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The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313-1450

Docket Number PTO-P-2019-0024

Re: USPTO Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board, 85 Federal Register 66502 (October 20, 2020)

Comcast Cable Communications, LLC (“Comcast”) appreciates the US Patent and Trademark Office’s continued commitment to improving the success of the administrative review proceedings created by Congress in the America Invents Act (“AIA”), as well as the opportunity to respond to the Office’s Federal Register request for comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board (“PTAB”). Comcast is both a leading innovator—listed among organizations that receive the most U.S. utility patents¹—and a company frequently subjected to abusive patent owner behaviors. Comcast believes that a balanced patent system that protects valid patents but rids the system of invalid patents promotes and protects U.S. innovation.

Congress created *inter partes* review (“IPR”) in the AIA as the result of a bipartisan effort to provide an improved alternative to litigation over the validity of granted patents by “establish[ing] a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”² Several aspects of IPR can make it, in some situations, a more advantageous venue for determining issues of patent validity than litigation in district courts or at the International Trade Commission (“ITC”). IPR is conducted by the expert patent judges of the PTAB, who are appointed by the Secretary of Commerce and must be “persons of competent legal knowledge and scientific ability,”³ while patent validity disputes in district court are resolved by lay jurors or judges likely without scientific training. In contrast to

¹ “Intellectual Property Owner’s Top 300 Organizations Granted U.S. Patents in 2019,” <https://ipo.org/wp-content/uploads/2020/05/2019-IPO-Patent-300%2%AE-Top-Patent-Owners-List-FINAL-DRAFT.pdf>, (indicating that Comcast procured 270 U.S. utility patents in 2019) (last visited Nov. 19, 2020).

² H.R. Rep. No. 98, at 39-40, 112th Cong., 1st Sess. (2011) (“House Report”).

³ 35 U.S.C. § 6(a), (c).

general verdicts in typical jury trials, IPR ends with a “final written decision,”⁴ which enables a more informed appellate review. In contrast to ITC rulings, IPR decisions are preclusive.⁵ Thus, IPR enhances patent quality and can offer a more effective and efficient means to challenge low-quality patents and mitigate abusive litigation tactics.

Until fairly recently, IPR has been working as intended: reducing the high costs of challenging low-quality patents and curbing abusive behaviors that coerce companies into settling frivolous cases.⁶ But recent actions taken by the PTAB, namely the expansive use of discretionary denials, have weakened the effectiveness of IPR in achieving the intended goals. Recent institution decisions, denying petitions based on purely procedural grounds and without regard for the merits, are functioning to cut off access to IPR altogether. This is evident in recent trends. For example, the institution rate for IPR had dropped every year since the launch of IPR in 2013.⁷ And an exponentially growing proportion of institution denials is attributable to procedural denial, and namely to denials due to the PTAB exercising its discretion under 35 U.S.C. § 314(a).⁸

Comcast, as a high-technology company and leading innovator, is often the target of infringement claims of low-quality patents that IPR was designed to weed out. Comcast has therefore availed itself of IPR extensively, ranking as a top filer of IPR petitions, with 75 IPR petitions instituted to date. Comcast has successfully established unpatentability of claims in 87% of the instances in which IPR has proceeded to a final written decision. Comcast has been

⁴ 35 U.S.C. § 318(a).

⁵ *Max-Linear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018).

⁶ *See, e.g.*, “Inter Partes Review: Five Years, Over \$2 Billion Saved,” <http://www.patentprogress.org/2017/09/14/inter-partes-review-saves-over-2-billion/> (estimating that “implementation of *inter partes* review has helped plaintiffs and defendants avoid at least \$2.31 billion in deadweight losses by providing an efficient system for challenging patents”) (last visited Nov. 19, 2020); “Inter partes review as a means to improve patent quality,” <https://www.rstreet.org/2017/09/25/inter-partes-review-as-a-means-to-improve-patent-quality/> (“[T]he PTAB’s decisions have been continually affirmed by the Federal Circuit, which clearly demonstrates its success thus far as a means to increase patent quality. ... In fact, startups, independent inventors and even large companies have prospered because of the corresponding invalidations of poorly constructed and overly broad patents.”) (last visited Nov. 19, 2020).

⁷ “PTAB Annual Report,” <https://portal.unifiedpatents.com/ptab/annual-report?year=2020> (last visited Nov. 19, 2020).

⁸ “PTAB Procedural Denials and the Rise of § 314,” <https://www.unifiedpatents.com/insights/2020/5/13/ptab-procedural-denial-and-the-rise-of-314> (last visited Nov. 19, 2020).

affected by the growth in procedural denials and has observed the weakening of IPR as a mechanism to weed out low-quality patents as Congress had intended. Specifically, a number of Comcast petitions have been discretionarily denied without any regard for the merits of the petitions themselves. As one recent example, three Comcast petitions were discretionarily denied institution based on the status of a co-pending ITC proceeding, where only one claim of the subject patent was at issue in the ITC proceeding, the ITC's invalidity ruling on that one claim was not binding, a parallel federal court action in which the patent was being asserted was stayed pending the ITC proceeding, and the Commission had even decided to review the ALJ's preliminary invalidity finding.¹¹

In response to the questions posed in the Office's Federal Register request for comments, Comcast supports the Office: (1) disregarding other proceedings in district court or the ITC in deciding whether to institute a petition on a patent that is or has been subject to such other proceedings; (2) disregarding the number of petitions filed in deciding whether to institute more than one petition filed at or about the same time on the same patent; and (3) disregarding whether the claims have previously been challenged in another petition in deciding whether to institute a petition. Each issue will be addressed in turn.

I. Proceedings in Other Tribunals

The Office's Federal Register request for comments posed the following questions regarding proceedings in other tribunals:

5. Should the Office promulgate 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?

6. Alternatively, in deciding whether to institute a petition on a patent that is or has been subject to other proceedings in district court or the ITC, should the Office (a) altogether disregard such other proceedings, or (b) altogether decline to institute if the patent that is or has been subject to such other proceedings, unless the district court or the ITC has indicated that it will stay the action?

Comcast supports the Office disregarding other proceedings in district court or the ITC in deciding whether to institute a petition on a patent that is or has been subject to such other proceedings.

Two recent precedential PTAB decisions have resulted in the massive expansion of procedural decisions under Section 314(a) based primarily, if not solely, on the status of

¹¹ *Comcast Cable Communications, LLC v. Rovi Guides, Inc.*, IPR2020-00800, IPR2020-00801, IPR2020-00802, Paper 10 (PTAB Oct. 22, 2020).

proceedings in a co-pending litigation.¹² These procedural decisions are not based on the merits of the petition. Rather, they result in the discretionary denial of meritorious, timely-filed IPR petitions and leave invalid patents in force to be litigated against the petitioner and others. Further, such discretionary denials are continuing to be more expansively used by the PTAB. A recent report shows that discretionary denials have grown exponentially over the past three years and are on track to double yet again this year.¹³

This trend has led to patent owners exerting gamesmanship to avoid IPR. By simply pointing to a proposed schedule in a pending district court or ITC proceeding that has not yet been stayed, IPR may be avoided, allowing questionable patents to remain unreviewed. This recent trend, in instituting petitions only where there is no co-pending litigation or the litigation is proceeding slowly, is severely misguided and undermines the very purpose of IPR. Congress intended for IPR to complement the patent litigation system, and a significant majority of IPRs arise from litigation.

In enacting the AIA, Congress explicitly considered the interaction between an already-filed patent infringement suit and an IPR petition filed by the defendant. Congress determined that, so long as the IPR petition is filed within a year after service of a complaint, IPR will not be unduly disruptive of the district court suit.¹⁴ In other words, Congress considered the potential for IPR to delay or otherwise interfere with a district court action that has already substantially progressed toward judgment—and it concluded that imposing a one-year deadline would adequately balance that concern with the need to provide alleged infringers adequate time to evaluate the patent claims and prepare for IPR.¹⁵ Indeed, the 2011 Committee Report noted that an initially proposed 6-month deadline was amended to a 12-month deadline, at least in part based on the following rationale:

High-technology companies, in particular, have noted that they are often sued by defendants asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant's products. Current [i.e., pre-AIA,] law imposes no deadline on seeking *inter partes* reexamination. And in light of the present bill's enhanced estoppels, it is important that the section 315(b) deadline afford defendants a reasonable opportunity to

¹² *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495 (PTAB Mar. 20, 2020); *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, 2018 WL 4373643 (PTAB Sept. 12, 2018).

¹³ "PTAB Discretionary Denials: In the First Half of 2020, Denials Already Exceed All of 2019," <https://www.unifiedpatents.com/insights/2020/7/27/ptab-discretionary-denials-in-the-first-half-of-2020-denials-already-exceed-all-of-2019> (last visited Nov. 19, 2020); "PTAB Procedural Denials and the Rise of § 314," <https://www.unifiedpatents.com/insights/2020/5/13/ptab-procedural-denial-and-the-rise-of-314> (last visited Nov. 19, 2020).

¹⁴ H.R. Rep. No. 112-98, at 47 (2011).

¹⁵ 35 U.S.C. § 315(b).

identify and understand the patent claims that are relevant to the litigation. It is thus appropriate to extend the section 315(b) deadline to one year.¹⁶

Congress knew IPR and litigation about the same patent claim would often proceed in parallel, and the one-year limit was carefully calibrated to ensure that IPR is not used for delay while also giving defendants an adequate opportunity to investigate the claims asserted against them in litigation. In derogation of the statutory deadline enacted by Congress, the PTAB has substituted its own policy preference by directing the “discretionary denial” of timely-filed IPR petitions if a co-pending litigation docket an early trial date. This has led to discretionary denials that vary based on the speed of a given forum, resulting in unpredictability in the availability of IPR and forum shopping by patent owners. This not only results in meritorious petitions being denied on extra-statutory grounds, but it also adds precisely the cost, complexity, and uncertainty that Congress sought to avoid by adopting a simple, clear one-year time bar, in 35 U.S.C. § 315(b).

To be sure, the PTAB may decline to institute IPR in individual cases.¹⁷ But the PTAB may not decline to institute on grounds that undermine Congress’s considered policy judgments. The one-year deadline in Section 315(b) reflects Congress’s judgment that a bright-line time bar—not a discretionary multifactor test—is the best mechanism for balancing the need to avoid disruption of district court proceedings with the need to allow defendants time to prepare their petitions. The *Fintiv* approach thus institutes the very discretionary, multifactor analysis that Congress declined to adopt. Under that approach, infringement defendants must account for the possibility that their petitions may be denied based on the progress of other litigation, even if they file within one year of that litigation. Rather than relying on the one-year deadline, IPR petitioners must attempt to file early—but in the face of considerable uncertainty about just how early they should file. IPR petitions will therefore lose the opportunity to evaluate the claims as asserted in litigation that Congress purposely gave them.

By contrast, where Congress wanted to give the PTAB discretion to deny IPR based on parallel proceedings, it knew how to do so explicitly. For example, the AIA provides that if the IPR petitioner has previously filed suit challenging the validity of a patent claim, IPR may not be instituted at all—regardless of how much time has passed between the suit and the IPR petition.¹⁸ Similarly, Congress expressly granted the PTAB discretion to decide how to manage IPRs when there is a parallel proceeding before the Office.¹⁹ Nowhere did Congress authorize denial of a timely IPR petition based on overlap with parallel district court or ITC litigation brought by the patent owner. To the contrary, Congress expressly provided that a petitioner’s counterclaim challenging the validity of a patent claim in such parallel proceedings would not bar IPR.²⁰ Although the AIA accords some discretion to the PTAB in evaluating the merits of IPR petitions

¹⁶ 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl); S. 23, 112th Cong. sec. 5(a), § 315(b) (2011) (as passed by the Senate).

¹⁷ 35 U.S.C. § 314(a).

¹⁸ 35 U.S.C. § 315(a)(1).

¹⁹ 35 U.S.C. §§ 315(d) and 325(d).

²⁰ 35 U.S.C. § 315(a)(3).

or promulgating rules governing IPR institution, that discretion is limited.²¹ It certainly is not unbounded and cannot be exercised in a manner that is contrary to the statute's text, structure, and purpose and contrary to Congress' considered policy judgments.

Besides exceeding the PTAB's statutory authority to decline to institute review, the current discretionary approach has analytical flaws and causes several adverse consequences. For one thing, as part of assessing the progress of a parallel proceeding, the PTAB's focus on past investment in the proceeding (*Fintiv* factor 3) is misplaced. This is a sunk cost. Instead, Comcast submits that the analysis, if any, should focus on *future* investment in IPR as compared to the co-pending litigation. This comparison will almost always favor IPR.

Looking to a trial schedule is also a misguided approach to deny institution. Trial schedules are inherently speculative and are pushed back in a significant proportion of cases. Many IPR petitions denied by the PTAB based upon a looming trial date have seen subsequent significant delays in trial dates.²² And most infringement cases never result in a trial. Thus, the premise that district courts will determine patent validity sooner than the PTAB is speculative and does not reflect reality.

Further, this new PTAB policy has been applied inconsistently. Unjustifiable and unpredictable disparities among similarly-situated IPR petitioners have resulted, reflecting the uncertainty and malleability of the factors used in considering discretionary denial. For example, an overlap in issues between IPR and litigation has sometimes favored institution, but at other times disfavored institution.²³

An issue of further inconsistency is the application of discretionary denials where there is a co-pending ITC investigation. Unlike most district court litigation, ITC investigations are expedited. An ITC investigation will typically finish more quickly than a PTAB proceeding.²⁴ Treatment of ITC expedited schedules has been greatly inconsistent. In one instance, the PTAB determined "that efficiency and integrity of the system are best served by instituting review," emphasizing the differences between an IPR and the parallel ITC investigation and disregarding

²¹ See 35 U.S.C. §§ 314(a) and 316(b).

²² "District Court Trial Dates Tend to Slip After PTAB Discretionary Denials," <https://www.patentspostgrant.com/district-court-trial-dates-tend-to-slip-after-ptab-discretionary-denials/> (last visited Nov. 19, 2020).

²³ *Compare Medtronic, Inc., & Medtronic Vascular, Inc. v. Teleflex Innovations S.à.r.l.*, IPR2020-00135, 2020 WL 3053201 (PTAB Jun. 8, 2020) with *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00122, 2020 WL 2511246 (PTAB May 15, 2020).

²⁴ "SECTION 337 STATISTICS: AVERAGE LENGTH OF INVESTIGATIONS," https://www.usitc.gov/intellectual_property/337_statistics_average_length_investigations.htm (last visited Nov. 19, 2020).

the schedule of the ITC investigation.²⁵ In other recent instances, involving a similar timeline, the PTAB declined institution noting the advanced stage in the ITC proceedings.²⁶

Given the expedited schedules of ITC investigations, IPR petitions likely would be denied whenever there are co-pending ITC investigations. For many reasons, an ITC investigation is a poor substitute for IPR. For instance, a patent-based ITC investigation can involve a wide range of issues—including infringement, invalidity (under all applicable theories), importation, technical and economic domestic industries, remedies and the public interest, while an IPR proceeding encompasses only patent validity challenges under anticipation or obviousness theories arising from prior art patents and printed publications. The three administrative patent judges handling an IPR have greater subject matter expertise and will have more time to focus on the relevant subset of patent invalidity issues than an administrative law judge at the ITC, who must consider more issues over a shorter period.

Lastly, and most importantly, the ITC does not have the power to cancel patent claims, even where a claim is demonstrated to be unpatentable. District courts and other tribunals are not bound by any ruling from the ITC that a patent is invalid²⁷, and such patents may continue to be asserted and litigated against the public, at great expense. An ITC investigation is a wholly inadequate substitute for IPR. Thus, in considering whether to discretionarily deny an IPR, the PTAB should disregard any parallel ITC case. And even if an ITC proceeding may end before an IPR, a follow-on parallel district court proceeding would not. Thus, at the very least, if the PTAB considers any parallel ITC proceeding at all, it should consider all potential cases: the ITC proceeding and any parallel district court proceeding that would have to go forward following the ITC proceeding.

Additionally, typically only a small handful of claims are tried in an ITC investigation, with the bulk of the patent claims being delayed for assertion in the district court. Discretionarily denying an IPR based on a co-pending ITC investigation means there will be a subsequent district court case years later where the validity of all claims will need to be litigated and potentially tried. For example, of the patents previously asserted against Comcast in 2016, none went to trial in the district court regarding Comcast's invalidity claims or otherwise. *See, e.g., Rovi Guides, Inc., v. Comcast Corp., et al., Joint Status Report*, Case No. 1:16-cv-09826-JPO (S.D.N.Y.) (July 2, 2020).

Under current trends, petitioners are forced to file IPR petitions at earlier stages of litigation, where there is less certainty over the patent claims at issue, their scope, and how the patent owner interprets them. This also leads to lower-quality IPR petitions. Forcing infringement

²⁵ *3Shape A/S v. Align Tech., Inc.*, IPR2020-00223, Paper 12 (PTAB May 26, 2020).

²⁶ *Bio-Rad Laboratories, Inc v. 10X Genomics, Inc.*, IPR2019-00567, Paper 23 (PTAB Aug. 8, 2019); *Fitbit, Inc. v. Koninklijke Philips*, IPR2020-00771, Paper 14 (PTAB Oct. 19, 2020).

²⁷ *See Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 851 F.2d 342, 344 (Fed. Cir. 1988) (stating that ITC determinations regarding patent issues should be given no collateral estoppel effect); *Corning Glass Works v. United States Int'l Trade Comm'n*, 799 F.2d 1559, 1570 n. 12 (Fed. Cir. 1986) (stating that the legislative history of the Trade Reform Act of 1974 supports the position that ITC decisions have no preclusive effect in district courts).

defendants to file IPR petitions earlier in litigation thus undermines a high quality and efficient IPR process. Even where an infringement defendant succeeds in rushing to file an IPR petition at a relative early date, the PTAB may still deny institution, simply based on the status of co-pending litigation.²⁸

Petitioners are already incentivized to file IPR petitions as soon as possible so that an invalidity decision resulting from IPR can affect the co-pending litigation and save costs. Of a set of 123 IPR petitions filed by Comcast, petitions were filed between 183 days and 363 days of service of a complaint. This timing is consistent with and attributable to the same concerns that Senator Kyl noted in recommending extending the statutory deadline from 6 months to one year. In addition, searching for and vetting the best prior art is an on-going, iterative process that can take months. Preparing strong IPR petitions that survive PTAB scrutiny along with the supporting documents similarly adds months to the filing timeline. This process takes long enough in isolation for one patent. But, as is often the case, preparing IPRs in response to the simultaneous assertion of multiple patents adds complication and time for these filings. Further adding to this timeline, these often complex proceedings must be modified and updated to reflect positions taken in parallel litigation. Additional time may also be needed for review of IPR petitions and related documents by clients and co-counsel. Filing an IPR petition close to the 1-year statutory deadline is not playing games, but a natural result of the time, effort, attention to detail, and parallel efforts by different teams of lawyers to identify the best prior art, understand the patent claims at issue and how the patentee interprets them, and then prepare a compelling petition or petitions that comply with the PTAB's IPR filing requirements.

Decisions by district courts are vastly more expensive (about 10 times more expensive) and offer no measurable increase in accuracy of patentability determinations. Thus, defendants are often forced into nuisance settlements with patent assertion entities, in which no forum ever considers the validity of the patent at issues—completely frustrating Congress's express purpose in creating IPR. These discretionary denials effectively undermine the purpose of IPR in providing a streamlined and specialized alternative to litigation over patent validity. In creating IPR, Congress sought to encourage defendants accused of patent infringement in litigation to assert their potentially meritorious challenges to patentability in an IPR petition—*inviting* overlap between IPR and litigation in which the petitioner would assert those same challenges as defenses against an infringement claim. Yet the recent application of discretionary denials threatens to make IPR unavailable in precisely the circumstances where Congress intended it to operate, defeating IPR's role as a more efficient mechanism for clearing away invalid patents and ultimately weakening the patent system.

Patent assertion entities may thus employ strategic gamesmanship in forum shopping for desirable trial timelines (*e.g.*, at the ITC or “rocket docket” district courts), strategically timing patent assertions and lawsuit, delaying certain stages of litigation, or expediting others, to avoid the possibility of an instituted IPR. For example, a patent owner can push for an aggressive trial

²⁸ *Fitbit*, IPR2020-00771, Paper 14 at 19 (denying institution citing to an estimated trial date despite commending “Petitioner’s diligence in filing this Petition within a short time after the ITC proceeding was instituted”).

schedule, or file in venues known for setting (but not necessarily keeping) aggressive schedules and early trial dates, and then argue that the PTAB should forego IPR because of the advanced stage of proceedings in the litigation. Even more damaging, the PTAB has not been willing to consider a patent owner's litigation history as relevant to institution.²⁹ This is a particularly acute problem for the technological industry in which Comcast operates.

Accused infringers may also face distorted incentives. For example, even though a motion to dismiss is available and can usefully crystallize the issues in the case, an accused infringer might be disincentivized to bring such a motion if doing so would accelerate the point where IPR institution may be denied due to progress of the litigation proceedings.

These actions degrade IPR and are a primary, direct contributor to the recent growth in the number of abusive suits brought by non-practicing entities.³⁰ The resultant increased litigation and forum shopping is precisely the type of "counterproductive litigation" that Congress sought to stem by passing the AIA.³¹ Such unnecessary and abusive litigation will be harmful to US companies and employers if this practice continues.

II. Parallel Petitions

The Office's Federal Register request for comments posed the following questions regarding parallel petitions:

3. Should the Office promulgate 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?
4. Alternatively, in deciding whether to institute more than one petition filed at or about the same time on the same patent, should the Office (a) altogether disregard the number of petitions filed, or (b) altogether decline to institute on more than one petition?

Comcast supports the Office ordinarily disregarding the number of petitions filed in deciding whether to institute more than one petition filed at or about the same time on the same patent, absent clear evidence of abuse. The Office should not institute a categorical prohibition on multiple petitions. There are several reasons that multiple petitions may be warranted for the same patent.

²⁹ See, e.g., *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00106, Paper 17 at 12-13 (May 5, 2020) (denying institution) (although petitioner extensively addressed plaintiff's prolific litigation history, the PTAB did not consider it as relevant to institution).

³⁰ "Litigation on the Rise: Number of New Cases Filed By Patent Assertion Entities (PAEs)," https://static1.squarespace.com/static/571681753c44d835a440c8b5/t/5eb03467c0e81e79e64c5bb0/1588606056624/Pae+stats+Diagram_Jan++Apr.pdf (last visited Nov. 19, 2020).

³¹ House Report, p. 40.

For instance, a patent may have numerous different embodiments falling within the claims. Different prior art references may have one or more embodiments but rarely have every embodiment. Such numerous embodiments may entail the application of various different prior art references or prior art combinations that necessitate multiple petitions.

As another example, some prior art may more closely resemble the accused product than the challenged patent. This type of prior art may be of interest so that even if the patent cannot be invalidated, the petitioner is ensured that practicing the prior art does not infringe the challenged patent.

Some prior art may be better tailored to a jury trial in a district court than the PTAB handling an IPR. A petitioner may seek to preserve those prior art references for trial while also petitioning for IPR with other prior art references better tailored to IPR, where PTAB judges have subject matter expertise.

The maximum word count for IPR petitions also necessitates multiple petitions in many instances. For example, some patents have a large number of claims or lengthy claims containing many limitations. As the claims that ultimately go to trial are subject to change throughout a litigation, a petitioner should be able to challenge all claims of a patent. Some patents have claims covering different inventive concepts that are difficult to cover in one petition. As another example, some patent claims may be subject to several potential claim constructions. It may not be possible to cover every possible claim construction position that the patent owner may take within the 14,000-word count limit of an IPR petition.

Following the Supreme Court's ruling in *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348 (2018), the PTAB must institute review with respect to all challenged claims in a petition if it institutes on one claim, even if a likelihood of success has been identified regarding only one of them. Parallel petitions may provide the PTAB with the ability to reach different institution decisions for different claims. In some of the above scenarios, dividing challenged claims or invalidity assertions among different petitions may more efficiently allow the PTAB to institute less than all asserted claims.

III. Serial Petitions

The Office's Federal Register request for comments posed the following questions regarding serial petitions:

1. Should the Office promulgate 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?
2. Alternatively, in deciding whether to institute a petition, should the Office (a) altogether disregard whether the claims have previously been challenged in another

petition, or (b) altogether decline to institute if the claims have previously been challenged in another petition?

Comcast supports the Office ordinarily disregarding whether the claims have previously been challenged in another petition in deciding whether to institute a petition, absent clear evidence of abuse. The Office should not institute a categorical prohibition on multiple petitions. So long as the petition is filed within the requirements set by 35 U.S.C. § 315(b), the status of an earlier filed IPR petition should bear little-to-no weight in deciding whether to institute a petition. For example, where a claim construction is adopted in a first IPR that differs from the claim construction presented in the petition, a petitioner should be permitted to file a second petition with the claim construction adopted by the PTAB, so long as it is filed within the timeline set by 35 U.S.C. §315(b). As another example, a petitioner may identify additional prior art references after an initial petition.

The PTAB has limited follow-on petitions under the premise that it may allow a petitioner to use the PTAB's denials as road map until a ground is found that results in institution. However, IPR proceedings are part of a prosecution file history and can be considered in other proceedings. There is no reason why an IPR petitioner should be prohibited from considering the previous IPR, as any other party could do. This is the same as a party considering the prosecution history of a patent when filing an initial IPR. If a patent owner argues for and receives a particular claim construction which the petitioner did not adequately anticipate, there is no ability to amend the IPR petition after claim construction. This leaves the IPR petitioner in a bind. Every district court allows the defendant to amend their invalidity contentions after claim construction. In an IPR, this basic due process is denied. The IPR process should either allow amendment after claim construction or allow for follow-on IPR petitions.

Further, denying a party any chance to use IPR simply because the patent owner sued some other, unrelated party earlier in time and that unrelated party sought to utilize IPR is fundamentally unfair, is an invitation for gamesmanship by the owners of invalid patents, and is at odds with Congress' goals in enacting the AIA.³²

Concerns about serial attacks and gamesmanship by petitioners are minimized given the one-year time bar applicable to petitioners and their real parties-in-interest or privies. Thus, if the relationship (if any) between petitioners in follow-on petition scenarios should be considered under the first *General Plastic* factor, Comcast proposes that the relationship should only extend to real parties-in-interest or privies.

IV. Conclusion

The recent actions by the PTAB, in denying institution of IPR without regard to the merits of the petition, harm the economy and are contrary to the promise of the AIA. A crucial element of any strong patent system is a mechanism for "weeding out" weak patents that never should have

³² House Report, p. 40.

been granted because the claimed invention was not novel or would have been obvious in light of prior art.³³

Comcast reiterates its support for the Office's goal to improve the administrative review process but respectfully disagrees with the PTAB's increasing use of discretionary denials. Promulgating a rule that codifies the use of discretionary denials would undermine due process in AIA post-grant proceedings and thwart Congress's stated purpose for these proceedings. Comcast appreciates the Office's consideration of its comments.

Sincerely,

/Heather A. Faltin/

Heather A. Faltin
Vice President and Senior Deputy General Counsel - Patents
Comcast Cable

³³ *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020).