

# PUBLIC SUBMISSION

<b>As of:</b> 11/9/20 11:56 AM
<b>Received:</b> November 07, 2020
<b>Status:</b> Posted
<b>Posted:</b> November 09, 2020
<b>Tracking No.</b> 1k4-9jyk-mq6a
<b>Comments Due:</b> November 19, 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-2020-0055-0021

Comment from Shoes by Firebug.

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## Submitter Information

**Name:** Roy smith

**Address:**

111 Mayfair Ct

Sugar Land, TX, 77478

**Email:** traesmith@firebugshoes.com

**Phone:** 7139274412

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## General Comment

Please review the two letters attached.

A small independent inventor such as myself must have a dream, a patentable idea, invest in research, development, patent applications, production, sales, marketing and much more in order to bring a new product to market. This process, is in fact the American dream and often times represents the commitment of a-life-time, agony, stress, risking everything, all of which may be lost simply because the invented product is rejected by consumers.

However, if the dreams of that inventor come true, if the invented product proves a success, just at the moment when the American dream may be in sight, you can fully expect a fortune 100 company to infringe, stripping away the success an inventor has poured their-life into, while investing everything. That inventor may contact a law firm. That law firm may take the inventors patent infringement case on a contingency-bases. That law suit may then be prosecuted within the U.S. Federal Court for nearly a year, at which time the defendant, that fortune 100 company files a petition within the PTAB. This is when the inventors federal law suit is stayed, frozen, waiting upon the results of the PTAB. This is where the small

independent inventor, myself, received an education, a shocking reality I never believed possible in the United States of America.

Simply put, the PTAB, its rules and administrative judges has destroyed our patent system.

#### 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,

Roy R. Smith III (Trae)  
President  
Shoes by Firebug LLC  
111 Mayfair Ct.  
Sugar Land TX 77478  
713-927-4412

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## **Attachments**

Plea for Help Director Iacun

Plea for Help PTAB Chief Judge Jacqueline Bonilla



Roy R. Smith III (Trae)  
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111 Mayfair Ct.  
Sugar Land TX 77478  
713-927-4412

[TraeSmith@FirebugShoes.com](mailto:TraeSmith@FirebugShoes.com)

September 30, 2020

The Honorable Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

By FedEx No 7716-7692-1153

Dear Director Iancu,

This is a plea for help. The U.S. Court of Appeals for the Federal District ruled the PTAB erred in its ruling concerning my '574 patent. However, the Court refused to remand that case back to the PTAB, stating that the err was "harmless" to me (Firebug) and my request for rehearing, denied.

Full disclosure, I was one of the nine inventors who met with you and your staff on October 22<sup>nd</sup>, 2019. In that meeting, you listened to our stories, the loss of jobs, businesses, financial means, our patents and the trauma this inflicted. However, I could have never imagined that the U.S. Court of Appeals would later agree with my argument, that a preamble is in fact limiting, yet rule, such an err is harmless.

Though denied by the Court, I have attached my request for rehearing. If you would please review at least the highlighted areas of this request for rehearing, I believe this would provide you with a precise understanding of my case, separate from the bullet points below, a photo of my invention and two prior art figures.

Inter Party Reviews IPR2017-01809 & IPR2017-01810:

1. The PTAB instituted the IPR for the '574 patent on the bases that the preamble "an internally illuminated textile footwear comprises" was not limiting. This, despite case law.
2. The PTAB instituted the IPRs on the bases that anything above the sole of a shoe is the upper. This, despite undisputable evidence from text book teachings, and U.S. Customs which state that attachable components such as eyelets, tongues, embroidery, bows and other accessories are not considered the upper and that for a material to be considered an upper, that material must be suitable for use as a shoe upper.
3. Upon institution, these two rulings had transformed my light diffusing textile footwear, illuminated from an internal source, resulting in the textile upper being internally illuminated with an ambient glow across the outer surface of the shoe's textile upper, into the petitioner's prior art, a leather shoe with a light positioned behind a plastic window; a "technology" more than 30 years old.



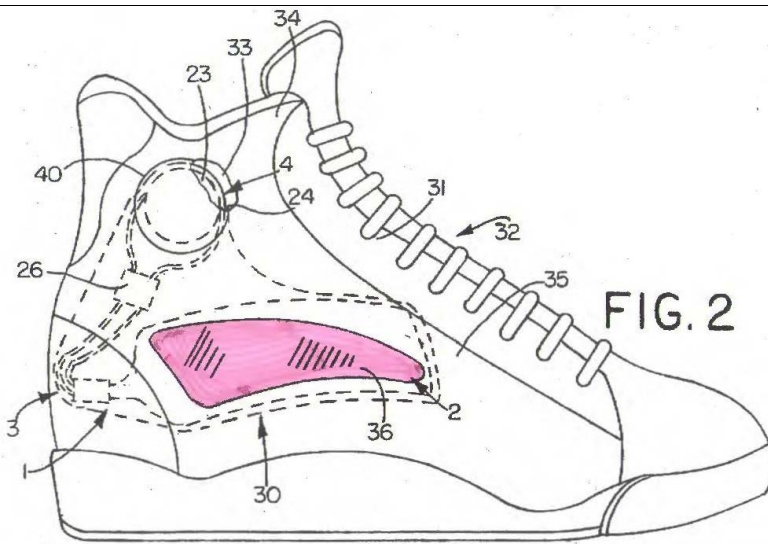
**'574 Firebug Patent**

**Preamble:**

“an internally illuminated textile footwear comprises”

**Final Limitation:**

“the plurality of illumination sources emitting light, wherein the light enters the light diffusing section, then exits the upper as diffused light, creating a visual impression of internal radiant illumination across an outer surface of the upper”



Upon institution the PTAB had transformed the Firebug patent '574, into the petitioner's prior art "figure 2" of Parker's '686, a leather shoe with a plastic window, whereby diffused light may pass through the plastic window, a technology more than 30 years old.

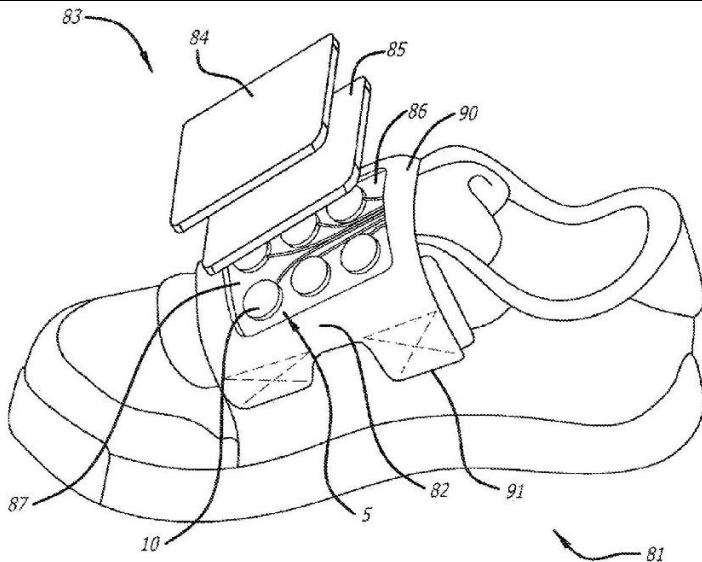


FIG. 1

Only in its final ruling did the PTAB cite in a footnote, the prior art Rosko (application 2011 0271558) writing that “Rosko suggests using porous material (85) in a light diffusing, internally illuminated part of footwear”, which is in fact positioned behind yet another plastic window, Rosko's display panel 84. The petitioner never argued that Rosko element 85 was the upper, nor was I ever allowed to respond to the PTAB's footnote. However, the Appeals Court cited this footnote in its final ruling and denied my request for rehearing.

My children's shoe business came under attack by a Berkshire Hathaway company and for the past 3 years, my company has had virtually zero gross revenue, while at the same time I have used all available resources to finance this litigation.

I respectfully request that you stay the invalidation of my '574 patent.

Truly yours,

A handwritten signature in black ink that reads "Roy R. Smith III". The signature is written in a cursive style with a large, stylized initial "R" at the beginning.

Roy R. Smith III (Trae)



Roy R. Smith III (Trae)  
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October 13, 2020

The Honorable Chief Judge Jacqueline Bonilla  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

By FedEx No 7717 8383 7670

Dear Chief Judge Bonilla,

I recently watched the America's Inventors Group webinar "Understanding Your Patent Rights in 2020" in which you participated. Though I would appreciate an opportunity to speak with you in more detail, your review of this letter is also appreciated. The U.S. Court of Appeals for the Federal District ruled the PTAB erred in its ruling concerning my '574 patent. However, the Court refused to remand that case back to the PTAB, stating that the err was "harmless" to me (Firebug) and my request for rehearing, denied.

Full disclosure, I was one of nine inventors who met with Director Iancu and his staff on October 22<sup>nd</sup>, 2019. In that meeting, the Director listened to our stories, the loss of jobs, businesses, financial means, our patents and the trauma this inflicted. However, I could have never imagined that the U.S. Court of Appeals would later agree with my argument, that a preamble is in fact limiting, yet rule, such an err is harmless.

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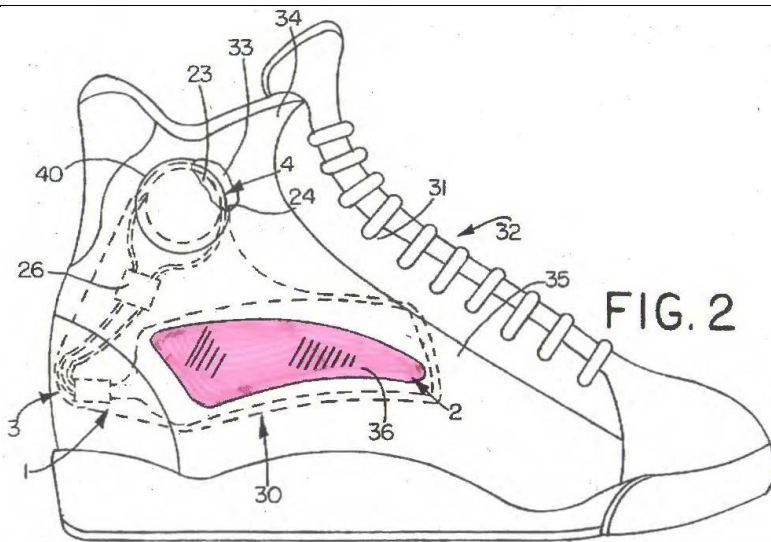
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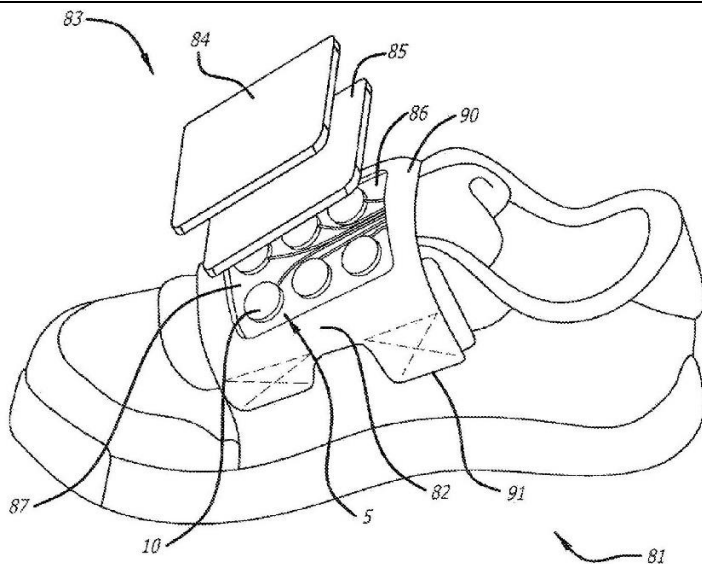


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Roy R. Smith III (Trae)