



December 3, 2020

Scott C. Weidenfeller
Vice Chief Administrative Patent Judge
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22314

Re: Request for Comments, Docket No. PTO-C-2020-0055

Dear Judge Weidenfeller:

NVIDIA writes to encourage the Office to strengthen the patent system by focusing on patentability in its institution decisions. Doing so fulfills Congress' aim in passing the AIA of creating an efficient process for improving patent quality. H.R. Rep. No. 112-98, pt. 1, at 39-40 (2011).

Multiple Petitions Can Further the Goals of the AIA

Patentability is the bedrock of the patent system. Patents should not be granted or maintained unless their claims meet the “conditions and requirements” of patentability. 35 U.S.C. § 101. Despite its importance, determining patentability may be difficult. The prior art is vast, claims may be long, vague, and numerous, and the Office’s resources are limited. Nevertheless, the focus should always be on whether the claimed inventions meet the requirements of patentability. Applied to the AIA context, the paramount consideration must be whether the grounds presented in a petition show a reasonable likelihood that issued claims are unpatentable and should be cancelled. H.R. Rep. No. 112-98, pt. 1, at 47.

To maintain patentability at the center of the Board’s institution decisions, NVIDIA offers three proposals in response to the Board’s questions about multiple petitions (*i.e.*, “serial” and “parallel” petitions).

First, the Board should not adopt a bright-line standard, whether by rule or agency practice, against multiple petitions. The mere existence of more than one petition says nothing about patentability. As an example, the denial of a prior petition on solely procedural grounds does not speak to patentability. Moreover, a single petition necessarily zooms in on a small number of references. Thus, even a substantive decision on a prior petition addresses only the particular references at issue in that petition without necessarily implying anything broader about the scope of the prior art. Accordingly, the Board should not deny a meritorious petition simply because another petition was also filed against the same patent claims.

Second, the Board should focus on substantive questions of patentability when comparing one petition against another. No petitioner writes on a blank slate. Even a first petition needs to explain what the art in the petition teaches in addition to what was previously addressed during the original prosecution. Similarly, any subsequent petition also needs to explain what its new art adds over what was addressed by any other petitions. Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at 63. Supplied with that context, the Board can efficiently and effectively evaluate whether additional petitions present materially different grounds or are simply redundant of previous petitions. The Board should focus on that substantive analysis rather than heavily weighting non-substantive factors, such as the identity of the petitioner or number of petitions filed, in its institution decisions.

Third, responding to arguments made by the patent owner or findings made by the PTAB is an efficient use of resources, not evidence of harassment. There is nothing improper about a petitioner filing a subsequent petition where, for example, further prior art is identified, claim constructions are brought to light, infringement claims are clarified or expanded, or correctable deficiencies in a prior petition are discovered. To the contrary, enabling the petitioner to address disputes within the statute's one-year window helps focus the parties and the Board on the key issues. Indeed, by penalizing petitioners who wait to file petitions until the case is further developed, precedents like *NHK Springs* and *Fintiv* may increase the need for subsequent petitions.

AIA Trials Are Not Duplicative of District Court or ITC Proceedings

In determining whether to institute an AIA trial, the Board should accord little weight, if any, to the existence of proceedings in the district courts or International Trade Commission. AIA trials serve a unique role in the patent system that is not made superfluous by those other proceedings. The administrative patent judges bring scientific expertise to the decisions, not merely legal knowledge. 35 U.S.C. § 6(a). This expertise differentiates AIA trials from invalidity inquiries within the district courts that are largely resolved by lay juries or investigations in the ITC. Moreover, the standard of proof in AIA trials is a preponderance of the evidence, whereas the standard of proof for determining patent invalidity in district court cases and ITC investigations is clear and convincing evidence. Compare 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d), with 35 U.S.C. § 282; *Microsoft Corp. v. i4i Limited Partnership*, 564 U.S. 91 (2011) (confirming that invalidity defenses raised under § 282 must be proven by clear and convincing evidence). These critical differences show that an AIA trial is not interchangeable with other ways of challenging a patent.

Even if the Office does weigh the existence of proceedings in other tribunals, it should not rely heavily on trial court schedules or generic propensities about stays. Unlike the statutory deadlines governing AIA trials (e.g., 35 U.S.C. § 316(a)(11)), district courts are not subject to any similar limits or deadlines. Trial dates are routinely reset multiple times as a district court case proceeds through discovery and the period for dispositive motions. By relying on early

scheduling orders, the Board runs the risk of denying institution of an AIA trial based on a tentative trial date only to have the district court extend the trial date by many months after the AIA trial was denied. In addition, in making any prediction of whether a district court would stay a litigation, the Board should not overemphasize a district court's prior practice. All stay decisions should be based on the arguments and facts presented in each unique motion. Moreover, nothing about a district court's trial schedule or stay history says anything about the patentability questions that should be the focus of the institution decision.

In sum, AIA trials are important to maintaining the strength and legitimacy of the patent system. As a result, the Office should confirm the independence of the Board by focusing its institution and final decisions on substantive patentability.

NVIDIA takes this opportunity to express its appreciation of the Office's exceptional dedication and devotion to promoting a strong and fair patent system, and NVIDIA thanks the Office for the opportunity to submit these comments.

Regards,

A handwritten signature in blue ink, appearing to read "Ben Damstedt".

Ben Damstedt
Senior Director, Litigation
NVIDIA Corporation