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.

Thank you,
Cindy Cox