

Kostelnik, Summer

From: David Prokop <davidprokop@gmail.com>
Sent: Saturday, February 09, 2013 2:58 AM
To: IP Policy
Subject: Request for Comments on a Patent Small Claims Proceeding in the United States

Dear MS Elizabeth Shaw,

Thank you for allowing me to give feedback regarding the patent small claims proceeding and tell my inventor's story.

below are my comments and story:

1. Provide a general description of your understanding of the need or lack of a need for a patent small claims court or other streamlined proceedings. If you believe there is a need, please provide a description of which types of patent cases would benefit from such proceedings. If you believe that there is not a need for such a court or proceedings, please share why you hold such a view. Show citation box

>> yes i believe there is a need for such a court proceeding. In fact I do not believe there is a 'workable' avenue for inventors to enforce thir claims.

I believe this court should have equal authority as the FTC to ban importation of infringing goods from international makers in China or other countries.

2. Please share your views, along with any corresponding analysis and empirical data, as to what a preferred patent small claims proceeding should look like. In doing so, please comment on any of the following issues:

(a) What the possible venues for a small claims proceeding should be, including whether patent small claims should be heard by Federal District Court judges or magistrates, whether patent small claims should be handled by an Article I court, such as the U.S. Court of Federal Claims, or whether patent small claims should be heard in another venue not specifically listed here;

>>federal court with judges that have experience with patents

(b) What the preferred subject matter jurisdiction of the patent small claims proceeding should be, including which if any claims, counterclaims, and defenses should be permitted in a patent small claims proceeding;

>> reduce the number of defences that can be used - re examinations, latches, etc.

(c) Whether parties should agree to waive their right to a jury trial as a condition of participating in a small claims proceeding;

>> no juried trials have proven to help inventors - big business wants a judge to decide, it has been proven judges award less damages than juries.

(d) Whether there should be certain required pleadings or evidence to initiate a small claims proceeding;

>> yes their should be discovery evidence showing patent infringement.

(e) Whether a filing fee should be required to initiate a small claims proceeding and what the nature of that fee should be;

>> the fee should be \$500

(f) Whether multiple parties should be able to file claims in a small claims proceeding and whether multiple defendants may be sued together;
>> yes multiple defendants, big business want inventors to sue them each individually - thus driving up the costs of patent enforcement.

(g) What role attorneys should have in a small claims proceeding including whether corporations should be able to represent themselves;
>> attorneys should help create the claims charts. The corporations should hand evidence to government attorney and they name of the corporation should not be made public.

(h) What the preferred case management characteristics that would help to control the length and expense of a small claims proceeding should be;
>> filed in inventor's state, should run as quickly as the FTC runs exclusion complaints.

(i) What the preferred remedies in a small claims proceeding should be including whether or not an injunction should be an available remedy and any minimum threshold or maximum cap on damages that should be imposed;
>. yes injunction effectively don't happen anymore - big infringing corporations prevent injunctions.

(j) Whether a small claims proceeding should include attorney's fees or some form of a "loser pays" system;
>> patent should be cancelled. should be the only penalty for inventor losing an infringement lawsuit.

(k) Whether a small claims proceeding should include mediation and whether mediation should be mandatory or permissive;
>> I did mediation and it did not work well.

(l) What type of record should be created during a small claims proceeding including whether hearings should be transcribed and whether a written decision should be issued;
>> yes written decision should be issued

(m) What weight should be given to a decision rendered in a small claims proceeding in terms of >. full precedent, res judicata, and estoppel;
>> full weight

(n) How should a decision in a small claims proceeding be enforced;
inventor loses patent.
infringer pays a reasonable royalty and does not invent around or try to circumvent the fee.

(o) What the nature of appellate review should be including whether there should be a direct appeal to the U.S. Court of Appeals for the Federal Circuit or whether there should be intermediate review by a U.S. district court or some other venue;
>> no review, too expensive, gets back into the same drive up costs scenario as current state of affairs.

(p) What, if any, constitutional issues would be raised by the creation of Federal small claims proceedings including separation of powers, the right to a jury trial, and/or due process;
>> inventors are currently protected under the constitution - is pretty clear section 8. never enforced.

(q) Whether the patent small claim proceedings should be self-supporting financially, including whether the winning and/or losing parties should be required to defray any administrative costs, and if so, how would this be accomplished;

>> should be supported by uspto patent fees system, no additional costs.

(r) Whether and how to evaluate patent small claims proceedings, including whether evaluations should be periodic and whether the patent small claims proceeding should be launched initially as a pilot program; and

>. immediately started

(s) Any other additional pertinent issues not identified above that the USPTO should consider. all information here is publically available.

i invented the gel filled mousepad for computer users in 1995 pat# 5,566,913. In 1998 i entered into an exclusive licensing contract with Case Logic, they paid me a 5% royalty for 6 years. (approx \$600,000) Case Logic exited the marketplace in 2004 due to aggressive marketing by other companies (3M) to 'buy shelf space' in retail stores, CaseLogic could no longer compete and they dropped the Geleez product line. in 2005 i took over the production and sales of the Geleez mousepad and filed a patent infringement lawsuit in Minnesota naming - 3M, fellowes, kensington, ACCO, fourstar. i settled out of court under council from my lawyer with the logic that the patent has never been 'tested' in court. I settled the lawsuit and took a "nuisance" fee of <\$70,000 as payment, on millions and millions of units of sales by the defendants approx .0001 royalty rate. I did not have the funds or experience to pay for a 'protracted' lawsuit, my lawyer was ill equipped to fight the defendants.

In 2007 I filed a second patent infringement lawsuit against - staples, velo (chinese knock off company), belkin, sp richards. The defendants immediately filed a re-examination request with the uspto (the lawsuit was stayed). after 4 years and appealing to the BPAI, the patent stood and came out stronger with new claims going from 21 claims to 35 claims. THE DAY AFTER THE RE-ISSUE CERTIFICATE, the defendants filed a SECOND re-examination request, it was granted AGAIN. I am in the 2nd year of the second reexamination, the lawsuit has been stated 6 years. All the money i made on the patent has been spent defending the re examinations. I am now in debt and doubtful the patent will withstand a second reexamination, i have exhausted my funds, and likely have only months left of answering the 20th office action by the uspto. The defendants can request a THRID re-examination.

There is no question in my mind a patent is not worth the time, money and effort I have put into trying to protect my patent rights. Even thou the gel mousepad product has been wildly successful product and has helped millions of computers users prevent carpal tunnel syndrome and US government OSHA recommends gel mousepads and gel wristrests as part of a safe computer workstation environment. I am proud of inventing a useful and helpful product, however I have risked all of my retirement and facing financial ruin, all while big corporations have made millions and millions of dollars of profit, and Velo the chinese company is 'un touchable', even if i win my lawsuit, they will likely never pay a penny.

I have 22 other inventions I have patented, however my first and most successful patent has brought me only grief.

A lone inventor doesn't have a chance against big corporations, the US Consitution section 8, does NOT protect inventors rights.

currently the cost to bring a patent lawsuit is \$2.5million dollars, very, very few independant patent holders can afford this fee.

Thank you
David Prokop