

Comments from Kenneth Stanwood

I am an inventor and US citizen with 161 issued US patents.

I would like to start by stating that it is my belief that the PTAB does not have the legal authority to overturn the Federal courts. In fact, I believe that the opposite is true, and that relationship is one way. Any petition containing issues already addressed by federal court should be denied.

Wording in quotes is wording from the ANPRM.

- 1) I agree with rule changes that would allow for discretionary denials of petitions in the following categories:
 - a. "Petitions challenging patent claims previously subject to a final adjudication upholding the patent claims against patentability challenges in district court or in post-grant proceedings before the USPTO";
 - b. "Serial petitions";
 - c. Petitions raising "previously addressed prior art or arguments";
 - d. "Parallel petitions; and petitions challenging patents subject to ongoing parallel litigation in district court".
- 2) I agree with rule changes:
 - a. "requiring petitioners to file a stipulation that neither they nor their privy or real parties have filed prior post-grant proceedings ... on the challenged claims."
 - b. "if their post-grant proceeding is instituted, neither they nor their privy or real parties in interest, will challenge any of the challenged claims in a subsequent post-grant proceeding"
- 3) I agree with "adopting a "substantial relationship" test to evaluate whether certain entities are sufficiently related to a party in an AIA proceeding such that discretionary denial is warranted".
- 4) I agree that the USPTO should consider "those involved in a membership organization, where the organization files IPRs or PGRs, as having a substantial relationship with the organization."
- 5) I disagree that patent owner:
 - a. Should be required to disclose any ownership interests in the patent owner or challenged claims. The patent owner is under attack, therefore, all such information is immaterial.
 - b. "disclose anyone with an ownership interest in the patent owner". This is too broad as it pulls in individual shareholders of large corporations.
 - c. Disclose "any government funding related to the patent" as this is made immaterial by the Bayh-Dole act.
- 6) I is my opinion that if a "proceeding is allowed to proceed at the Board even where the petition would otherwise potentially be a candidate for the discretionary denial," then a "compelling merits standard" is preferable to "reasonable likelihood" or "preponderance of the evidence" standards.
- 7) A patent is a property right and should be deemed valid until proven otherwise, therefor it is my opinion that, when assessing compelling merits, "the Office should adopt a test whereby (1) the record will be viewed in the light most favorable to the patent owner".
- 8) I agree that the Board should "discretionarily deny any petition for IPR or PGR filed by an entity that: (1) is a for-profit entity; (2) has not been sued on the challenged patent or has not been

threatened with infringement of the challenged patent in a manner sufficient to give rise to a declaratory judgement (3) is not otherwise an entity that is practicing, or could be alleged to be practice, in the field of the challenged patent with a product or service on the market or with a product or service in which the party has invested to bring to market; and (4) does not have a substantial relationship with any entity that falls outside the scope of elements (1)-(3).

- 9) It is my opinion that the USPTO “should discretionarily deny an IPR or PGR if the patent owner provides a covenant not to sue.”
- 10) It is my opinion that “prior final adjudications by a district court or by the Office in AIA post-grant proceedings upholding the validity of claims that substantially overlap the challenged claims will result in discretionary denial”.
- 11) It is my opinion that the Office should use the “at least one overlapping claim” test rather than the “substantial overlap” of claims test when deciding to discretionarily deny serial petitions.
- 12) It is my opinion that the “Office should discretionarily deny any serial petition, regardless of the relationship to the first petitioner.
- 13) It is my opinion that, instead of filing multiple petitions (arguably in the case of too many claims for one petition), the petitioner should be allowed to pay additional fees for a higher wordcount in the petition and reply to patent owner response, giving the patent owner a higher wordcount in the response and sur-reply.
- 14) It is my opinion that the “Board would apply a clear, predictable rule and deny institution of an IPR in view of pending parallel district court litigation involving at least one of the challenged claims”.
- 15) I agree that “the most appropriate approach is to maintain the current practice of permitting a petitioner to avoid a discretionary denial only by filing a *Sotera* stipulation”.
- 16) I support “making a *Sotera* stipulation a necessary but not sufficient basis for institution.” “to survive a challenge under *Fintiv*, the Petitioner would necessarily need to file a *Sotera* stipulation. The Petitioner would still need to meet the other criteria for institution in view of a parallel litigation”.
- 17) I support “omitting *Fintiv* factor 5 (whether the petitioner and the defendant in the parallel proceeding are the same party) in favor of considering real parties in interest and privies, or alternatively parties that are substantially related.”
- 18) I support “as a condition to not discretionarily denying institution under 35 U.S.C.314(a), requiring petitioners to file a stipulation that neither they nor their privy or real parties have filed prior post-grant proceedings ... as to any of the challenged claims, and that if their post-grant proceeding is instituted, neither they nor any privy or real parties in interest, will challenge any of the challenged claims in a subsequent post-grant proceeding”.
- 19) I support “amending the rules to provide for a separate briefing on discretionary denial, in which the patent owner would file, ..., a separate request for discretionary denial”.
- 20) I disagree that “the Office should require patentees to provide ... additional information as to patent ownership as a precondition for the Board considering discretionary denial.”
- 21) It is my opinion that the parties should not be required to file true copies of settlement agreements with the Board prior to termination of the proceeding. Likewise, it is my opinion that the parties should not be required to file a binding term sheet.