

**From:** John D'Agostino  
**To:** [PTABNPR2018](#)  
**Subject:** Revised Comments In Support of Proposed Patent Office Rule Changes (PTO-P-2018-0036).  
**Date:** Monday, July 9, 2018 10:45:56 PM

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RE:PTO-P-2018-0036.

Dear Director Iancu:

These comments are submitted in support of your proposed rule changes to bring some semblance of reason back to the examination of patents in view of the manor in which the USPTO destroys an alarmingly high number of the patents it grants, at the instigation of large corporate infringers who have used procedures such as IPRs and CBM reviews (among others) as methods to create confusion regarding the validity of issued patents so that they can take advantage of their huge legal and lobbying budgets to infringe patents, and particularly those held by individual inventors and small companies, with impunity.

Simply stated, it is inherently ridiculous to give a patent claim two different meanings depending on who is reading it. A patent claim either does or does not mean the same thing as a prior art disclosure. A patent claim either does or does not cover a product or process. It should not make any difference what venue is analyzing it. This is self evident and is simple common sense that anyone can easily understand. The standard for construing claims should be standardized and uniform. The Phillips standard of using the patent description as key guide for understanding what the claims mean is the most logical approach. Who is better suited to explain the meaning of the invention than the inventor? Just because it is theoretically possible for a claim term to have a broader meaning than the ordinary meaning "in view of the specifications", does not make such a presumption reasonable. Infringers frequently use the broader standard as an excuse to proffer senseless claim construction theories which may be theoretically possible in a vacuum, but make little sense in view of the actual invention as described in the patent. This is one of their favorite tricks. That's why infringers love the broader standard. It is a great way to create confusion and they know this and capitalize on it routinely. They are always trying to confuse what is possible with what is reasonable. The broader standard helps them do this.

As for considering claim construction used in prior office procedures when construing claims, obviously this should be given strong consideration. The current state of affairs makes double jeopardy seem like a stroke of good luck. Where else but in the USPTO can someone have the same rights challenged and vindicated two, three, four, or even 5 times, and still be at risk of having a well funded corporate infringer use the Patent Office as a tool to make the same challenge, based on the same prior art, yet again? In my case, I am now in my second CAFC appeal (having won the first one) of yet another Patent Office ruling of invalidity based on the very same prior art which was: a) pointed out twice for special consideration prior to my patents being granted, b) denied as a basis for a reexamination because it could not meet even the low standard of raising a "substantial new question of patentability", c) completely overcome in a total validity victory in a reexamination which resulted after the infringer circumvented the denial decision by lobbying the unit director to reconsider the denial, d) denied as a basis for a CBM review, and e) later used by the Patent Office as the basis of invalidity in an IPR, only to have the bazaar new claim construction they used tossed by the CAFC as being completely unreasonable. Yes, that is exactly what happened. So how did the IPR panel respond upon remand? They resurrected an equally ridiculous claim construction

that had been rejected by the Patent Office in every procedure described above, including their own IPR, and decided that is suddenly made sense. It didn't. As I said, I must now appeal a claim construction which has already been rejected by the Patent Office multiple times. This is ludicrous!

The infringer lobby has made a mockery of post-grant proceedings and has made the Patent Office look ridiculous. It seems as though the Office spends more time overturning its own patent grants than it does granting patents. What other organization could operate with such inefficiency? When should an office decision on claim construction be final? When should an office determination of validity be final? The answer today is a resounding "never". How many times should the office change its own claim construction? How many times should the office reconsider the exact same prior art challenge? The answer for me has been that there is no limit.

I strongly support your proposed rule changes. These are long overdue steps in the right direction to address gross inequities in the present system which are the product of well funded lobbyists who get the laws and rules they want regardless of how unfair and unreasonable they are. It is an embarrassment.

Respectfully submitted,

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