June 18, 2024

Michael P. Tierney, Vice Chief Administrative Patent Judge
Amber L. Hagy, Lead Administrative Patent Judge
Jamie T. Wisz, Lead Administrative Patent Judge
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Submitted via: https://www.regulations.gov

Dear Judges Tierney, Hagy, and Wisz:


IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO’s vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO’s mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO supports the USPTO’s mission to drive innovation, entrepreneurship, and creativity for the benefit of all Americans and people around the world. We provide the following recommendations and further suggest that the Patent Trial and Appeal Board de-designate precedent opinions that are inconsistent with, or mooted by, the proposed rules.

(1) Briefing of Discretionary Denials

The proposed amendments to 37 C.F.R. §§ 42.24, 42.107, 42.108(c)(1), 42.207, and 42.208(c)(1) provide for additional briefing to address discretionary denials. Under the status quo, patent owners may allocate any desired portion of their Preliminary Response to discretionary denial arguments. Under the proposed rule, the Preliminary Response shall not address discretionary denial and patent owners must raise any requests for discretionary denial in a separate filing,
limited to ten pages, one month before the due date for the Preliminary Response. As a result, patent owners that would have allocated more than ten pages of their Preliminary Response to addressing discretionary denial would have fewer pages in which to do so and all patent owners would have an earlier deadline for raising discretionary denial issues. Petitioners would get an opposition and patent owners would get a sur-reply, which would benefit both parties by creating a more consistent and predictable briefing process than leaving it up to each panel’s discretion and would free panels from managing briefing to address discretionary denials on an ad hoc basis. Because a petitioner would not need to address discretionary denial in the petition, the Board would receive petitions that more fully address the merits.

Because it is unclear whether parties would find ten pages inadequate to address discretionary denial and whether two months is sufficient time to prepare discretionary denial arguments, IPO suggests a pilot program to study the potential impact of the proposed rule before widespread implementation.

(2) Serial Petitions

IPO recommends adoption of the proposed amendments to 37 C.F.R. §§ 42.2, 42.108(e), and 42.208(f) to address serial petitions. As set forth in comments submitted by IPO in December 2020 and June 2023, IPO supports rulemaking regarding the factors to be considered in exercising discretion to institute serial petitions against the same patent, including adoption of the factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, 2017 WL 3917706, at *7 (PTAB Sept. 6, 2017).

The definition of “serial petition” in proposed § 42.2 applies to “the petitioner, the petitioner’s real party in interest, or a privy of the petitioner.” This is an improvement over the “significant relationship” of *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019), creating more certainty for petitioners and patent owners alike. IPO therefore supports this aspect of the definition.¹

The proposed definition includes a timing element, defining serial petitions as those filed after the filing of a patent owner Preliminary Response or the expiration of the period for filing such a response. This differentiates serial petitions from parallel petitions, which proposed § 42.2 defines as to be filed before the end of these periods. The definitional distinction between parallel and serial petitions follows the trial practice guide. *See U.S. PAT. & TRADEMARK OFF., PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE 59 (2019)*. The express timing in the “serial petition” definition provides clarity regarding which discretionary denial criteria apply to a particular petition.

IPO supports the adoption, in proposed §§ 42.108(e) and 42.208(f), of four of the seven factors for considering discretionary denials of serial petitions as set forth in *General Plastic*:

(1) Whether, at the time of filing of the first petition, the petitioner knew of the prior art asserted in the second petition or should have known of it;

¹ For similar reasons, further clarity regarding the determination of whether a party is a real party in interest is warranted.
(2) Whether, at the time of filing of the second petition, the petitioner had already received the patent owner Preliminary Response to the first petition or had received the Board's decision on whether to institute review in the first petition;

(3) The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and

(4) Whether the petitioner provided an adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.

2017 WL 3917706, at *7.

The rule states these four factors will be considered when the Board determines whether to institute review of serial petitions. This aligns with current practice by the Board when considering discretionary denials of serial, follow-on petitions.

The first General Plastic factor—whether the same claims of the same patent have been previously challenged—is now incorporated into the definition of serial petitions. As written, the rule applies this factor to “the same or overlapping claims” not just “the same claims” as in General Plastic. IPO supports this wording change, which clarifies the proposed rule’s scope.

The Patent Office’s Discussion of Proposed Changes says the Board may still consider the two remaining General Plastic factors—finite Board resources and the statutory deadline of 35 U.S.C. § 316(a)(11). Omitting these two factors from the mandatory list of factors identified above lessens the briefing burden on patent owners and petitioners. However, for clarity, if these factors may optionally be considered, the USPTO should make that clear in the text of the final rule.

(3) Parallel Petitions

IPO recommends adoption of the proposed amendments to 37 C.F.R. §§ 42.2, 42.108(d), and 42.208(e) relating to discretionary denial of parallel petitions challenging the same patent. The definition of “parallel petitions” in § 42.2 limits this term to petitions filed by the same petitioner on or before either the filing of a patent owner Preliminary Response to any of the parallel petitions or the first date for filing such a response. The proposed rule provides five pages for the petitioner to address the good cause for parallel petitions. It provides for a patent owner response on this topic, and it identifies information that may be relevant to a finding of good cause. This provides guidance for future Board panels, without imposing too rigid of a structure on petitioners.

(4) Limitation of 35 U.S.C. § 325(d)

IPO recommends adoption of proposed 37 C.F.R. §§ 42.108(f) and 42.208(g) to the extent they codify the Board’s precedential framework articulated in Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020). In particular, IPO supports limiting the application of 35 U.S.C. § 325(d) to circumstances where the same or substantially the same prior art or arguments were “meaningfully addressed” by the Office in
connection with the challenged patent. IPO takes no position on the portion of the proposed rule that would expand the inquiry to related patents or patent applications.

(5) **Defining Interplay of Discretionary Denials and Joinder of Petitions**

IPO recommends the proposed addition of 37 C.F.R. §§ 42.108(c)(2) and 42.208(c)(2) to limit application of discretionary denials for parallel petitions and previously presented arguments governed by 35 U.S.C. § 325(d) to petitions for joinder. This accords with established Board practice.

(6) **Termination of Proceedings**

IPO makes no recommendation regarding the proposed amendments to 37 C.F.R. §§ 42.72 and 42.74.

Thank you for considering these comments.

Sincerely,

Krish Gupta
President