

# PUBLIC SUBMISSION

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**Docket:** PTO-C-2020-0055

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-2020-0055-0473

Comment from Sitting Man, LLC

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## Submitter Information

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## General Comment

My name is Paul Morris. I have been an inventor for over 20 years and an independent inventor since 2009. I have worked at large technology companies, but spent most of my time working for or with startups before inventing independently. I know first hand that patents are particularly important for startups (or at least they were before the AIA and the PTAB). I have over 150 issue patents. I make a living mostly from selling my patents as licensing has been too difficult and expensive in recent years. The patents I control are assigned to Sitting Man, LLC. I am the only member of Sitting Man.

My patents relate to operating systems, network protocols, user interfaces, user communications (e.g. text messaging, email, etc.), social media, and telematics - to name some of the areas in which I have invented.

After the passage of the AIA and the operation of the PTAB it has become increasingly difficult to make a living inventing. In fact, I've decided that it no longer makes sense for me to continue to invent. Inventing is not valued in the USA as it once was. Inventing is not respected in the

USA as it once was.

I strongly believe that it is the interests of the the United States that regulations governing the discretion to institute PTAB trials be adopted. I recommend that these regulations should provide predictability, prevent abuse of multiple petitions, take into consideration litigation in Federal Courts or the FTC, and take into account economic impact.

With respect to 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.

To prevent abuse of 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.

Proceeding in other courts or tribunals should be taken into account.

- 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.

With respect to 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.

Finally, 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. 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.

Respectfully,  
Robert Paul Morris