

UNITED STATES
PATENT AND TRADEMARK OFFICE



The New York Intellectual Property Law Association

SAS Implications and Guidance

W. Tim Fink

Vice Chief Administrative Patent Judge

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SAS Guidance

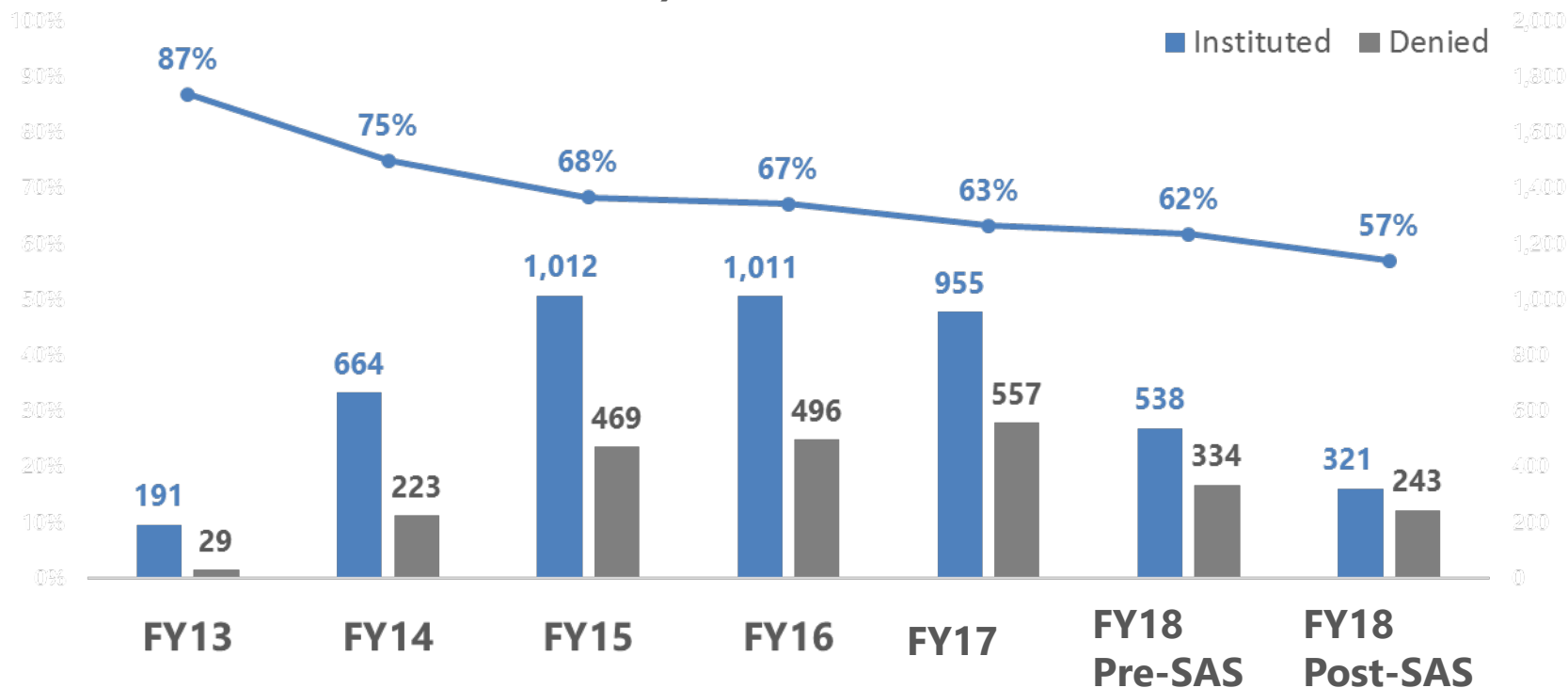
- Initial Guidance, April 26th
 - Board will institute on all claims and all grounds
 - <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>
- Revised Guidance (Q&A), June 5th
 - Among other things, provides guidance on
 - When the Board will extend the statutory deadline to comply with SAS
 - When the Board will address SAS issues for cases on appeal to the Federal Circuit
 - How the Board will address § 325(d) arguments in light of SAS
 - How the Board will address excessive or voluminous grounds in light of SAS
 - What the parties can do to limit on-going proceedings in light of SAS
 - Accessible at:
 - https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf

SAS Operational Impact

- 810 ongoing trials at the time SAS was decided
 - 356 not instituted on all claims and all grounds (44%) and needed to be revised for SAS
 - 34 extended for good cause
- 21 remands to date from the Federal Circuit due to SAS or having SAS issues

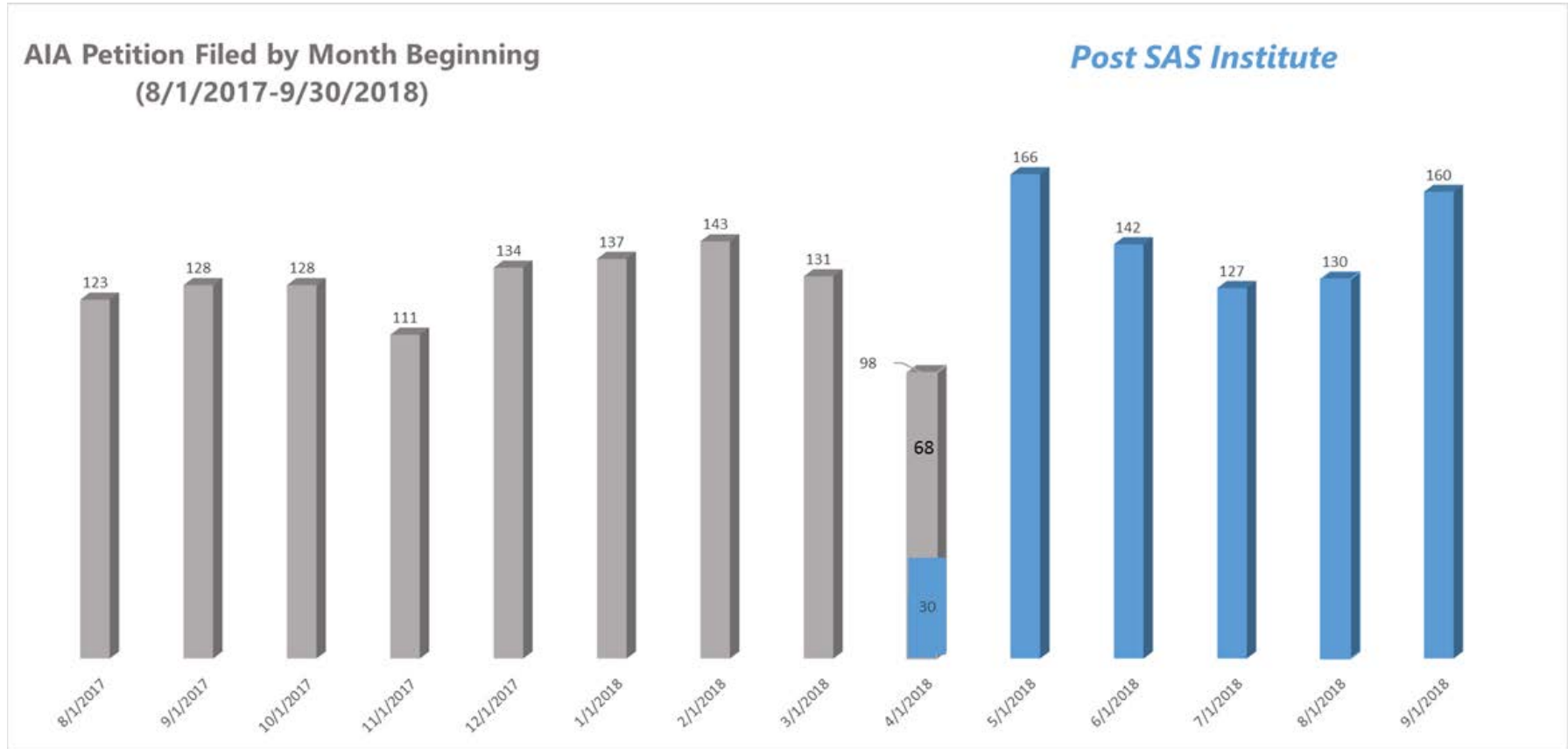
Institution Rates by Fiscal Year

(FY13 to FY18: 10/1/12 to 9/30/18)



Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

Petition Filings, Pre- and Post-SAS, Oil States



SAS Q&A: 325(d)

35 U.S.C. § 325(d)

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the [Director](#) may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

Q: In view of the Office's policy to institute on all challenges or none, how will the Board handle 35 USC § 325(d) in situations where only some of the challenges fall within its scope?

A: The panel will evaluate the challenges and determine whether § 325(d) is sufficiently implicated that its statutory purpose would be undermined by instituting on all challenges. If so, the panel will evaluate whether the entire petition should be denied.



SAS Q&A: 112(f)

37 C.F.R. § 42.104 Content of petition.

[T]he petition must set forth: ... (b)(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;

Q: How will the Board handle petitions where, prior to SAS, some claims would have been denied because the Petitioner does not provide a construction under 35 USC § 112(f)?

A: The panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (see 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).

SAS Q&A: Excessive Grounds

Q: In view of the Office's policy to institute on all challenges or none, how will the Board handle petitions that contain voluminous or excessive grounds for institution in light of the Office's policy of instituting on all claims?

A: The panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (see 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).

SAS Q&A D2

SAS Q&A: Waiving Additional Grounds

- **Parties can agree to waive additional grounds.**
- **Can one party limit additional grounds?**

Q: If the parties cannot agree to waive additional claims, is there anything a party can do on its own to limit the scope of the proceeding?

A: Yes.

- a. The Patent Owner can disclaim claims at any time.
- b. The Petitioner can request adverse judgment on claims and/or grounds at any time.

SAS Q&A B12

- **Does estoppel apply to Petitioner in either case?**



SAS Q&A: Content of DI

Q: Will the Board change how it does institution decisions as a result of SAS? For example, will the Board's institution decisions address one claim and one ground?

A: The Board will endeavor to provide details to the parties. For example, a panel generally will try to provide information responding to the Patent Owner's arguments (assuming the Patent Owner filed a Preliminary Response) to help the parties understand the panel's preliminary view of the merits of the parties' arguments.

SAS Q&A E1

Questions and Comments

W. Tim Fink

Vice Chief Administrative Patent Judge

(571) 272-9797

William.Fink@USPTO.gov

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