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Discretion to Institute Trials Before the Patent Trial and Appeal Board

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Comment from Alan Burnett

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General Comment

I represent a small company that has had to defend its patents against two IPRs, two ex-parte reexams, and four inter partes reexams. All four inter partes reexams are still pending after 8-9+ years and likely will be pending for several more years. One would think at this stage future IPRs would be barred. But that is not the case. What is worse is that the PTAB APJs are not technically competent to be making obvious determinations that are primarily based on expert declarations that may contain many false statements. The APJs see "PhD" and think he/she must be correct. I can assure you that the law firms representing big tech companies write the declarations with relatively little input from the alleged expert, and the alleged signs the declaration, having been paid handsomely. These abusive practices are widespread, but the PTAB is agnostics to them. Unlike a live trial, the Patent Owner is not afforded the opportunity to truly cross-examine the expert. Yes, the PO is permitted to depose the expert and provide a transcript, but this is not the same.

The companies whose lobbyists pushed through the AIA are the who's who of the infringers lobby. The patent system is supposed to be fair to everyone and not have separate rules for

small companies and individual inventors and different rules for big tech. But that is the reality small companies and individual inventors face today. Director Iancu has instituted some good changes to stem the tide of abusive IPR practice, but more needs to be done. Serial IPRs should be barred. IPRs submitted by 3rd party proxies, such as RPX and AST should be barred. In parallel litigation and IPRs there should be no page limit to the Patent Owner's response such that the PO can submit evidence from trial that is favorable. In theory, the concept behind IPRs was to reduce costs. However, for patents with significant value the cost of defending serial IPRs is much greater than defending the patents at trial, where patent owners are provided with a fair opportunity to defend their patents.

The approach the IPR boards have taken for years is to disregard Fed. Circuit and Supreme Court precedent and roll the dice that the Fed. Circuit will not want to do its job and issue a Rule 36 judgment, which happens all too frequently. When the Fed. Circuit does its job, the IPR FWDs are often reversed (which is good), but this should not have occurred if the APJs were more competent and actually followed case law precedent. You see over and over again where PTAB decisions are full of conclusory assertions not supported by factual evidence and/or based on conclusory "expert" testimony. This should not happen.

The infringer lobby's approach is clear. Throw enough darts (IPR petitions) and you are bound to "hit" an incompetent IPR board that can be easily convinced that patent claims are invalid. In a criminal proceeding a federal court is precluded from a double jeopardy outcome. Under serial and parallel IPRs, the validity case can be tried over and over again with a single negative outcome invalidating claims regardless of whether those same claims survived a half a dozen separate challenges. This is not fair on any level. The IPR abuses need to be stopped.

In summary, both Serial and Parallel IPR proceedings should be precluded. If patent claims are infringed by companies in a particular industry, the companies can currently collude to file multiple serial or parallel IPR petitions. For example, an orchestrator company 'A' can file a first petition and arrange for other companies 'B', 'C', 'D', etc. that nominally fall under "real party in interest" file other IPR petitions in parallel or serially. Oftentimes the same law firms and/or same experts are used. This is wrong.

Third parties such as RPX and AST should be precluded from filing IPR petitions on behalf of their members. These third parties rightly do not have standing for appealing PTAB decision to the Federal Circuit, but they likewise not have standing to file IPR petitions to begin with.

For parallel court proceedings, patent owners should be able to submit evidence favorable to patentability without limitation. Having a IPR Board invalidate claims over the same art for which claims survived a district court litigation should be precluded.