

PTAB COMMITTEE MEETING: **ASK THE PTAB**



Tuesday, April 16th, 2024
4:00pm-5:00pm ET



Featured guest speaker:
Hon. Ifti Ahmed,
Lead Administrative Patent Judge, USPTO



Featured guest speaker:
Hon. Jeffrey W. Abraham
Lead Administrative Patent Judge, USPTO



Featured guest speaker:
Hon. Janet Gongola
Vice Chief Judge, USPTO



Co-chair of the PTAB Committee
Charles R. Macedo



Co-chair of the PTAB Committee
Ken Adamo



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Additionally, the following content is presented solely for discussion and illustration and does not comprise, nor is it to be considered legal advice.



UNITED STATES
PATENT AND TRADEMARK OFFICE



Appeals

1. Opening brief

Dear PTAB,

I am preparing to file my opening brief in my first appeal.

What is the best way to organize the arguments? Should I start with the strongest or the weakest? Does organization even matter as long as I include all my issues?

Sincerely,

My Opener

Dear Mr. Opener,

Thank you for your letter. I am pleased to tell you about: **Opening brief**

- **Identify your strongest arguments and present them first**
 - Avoid diluting your strong arguments with weaker ones
 - But keep in mind– any rejection that you decide not to address and any arguments that you decide not to present **cannot** be presented later
- **There is no limit on number of pages**
 - But the clearer and more concise your arguments, the better your chances of prevailing

Dear Mr. Opener,

Thank you for your letter. I am pleased to tell you about: **Opening brief**

- Address each ground of rejection under a separate heading
- Identify the ground of the rejection by claim number, statutory basis, and references (if any)
- If the same argument applies to two or more claims, consider arguing the claims as a group under a single heading or sub-heading
- Use a separate heading or sub-heading for any claim that you want the PTAB to consider separately
- For whatever argument you make to show that the examiner erred, you should always give reasons to support your position
 - Explain why – because, because, because



2. Reply brief

Dear PTAB,

In the Examiner's Answer, the examiner appears to merely repeat the final rejection. Should I file a reply brief, and if so, what should I include?

Sincerely,

Will I. Brief

Dear Mr. Brief,

Thank you for your letter. I am pleased to tell you about: **Reply brief**

- Argue the substance of any new findings that the Examiner made in the examiner answer. For example, you might argue:
 - If the Examiner makes a new finding, construes a claim term, or cites a new reference,
 - Address why a limitation is not met in the new finding or construction
 - Address why the combination is not obvious over the new finding or construction
- If the Examiner clarifies the reasoning in the rejection,
 - Address the clarified reasoning head-on
- Repeating arguments from the Appeal Brief is seldom effective.

3. New grounds of rejection

Dear PTAB,

When does the PTAB issue a new ground of rejection and what options do I have to address it?

Sincerely,

N.U. Grounds

Dear Ms. Grounds,

Thank you for your letter. I am pleased to tell you about: **New grounds of rejection**

- A new ground of rejection is the presentation of new information, findings, or reasoning in the examiner's answer
 - If the examiner is **changing the thrust of the rejection** in the examiner's answer, it may be formally designated as a new ground of rejection in the examiner's answer.
- The Office has established guidelines at MPEP 1207.03 as to what constitutes a new ground of rejection.



Dear Ms. Grounds,

Thank you for your letter. I am pleased to tell you about:

New grounds of rejection

- If the new ground of rejection is clearly identified by the examiner, Appellant's next steps:
 - 2 months to respond
 - Response options*:
 - Request that prosecution be reopened; or
 - Submit a reply brief that addresses all new grounds to maintain the appeal

* The appeal will be **dismissed** if one of the above is not filed



Dear Ms. Grounds,

Thank you for your letter. I am pleased to tell you about:

**New grounds of
rejection**

- If the new ground of rejection is not clearly identified by the examiner, Appellant's options:
 - Petition (37 C.F.R. § 1.181)
 - Within 2 months
 - Before filing of a reply brief
 - Submit arguments in a reply brief addressing Examiner's argument raised for the first time in the Examiner's Answer

AIA proceedings

4. Contacting the Board

Dear PTAB:

I filed a patent owner response in one of my IPRs but later discovered that some of the citations to the filed exhibits were incorrect. I would like to file a corrected version of the brief, but petitioner opposes.

Should I just ignore petitioner or should I contact the panel for prior authorization?

Thanks,

Sue Wright, Esquire

Dear Ms. Wright:

Thank you for your letter. I am pleased to tell you about:

Contacting the Board

- Consolidated Trial Practice Guide (“CTPG”) – Where a party believes it has a basis to request relief on a ground not identified in the rules, the party should contact the Board and arrange for a conference call with the Board.
- Requesting email should: (1) copy all parties, (2) indicate generally the relief requested or subject matter of the call, (3) not include substantive argument or attachments (e.g., draft motions), (4) include multiple times when all parties are available, and (5) state any opposition and address the meet & confer requirement.
- 37 C.F.R. § 42.20 – Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion, with prior authorization.
- Need panel authorization for motions: (1) to file supplemental info, (2) to strike, (3) to expunge, (4) to terminate, (5) for additional discovery, and others.

5. Petition size

Dear PTAB:

I am representing a petitioner. I have prepared the petition, and unfortunately, I am just over the word limit. How can I secure more space to fully make all the arguments that my client wants me to include?

Thanks,

Anita Word, Esquire

Dear Ms. Word:

Thank you for your letter. I am pleased to tell you about: **Petition size**

- Rule 42.24(a) sets the word limit for petitions (14,000 words).
- Rule 42.24(b) states that the petition may be accompanied by a motion to waive the word count.
 - You must show in the motion how a waiver of the word counts is in the interests of justice *and*
 - You must append a copy of the proposed petition exceeding the word count to the motion.
- If the motion is not granted, the proposed petition exceeding the word count may be expunged or returned.



6. Replies to PO's preliminary response

Dear PTAB,

I represent petitioners in AIA proceedings before the Board. In putting together a petition, I try to think of any possible arguments that the patent owner may raise in its POPR. But I'm always faced with POPR arguments that I did not foresee, and my clients get very concerned about addressing those.

Can you please provide me with some guidance on when I can successfully request leave for a reply to the POPR? Also, what is the preferred length of a reply to the POPR?

Thank You,

Anna Re Ply, Esquire

Dear Ms. RePly:

Thank you for your letter. I am pleased to tell you about: **Preliminary Replies**

- **37 C.F.R. § 42.108(c)** – Petitioner may seek leave to file a reply to the POPR; such request must show good cause.
- **37 C.F.R. § 42.23(b)** – Reply may only respond to the POPR; sur-reply may only respond to arguments raised in the corresponding reply.
- Potential bases to file replies to POPRs may include responding to POPR arguments relating to § 314(a) (e.g., *Fintiv*) and § 325(d), whether a reference qualifies as prior art, changes in law or USPTO guidance, interim claim construction or other relevant rulings in district court.
- **37 C.F.R. § 42.24(c)** – Page limit for replies: five pages. Can ask for more pages if need to address multiple issues raised in the POPR. If the Board authorizes a reply, it likely will authorize patent owner to file a sur-reply.



7. Reply and Sur-reply evidence

Dear PTAB:

I am preparing to file a reply and believe new evidence may be necessary to fully respond to the patent owner response. When will the Board allow a party to submit evidence with a reply/sur-reply?

Argumente B. Newby

Dear Ms. Newly:

Thank you for your letter. I am pleased to tell you about: **Reply Evidence**

- Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23.
- “Respond” does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing.
- Petitioner may not submit new evidence or argument in reply when that evidence or argument could have presented earlier, e.g., to make out a *prima facie* case of unpatentability.
- A party may submit rebuttal evidence in support of its reply.



Dear Ms. Newly:

Thank you for your letter. I am pleased to tell you about: **Reply Evidence**

- In deciding the proper scope of rebuttal evidence, the Board may consider:
 - Does the new evidence or declaration fairly respond to argument or evidence in the response?
 - Does the evidence or argument properly expand on and is a fair extension of theories set forth in the petition?
- Sur-Reply – if a reply has a new declaration, patent owner may depose the declarant; the sur-reply offers the opportunity to respond to a reply (and new evidence) and to also point out cross examination testimony.
- But, § 42.23(b) states: “A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.”



8. Supplemental information

Dear PTAB:

After filing my Patent Owner Response, I recently uncovered new evidence that is pertinent to the case. How can I get this new evidence into the record?

Should I file a motion for supplemental information? If so, what do I include in the motion?

Thanks,

Phil Inn, Esquire

Dear Mr. Inn:

Thank you for your letter. I am pleased to tell you about:

Supplemental Information

- Supplemental information is different from supplemental evidence under 37 C.F.R. § 42.64(b)(2).
- Supplemental information requires an authorized motion. 37 C.F.R. § 42.123.
- **Criteria**
 - Within 1 month of instituting trial
 - Relevance to a claim on which trial instituted (not the grounds)
 - If more than 1 month, must show: (1) why the information could not reasonably have been obtained earlier; and (2) why in the interests of justice
- Not automatic, even if criteria met; Board considers efficient administration and completing IPR on time.
- Motion to submit should not include the exhibit itself – exhibit submitted only if motion is granted.
- Board may also consider prejudice to opposing party and may grant additional relief.

9. Director Review

Dear PTAB:

I was a party in an IPR proceeding that recently concluded. Unfortunately, I did not receive a favorable outcome.

After reading the panel's decision, I've identified some important issues that I believe warrant a second look. A colleague of mine recently went through something similar, and told me that I can ask the Director to review the decision.

How do I ask for Director Review, and how does the process work?

Sincerely,

Dewey Revu

Dear Mr. Revu:

Thank you for your letter. I am pleased to tell you about: **Director Review**

- A party must
 - file a timely Request for Director Review (“Request”) in the Patent Trial and Appeal Case Tracking System, P-TACTS
 - Timing governed by 37 C.F.R. 42.71(d)
 - email Director_PTABDecision_Review@uspto.gov (“Notification Email”), copying counsel for all parties
- The Notification Email must include
 - a priority-ranked list of issues for which the party seeks review, and
 - an express identification of the alleged (a) abuse of discretion, (b) important issue of law or policy, (c) erroneous finding of material fact, and/or (d) erroneous conclusions of law



Dear Mr. Revu:

Thank you for your letter. I am pleased to tell you about: **Director Review**

- Advisory Committee assists Director by:
 - Evaluating each Director Review request and providing a recommendation to the Director
- The Director, upon review of the evidence, arguments, and Advisory Committee recommendation may:
 - grant review, deny review, or delegate review
- The Director may, in whole or in part:
 - affirm, reverse, modify, vacate, and/or remand the decision to the Board for further proceedings



Dear Mr. Revu:

Thank you for your letter. I am pleased to tell you about: **Director Review**

- The Director may make any findings or conclusions that the Director deems proper based on the record
- By default, a grant of Director Review does not stay the underlying proceeding before the Board; however, the Director maintains authority over all issues in the case, unless the Director orders otherwise
- **PTAB's Interim Director Review process website**

[www.uspto.gov/patents/ptab/decisions/
revised-interim-director-review-process](http://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process)



CLE Code

10. Rehearing Request or Director Review

Dear PTAB:

I received an unfavorable decision from PTAB. Sometimes, I think requesting Director Review is the right thing to do. Other times, I think filing a request for rehearing would be the better option.

Can you offer any help to someone trying to decide between asking for a rehearing vs. Director Review?

Sincerely,

Bach Enforth



Dear Mr. Enforth:

Thank you for your letter. I am pleased to tell you about:

**Rehearing
Requests**

Remember:

A party may request Director Review *or* rehearing by the Board, but not both

Dear Mr. Enforth:

Thank you for your letter. I am pleased to tell you about:

Rehearing Requests

Party requests for Director Review are limited to the following issues:

Decisions on Institution*	Final Written Decisions
An abuse of discretion	An abuse of discretion
Important issues of law or policy	Important issues of law or policy
	Erroneous findings of material fact
	Erroneous conclusions of law

* Both discretionary and merits-based issues may be raised, subject to limitations above



Dear Mr. Enforth:

Thank you for your letter. I am pleased to tell you about:

Rehearing Requests

- A request for rehearing must specifically identify
 - all matters the party believes the Board misapprehended or overlooked; and
 - the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

37 C.F.R. § 42.71(d)

Hearings

11. Demonstratives

Dear PTAB,

I recently received an order granting my request for oral argument in an AIA trial. YAY!

The order indicated that I could use demonstratives. What can I include in the demonstratives and how can I effectively use the demonstratives to make my case?

Sincerely,

P.T. Slides

Dear Mr. Slides,

Thank you for your letter. I am pleased to tell you about: **Demonstratives**

- Sometimes more is just more, not better.
- Be surgical.
- Figures or quotes.
- Comparisons of different parts of the record.
- Demonstratives are not evidence.
- Demonstrative should include citations to the record.
- Work with the opposing party to resolve any disputes over demonstratives.
- Remember, the judges have the record in front of them during oral argument.
- You can refer to the record in addressing their questions.

12. Pre-hearing conference

Dear PTAB:

I am considering whether to request a pre-hearing conference. Under what circumstances will the Board grant this conference? Also, what topics are generally covered at the conference?

Please help!

Sal V. Meet

Dear Mr. Meet:

Thank you for your letter. I am pleased to tell you about: **Pre-hearing conference**

- **Topics may include**
 - Requests for additional time
 - Early rulings on motion to exclude, motion to Strike, objections to demonstratives
 - Preview (but not argue) issues
 - Seek guidance from the panel as to particular areas of interest
- **Requesting a pre-hearing conference**
 - Meet and confer with opposing counsel.
 - Contact the Board by the due date for requesting a pre-hearing conference.
 - Refer to the guidance for a pre-hearing conference.
 - Scheduling Order
 - Order Setting Oral Argument
 - Consolidated Trial Practice Guide

13. New argument at hearing

Dear PTAB,

I am preparing for my first oral hearing. What should I do if my opposing counsel raises a new argument during the hearing? Will I have a chance to respond to it?

Sincerely,

Mark Myword

Dear Mr. Myword:

Thank you for your letter. I am pleased to tell you about: **New Arguments**

- **DO NOT interrupt during opposing counsel's presentation**
- **Take notes and raise the objection during your next chance to speak**
 - If the new argument comes during Patent Owner's sur-reply, counsel for Petitioner may politely ask for a chance to speak again before the hearing concludes to raise the new argument objection
- **Identify the argument as new**
 - Inform the panel that they should not consider the argument
 - Consider making a conditional response (e.g., "Should the court consider the new argument, we would respond by arguing . . .")
- **The panel may not rule on your objection during the hearing**



Questions?

