



**IN THE MATTER OF Changes Under Consideration to Patent Trial and Appeal Board  
Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d)  
Considerations, Instituting Parallel and Serial Petitions, and Termination Due to  
Settlement Agreement**

**Docket No. PTO-P-2023-0048**

**COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION**

The Electronic Frontier Foundation (“EFF”) welcomes this opportunity to respond to the United States Patent and Trademark Office’s (“USPTO”) Notice of Proposed Rulemaking, Docket No. PTO-P-2020-0022, published on Friday, April 19, 2024 (“NPRM”).

EFF is a nonprofit civil liberties organization that has worked for over 30 years to protect consumer interests, innovation, and access to knowledge in the digital world. EFF and its more than 30,000 dues-paying members care deeply about ensuring that patent law in this country serves the goal outlined in the Constitution: promoting the progress of science and technological innovation by granting limited exclusive rights.

To ensure the voices of consumers, end users, and developers are heard, EFF routinely submits comments regarding USPTO policies and procedures that affect the patent system’s ability to achieve these goals, including the Patent Trial and Appeal Board (“PTAB”) trial practice and

procedures.<sup>1</sup> The PTAB plays a critical role in the public's ability to mitigate the harmful effects of invalid patents. Hence, EFF takes special interest in ensuring that PTAB proceedings and rules are formulated and implemented to achieve this goal.

EFF believes denials of meritorious challenges are generally an unnecessary restraint on the public's right to challenge patents and we write to express our support for some of the proposed regulations, particularly provisions that:

1. Allow separate briefings for discretionary denial arguments that would have otherwise taken the space and focus from arguments on the merits of the institution, and as a result, make a petition's merits the primary factor in the PTAB's decision to institute it. (*See* Proposed 37 CFR § 42.108.)
2. Require PTAB to consider multiple factors in determining whether to institute an inter partes review (IPR) for parallel petitions and serial petitions instead of denying them without giving any consideration. (*See* Proposed 37 CFR § 42.108 and § 42.208.)
3. Require PTAB to consider only the same or substantially the same prior art references or arguments that were previously presented and meaningfully addressed by USPTO instead of simply any prior art references or arguments that were made of record during prosecution but not applied or substantively discussed by the examiner when analyzing

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<sup>1</sup> *See, e.g.*, Comments of EFF re: Advance Notice of Proposed Rulemaking for Changes to Discretionary Institution Practices, Petition Word-Count Limits, And Settlement Practices For America Invents Act Trial Proceedings Before The Patent Trial And Appeal Board, Docket No. PTO-P-2020-0022 (June 20, 2023), [https://www.eff.org/files/2023/06/29/eff\\_comments\\_to\\_uspto\\_6-20-23.pdf](https://www.eff.org/files/2023/06/29/eff_comments_to_uspto_6-20-23.pdf); Comments of EFF re: Discretion to Institute Trials Before the Patent Trial and Appeal Board, Docket No. PTO-C-2020- 0055 (Dec. 3, 2020), [https://www.eff.org/files/2021/02/09/eff\\_comments\\_re\\_uspto\\_discretion\\_to\\_deny\\_institution\\_of\\_ptab\\_trials.pdf](https://www.eff.org/files/2021/02/09/eff_comments_re_uspto_discretion_to_deny_institution_of_ptab_trials.pdf); Comments of EFF re: Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, Docket No. PTO-P-2018- 0062 (Dec. 20, 2018), <https://www.uspto.gov/sites/default/files/documents/12.20.2018%20EFF.pdf>; Comments of EFF re: Notice of Proposed Rulemaking for Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings before the Patent and Trial Appeal Board, Docket No. PTO-P-2018-0036 (July 9, 2018), [https://www.eff.org/files/2018/07/13/comments\\_of\\_eff\\_re\\_docket\\_no\\_pto-p-2018-0036.pdf](https://www.eff.org/files/2018/07/13/comments_of_eff_re_docket_no_pto-p-2018-0036.pdf); Comments of EFF, Engine, and Public Knowledge re: Enhancing Patent Quality, Docket No. PTO-P-2014-0043 (May 6, 2015) [https://www.eff.org/files/2015/05/08/final\\_eff\\_engine\\_and\\_pk\\_comment\\_on\\_patent\\_quality.pdf](https://www.eff.org/files/2015/05/08/final_eff_engine_and_pk_comment_on_patent_quality.pdf); Comments of EFF Regarding Guidance Pertaining to Patent-Eligible Subject Matter, Docket No. PTO-P-2014-0036 (July 31, 2014), at [https://www.eff.org/files/2014/08/11/eff\\_comments\\_regarding\\_patentable\\_subject\\_matter\\_and\\_alice\\_corp.pdf](https://www.eff.org/files/2014/08/11/eff_comments_regarding_patentable_subject_matter_and_alice_corp.pdf).

35 U.S.C. 325(d) factors in determining whether to institute an IPR. (*See Proposed 37 CFR § 42.108 and § 42.208.*)

4. Define serial petitions as petitions that challenge overlapping claims of the same patent by the same petitioner or the petitioner's real party in interest instead of defining them as petitions that challenge the same patent and by any entity. (*See Proposed 37 CFR § 42.2.*)

These provisions represent a significant step in the right direction: towards a system that more fairly balances the public's interest in eliminating invalid patents and the patent owners' interests in avoiding PTAB review. By giving more weight to the merits of a petition instead of discretionary factors, these regulations attempt to align the USPTO's goals with Congress's intent when it created these proceedings.

EFF also applauds the fact that the proposed rules in the NPRM, unlike previous provisions in the October 2020 Request for Comments (RFC) and the April 2023 Advance Notice of Proposed Rulemaking, remove some of the limitations on challenging invalid patents. For example, the proposed rules in the NPRM preserve the ability of "any person" to file a petition for review, as provided by the America Invents Act, and do not limit certain groups' opportunities to challenge a patent. Additionally, the proposed rules do not require a petition to institute an IPR to be denied because of an active parallel district court action. These previous proposals would have closed many avenues for reviewing the invalidity of patents, negatively affecting the quality of the patent system.

We commend the USPTO for its chosen direction in promulgating these regulations and look forward to engaging in their implementation in the future. Ensuring that PTAB proceedings remain accessible and effective is vital for innovation, competition, and the public interest.

Respectfully submitted,

**Electronic Frontier Foundation**

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