to it not being worth it for anyone to innovate..... at least not in this country. Thus the death of American ingenuity"...

If the power of the patent is stripped from this country, it not only disables independent inventors, but handicaps small companies and startups and even hurts large companies by disincentivizing invention and innovation.

And then ultimately this trickles back up and hurts the whole of America. globally.

Interestingly, the last paragraph on the receipt from every new patent application begins with:

SelectUSA

The United States represents the largest, most dynamic marketplace in the world and his an unparalleled location for business investment innovation and commercialization of new technologies. The U.S. offers tremendous resources and advantages for those who invest in manufactured goods here.

The reality is that the current state of the AIA/PTAB work directly against this statement and mandate.

As such :

I urge adoption of regulations to govern the discretion to institute PTAB trials consistent with the following principles that others have detailed more extensively, as this submission form is limiting the length/number of characters.

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.

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. 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 .
- 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.