Comments by Canon Inc. ("Canon") on Discretion To Institute Trials Before the Patent Trial and Appeal Board [Docket No. PTO–C–2020–0055]

November 19, 2020
Canon Inc.

We, Canon, hereby respectfully provide our thoughts on the topics for which the United States Patent and Trademark Office (the "USPTO") invited public comments on October 20, 2020.

Summary

In the Patent Law, there exist only very limited provisions under which the USPTO can have its discretion in deciding whether to institute AIA trials, i.e., 35 U.S.C. 314(a), 324(a) and 325(d). We firmly believe that the USPTO should adhere to and comply with specific languages stated in such provisions in making institution decisions for AIA reviews. Therefore, for all the cases raised in questions 1 through 6, the USPTO should always authorize an AIA review to be instituted to the extent that the information presented in the petition and any response thereto shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of challenged claims in accordance with 35 U.S.C. 314(a) or 324(a).

Comments on specific questions

Questions 1 and 2 (Serial Petitions)

We agree with the USPTO's current practice to conduct case-specific analysis 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, provide that the same claim(s) of the same patent(s) as those challenged in previous another petition are subsequently challenged again by the same petitioner or other party having significant relationship with the previous petitioner with respect to assertion of the subject patent. We also agree that the USPTO promulgate such rulings.

Because of effect of estoppel set forth in 35 U.S.C. 315(e) and 325(e), a petitioner is expected to and should make the strongest invalidity arguments in the first

petition, and thus argument in the subsequent petition would be probably weaker and lack reasonable likelihood of invalidity. In view of such situation, we believe the USPTO's current practice based on *General Plastic, Valve I, Valve II* and their progeny is structured to effectively eliminate such weaker petition which does not have reasonable likelihood of invalidity in accordance with 35 U.S.C. 314(a) or 324(a).

Questions 3 and 4 (Parallel Petitions)

Even in the case where more than one petition are filed at or about the same time on the same patent, we believe that the USPTO should always authorize each review to be instituted to the extent that the information presented in the petition and any response thereto shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of challenged claims in accordance with 35 U.S.C. 314(a) or 324(a).

Based on our past experience, one petition is not sufficient to challenge the claims of a patent. As the USPTO recognizes its possibility in the Consolidated Trial Practice Guide (November 2019) on Page 59, there exist circumstances in which more than one petition are necessary, especially when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. There also exist cases in which it is difficult to have one single reasonable interpretation of claims due to vague expressions of claim languages and specifications, and furthermore, there also exist cases in which the patentee is taking unreasonably broad interpretations in the litigation proceedings. Those cases are pretty common and in such cases, we have to build and make invalidity arguments by handling various versions of interpretation for large numbers of claims, and just one petition is not sufficient at all.

If, however, in view of its limited resource and existing workload it is difficult for the USPTO to conduct the review as proposed above, we believe the USPTO should accept at least parallel petitions based on two (2) different main references for the invalidity arguments (and in the case there is a dispute about priority date, two (2) more main references can be added).

Or, of course it would be alternatively acceptable if rules are changed so that

petitioner can file a petition containing all the necessary argument without any limitation on numbers of pages, references and arguments.

Questions 5 and 6 (Proceedings in Other Tribunals)

We believe the USPTO should altogether disregard other proceedings in a U.S. District Court or the ITC. Again, we believe that the USPTO should always authorize review to be instituted to the extent that the information presented in the petition and any response thereto shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of challenged claims in accordance with 35 U.S.C. 314(a) or 324(a).
If a petitioner cannot have a chance to challenge validity of patents-at-issue just because of existence of proceedings of other tribunals, it leaves the invalid patents in place and such situation is contrary to the legislative intent of the AIA.

Question 7 (Other Considerations)

In addition to the USPTO's discretion under 35 U.S.C. 314(a) or 324(a), we also believe the USPTO's decision on whether to institute or deny review based on 35 U.S.C. 325(d) should be made solely on the analysis of reasonable likelihood of invalidity arguments.
The role and responsibility of the Patent Trial and Appeal Board of the USPTO is to revisit and investigate validity of the patent by seeing if an examiner overlooked or erred in granting the patent. And, there would be vast numbers and various kinds of references presented to the USPTO during the prosecution. Especially, with respect to the references presented by applicant just through Information Disclosure Statement procedure, we are not sure if examiner really reviewed them.
Under such circumstances, in order to decide whether to institute review based on the references which have been previously presented, we believe the USPTO have to conduct specific analysis as to if the invalidity arguments have reasonable likelihood and should always institute review to the extent such reasonable likelihood exists.