

EXHIBIT 1

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US INVENTOR, 360 HEROS, INC.,
LARRY GOLDEN, WORLD SOURCE ENTERPRISES, LLC,
DARELTECH LLC, TINNUS ENTERPRISES, LLC,
CLEARPLAY, INC., E-WATCH, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE, INC., et al.

Plaintiffs,

v.

ANDREI IANCU, in his official capacity as
Under Secretary of Commerce for Intellectual
Property and Director, United States Patent and
Trademark Office,

Defendant.

Case No. 5:20-CV-06128-EJD

**COMPLAINT IN INTERVENTION FOR
DECLARATIVE AND INJUNCTIVE
RELIEF**

Under Federal Rule of Civil Procedure 24, Intervenors US Inventor, 360 Heros, Inc., Larry Golden, World Source Enterprises, LLC, Dareltech LLC, Tinnus Enterprises, LLC, Clearplay, Inc., and E-Watch, Inc., allege for their Complaint in Intervention as follows:

1 **NATURE OF SUIT**

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3 1. This is a suit under 5 U.S.C. § 706(1) of the Administrative Procedure Act (“APA”) to
4 compel “agency action unlawfully withheld” by the United States Patent and Trademark Office
5 (“USPTO”). This is also a suit under 5 U.S.C. § 706(2)(D) of the APA to “hold unlawful and set aside
6 agency action” that is “without observance of procedure required by law.”

7
8 2. The text of the APA provides distinct remedies for judicial review of both agency
9 inaction and action. This suit addresses USPTO unlawful inaction in the form of incomplete and/or
10 procedurally unlawful rulemaking to govern how the USPTO Director (and his designees) exercise
11 discretion whether to grant or deny institution of patentability trials. This suit addresses USPTO
12 unlawful action in the form of attempts at rulemaking that unlawfully circumvent proper publication,
13 notice and comment.

14
15 3. Intervention is proper under Fed. R. Civ. P. 24, as described in the accompanying motion
16 to intervene.

17 **JURISDICTION AND VENUE**

18 4. This case arises under the APA, 5 U.S.C. § 701 *et seq.*. This Court has subject matter
19 jurisdiction under 28 U.S.C. § 1331.

20
21 5. Under 5 U.S.C. § 702, Defendant has waived sovereign immunity for purposes of this
22 suit.

23 6. Intervenors’ claim for declaratory and injunctive relief is authorized under 28 U.S.C. §§
24 2201 and 2202, by 5 U.S.C. §§ 702-706, by Federal Rules of Civil Procedure 57 and 65, and by the
25 inherent equitable powers of this Court.

26
27 7. Venue is proper in this District under 28 U.S.C. § 1391(e) and 5 U.S.C. § 703 because
28 venue is proper in the underlying suit into which Intervenors hereby intervene. Venue is also proper
because each of the original plaintiffs to the underlying suit reside in this judicial district.

8. The agency actions unlawfully withheld (discussed below) are deemed under the APA to be final agency actions subject to judicial review under 5 U.S.C. § 704. The agency actions unlawfully undertaken (discussed below) are deemed under the APA to be final agency actions subject to judicial review under 5 U.S.C. § 704.

PARTIES

9. Intervenor US Inventor is an Indiana nonprofit corporation with its principal office in Clearwater, Florida. US Inventor fosters innovation through advocacy, education and public outreach on matters of importance to individual inventors and small innovative businesses. US Inventor frequently works with policymakers in government to advocate for more certain patent rights. US Inventor also frequently files amicus briefs in pending court proceedings to advance the point of view of its inventor-membership. In August 2020, US Inventor filed with the United States Patent and Trademark Office its Petition for Rulemaking Pursuant to 5 U.S.C. § 553(e) for Specific Criteria for Deciding Institution of AIA Trials. No action has occurred on that petition. US Inventor as a public interest nonprofit group has a strong interest in the relief sought in this civil action: rulemaking that would bring certainty to its membership about how discretionary considerations factor into the decision whether to grant institution of USPTO patentability trials.

10. As part of its educational mission, US Inventor provides information to its membership to help them deal with potential AIA trial reviews of their issued patents. One of the primary ways in which US Inventor accomplishes its mission is to educate the public by providing information about the factors that will lead to a grant, versus a denial, of institution of AIA trials, particularly on discretionary factors. To do so, US Inventor relies (or would rely) on issued regulations published in the Federal Register for notice and comment, ultimately appearing in the Code of Federal Regulations. But the USPTO and its past and current Directors never promulgated any such notice-and-comment regulations on the topic of how discretionary considerations impact “sufficient grounds” for institution decisions. Because the Director’s and the USPTO’s inaction denied US Inventor access to authoritative and clear

1 key information it wishes to use in its routine information dispensing activities and to fulfill its mission,
2 the USPTO and the Director have inhibited its daily operations.

3 11. 360Heros, Inc. is a patent owner harmed by the unlawful agency action and withholding
4 of agency action described below. 360Heros is a Delaware corporation with its principal place of
5 business at 518 Queen Street, Olean, New York 14760. 360Heros manufactures accessories for camera
6 equipment. 360Heros has been forced to respond to at least one AIA trial petition that was ultimately
7 denied (IPR2018-00853), but that would not have been brought in the first place had the USPTO issued
8 lawful regulations governing discretionary denial prior to the bringing of that petition. As a patent owner
9 facing a likelihood of future infringers making future challenges through future AIA trial petitions,
10 360Heros' injury is likely to recur.

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12
13 12. Intervenor Larry Golden is a patent owner harmed by the unlawful agency action and
14 withholding of agency action described below. Mr. Golden is an individual residing in Greenville, South
15 Carolina. Mr. Golden has been forced to respond to at least one AIA trial petition that was ultimately
16 granted without Mr. Golden having made arguments for discretionary denial (IPR2014-00714), but that
17 would have been denied had the USPTO issued lawful regulations governing discretionary denial prior
18 to the bringing of that petition. As a patent owner facing a likelihood of future infringers making future
19 challenges through future AIA trial petitions, Mr. Golden's injury is likely to recur.

20
21 13. Intervenor World Source Enterprises, LLC ("WSE") is a patent owner harmed by the
22 unlawful agency action and withholding of agency action described below. WSE is a Nevis company
23 having a principal place of business in High Point, North Carolina. WSE has been forced to respond to
24 at least one AIA trial petition that is still pending an institution decision, where WSE has presented
25 arguments for discretionary denial (IPR2020-00768). The pending petition would be more clearly
26 deniable had the USPTO issued lawful regulations governing discretionary denial prior to the bringing
27 of that petition. As a patent owner facing a likelihood of future infringers making future challenges
28 through future AIA trial petitions, WSE's injury is likely to recur.

1 14. Intervenor Dareltech LLC (“Dareltech”) is a patent owner harmed by the unlawful
2 agency action and withholding of agency action described below. Dareltech is a Delaware company
3 having a principal place of business in Bethesda, Maryland. Dareltech has been forced to respond to at
4 least one AIA trial petition that is still pending an institution decision, where Dareltech has presented
5 arguments for discretionary denial (IPR2020-00483). The pending petition would be more clearly
6 deniable had the USPTO issued lawful regulations governing discretionary denial prior to the bringing
7 of that petition. As a patent owner facing a likelihood of future infringers making future challenges
8 through future AIA trial petitions, Dareltech’s injury is likely to recur.

9
10 15. Intervenor Tinnus Enterprises, LLC (“Tinnus”) is a patent owner harmed by the unlawful
11 agency action and withholding of agency action described below. Tinnus is a Texas company having a
12 principal place of business a 3429 18th St, Plano, Texas 75074. Tinnus has been forced to respond to
13 eight AIA trial petitions, of which half were instituted (PGR2015-00018, PGR2016-00030, PGR2016-
14 00031, and PGR2017-00015) and half were denied (PGR2017-00024, PGR2017-00040, PGR2017-
15 00051, and PGR2017-00052). PGR2017-00015 is an example petition where the Director granted
16 institution after disagreeing with Tinnus’s arguments for discretionary denial. PGR2017-00024 is an
17 example petition where the Director denied institution after agreeing with Tinnus’s arguments for
18 discretionary denial. These petitions would, respectively, have been denied or not have been brought had
19 the USPTO issued lawful regulations governing discretionary denial prior to the bringing of those
20 petitions. As a patent owner facing a likelihood of future infringers making future challenges through
21 future AIA trial petitions, Tinnus’s injury is likely to recur.

22
23 16. Intervenor Clearplay, Inc. (“Clearplay”) is a patent owner harmed by the unlawful agency
24 action and withholding of agency action described below. Clearplay is a Delaware company having a
25 principal place of business in Murray, Utah. Clearplay has been forced to respond to five AIA trial
26 petitions, of which four were instituted (IPR2014-00430, IPR2014-00383, IPR2014-00339, IPR2013-
27 000484) and one was denied, on discretionary grounds (IPR2014-00783). These petitions would,
28

1 respectively, have been denied or not have been brought had the USPTO issued lawful regulations
2 governing discretionary denial prior to the bringing of those petitions. For example, IPR2013-00484
3 involved a grant of institution even after Clearplay requested denial because the same prior art and
4 arguments had been rejected by the USPTO in a prior request for inter partes reexamination. As a patent
5 owner facing a likelihood of future infringers making future challenges through future AIA trial
6 petitions, Clearplay's injury is likely to recur.

7
8 17. Intervenor E-Watch, Inc. ("E-Watch") is a patent owner harmed by the unlawful agency
9 action and withholding of agency action described below. E-Watch is a Nevada company having a
10 principal place of business in San Antonio, Texas. E-Watch has been forced to respond to over 20 AIA
11 trial petitions. IPR2015-00412 is an example of a petition filed against E-Watch where the Director
12 granted institution after disagreeing with E-Watch's arguments for discretionary denial. IPR2015-00610
13 is another example of a petition filed against E-Watch where the Director granted institution after
14 disagreeing with E-Watch's arguments for discretionary denial. These petitions, and others filed against
15 E-Watch, would, respectively, have been denied or not have been brought had the USPTO issued lawful
16 regulations governing discretionary denial prior to the bringing of those petitions. As a patent owner
17 with a large portfolio of patents, E-Watch faces a likelihood of future infringers making future
18 challenges through future AIA trial petitions, E-Watch's injury is likely to recur.

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20
21 18. Defendant Andre Iancu is the Under Secretary of Commerce for Intellectual Property and
22 Director of the USPTO. The Director oversees the operations of the USPTO and is statutorily vested
23 with the authority both to decide whether to institute IPR of a patent claim, 35 U.S.C. § 314, and to issue
24 regulations governing such institution decisions, 35 U.S.C. § 316. Defendant Iancu is being sued in his
25 official capacity. His principal places of business are in Alexandria, Virginia and Washington, D.C.

26
27 19. Though Director Iancu is named as defendant in his official capacity, the unlawful
28 activities alleged here originate with actions and inactions committed by his predecessors: Joe Matal
(officer who for a time was "Performing the Functions and Duties of" the Director position), Michele

1 Lee (former Director), Theresa Stanek Rea (former Acting Director) and David Kappos (former
 2 Director). Director Iancu has attempted during his tenure to make AIA trials more fair for patent owners.
 3 This Complaint seeks that outcome through processes that are lawful under the APA.

4 **FACTUAL ALLEGATIONS**

5
 6 20. The USPTO administers patentability trials under the America Invents Act of 2011
 7 (“AIA trials”). Such AIA trials include IPR (“inter partes review”) and PGR (“post grant review”). The
 8 administration of such trials occurs in two phases: an institution phase, and (if there is institution) a trial
 9 phase. The decision whether to institute includes legal and factual determinations (*i.e.*, the level of merit
 10 of a petitioner’s unpatentability argument), but also includes discretionary factors (*e.g.*, the impact of
 11 numerous factors relating to other court or other USPTO proceedings). *See, e.g.*, 35 U.S.C. §§ 314(a),
 12 315(d); Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019), available at
 13 www.uspto.gov/sites/default/files/documents/tpgnov.pdf; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019,
 14 Paper 11 (P.T.A.B. Mar. 20, 2020); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte*
 15 *GmbH*, IPR2019-01469, Paper 6 (P.T.A.B Feb. 13, 2020); *Gen. Plastic Indus. Co. v. Canon Kabushiki*
 16 *Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B Sep. 6, 2017).

17 **Effects of Incomplete and Withheld Rulemaking**

18
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 20 21. AIA trials are expensive and often ruinous to defend. In costs and legal fees, patent
 21 owners can expect to spend on average \$451,000 per patent, just to maintain the status quo of keeping a
 22 patent that the law already presumed to be valid. 35 U.S.C. § 282. Patent owners who are dragged into
 23 an AIA trial have no upside—the USPTO cannot adjudicate infringement and cannot award damages.
 24 This is on top of the costs and fees already expended just to obtain the patent right, which can be
 25 considerable, sometimes more than \$100,000 per patent. Government fees spent on filing, issuing and
 26 maintaining each such patent often exceed \$10,000, but (under current law) a declaration of invalidity in
 27 an AIA trial does not entitle the patent owner to any refund of such fees for the “mistaken” work by the
 28 government during original examination.

1 22. AIA trials, once instituted, impose an 80% likelihood of invalidation. Accounting for
2 multiple petitions, 85% of patents reviewed result in invalidation of one or more claims. This is at least
3 2-3 times higher than in district court proceedings, which afford more procedural protections, a
4 presumption of validity (including deference due a qualified government agency official presumed to
5 have performed his or her job), and a clear and convincing burden of proof of invalidity. Thus, the
6 institution decision effectively determines the fate of the business of the patent owner, implicating 35
7 U.S.C. § 316(b).

8 23. The AIA requires that “The Director shall prescribe regulations...setting forth the
9 standards for the showing of sufficient grounds to institute a review [and] shall consider the effect of any
10 such regulation on the economy, the integrity of the patent system, the efficient administration of the
11 Office.” 35 U.S.C. 316(a)(2) and (b).

12 24. Ad hoc decision-making of AIA trial institution decisions has resulted in harm to the U.S.
13 economy including: the U.S. falling from its perennial number one position in international patent
14 rankings; reducing access to capital for cutting edge technology ventures; and shielding trillion-dollar
15 corporations from would-be competitors with disruptive inventions.

16 25. Ad hoc decision-making of AIA trial institution decisions has resulted in substantial loss
17 of confidence in the integrity of the patent system, leaving entrepreneurs without any reliable path to
18 “securing...the exclusive Right to their...Discoveries”. U.S. Const. art. I, § 8, para. 8. Regardless of how
19 carefully an inventor and examiner follow the laws and procedures, and how thoroughly familiar they
20 are with the prior art, and how flawlessly they perfect an application that is granted by the Director, it is
21 impossible to predict whether the PTAB will institute an AIA trial of the issued patent. It is likewise
22 uncertain even after a patent has been reexamined by the USPTO or declared not invalid by the final
23 judgment of an Article III court – such patents are still likely to be instituted for review by the PTAB.

24 26. Ad hoc decision-making of AIA trial institution decisions has harmed the efficient
25 administration of the USPTO and the judicial system. Such decisions often conflict with and nullify

1 prior determinations of the USPTO, including when the USPTO has previously considered the same or
2 substantially the same prior art or arguments. Such decisions often conflict with determinations of
3 Article III courts, in many instances nullifying final judgments incorporating years of adjudication and
4 jury verdicts.

5
6 27. Dareltech's plight of being dragged into ruinous proceedings with an uncertain outcome
7 is exemplary of the burden on the economy from the Director's unlawful withholding of rulemaking,
8 and fully explained in its Preliminary Response to the IPR filed against one of its patents by Microsoft,
9 Inc., a trillion dollar company.

10
11 28. The entire Dareltech operation is self-financed by the inventors, with zero debts,
12 encumbrances, VC, or other debt financing. The Dareltech inventors developed a commercial
13 embodiment of an invention called the HandlePa. The HandlePa is a selfie stick with control buttons to
14 communicate wirelessly with the smartphone and to control and operate at least the camera function
15 using just one finger. The apparatus yields clearer and steadier pictures than the prior art, while allowing
16 the user to take more difficult angle shots using only one hand to securely grasp the stick and operate the
17 systems safely and comfortably.

18
19 29. The Dareltech inventors engineered, designed, tested, and manufactured the HandlePa
20 product, producing 11,500 units at a cost of \$322,000. Before Dareltech could get a foothold in the
21 market, cheap similar products flooded the market. It quickly became impossible for a Dareltech to
22 compete against established brands, so Dareltech focused on securing the patent rights to the invention
23 at the USPTO.

24
25 30. After thorough examinations, the USPTO issued four patents for the invention each titled
26 HANDLE FOR HANDHELD TERMINAL. The Dareltech inventors invested from personal funds
27 approximately \$650,000 in the development and commercialization of the claimed invention, without
28 any significant revenue to date. Furthermore, the inventors stretched their credit to the limit including
borrowing against at least one of their homes. As a result, Dareltech has no funding to defend the

1 currently-attacked patent should a trial be instituted. The average cost of an IPR defense is \$451,000 and
2 the cost for top tier representation is \$750,000.

3 31. From 2012 to 2017 Dareltech prosecuted its family of patents, following all relevant laws
4 and procedures. Dareltech budgeted and paid approximately \$16,000 in fees to the USPTO and
5 approximately \$150,000 in attorney fees to obtain these patents. Dareltech did not budget and has no
6 means to pay an additional \$450,000 to \$750,000 in order to defend one of them should Microsoft's IPR
7 be instituted.
8

9 32. In related proceedings filed by a different attacker, Dareltech was forced to disclaim
10 approximately half of the patent claims in hopes of avoiding a trial it could not afford. When trial was
11 instituted, Dareltech was forced to settle with the other attacker and allow them to infringe the remaining
12 claims because Dareltech could not pay the cost or countenance the risk of a full trial.
13

14 33. The Dareltech inventors complied with their end of the patent bargain, invested all
15 available funds to obtain the portfolio, and were already forced to surrender substantial rights due to
16 filing and institution of the prior petitions by the time Microsoft filed its IPR.
17

18 34. Microsoft petitioned for IPR against Dareltech even though there is no legal dispute
19 between them, and even though the USPTO had already considered the same or substantially the same
20 prior art. Microsoft does not, to Dareltech's knowledge, infringe any of the claims of the attacked patent
21 and stands to gain no benefit from its cancellation. There can be no district court suit since Microsoft
22 and Dareltech lack standing to sue one another.
23

24 35. The relative cost to the parties is dramatic. For Dareltech the cost of a trial far exceeds its
25 total available cash, whereas for Microsoft the cost of a trial (based on an average of \$451,000) is about
26 0.000032% of their \$1.4 trillion value and 0.00034% of the \$133 billion cash and short term deposits.
27

28 36. Dareltech awaits decision on its arguments for discretionary denial that it had to make
without the benefit of guidance through rulemaking. Had clear rulemaking on discretionary
considerations by the Director occurred, Microsoft would have had clear guidance that its petition

1 against Dareltech was futile, and would not have filed it; or, alternatively, the cost to prove Dareltech's
2 immediate right to denial of the petition would have been negligible (unlike what has in fact transpired).

3 37. Intervenor Tinnus represents another example of the burden on the economy from the
4 Director's unlawful withholding of rulemaking. Tinnus was founded and is owned by Josh Malone, a
5 father of 8 who quit his corporate job in 2006 to become a full-time inventor. After 8 years of struggling
6 to make ends meet, he solved a 63-year-old problem of filling and sealing water balloons and
7 immediately applied for a patent for his Bunch O Balloons invention. Launched on Kickstarter, it went
8 viral and quickly ascended to become the number one selling summer toy.

9
10 38. A major As Seen on TV company posing as a backer of the Kickstarter campaign
11 purchased a first edition Bunch O Balloons product, reverse engineered it, and raced their copy of the
12 product to market, selling millions of units at major retailers such as Walmart, Target, Bed Bath &
13 Beyond, Kroger, Toys-R-Us, Walgreens, and Home Depot.

14
15 39. Tinnus sought to enforce its patent rights, leading to 4 district court actions, 8 petitions
16 for PTAB review, and 14 appeals to the Court of Appeals for the Federal Circuit, spanning about 4
17 years.

18
19 40. The district court preliminarily enjoined the copied product, in a decision affirmed by the
20 Federal Circuit which held that the term "substantially filled" was not indefinite.

21 41. Subsequent to the district court injunction and a week prior to the appellate affirmance,
22 the PTAB ruled in PGR2015-00018 that the term "substantially filled" was indefinite and all the patent
23 claims were therefor invalid. That decision was reversed on appeal a year and a half later.

24
25 42. After being enjoined, the infringer introduced additional infringing products with slight
26 alterations of the version previously enjoined. In total, the infringer produced three variations, each of
27 which was enjoined by the district court while holding that the validity challenges did not present a
28 likelihood of success.

1 43. The PTAB instituted review in a total of 4 petitions, all relying on the same prior art
2 considered by the examiner and overruled by the district court in granting preliminary injunctions of the
3 various infringing products.

4 44. Over one million dollars in additional litigation costs were incurred due to the PTAB
5 petitions and trials.

6 45. PGR2015-00018 was pending for 3 years and 10 months, causing the infringement trial
7 to be delayed by more than 2 years, ultimately forcing Tinnus to settle with the infringer for a fraction of
8 the damages caused by the infringement.

9 46. The PTAB administrative patent judges had no particular expertise in water balloons and
10 in fact no professional technical experience of any kind. During the one hour trial, one of the APJs
11 mused (via remote connection) "I don't understand why with the first few drops it's already not
12 expanding, given that the material is elastic." The district court never sought expertise from the PTAB,
13 and the PTAB only confounded, confused, and delayed the resolution of the invalidity dispute.

14 47. Had clear rulemaking on discretionary considerations by the Director occurred, the
15 petitions against Tinnus' patents would have been denied resulting in a faster and less expensive
16 resolution to the dispute with the infringer. The economy and integrity of the patent system would be
17 improved. Mr. Malone and other inventors would have increased confidence that patents will effectively
18 protect their investment in developing and commercializing their inventions from brazen copycats.

19 48. E-Watch suffered the harmful effect on the economy from the Director's unlawful
20 withholding of rulemaking. The abuses endured by E-Watch due to serial IPRs being filed against its
21 patents were significant. E-Watch is a small company owned by David Monroe, a prolific inventor who
22 spent millions of dollars developing an invention for digital pictures to be captured, converted and
23 transmitted digitally. Mr. Monroe and E-Watch's invention can be best described as the camera phone.
24 At great expense, E-Watch patented its ground-breaking camera phone invention, which culminated in
25 two patents: United States Patent No. 7,365,871 (the "871 Patent"), issued April 29, 2008, for
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27
28

1 “Apparatus for Capturing, Converting and Transmitting a Visual Image Signal Via a Digital
2 Transmission System”; United States Patent No. 7,643,168 (the “’168 Patent”), issued January 5, 2010,
3 for “Apparatus for Capturing, Converting and Transmitting a Visual Image Signal Via a Digital
4 Transmission System” (collectively, the “Camera Phone Patents”).

5
6 49. On December 9, 2013, E-Watch, Inc. filed suit against camera phone manufacturers,
7 including Apple, Blackberry, HTC, Huawei, Kyocera, LG Electronics, Nokia, Samsung, Sharp, Sony
8 Mobile and ZTE, asserting infringement of the ’871 Patent and the ’168 Patent.

9
10 50. The IPRs filed against E-Watch included one filed by Iron Dome LLC, a third-party that
11 had not been sued by E-Watch and did not manufacture or sell infringing products. Iron Dome
12 previously threatened to file an IPR against E-Watch’s ’871 Patent unless E-Watch agreed to give Iron
13 Dome a portion of its licensing enforcement proceeds. E-Watch refused and, on February 18, 2014, Iron
14 Dome filed IPR2014-00439 (the “Iron Dome IPR”). E-Watch implored the Board to exercise its
15 discretion not to institute the Iron Dome IPR. The Board refused and instituted the Iron Dome IPR
16 against E-Watch.

17
18 51. But the attacks on E-Watch’s Camera Phone Patents did not stop there. In response to
19 the lawsuit, the defendants launched a campaign of serial and cumulative IPR filings to invalidate E-
20 Watch’s Camera Phone Patents. In its preliminary response to certain of these IPRs, E-Watch requested
21 that institution be denied because of the cumulative nature of the prior art and arguments across the
22 various IPRs and that that these were serial filings. For example, in IPR2015-00412, E-Watch stated to
23 the Board:

24
25 As a result, many of these petitions, including this petition (i.e., IPR2015-00412), are redundant
26 and present cumulative prior art and substantially the same arguments as other earlier-filed IPR
27 petitions, concurrently-filed IPR petitions, and/or later-filed IPR petitions. The Patent Trial and
28 Appeals Board (“PTAB”) should exercise its discretion under 35 U.S.C. 325(d) to deny
institution of this petition for this reason alone.

1 E-Watch urged the Board to exercise its discretion to decline to institute the inter partes review. The
2 Board refused and instituted the IPR on May 11, 2015. By the end of the punitive IPR campaign, the
3 number of IPR petitions filed against E-Watch's Camera Phone Patents was staggering. The '871 Patent
4 had 12 IPRs filed against it: IPR2014-00439, IPR2014-00987, IPR2014-00402, IPR2014-00404,
5 IPR2014-00406, IPR2014-00411, IPR2014-00412, IPR2014-00413, IPR2014-00541, IPR2014-00610,
6 IPR2014-00612 and IPR2014-01366. The '168 Patent had eight IPRs filed against it: IPR2014-00989,
7 IPR2014-00401, IPR2014-00407, IPR2014-00408, IPR2014-00414, IPR2014-00543, IPR2014-00607
8 and IPR2014-00611. Ultimately, E-Watch was forced to defend against 20 IPRs across its two Camera
9 Phone Patents, spent hundreds of thousands of dollars defending against all of these IPRs and had its
10 district court case irreparably damaged as a result.
11

12
13 52. Had clear rulemaking on discretionary considerations by the Director occurred, at least
14 some of the petitions against E-Watch's Camera Phone Patents would have been denied resulting in a
15 faster and less expensive resolution to the dispute with the infringer. The economy and integrity of the
16 patent system would be improved. Mr. Monroe, E-Watch and other inventors would have increased
17 confidence that patents will effectively protect their investment in developing and commercializing their
18 inventions from brazen copycats.
19

20 53. Each of the other patentee Intervenor experienced severe disruption to their business
21 and their legal interests because of institution of AIA trials that occurred without rulemaking on
22 discretionary factors.
23

24 54. Larry Golden ended up having to prosecute his IPR *pro se* against a government agency
25 petitioner after losing the assistance of his counsel after the PTAB instituted trial. A later Supreme Court
26 ruling in a different case held that the government had no statutory right to petition for IPRs in the first
27 place.
28

1 55. 360Heros originally faced a grant of institution, until the PTAB (in a specially-convened
2 panel different from the original panel, and including the Director) granted reconsideration and denied
3 review because the petitioner violated the time bar of 35 U.S.C. § 315(b).

4 56. WSE develops, markets and sells fertilizer additive products that lessen the
5 environmental impact of nitrogen in waterways and in the atmosphere. Success of WSE's
6 environmentally friendly solutions would be an existential threat to nitrogen / fertilizer manufacturers,
7 causing them to lose up to 50% of existing sales. A competitor of WSE who WSE believes infringes its
8 patents has filed multiple petitions at the PTAB to try to invalidate them, while filing multiple patent
9 applications for essentially the same technology. WSE has sought discretionary denial in at least one
10 pending petition not yet decided, which would have been much less costly to do had the USPTO already
11 issued lawful and clear rulemaking on discretionary factors for the "sufficient grounds" decision.
12

13 57. Clearplay had to go through IPRs that should have been discretionarily denied if clear
14 and legal rulemaking had occurred, including at least one in which the USPTO contradicted a prior
15 federal judge decision by issuing a broader claim interpretations for a material claim limitation than the
16 judge did, leading to an invalidation decision that a federal court would never make.
17

18 58. Intervenors have therefore suffered concrete economic injury from the absence of
19 "discretionary consideration" rulemaking. In a like manner, the absence of complete rulemaking on
20 "sufficient grounds" for the institution decision runs afoul of the requirement that rulemaking must take
21 into account the effect on the economy. 35 U.S.C. § 316(b).
22

23 **The Director's Clear (and Ignored) Statutory Mandate for Rulemaking**

24 59. Congress did not intend either IPR or PGR to be an easier process for accused infringers
25 to invalidate so-called "weak" patents. Instead, Congress intended IPR and PGR to be an accurate and
26 less costly alternative to district court litigation of particular patentability issues, one that would be
27 "objective, transparent, clear, and fair to all parties." 157 Cong. Rec. 3433 (Mar. 8, 2011) (Sen. Kyl).
28

The measure of a "fair" system is one in which rates for final determinations on patent validity at the

1 PTAB roughly match rates for final determinations on validity in U.S. District Courts. That has not been
2 the case. In federal court final determinations, only 25-30% of patents are invalidated, whereas in PTAB
3 final determinations, that number is 80-85%.

4 60. AIA trials have been heavily used by large corporations, who can easily have afforded to
5 litigate their invalidity challenges in district court, where a small business might obtain contingency
6 representation and an opportunity to plead its case to a jury. AIA trials impose asymmetric burdens,
7 since, aside from a hypothetical right to seek sanctions for egregious conduct, a patent owner has no
8 basis to obtain a monetary recovery against a petitioner. The majority of AIA trial cases involve a
9 corporation with orders of magnitude greater resources than the patent owner.
10

11 61. All AIA trial stakeholders have an interest in predictability of the institution decision.
12 Patent owners especially do. Congress intended to further the goal of predictability through legislative
13 mandates requiring the USPTO to promulgate regulations. In promulgating such regulations, the
14 Director is required to “consider the effect of any such regulation on the economy, the integrity of the
15 patent system, the efficient administration of the [USPTO], and the ability of the [USPTO] to timely
16 complete proceedings instituted under [the AIA].” 35 U.S.C. §§ 316(b) and 326(b).
17

18 62. The USPTO has and had a clear legislative mandate under 35 U.S.C. § 316(a)(2) to
19 “prescribe regulations . . . setting forth the standards for the showing of sufficient grounds to institute a
20 review under section 314(a)” for IPRs. The USPTO also has and had a clear legislative mandate under
21 35 U.S.C. § 326(a)(2) to “prescribe regulations . . . setting forth the standards for the showing of
22 sufficient grounds to institute a review under subsections (a) and (b) of section 324” for PGRs.
23

24 63. “Sufficient grounds” under the respective statutes include not only the legal and factual
25 merits related to patentability as presented by the petitioner. “Sufficient grounds” also include why the
26 Director should not apply discretionary factors to deny review. The USPTO has plenary authority,
27 unreviewable on appeal or mandamus, to deny review of any AIA trial petition for any reason.
28

1 *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but
2 never compelled, to institute an IPR proceeding”).

3 64. The USPTO’s rulemaking actions purporting to comply with its obligations under 35
4 U.S.C. §§ 316 and 326 have omitted required lawful procedures. In particular, they have omitted
5 discretionary considerations entirely, or relegated them to rulemaking that is procedurally unlawful. No
6 “agency action” that is lawful has ever occurred on this topic, despite the legislative mandate.
7

8 65. Rulemaking on “sufficient grounds” began with promulgation of 37 CFR § 42.108(c) (for
9 inter partes review) and 37 CFR §§ 42.208(c) and (d) (for post grant review). These rules do not include
10 any content addressing how the Director (or his designee, panels of the Patent Trial and Appeal Board)
11 will make institution decisions under any discretionary factors. On May 27, 2020, the USPTO published
12 a Notice of Proposed Rulemaking that would amend these rules, but those proposed amendments still
13 omit discretionary factors. 85 FR 31728.
14

15 66. Rulemaking on “sufficient grounds” discretionary considerations occurred in
16 procedurally unlawful ways. Rather than through publication, notice and comment, the USPTO has
17 communicated substantive “rules” about how the Director and his designees will apply their discretion
18 through ad hoc adjudicative processes.
19

20 67. In particular, the USPTO created a process for designating adjudicated decisions
21 “precedential” within the USPTO, such that future panels purportedly are obligated to follow such
22 decisions. *See* Patent Trial and Appeal Board, Standard Operating Procedure 2 (Rev. 10) (“SOP-2”), at
23 1-2, 8-12. Under this procedure, the Director decides whether to designate a Board decision as
24 precedential. Such “precedential” decisions are effectively rules / regulations, whether labeled so or not.
25

26 68. Although members of the public (or the Board) may nominate a Board decision for
27 designation as precedential, the procedure otherwise does not allow for public notice and comment.
28

69. Continued unlawful rulemaking on the discretionary factor topic occurred through such
adjudicative decisions. The Director made precedential the decision in *General Plastic Industrial Co.*,

1 *Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357 (Paper 19) (P.T.A.B. Sept. 6, 2017), to govern Board
2 discretion under 35 U.S.C. §§ 314(a) and 324(b-c) in deciding whether the relationship of a petition to
3 other petitions should lead to discretionary denial. The Director made precedential the decisions in *NHK*
4 *Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018), and
5 *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6
6 (P.T.A.B. Feb. 13, 2020), to govern Board discretion under 35 U.S.C. §§ 315(d) and 325(d) in deciding
7 whether the relationship of a petition to prior art and arguments considered during earlier patent
8 examination, reexamination, or AIA reviews should lead to discretionary denial. The Director made
9 precedential the decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5 (P.T.A.B. Mar. 20,
10 2020), to govern Board discretion under 35 U.S.C. §§ 314(a) and 324(b) and (c) in deciding whether the
11 relationship to parallel court proceedings should lead to discretionary denial.
12
13

14 70. Precedential decisions such as *General Plastic*, *Advanced Bionics*, *NHK* and *Fintiv* are
15 shortcuts that circumvent lawful rulemaking, and have not translated into predictability. These four
16 decisions provide “non-exclusive” factors that are to be “weighed” as a part of a “balanced assessment.”
17 These decisions, though, do not guide how a factor should be scored, how much weight each gets, or
18 what score will assure or prevent denial of institution. A sample of recent institution decisions illustrates
19 the problem.
20

- 21 • On September 12, 2019 institution was **denied** in IPR2018-00752. A district court trial between
22 the same parties was scheduled 6 months ahead of the PTAB final decision. The judge had not
23 ordered a stay or issued any order contingent on the PTAB. There were 134 docket entries
24 including a Markman order.
- 25 • On May 13, 2020 institution was **denied** in IPR2020-00019. A district court trial between the
26 same parties was scheduled 2 months ahead of the PTAB final decision. The judge had not
27

1 ordered a stay or issued any order contingent on the PTAB. There were 89 docket entries
2 including a Markman order.

3 • On June 16, 2020 institution was **granted** in IPR2019-01393. A district court trial between the
4 same parties was scheduled 4 months ahead of the PTAB final decision. The judge had not
5 ordered a stay or issued any order contingent on the PTAB. There were 101 docket entries
6 including a Markman order.

7
8 • On July 28, 2020 institution was **granted** in IPR2020-00235. A district court trial between the
9 same parties was scheduled 9 months ahead of the PTAB final decision. The judge had not
10 ordered a stay or issued any order contingent on the PTAB. There were 192 docket entries
11 including a Markman order.

12
13 71. The USPTO “unlawfully withheld” the “agency action” of promulgating such rules
14 governing “sufficient grounds” as actual lawful “regulations,” as Congress mandated they must. 35
15 U.S.C. §§ 316 and 326.

16
17 72. Had the Director promulgated regulations in a lawful manner on the topic of
18 discretionary considerations that make up “sufficient grounds” for institution, the notice and comment
19 process would have led to better-crafted regulations factoring in public comment. This, in turn, would
20 have contributed to better predictability of the institution decision.

21
22 73. Making rules lawfully would also have led to proper incorporation of the Congressionally
23 mandated considerations, particularly “the effect of any such regulation on the economy, the integrity of
24 the patent system, [and] the efficient administration of the [USPTO].” Adjudicative rulemaking is
25 particularly unsuited for incorporation of such considerations, as the parties to a patent validity dispute
26 are unlikely to be in a position to create an adequate policy-based or economy-based record, and
27 administrative patent judges are not likely to be trained or equipped to make policy-based on economic-
28 oriented decisions in the heat of a deadline-constrained institution decision.

1 74. The rulemaking Intervenor's accusation here of being unlawful has already been declared
2 unlawful. The Court of Appeals for the Federal Circuit, reissued a panel decision (after panel rehearing)
3 in *Facebook, Inc. v. Windy City Innovations, LLC*, No. 18-1400 (slip op. Sept. 4, 2020) (precedential). In
4 Additional Views joined by all members of the panel, the Court issued an alternative holding addressing
5 the unlawfulness of the Director's use of "Precedential Opinion Panels" under its SOP 2. The panel
6 noted that SOP 2 "precedential" designations may not lawfully substitute for notice and comment
7 rulemaking: "There is no indication in the statute that Congress either intended to delegate broad
8 substantive rulemaking authority to the Director to interpret statutory provisions through POP opinions
9 or intended him to engage in any rulemaking other than through the mechanism of prescribing
10 regulations." The Court went on to observe that Congress empowered the "Director" to establish
11 regulations, not the Board, such that "Congress's delegation in the AIA for the adjudication of
12 patentability in IPRs is not a delegation of authority to issue adjudicative decisions interpreting statutory
13 provisions of the AIA." The Court concluded, "in agencies where Congress has not expressly delegated
14 both rulemaking and adjudicative authority to a single delegee, as in the PTO, adjudication may not
15 operate as an appropriate mechanism for the exercise of rulemaking."
16
17

18
19 75. Therefore, the Director's attempt to use his SOP 2 authority to designate decisions on
20 how to apply discretionary considerations as "precedential" constitutes an invalid and unlawful attempt
21 at notice and comment rulemaking. The Director will be issue-precluded from arguing otherwise in this
22 litigation, because of the *Facebook v. Windy City* decision discussed above, in which he participated as
23 Intervenor.
24

25 **COUNT I – Agency Inaction in Violation of 5 U.S.C. § 706(1)**

26 76. Under the APA, the Court shall "compel agency action unlawfully withheld or
27 unreasonably delayed."
28

29 77. The USPTO Director's rulemaking on discretionary factors that guide whether a
petitioner has raised "sufficient grounds" for institution has occurred without publication, notice or

1 comment that agency rulemaking requires. “Agency action” in the form of rulemaking mandated under
2 the AIA has thus been “unlawfully withheld.”

3 78. The USPTO Director could not lawfully adopt such guidance concerning the
4 discretionary factors implicit in “sufficient grounds” for institution without notice-and-comment
5 rulemaking. *See* 5 U.S.C. § 553; 35 U.S.C. §§ 2(b)(2), 316(a), 326(a-b).
6

7 79. The USPTO Director propounded discretionary consideration rules for the “sufficient
8 grounds” decision as binding substantive rules without notice and comment in violation of the APA.

9 **COUNT II – Agency Action in Violation of 5 U.S.C. § 706(2)**

10 80. Under the APA, the Court shall “hold unlawful and set aside agency action” that is
11 “without observance of procedure required by law.”
12

13 81. The USPTO Director’s rulemaking on discretionary factors that guide whether a
14 petitioner has raised “sufficient grounds” for institution has occurred without publication, notice or
15 comment that agency rulemaking requires. Rulemaking under the AIA through adjudicative decisions is
16 (and has been held) unlawful. The Director’s rulemaking on discretionary factors has unlawfully
17 occurred though adjudicative decisions. “Agency action” in the form of rulemaking mandated under the
18 AIA has thus been “without observance of procedure required by law.”
19

20 82. The USPTO Director could not lawfully adopt such guidance concerning the
21 discretionary factors implicit in “sufficient grounds” for institution without notice-and-comment
22 rulemaking. *See* 5 U.S.C. § 553; 35 U.S.C. §§ 2(b)(2), 316(a), 326(a-b).
23

24 83. The USPTO Director propounded discretionary consideration rules for the “sufficient
25 grounds” decision as binding substantive rules without notice and comment in violation of the APA.

26 **RELIEF REQUESTED**

27 WHEREFORE, Intervenor respectfully request that the Court enter judgment in their favor and:

28 1. Declare adjudicative rulemaking on discretionary considerations for the “sufficient
grounds” decision to be unlawful;

1 2. Compel notice-and-comment rulemaking on discretionary considerations for the
2 “sufficient grounds” decision, as Congress has mandated;

3 3. Preliminarily and permanently enjoin the Director from granting institution in any AIA
4 patent trial pending completion of compelled rulemaking (at which point properly promulgated rules
5 will govern Board panel institutions and adjudications);

6 4. Preliminarily and permanently enjoin the Director from requiring Board panels to treat
7 any prior adjudicated Board decision analyzing discretionary considerations as “precedential” in any
8 upcoming decision, pending completion of compelled rulemaking (at which point properly promulgated
9 rules will govern Board panel institutions and adjudications);

10 5. Award Intervenors their costs and attorney’s fees and expenses as allowed by law; and

11 6. Provide such other and further relief as the Court deems appropriate.

12 Dated: September 14, 2020

13 Respectfully submitted,

14 /s/ Lewis E. Hudnell, III

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