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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-2020-0055-0244
Comment from Matthew Gerules.

Submitter Information

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General Comment

Dear Sir or Madam,

I am writing to provide my view of the current unfair and disadvantaged climate for US ingenuity within the PTAB system.

As an employee, I have been privy to corporate executives mentioning that 'we'll just get their patents invalidated', when referencing others' intellectual property rights that lay in their path to quick market dominance.

I have been named as inventor on a number of patents and have also started my own company.

BUT, the climate of grass-roots American ingenuity, not originating from multi-national corporate conglomerates, is souring to the point that I, and many others like me, may not even pursue IP.

I feel the PTAB system is a rigged game and exists primarily as a business expense line-item to those rigging the game.

As the cost of living in America becomes more burdensome, with the headwinds of inflation, insurance, higher taxes, and wage plateaus for the typical American employee, and the cost of properly starting a legitimate side or start-up business keeps increasing, the propensity for individuals within the American populace to have the resources to actually follow-through on an innovation becomes logistically impossible.

Imagine the sheer magnitude of the opportunity cost, attributed to IP-Potential attrition of the American populace, as they are, more often than not, saying to themselves, "why bother with that, let's play another Tencent game, or watch another Netflix movie." No more Wright Brothers, no more Henry Fords, not more Westinghouses.

I am passionate about saving American ingenuity, because the very survival of our world just might depend on it.

I urge adoption of regulations to govern the discretion to institute PTAB trials consistent with the following principles.

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.

Faced with these attacks, it is simply not worth anyone laying out money and time to get a patent.

Sincerely,
Matt Gerules