

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR OF  
THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OPENSKY INDUSTRIES, LLC,  
INTEL CORPORATION,  
Petitioners,

v.

VLSI TECHNOLOGY LLC,  
Patent Owner.

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IPR2021-01064  
Patent 7,725,759 B2

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PATENT QUALITY ASSURANCE, LLC,  
INTEL CORPORATION,  
Petitioners,

v.

VLSI TECHNOLOGY LLC,  
Patent Owner.

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IPR2021-01229  
Patent 7,523,373 B2

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BRIEF OF *AMICI CURIAE* ENGINE ADVOCACY, ACT | THE APP  
ASSOCIATION, AND THE DEVELOPERS ALLIANCE  
IN SUPPORT OF NEITHER PARTY

**TABLE OF CONTENTS**

I. INTERESTS OF *AMICI CURIAE*.....1

II. INTRODUCTION .....2

III. ARGUMENT.....3

    A. The Agency Should Focus on Patent Validity in Assessing Whether  
        Conduct Thwarts or Advances the Goals of the PTO and AIA.....3

    B. The Agency Should Not Ignore Meritorious PTAB Petitions Due to  
        Alleged Misconduct Unrelated to the Merits.....6

    C. The PTO Must Not Adopt Policies, to Counter Potential Misconduct,  
        Which Would Hinder the PTAB’s Ability to Clear Out Invalid Patents  
        That Stand In the Way of Startup Success.....9

        1. A functioning PTAB benefits startups, small business innovators,  
            and the public .....9

        2. Citing alleged misconduct as a justification to ignore certain types  
            of petitioners would hurt startups and small business innovators .13

    D. When the PTO Identifies Abuse of Process or Conduct that Thwarts Its  
        Mission, the Agency Must Also Reflect on the Role Its Policies and  
        Practices Played and How to Rectify Problems.....15

IV. CONCLUSION.....17

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**I. INTERESTS OF *AMICI CURIAE***

*Amici* are organizations that represent high-technology startups and small business innovators and are dedicated to ensuring that the patent system works to foster innovation. This includes preserving the efficacy of administrative mechanisms to clear out invalid patent claims.<sup>1</sup>

Engine Advocacy (“Engine”) is a non-profit technology, policy, research, and advocacy organization that bridges the gap between policymakers and startups. Engine works with government representatives and a community of high-technology, growth-oriented startups across the nation to support the development of technology entrepreneurship.

ACT | The App Association (the “App Association”) is an international not-for-profit grassroots advocacy and education organization representing more than 5,000 small technology-development companies that create leading software and hardware solutions. The App Association is deeply invested in ensuring that its members and the app economy can rely on a predictable and fair American patent system to grow and innovate.

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<sup>1</sup> No party or party’s counsel authored this brief in whole or in part. Intel is one among the companies and organizations that provide financial support or sponsorship to amici, but it took no part in the preparation or funding of this brief.

The Developers Alliance is the world's leading advocate for software developers and the companies invested in their success. Alliance members include industry leaders in consumer, enterprise, industrial, and emerging software, and a global network of more than 70,000 developers.

## **II. INTRODUCTION**

The Patent and Trademark Office (PTO) is faced with an unusual and rare circumstance, and as it evaluates these specific petitions with an eye toward identifying and responding to misconduct in the future, it is critical the agency keep focused on the issuance and balanced enforcement of (only) valid patents.

The questions posed in this Director review implicate the ability of the PTO to do its work in a way that instills confidence and integrity in our patent system. Focusing diligently on patent validity will help the PTO and Patent Trial and Appeal Board (PTAB) alleviate a variety of potential misconduct in the system. In part, fulfilling that focus means the PTAB should not ignore compelling, meritorious petitions for reasons unrelated to the merits. Indeed, the Board plays a valuable role advancing the agency's goals and mission, and startups and small business innovators have come to depend on post-grant PTAB reviews that remove invalid patent claims from the system and create space for innovation, competition, and growth. Responding to misconduct, especially conduct that has no bearing on the merits of a patent's (in)validity, should not stand in the way of these benefits.

And when the PTO does encounter misconduct, part of the agency's response should include self-reflection to understand the role its own policies play.

Ensuring examiners and the PTAB are able to do their work with a true focus on validity is paramount, and if parties engage in conduct that thwarts patent validity, the PTO is right to respond without deprioritizing that core goal.

### **III. ARGUMENT**

#### **A. The Agency Should Focus on Patent Validity in Assessing Whether Conduct Thwarts or Advances the Goals of the PTO and AIA**

The PTO must be clear-eyed about its goals and mission when assessing the conduct of parties that appear before it. Valid patent claims are fundamental to the integrity of our patent system, and validity must also be the guiding principle for the Board's work. Conduct that helps the PTO and the PTAB hone in on validity—issuing valid claims and canceling invalid ones—advances the goals of the agency and helps it fulfill the purpose of the AIA. Yet conduct that impedes the agency's ability to accurately assess validity thwarts those aims.

Our patent system is rooted in the fact that valid claims—those that sufficiently disclose new, non-obvious inventions—can support innovation, progress, and the public's interests. *See generally* JANICE M. MUELLER, PATENT LAW 21-31 (3d ed. 2009) (exploring economic and philosophical justifications of U.S. patent system). On the flip side, when the agency

inadvertently grants an invalid claim, it “clog[s] the system and hinder[s] true innovation.” 157 Cong. Rec. S5356-57 (Sept. 7, 2011) (statement of Sen. Amy Klobuchar).<sup>2</sup> Invalid claims drain resources away from innovative companies, they are routinely weaponized against startups and small businesses, and they undercut confidence in the U.S. patent system. *See, e.g.,* Colleen Chien, *Startups and Patent Trolls*, 17 STAN. TECH. L. REV. 461 (2014) (analysis of litigation data and startup surveys).

Congress knew all this, and in passing the AIA it emphasized patent validity and sought to prevent the costs and harms associated with invalid claims. Reflecting on the “growing sense that questionable patents [were] too easily obtained and [were] too difficult to challenge,” lawmakers designed the AIA to “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. REP.

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<sup>2</sup> *See also, e.g., Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 100 (1993) (emphasizing “the importance to the public at large of resolving questions of patent validity”); 153 Cong. Rec. E773-75 (Apr. 18, 2007) (statement of Rep. Berman referring to AIA precursor, noting concerns about low quality patents and concluding “we must act quickly . . . to maintain the integrity of the patent system”); 153 Cong. Rec. H10270-307 (Sept. 7, 2007) (statement of Rep. Lamar Smith, referring to AIA precursor: “[i]t will enhance the quality of patents and increase public confidence in their legal integrity”).

112-98, 39-40.<sup>3</sup> Those guideposts should continue to direct the PTO and PTAB’s work today.

Finally, delivering progress to the public is the “main object” of our patent system, *U.S. v. Masonite Corp.*, 316 U.S. 265, 278 (1942) (“reward of inventors is secondary and merely a means to that end”); it is “not [for] the creation of private fortunes for the owners of patents.” *Motion Picture Pats. Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 511 (1917). Canceling wrongly-issued claims “helps protect the public’s ‘paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.’” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279-80 (2016) (quoting *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1945)). And the PTO cannot prioritize the acquisition or enforcement of invalid claims. See Christopher R. Leslie, *The Anticompetitive Effects of Unenforced Invalid Patents*, 91 MINN. L. REV. 101, 103 (2006).

As the agency considers how to define misconduct and abuse, validity should stay at the center, so that the PTO does not inadvertently deter people willing to help it grant valid claims and weed out invalid ones.

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<sup>3</sup> See also, e.g., 153 Cong. Rec. H10270-10307 (Sept. 7, 2007) (statement of Rep. Cannon, “[p]atents of questionable validity are limiting competition and raising prices for consumers”); *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1290–92 (Fed. Cir. 2015) (quoting H.R. Rep. No. 112-98) (summarizing legislative history).

**B. The Agency Should Not Ignore Meritorious PTAB Petitions Due to Alleged Misconduct Unrelated to the Merits**

In responding to alleged misconduct or abuse, the PTO cannot sacrifice validity and it should align its sanctions to the problems it encounters. In part, this means the Board should not ignore compelling, meritorious petitions when there is misconduct unrelated to those merits.

The Board should not dismiss petitions for alleged misconduct if there is a reasonable likelihood at least one challenged claim is invalid. Courts are reluctant to dismiss cases, claims, or defenses as a sanction for misconduct. *See, e.g., Safe-Strap Co. v. Koala Corp.*, 270 F. Supp. 2d 407, 417-18 (S.D.N.Y. 2003) (in Rule 11 context, “[t]he remedy of dismissal is pungent, rarely used, and conclusive”) (quoting *Dodson v. Runyon* 86 F.3d 37, 39 (2d Cir. 1996)); 5A Charles Alan Wright & Arthur R. Miller, *Federal Practice and Procedure* § 1336.3 (4th ed.) (“Rule 11 helps judges avoid the ‘death penalty’ sanctions of dismissal of claims or defenses,” and “[d]ismissals for frivolous actions ordinarily should be made under Rule 12(b)(6)”). If a petition is weak on the merits, the Board can deny institution on that basis. *See* 35 U.S.C. § 314(a). For conduct unrelated to the merits, other sanctions are available.

This approach is consistent with how the Board and courts already approach alleged misconduct, crafting sanctions to deter bad behavior without giving up on

the substance of disputes. Instead of disregarding compelling evidence of invalidity, the Board—like courts—can (and has) looked to less severe, more tailored sanctions like awarding fees or striking improper evidence. *E.g.*, *Square, Inc. v. Think Comput. Corp.*, CBM2014-00159, Paper 48, at 2 (PTAB Nov. 27, 2015) (sanctions motion should address proportionality to harm suffered) (citing *Ecclesiastes 9:10-11-12, Inc. v. LMC Holding Co.*, 497 F.3d 1135, 1143 (10th Cir. 2007)); *Atlanta Gas Light Co. v. Bennet Regul. Guards, Inc.*, IPR2015-00826, Paper 39, at 8 (PTAB Dec. 6, 2016) (similar, awarding fees and costs); *HTC Corp. v. Cellular Commc’ns Equip., LLC*, IPR2014-01133, Paper 48, at 6 (PTAB Jan. 4, 2016) (declining to vacate institution for failure to identify real parties in interest); *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 10 F.4th 1358, 1364 (Fed. Cir. 2021) (affirming order to strike portions of expert report for failures to disclose evidence and tether opinions to facts and law).

It is especially important that the PTO not stretch the sanctions for misconduct so that it is dismissing meritorious petitions, because a patent’s validity matters to the broader public. If the agency decides one petitioner did something wrong, and elevates that over questions of validity, that would run directly counter to its public-oriented mission. “[P]atent validity challenges are complaints about government conduct that implicate important public interests and potentially affect many parties not before” the agency. Megan M. LaBelle, *Patent Law as Public*

*Law*, 20 GEO. MASON L. REV. 41, 42-43 (2012). One patent’s invalid claims can stand in the way of many innovators and small businesses.<sup>4</sup> The Board has flexibility to remedy misconduct, and it should not sacrifice the PTO’s ability to serve the public by accurately administering patent validity.

That said, where a party’s misconduct has a direct bearing on the merits of the action, that might be grounds for dismissal. By analogy, courts evaluating inequitable conduct look to whether the misconduct is “material” to a patent’s issuance. *Hoffmann-La Roche, Inc. v. Promega Corp.*, 323 F.3d 1354, 1359 (Fed. Cir. 2003); *see also, e.g., Gilead Scis., Inc. v. Merck & Co.*, 888 F.3d 1231, 1240 (Fed. Cir. 2018) (unclean hands applies “if the [alleged mis]conduct normally would *enhance the claimant's position* regarding legal rights that are *important to the litigation*”) (emphasis added). Misconduct before the PTAB might similarly damage the merits and warrant a different approach. For example, if a party altered

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<sup>4</sup> *E.g., HP Inc. v. MPHJ Tech. Invs., LLC*, 817 F.3d 1339, 1342 (Fed. Cir. 2016) (after letters were sent “to numerous small businesses, alleging that those businesses likely infringed the ’381 patent,” and “[b]ecause the letters were sent to users of HP’s multi-function printers, HP petitioned for IPR of the ’381 patent”); Aaron L. Parker et al., *How Sports Tech Companies Can Fight Back Against Patent Trolls*, FINNEGAN (July 27, 2018), <https://www.finnegan.com/en/insights/articles/how-sports-tech-companies-can-fight-back-against-patent-trolls.html> (IPR used to challenge patent asserted against more than 100 defendants); Bart Eppenauer, *Sound View Escalates Patent Assault on Open Source Software with New Wave of Lawsuits*, JD SUPRA (May 1, 2019), <https://www.jdsupra.com/legalnews/sound-view-escalates-patent-assault-on-69280/> (IPR challenged patents asserted against open source software users).

the publication date on a piece of prior art (either moving the publication later to try and avoid invalidity or moving the publication earlier to try to establish it), that would affect the merits of the proceeding and the Board could reject any arguments based on that reference. *Cf. Fraige v. Am.-Nat'l Watermattress Corp.*, 996 F.2d 295 (Fed. Cir. 1993) (remanding for new trial where defendant altered advertisements that purportedly predated patent-in-suit). But absent such extraordinary circumstances, ignoring strong petitions is a poor fit for the PTAB.

**C. The PTO Must Not Adopt Policies, to Counter Potential Misconduct, Which Would Hinder the PTAB's Ability to Clear Out Invalid Patents That Stand In the Way of Startup Success**

The PTO must not, especially in response to this rare circumstance, develop policies to deter misconduct which restrict the ability of companies—including startups and small businesses—to reap the substantial benefits of PTAB review. Innovators of all sizes across the nation benefit when the patent system includes accessible mechanisms like inter partes review (IPR) to clear out invalid claims.

**1. A functioning PTAB benefits startups, small business innovators, and the public**

Startups and small business innovators operate on thin margins and they do not have time or resources to spare defending frivolous patent assertions involving

invalid claims.<sup>5</sup> Yet, this also makes them a frequent and attractive target of patent assertion entities (PAEs) seeking nuisance value settlements. *See, e.g.,* Chien, *Startups and Patent Trolls, supra*, at 461-62 (finding most unique defendants in PAE suits are small and majority of survey respondents reported significant operational impact).<sup>6</sup> Likewise, incumbents seeking to stifle new market entrants can use questionable patents strategically to “impose distress on their financially disadvantaged rivals,” Colleen V. Chien, *Of Trolls, Davids, Goliaths, and Kings: Narratives and Evidence in the Litigation of High-Tech Patents*, 87 N.C. L. REV. 1571, 1587-89 (2009), and assert such patents in a way to “prevent innovative,

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<sup>5</sup> Engine has taken similar positions before the agency in the past. *See, e.g.,* Comments of Engine Advocacy in Response to *Request for Comments on Discretion to Inst. Trials Before the Pat. Trial and Appeal Bd.*, Docket No. PTO-C-2020-0055 (Dec. 3, 2020), <https://www.regulations.gov/comment/PTO-C-2020-0055-0807>.

<sup>6</sup> *See also, e.g.,* Amy L. Landers, *The Antipatent: A Proposal for Startup Immunity*, 93 NEB. L. REV. 950, 979 (2015) (small “entities are more likely to settle for a higher royalty rate to avoid the high transaction costs of patent litigation”); Nathaniel Borenstein, Opinion, *More Patent Trolls Are Targeting Startups. Here's What You Can Do.*, ENTREPRENEUR (Apr. 10, 2018), <https://www.entrepreneur.com/article/310648> (“A disproportionate number of patent trolls target smaller companies . . . the whole point is to impose a costly and scary lawsuit, so that startups with limited resources to protect and defend themselves are more likely to settle than fight.”); Ryan Damon et al., *Five Years Later: Lessons Learned from the First Inter Partes Review*, ACC DOCKET (May 1, 2018), <https://docket.acc.com/5-years-later-lessons-learned-first-inter-partes-review> (“it was often prudent to consider a cost-of-defense settlement rather than seek litigation based on the merits”).

disruptive technologies from competing.” Ted Sichelman, *The Vonage Trilogy: A Case Study in “Patent Bullying,”* 90 NOTRE DAME L. REV. 543, 549-50 (2014).

IPR has helped ease these problems. While PTAB review is still expensive, it is much more affordable than a district court case and can be within reach for many startups and smaller tech companies. *Compare* Am. Intell. Prop. Law Ass’n, 2019 Report of the Economic Survey 50-51 (2019) *with id.* at 52 (cost to defend lower-stakes PAE suit is \$1.8 million whereas cost of IPR is \$325,000). By reducing the cost of clearing out invalid claims, IPR has also helped level the playing field in patent assertion—which has contributed to lower costs in patent litigation, lower settlement values for questionable patents, and less abusive patent assertion overall. *E.g.*, Malathi Nayak, *Cost of Patent Infringement Litigation Falling Sharply*, BLOOMBERG BNA (Aug. 11, 2017), <https://biglawbusiness.com/cost-of-patent-infringement-litigation-falling-sharply>; Damon et al., *supra* (showing how “IPRs have reduced the cost to challenge questionable patents and also reduced their settlement value”); *Patent Review is Working for Startups*, ENGINE, <https://innovatewithoutfear.engine.is/wp-content/uploads/2020/01/IPR-is-working-one-pager.pdf> (showing a drop in PAE litigation since IPR went into effect).

With those benefits in mind, it is no surprise that startups and small business innovators confirm and experience the PTAB’s value and importance, for example:

- “The PTAB is the best forum to address and resolve patent validity issues, especially for startups. Patent litigation is extremely expensive and a single lawsuit could potentially be a death knell to a startup based just on the cost it takes to defend in court. Additionally, pending patent litigation matters affect a startup’s ability to obtain funding, grow, bring in new talent, and protracted litigation also operates as a drain on the startup’s resources given the amount of participation required from every part of the company (engineers, finance team, product developers, management team, etc.). Given that the validity of a patent is an essential and threshold matter to resolve in patent litigation trials, it is efficient, less expensive, and judicious to get this done at the PTAB.” – Kirupa Pushparaj, General Counsel and Corporate Secretary, Step<sup>7</sup>
- “The IPR system has been a useful tool for curbing the negative market effects of patent trolls, increasing U.S. business activity, and disincentivizing frivolous patent lawsuits as it makes their abusive practices less profitable. . . . As a software developer and inventor with multiple patents in my name, I can attest that there are a large number of patents that should have never been awarded because of vague and far-reaching claims. These low-quality patents ultimately weaken the U.S. patent system and encourage patent trolls to go after startups such as mine.” - Todd Moore, CEO & Founder, TMSoft<sup>8</sup>
- “Having the IPR process available to us as a means of defending our innovation is critical. The number one thing the patent office

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<sup>7</sup> *Patent Trial and Appeal Board After 10 Years: Impact on Innovation and Small Businesses: Hearing Before the Subcomm. on Cts., Intell. Prop., and the Internet of H. Comm. on the Judiciary*, 117th Congress at 2 (2022) (testimony of Kirupa Pushparaj), <https://docs.house.gov/meetings/JU/JU03/20220623/114937/HHRG-117-JU03-Wstate-PushparajK-20220623.pdf>.

<sup>8</sup> Letter from Todd Moore to Pat. and Trademark Off. (Dec 3, 2020), <https://static1.squarespace.com/static/53864718e4b07a1635424cdd/t/5fcabe045480b554f8a06546/1607122436774/Todd+Moore+Patent+Letter.pdf>. Mr. Moore is also on the Board of Directors of Developers Alliance.

could do to protect patent quality is not do anything. The current process with IPR . . . has been hugely beneficial to the tech industry.” – Colin Sullivan, Vice President of Legal, Patreon<sup>9</sup>

As the agency thinks about defining and addressing alleged misconduct, it cannot lose sight of the PTAB’s immense value or create policies that make it too hard for the PTAB to cancel invalid claims.

## **2. Citing alleged misconduct as a justification to ignore certain types of petitioners would hurt startups and small business innovators**

Third parties—who have not been accused of infringement—have used IPR in beneficial and productive ways that protect startups and small businesses who are being threatened with invalid claims. The agency should be very cautious to not start suspecting petitioners of misconduct just because they have not been sued (yet). That could erect something like a standing requirement, curtailing the broader benefits of PTAB review in conflict with the letter and spirit of the AIA.

Congress created IPR so that any “person who is not the owner of a patent” may file an IPR petition. 35 U.S.C. § 311; *see also, e.g., Cuozzo*, 579 U.S. at 279 (“[p]arties that initiate the proceeding need not have a concrete stake in the outcome”). It would be improper for the PTO to supplant that choice by creating

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<sup>9</sup> *Innovation Toolkit for Startups - Patreon*, YOUTUBE (Dec. 18, 2018), [https://www.youtube.com/watch?time\\_continue=1&v=JjFcZl\\_Ftpc](https://www.youtube.com/watch?time_continue=1&v=JjFcZl_Ftpc).

misconduct policies which use sanctions to effectively dictate the types of petitioners who get to file.

This is of particular relevance to startups and small businesses, because even if they cannot afford to file an IPR, they reap the benefits when others take the time and spend the money to challenge invalid claims. For example, in *Personal Audio LLC v. Electronic Frontier Foundation*, 867 F.3d 1246 (Fed. Cir. 2017), the Electronic Frontier Foundation (EFF) challenged a patent that claimed, according to its owner, the basic idea of podcasting. EFF was not accused of infringing, but Personal Audio (the patent owner) was threatening lawsuits against podcasters and podcasting companies across the country. Under EFF's petition, all of the challenged claims were canceled as anticipated and/or obvious, and that protected a community of small businesses who could not afford their own, solo defense against threats from invalid claims. *E.g., id.*; Daniel Nazer, *EFF Wins Final Victory Over Podcasting Patent*, ELEC. FRONTIER FOUND. (May 14, 2018), <https://www.eff.org/deeplinks/2018/05/eff-wins-final-victory-over-podcasting-patent>.<sup>10</sup>

As the agency thinks about defining conduct that thwarts the agency's work or abuses processes, it is essential to preserve the ability of one entity to file a

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<sup>10</sup> This is one of many examples where one IPR petition benefited numerous others. *See also, e.g., supra* note 4.

challenge that benefits others. If the agency starts down the path of scrutinizing whether a given IPR petitioner is the “right” type of petitioner, it could frustrate these benefits and make it more expensive and complicated for, e.g., entities like EFF or companies that manufacture technology to file petitions to protect startups, small businesses, and customers.

**D. When the PTO Identifies Abuse of Process or Conduct that Thwarts Its Mission, the Agency Must Also Reflect on the Role Its Policies and Practices Played and How to Rectify Problems**

As the PTO considers how to confront alleged misconduct in the future, it must include a process for self-reflection to understand how it may have enabled problems and what it could do to prevent them in the future. Separately, if the agency wants to avoid the present situation from recurring, it could de-designate or vacate *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020), and *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (Sept. 12, 2018) (designated precedential May 7, 2019); and instruct the Board to review the merits of all petitions.

In this case, the conduct being criticized is a direct result of prior discretionary denial policies that triggered the PTAB to ignore meritorious IPR petitions. Intel first petitioned for review of the '759 and '373 patents in October

and November 2019.<sup>11</sup> If the Board had addressed the merits of those petitions and instituted review, it would have issued Final Written Decisions between May and August 2021, *see Intel Corp. v. VLSI Tech. LLC*, IPR2020-00106, Paper 17, at 7 (PTAB May 5, 2020); IPR2020-00158, Paper 16, at 8 (PTAB May 20, 2020); IPR2020-00498, Paper 16, at 6 (PTAB Aug. 19, 2020), and most of the challenged claims would have been addressed by the Board well before OpenSky or Patent Quality Assurance (PQA) filed petitions.<sup>12</sup>

Instead of reviewing the substance of Intel’s petitions, though, the Board denied institution under *Fintiv* and only evaluated Intel’s arguments when OpenSky and PQA later filed nearly-identical petitions. *See OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 17, at 9, 10 (PTAB Dec. 23, 2021) (instituting IPR, noting neither prior “denial considered the merits of Intel’s challenges,” petition copied substantive grounds from prior one); *PQA, LLC v. VLSI Tech. LLC*, IPR2021-01229, Paper 10, at 7, 8 (PTAB Jan. 26, 2022) (same).<sup>13</sup>

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<sup>11</sup> After VLSI served infringement contentions asserting additional claims, Intel filed a second petition for the ’759 patent covering claims that were not previously asserted. *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00498, Paper 4, at 5 (Feb. 4, 2020).

<sup>12</sup> OpenSky filed its first petition in June 2021 and PQA first filed in July 2021. IPR2021-01064, Paper 2; IPR2021-01229, Paper 1.

<sup>13</sup> By contrast, when instituting review of the ’759 patent, the Board spent fifteen pages discussing the merits of the challenge, and it spent twelve pages discussing

If the Board had evaluated Intel’s arguments in the first instance, we would not be in this situation. *See, e.g.,* Joe Matal, *Guest Post: A Solution to the OpenSky Problem*, PATENT PROGRESS (Apr. 18, 2022), <https://www.patentprogress.org/2022/04/18/guest-post-a-solution-to-the-opensky-problem/> (“none of this would have happened if PTAB petitioners could still reliably get their cases heard on the merits”).

Regardless of whether one characterizes the present petitions as positive, negative, or neutral, the easy way to avoid anything similar in the future is to vacate or de-designate *Fintiv* and *NHK* and confirm that the Board will weigh the merits of each IPR petition before making an institution decision. *Cf.* Joel D. Sayres & Reid E. Dodge, *Unfettered Discretion: A Closer Look at the Board’s Discretion to Deny Institution*, 19 CHI.-KENT. J. INTELL. PROP. 536, 536 (2020) (noting broad interpretation of discretion to deny institution may be “hindering Congress’ intent to provide an effective administrative alternative to litigation on the issue of patent validity”).

#### IV. CONCLUSION

Amici appreciate the opportunity to submit these views and applaud the agency for this open and transparent approach to exploring potential abuses of

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arguments pertaining to the ’373 patent. IPR2021-01064, Paper 17, at 15-30; IPR2021-01229, Paper 10, at 13-24.

process or conduct that thwarts its goals. We urge the PTO to focus its policies and decisions on the ultimate goal of patent validity, and resist ignoring compelling, meritorious PTAB petitions for reasons that have no bearing on those merits.

Dated: August 18, 2022

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on August 18, 2022, I served a copy of the foregoing *Brief of Amicus Curiae Engine, ACT / The App Association, and The Developers Alliance* via email to the addresses of record as follows:

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