

# PUBLIC SUBMISSION

<b>As of:</b> 12/1/20 9:52 AM
<b>Received:</b> November 21, 2020
<b>Status:</b> Posted
<b>Posted:</b> November 24, 2020
<b>Tracking No.</b> 1k4-9k7t-yckb
<b>Comments Due:</b> December 03, 2020
<b>Submission Type:</b> API

**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-2020-0055-0641

Comment from Lawrence Edelman

---

## Submitter Information

**Name:** Lawrence Edelman

**Address:**

130 San Aleso Avenue  
San Francisco, CA, 94127

**Email:** lawrence.edelman@comcast.ent

**Phone:** 707 548 0448

**Fax:** 415 334 6836

**Organization:** The Law Office of Lawrence Edelman

---

## General Comment

The PTAB process was supposed to be a cheaper and faster alternative to the courts, for both patent owners and accused infringers to have the validity of asserted patents quickly and efficiently reviewed by the agency that issued them. Unfortunately it has become just as expensive, and a process where the validity rate is the inverse of that in Federal court. I believe the main reason for this disparity lies in the difference presumptions of validity that are applied.

To be more specific, the presumption in Federal court is that a patent is valid, and to uphold validity the claims are interpreted in a way that will maintain their validity in light of the prior art. Thus claims, to the extent possible, are interpreted as narrowly as possible (in light of the file history, common meaning of terms, etc.) in order to distinguish over the prior art. The trade off is that in finding the claims as "interpreted" by the court to be narrower than originally asserted by the patentee, a defendant can use this narrowed interpretation to avoid a claim of infringement. In this process, the patentee may lose the case but retains his patent.

The PTAB on the other hand has taken an entirely different approach to claim interpretation based on the false assumption that the claims can easily be amended, essentially applying the same claim interpretation standard as applied during patent prosecution: that is the claims are to be given their broadest reasonable interpretation. Here the burden shifts to the patent applicant to narrow claims during prosecution in order to overcome the prior art.

The difference between using this standard during initial prosecution and PTAB review is in the former the claims can be narrowed as a matter of right. This same right to amend also applied in Ex Parte Re-examination proceedings where amendments were freely permitted. In this context the "broadest reasonable interpretation standard made sense.

The problem in inter party review is that the application of this same claim interpretation standard has led to a patent kill rate approaching 65% for those cases that go to decision. Think of the PTAB as a form of quality control. If any entity had an product reject rate this high, it would be out of business. Even if the reject rate were only 40%, as some have argued, that would still be way to high. No normal business could survive a such a high rate. So what is happening?

I believe it is the application of different claim interpretation standards. Before the PTAB, in the one case I was involved with, amendment of claims was not a right but in essence a privilege. One had to petition the board, and then in a brief no longer than 25 pages, convince the PTAB that the amendment would render the claims allowable over all cited prior art, regardless of whether or not the cited references were relieved upon by the board in reaching its decision to initiate inter party review. This was an impossible to meet requirement, with very very few patentees attempting to amend under that system.

I understand the rules have since been liberalized somewhat, though amending claims is still not a matter of right. The net affect is to apply a claim interpretation standard which is based on a false premise: that the patentee can easily amend claims (as was the case during prosecution or ex parte re-examination) in order to distinguish over the prior art.

Bottom line, before the PTAB, I suggest the rules be changed to either grant the patentee the RIGHT to amend claims without having to petition , or apply the same claim interpretation standard as applied to claims by the Federal Courts. Then the inter parties process will become what was intended: a cheaper and faster alternative to the Federal courts for adjudicating patent validity.

Thank you.