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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-2020-0055-0349
Comment from Larry Robertson.

Submitter Information

Name: Larry Robertson
Address:
3407 Bella Vista Way
Bella Vista, AR, 72714
Email: lrobertson@aoninvent.com
Phone: 479-855-6699
Submitter's Representative: Larry Robertson
Organization: AON Invent

General Comment

My team and I work hard to help everyday Americans take their ideas to market. We may be the ONLY Invention company that has never had a complaint lodged against us. Unfortunately, we are all too aware of how large companies openly steal from anyone who can't afford to fund a million-dollar IP infringement case... The scales are unfairly tipped in favor of large corporations.

The USPTO needs regulations that govern the Director's discretion to institute PTAB trials. It's important that these regulations abide by the following precepts:

1. Sense of Congress & Impact on the Economy

The Sense of Congress in the AIA says the patent system should "protect the rights of small businesses and inventors from predatory behavior." Thus, the AIA requires regulations to help these entities protect their inventions. However, the current state of AIA trials allows big

business to engage in predatory behavior against them. Also, small businesses and inventors lack financial resources and access to effective legal representation in AIA trials. Today's knowledgeable inventors realize that AIA trials instituted on a patent owned by an inventor or the inventor's small business cause irreparable harm, and the idea of patent protection has shifted away from being an investment vehicle to being a risk of unnecessary disclosure and financial loss. Also, yesteryear's inventors who entered into the patent bargain and disclosed their inventions prior to the AIA did not agree to AIA trials, nor should they have expected it.

In sum, AIA trials have damaged inventors' trust in the patent grant, and the integrity of the patent system has become lost. This ruins the incentive to innovate and seek patent protection, thwarts new business development and competition, and harms the economy.

2. 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.

3. 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.

4. Proceeding Preference

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.

5. Privy & Interest

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.

Implementing these regulations will bring balance and protect the rights of small businesses and inventors, will cause inventor and investor confidence in the patent system to flourish, and will enable inventors to "continue to develop new technologies that spur growth and create jobs across the country", in accordance with the AIA's Sense of Congress.