



15 November 2023

Senator Richard Durbin
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Senator Lindsey Graham
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Senator Chris Coons
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Senator Thom Tillis
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Senator Mazie Hirono
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

In re: *S.2220, the Promoting and Respecting Economically Vital American Innovation Leadership Act (PREVAIL Act)*

IEEE-USA writes to express full support for *S.2220, the Promoting and Respecting Economically Vital American Innovation Leadership Act (PREVAIL Act)*. Thousands of individual U.S.-based members of IEEE depend on reliable and effective patent rights to secure the benefits of their inventions and technological innovations. High-tech inventions have driven the U.S. economy since IEEE founders Thomas Edison, Alexander Graham Bell, Nicola Tesla, and others gave birth to the revolution in electrical consumer products and services over a century ago. Like Edison, Bell, and Tesla, IEEE members rely on predictable and effective patent rights to license or otherwise commercialize their inventions in the innovation economy, growing jobs and contributing to economic growth.

Following its creation in the *America Invents Act of 2011*, the Patent Trial and Appeal Board (PTAB) has dramatically weakened this key pillar of the U.S. innovation economy. Regardless of whether this was by design or by accident, the PTAB is rightly criticized for failing to protect the due process rights of patent owners. PTAB “shenanigans” — a phrase regularly used by Supreme Court Justices, lawyers, and commentators to refer to PTAB actions — are well known. Multiple PTAB petitions are filed to cancel the same patent — sometimes 30–40 petitions filed against the same patent. Some PTAB petitioners extort patent owners in exchange for not filing or withdrawing previously filed

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petitions. Big Tech companies extensively use PTAB petitions to harass patent owners with delays and costs as part of their predatory infringement tactics. PTAB rules and procedures also change with each new administration, and often many times in the same administration, as has occurred in the past three years. PTAB patent cancellation rates are approximately 83 percent, and cancellation rates have been 100 percent in some of the hearing programs, such as the now-defunct Transitional Covered Business Method program.

As a result, the PTAB has undermined the incentives for technological innovation and economic growth. It threatens the longstanding U.S. technological leadership in the global innovation economy, from digital telecommunication standards to next-generation technologies in artificial intelligence and the Internet of Things. At a time when the U.S. faces geopolitical challenges from global competitors such as China, the U.S. should enact the PREVAIL Act and reform the PTAB.

The PREVAIL Act brings much-needed reform to an administrative tribunal that has destabilized the patent system. The legislation builds into the PTAB permanent, important procedural guardrails and other legal protections of patent owner rights. It will bring an end to the above-described abuses and bring balance back to the patent system.

IEEE-USA thanks Senator Coons, Senator Hirono, and Senator Tillis for sponsoring S.2220 and we ask that the Committee pass this bill as soon as possible. Please do not hesitate to contact Erica Wissolik at e.wissolik@ieee.org or (202) 530-8347 if you have any questions or wish to discuss the issue with us further.

Sincerely,

A handwritten signature in blue ink that reads "Eduardo F. Palacio". The signature is fluid and cursive, with a large initial "E" and "P".

Eduardo Palacio
IEEE-USA President