PUBLIC SUBMISSION

As of: 11/6/20 8:10 AM
Received: November 05, 2020
Status: Posted
Posted: November 06, 2020
Tracking No. 1k4-9jx5-tc1z
Comments Due: November 19, 2020
Submission Type: API

Docket: PTO-C-2020-0055
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-2020-0055-0011
Comment from Dr. Steven LeBoeuf.

Submitter Information

Name: Dr. Steven LeBoeuf
Address:
4601 Six Forks Rd., Suite 103
Raleigh, North Carolina, 27609
Email: leboeuf@valencell.com
Phone: 919.601.7956
Submitter's Representative: Dr. Steven F. LeBoeuf
Organization: Valencell, Inc.

General Comment

PTAB folks,

Thanks for y'all's time! You may be familiar with the Valencell story, as we have become the well-publicized poster-child for the weaponization of IPRs against small tech start-ups by big-tech competitors (please see this link for the story: https://www.robinskaplan.com/-/media/pdfs/weaponizing-iprs.pdf?la=en).

In short, after filing suit against Apple and Fitbit for infringing several of our patents on biometric sensor technology for wearables, representing inventions we use in several product offerings around the world, Apple levied over a dozen IPRs against Valencell's patent portfolio -- even patents that were unrelated to our lawsuit! It appears that Apple's goal was to exploit loopholes in the IPR system to threaten Valencell with bankruptcy, by forcing us to defend our assets at the PTAB with millions and millions in legal bills. And they almost succeeded. Only by the grace of God did we survive.

Since then, we have joined forces with the US Inventor folks to help restore balance to our patent system. And while Valencell's fight with Apple has ended, we do believe our efforts can help prevent other tech start-ups and other small practicing entities from getting plowed-over by big tech.

Below I have copied some of the tenants we'd much like you to consider in policies of discretion to be used at the PTAB. Moreover, I'd be delighted to speak with y'all directly to provide constructive feedback based on my experiences with the IPR process.

Thanks for y'all's time, and good luck with y'all's work!

Lache pas,

Dr. Steven F. LeBoeuf
President & Co-founder
Valencell, Inc.

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.