



December 2, 2020

Patent Trial and Appeal Board
United States Patent and Trademark Office
Department of Commerce

RE: Docket No. PTO-C-2020-0055

Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board

The Center for Innovation and Free Enterprise (CIFE) has a longstanding history in supporting strong patents and legislative actions that promote American innovation.

As it relates to the Patent Trial and Appeal Board's request for comments re: Docket No. PTO-C-2020-0055, CIFE **supports** the following:

Per Serial Petitions

A rule with a case-specific analysis, such as generally outlined in *General Plastic, Valve I, Valve II* and their progeny for deciding whether to institute a petition on claims that have previously been challenged in another petition.

Per Parallel Petitions

A rule with a case-specific analysis, such as generally outlined in the Consolidated Trial Practice Guide for deciding whether to institute more than one petition filed at or about the same time on the same patent.

Per Proceedings in Other Tribunals

A rule with a case-specific analysis, such as generally outlined in *Fintiv* and its progeny for deciding whether to institute a petition on a patent that is or has been subject to other proceedings in a U.S. district court or the ITC.

Alternatively, as it relates to the Patent Trial and Appeal Board's request for comments re: Docket No. PTO-C-2020-0055, CIFE **opposes** the following:

Per Serial Petitions

The Office disregarding whether claims were previously challenged in another petition.

Per Parallel Petitions

The Office altogether disregarding the number of parallel petitions being filed.

Per Proceedings in Other Tribunals

The Office altogether disregarding the pendency of other proceedings in district court or the ITC.

CIFE proposes that the Office considers if the Petitioner is an accused infringer of the challenged patent when exercising discretion as well as if the Petitioner(s) who are not accused infringers be required to submit an explanation as to why they are seeking cancellation of a Patent Owner's claims.

Sincerely,



Ginevra Joyce-Myers

Executive Director

Center for Innovation and Free Enterprise

A Project of Americans for a Balanced Budget