

PMC urges adoption of regulations governing discretionary institution of PTAB trials consistent with the following principles.

#### I: PREDICTABILITY

Regulations must provide predictability. Stakeholders deserve to know in advance whether for policy reasons a petition will be instituted or denied. Regulations should prescribe an objective analysis. Subjectivity, balancing, weighing, holistic viewing, and panel-dependent approaches should be avoided. The decision-making should be procedural and 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

IPRs were intended to backstop PTO decisions to issue patents, correcting errors under Sections 102 or 103. The IPR process was never intended to create an unending second-guessing of PTO operations. A 2nd-look is good error correction; a 5th-look is clearly an excessive burden on both patent owners and the PTO.

- 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 its 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

The IPR process was intended to provide a faster, less expensive method of resolving patent disputes under Section 102 and 103. Congressional intent was that IPRs would be a substitute for Article III trials, not an avenue for unlimited additional opportunities to invalidate a patent if a party is unsuccessful in District Court litigation. IPRs were not intended to give litigants a second bite at the apple when it comes to patent validity, let alone a third, fourth or fifth.

- 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 and trial is scheduled to occur within 18 months of the petition filing date.
- d) A petition should be denied when the challenged patent has been held not invalid in a final