

NYIPLA

PTAB and Young Lawyers Committees

July 5, 2022

PTAB Bootcamp: A Primer of Milestones in a PTAB Trial

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Board Liaison

Greenspoon Marder LLP

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

PTAB Committee & Young Lawyers Committee

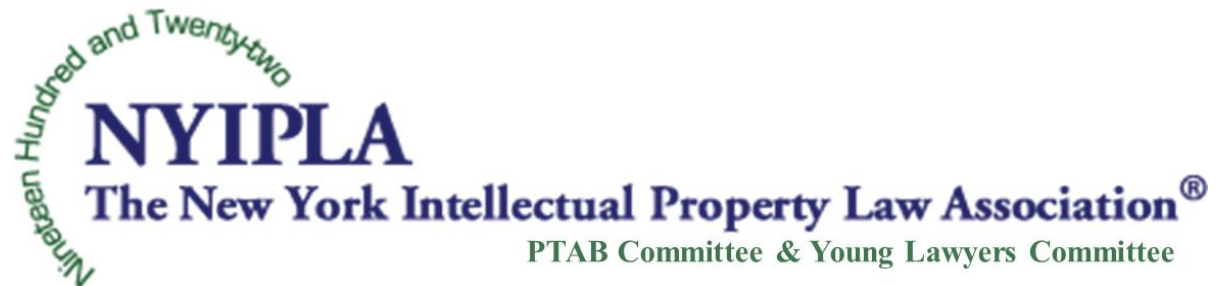


Patent Trial And Appeal Board

Disclaimer

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of the New York Intellectual Property Law Association, the PTAB Committee, the Young Lawyers Committee, or its members.

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



Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing
- Final Written Decision

Agenda

- Overview of Proceedings

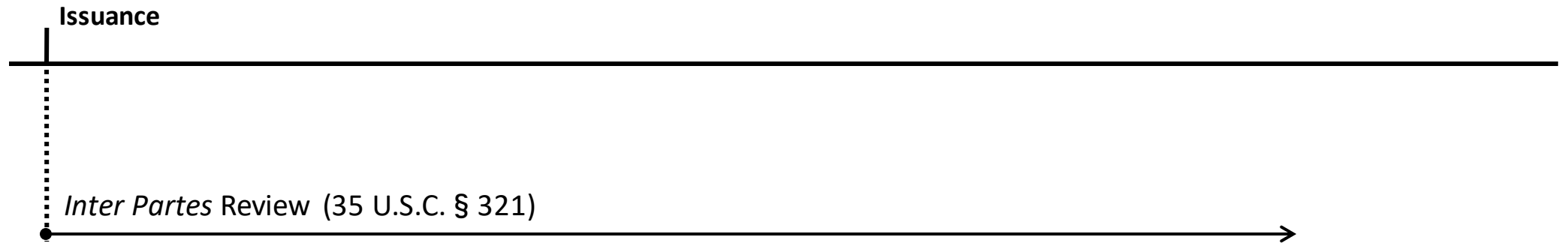


New CBMs are No Longer Available

Effective Sept. 16, 2020, the statutory time period for a petition to bring a new covered business method proceeding (CBM) expired, and new petitions may not be filed.

Pub. L. 112-29, §18, Sept. 16, 2011, 126 Stat. 329 and 77 FR 48679

Petition Timing

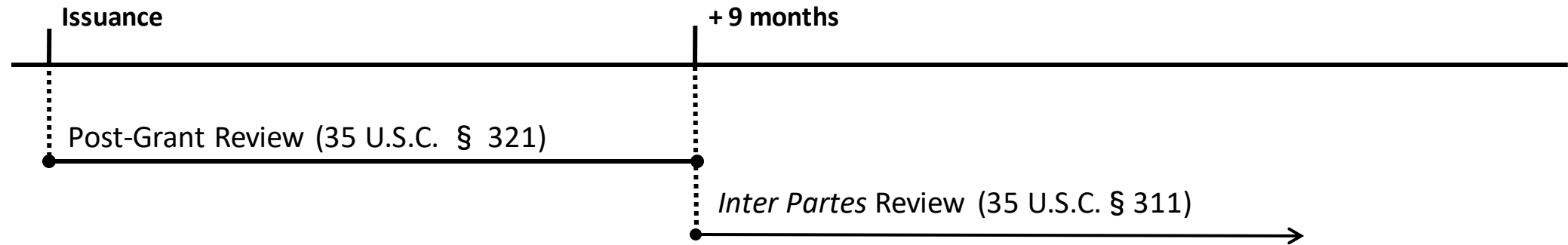


Pre AIA:

- IPR may be filed from patent issue date
- PGR not available for:
 - Patents filed under the 'first to invent' regime (before March 16, 2013).
 - Patents which claim priority to a first-to-invent application. *SweeGen, Inc. v. PureCircle USA, Inc.*, 2021 WL 203202 (PTAB Jan. 19, 2021).

See 37 C.F.R. § 42.102(a)

Petition Timing



Pre AIA:

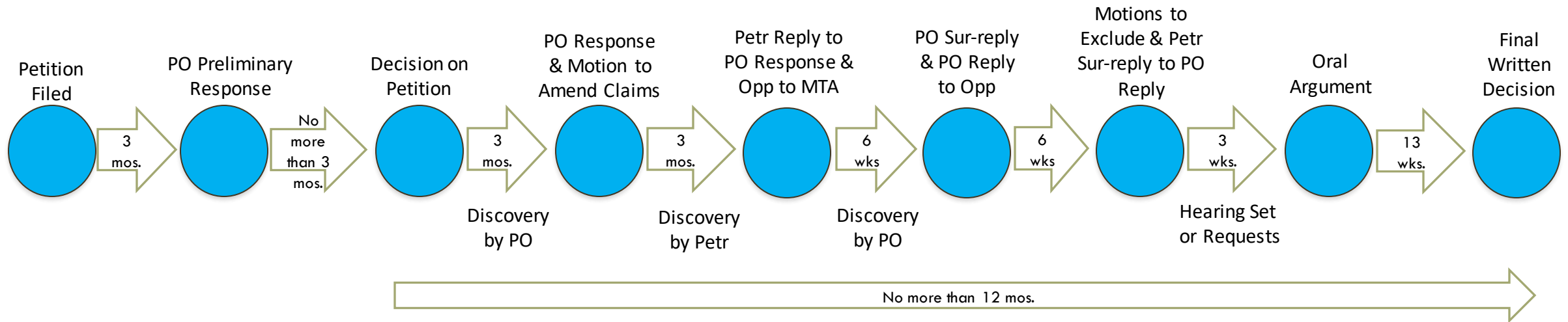
- IPR may be filed from patent issue date
- PGR not available for:
 - Patents filed under the 'first to invent' regime (before March 16, 2013).
 - Patents which claim priority to a first-to-invent application. *SweeGen, Inc. v. PureCircle USA, Inc.*, 2021 WL 203202 (PTAB Jan. 19, 2021).

Post AIA:

- PGR may be filed within 9 months of issue date
- IPR may be filed by the later of:
 - 9 months after issue date
 - Termination of any PGR of the patent

See 37 C.F.R. § 42.102(a)

Typical Timeline for IPR and PGR



PTAB Consolidated Trial Practice Guide November 2019
84 FR 9497, Appx 1A

Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
 - T-6 Months: The Petition

T-6 Months: The Petition

Petition Filed





Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits
- Service Requirements





Filing Requirements Checklist

Petition (and its Content)



Petition Content

“Each petition or motion must be filed as a separate paper and must include:

- (1) A statement of the precise relief requested; and
- (2) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”





Petition Content

(1) A statement of the precise relief requested:

- Must specify the statutory grounds for the petition
 - IPR – 35 U.S.C. §§ 102 or 103
 - PGR – 35 U.S.C. §§ 101, 102, 103, 112, or 251
- Must show how the PTAB should construe each claim
 - *Phillips*-type approach, not “broadest reasonable construction,” used (83 Fed. Reg. 51340).
- Must identify how the construed claim is unpatentable under the statutory ground(s)
 - Must explain where each claim element is found in the prior art.
 - Typically paragraph form (prior practice is claim charts)
- Must include specific citations to exhibit numbers for the supporting evidence.

37 C.F.R. § 42.104, 42.204





Petition Content

Petitioners may also include a statement of material facts with the petition; this is not required.

- Statements should identify each fact in separate paragraphs, including specific citations to the supporting portions of the record.





Petition Standard for Institution

IPR Standard

“The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 **shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged** in the petition.”

PGR Standard

“The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that **it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.**”

35 U.S.C. §§ 314(a), 324(a)





Petition Content

Not Notice Pleading – Put Your Best Foot Forward

- PTAB limits the petitioner to the challenge grounds identified in the petition
- To the extent possible, include detailed arguments and all evidence supporting any challenges



Petition Word Count Limits

Petitions are limited to:

- 14,000 words for IPRs.
- 18,700 words for PGRs.

Word count limits do not include:

- Table of Contents
- Table of Authorities
- Mandatory Notices
- Certificates of service or word count
- Appendix of exhibits or claim listings

Petitions must include a certification stating the number of words in the paper (37 C.F.R. § 42.24(d)).

PTAB will accept this word count, except when:

- Includes excessive words in figures, drawings, or images
- Deletes spacing between words
- Uses excessive acronyms or abbreviations

37 C.F.R. § 42.24(a)

PTAB Consolidated Trial Practice Guide November 2019





Rule 11-Type Certification

All papers filed with the PTAB in a proceeding must comply with the signature requirements set forth in 37 C.F.R. § 11.18(a) (37 C.F.R. § 42.11(b)).

By presenting a paper to the PTAB, an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under 37 C.F.R. § 11.18(b)(37 C.F.R. § 42.11(c)).



Filing Requirements Checklist

Petition (and its Content)

Fees



Fees

Type of Fee	IPR	PGR
Request Fee	\$19,000 (basic fee) plus \$375 (for each claim over 20, included unchallenged claims dependent on challenged claims)	\$20,000 (basic fee) Plus \$475 (for each claim over 20, included unchallenged claims dependent on challenged claims)
Post Institution Fee	\$22,500 (basic fee) plus \$750 (for each claim over 20, included unchallenged claims dependent on challenged claims)	\$27,500 (basic fee) plus \$1050 (for each claim over 20, included unchallenged claims dependent on challenged claims)
Total	\$41,500 plus excess claim fees	\$47,500 plus excess claim fees

All fees must be paid up-front at time of filing. If trial is not instituted, petitioner may file a request for a refund of any post institution fee paid. Fees are paid electronically on the USPTO's website.

37 C.F.R. § 42.15(a) and (b); www.uspto.gov





Toshiba America v. Monument Peak Ventures,
IPR2021-00330, Paper 20 (Jan. 14, 2022 Precedential (POP))

Question: On what day is a “real-time” fedwire transfer received?

POP Panel Concluded:

“Fedwire confirmation of payment constitutes sufficient evidence to demonstrate that the required fee accompanies a petition under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a), and constitutes sufficient evidence to demonstrate that ‘payment is received’ under 37 C.F.R. § 42.103(b).”

For more information:

<https://www.nyipla.org/assnfe/ev.asp?ID=1416>





Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices



Mandatory Notice Requirement

Petition must include a list of mandatory notices identifying:

- Each real party-in-interest
- Related judicial or administrative matters
- Lead and back-up counsel
- Service Information

Patent Owner must file the same mandatory notices within **21 days of service**, and parties must, when the information in the notice changes, file revised mandatory notices within **21 days of the change**.

If update occurs before institution and is made in good faith, without prejudice to patent owner, petitioner may update without changing the filing date of the petition (see *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019)(precedential)).



Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel



Designating Counsel

Parties must designate lead, as well as at least one back-up counsel. (37 C.F.R. § 42.10(a))

- Lead counsel expected to participate in all proceedings, but back-up counsel expected to participate when lead counsel cannot
- Either lead or back up counsel may conduct actions not before the USPTO

Power of attorney must be filed with the designation of counsel, unless the designated counsel is already counsel of record. (37 C.F.R. § 42.10(b))

Pro hac vice:

- Board may recognize counsel *pro hac vice*
- Lead counsel must be a registered practitioner (37 C.F.R. § 42.10(c))



Designating Counsel

**NYIPLA
PTAB Committee Meeting**

Kimberly Weinreich, Attorney, Office of Enrollment and Discipline
Amanda Wieker, Administrative Patent Judge, PTAB
Steven J. Fulk, Supervisory Patent Attorney, PTAB
May 4, 2021

***Pro hac vice* – best practices checklist**

- File PHV motion as paper
 - Filed by registered counsel of record
 - Includes “good cause” statement – litigation experience and specific familiarity with subject matter/record (§ 42.10(c); *Unified Patents Order*)
- File affidavit or declaration as exhibit
 - Properly executed/signed per § 42.2
 - Includes statements attesting to items i-viii of *Unified Patents Order*, or explanation of circumstances
- Pay proper fee
 - \$250 per attorney, per proceeding
 - E2E system links to PTO Financial Manager website – [return to E2E after payment and submit documents](#)
- Update power of attorney (§ 42.10(b)) and mandatory notices (§ 42.8)

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For more information, see a recent PTAB Committee meeting with members of the USPTO, “Insights on Ethics Issues at the USPTO,” https://www.linkedin.com/posts/nyipla_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B

Be sure to follow NYIPLA on LinkedIn to stay up-to-date on the latest Committee Presentations!



Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement





Parallel Petitions Ranking Statement

More than one petition may be necessary (i.e., because patent owner has asserted many claims or parties dispute priority date and must submit multiple prior art arguments).

Petitioners must, in a separate five-page filing:

- Rank the petitions based on desired order of review of merits.
- Explain:
 - The material differences between the petitions (preferably in table form); and
 - Why the Board should institute two petitions if it determines the petitioner has satisfied the institution threshold for one of them under 35 U.S.C. § 314(a).



Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits



Supporting Declarations and Evidence

TYPICAL LIST:

Ex1001: Patent in Suit

Ex1002: Expert Declaration

Ex1003: CV of Expert

Ex1004: Prosecution History of Patent-In-Suit

Ex1005: Parallel Litigation Documents (e.g. Complaint against Petitioner)

Ex1006: Prior Art Document

Etc.



Filing Requirements Checklist

- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits
- Service Requirements





Service Requirements

- Service must be by means at least as fast and reliable as Priority Mail Express, unless parties agree to electronic service.
- Each document filed must be served on each opposing party simultaneously with filing
- Service must be on counsel of record
- Service must include a certificates of service
 - Certificate of service included at the end of the document
 - Certificate must state:
 - The date and manner of service
 - The name and address of every person served
- When filing exhibits separately, a transmittal letter must be filed incorporating the certificate of service
 - One transmittal letter can be used for multiple exhibits and must state the name and exhibit for every exhibit filed with the letter



Agenda

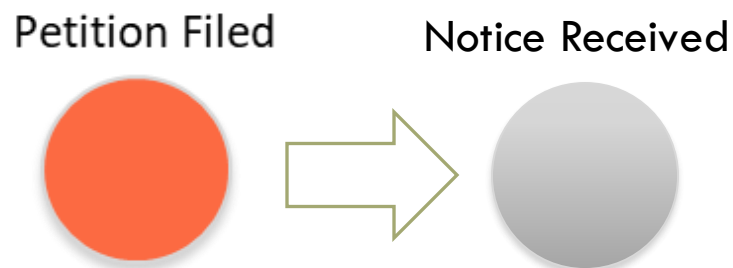
- Overview of Proceedings
- Pre-Institution Proceedings
 - T-6 Months: The Petition
 - T-6+ Months: Initial Post Filing Activity





Initial Post-Filing Activities

- Notices In Response to Petition (e.g., Notice to Accord Filing Date)
- Patent Owner's Mandatory Disclosure and Appearances (mandatory)
- Motions in Response to Notices (e.g., Motion to correct clerical mistakes) (optional)





Notice In Response to Petition

PTAB will issue a notice in the weeks following filing if it detects defects in the petition.

Sample notices include:

- Notice of Filing Date Accorded (see *Askeladden L.L.C. v. Authwallet, LLC*, IPR2021-00005, Paper 3, (PTAB Oct. 26, 2020))
- Notice of Defective Petition (see *Unified Patents, LLC v. Dolby Labs. Licensing Corp.*, IPR2021-00275, Paper No. 3 (Dec. 23, 2020))
- Notice of Incomplete Petition (see *Automotive Data Sols., Inc., et al. v. AAMP of Florida, Inc.*, IPR2016-00061, Paper No. 5 (PTAB Oct. 23, 2015))





Notice of Filing Date Accorded

Trials@uspto.gov
571-272-7822

Paper No. 3

Case IPR2021-00005
Patent 8,280,776 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN L.L.C.,
Petitioner,

v.

AUTHWALLET LLC,
Patent Owner.

Case IPR2021-00005
Patent 8,280,776 B2

Mailed: October 26, 2020

Before PATRICK E. BAKER, *Trial Paralegal*.

NOTICE OF FILING DATE ACCORDED TO PETITION
AND
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review filed in the above proceeding has been accorded the filing date of October 1, 2020.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is limited to setting forth the reasons why the requested review should not be

instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), which is available on the Board Web site at <http://www.uspto.gov/PTAB>.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel pro hac vice requires a showing of good cause. The parties are authorized to file motions for pro hac vice admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the "Order -- Authorizing Motion for Pro Hac Vice Admission" in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under "Representative Orders, Decisions, and Notices." **The parties are reminded that, in order for any motion for pro hac vice admission to be considered by the Board, the requisite fees must first be paid.** The current fee schedule is available at <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>.

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in Patent Trial and Appeal Board End to End (PTAB E2E), accessible from the Board Web site at <http://www.uspto.gov/PTAB>. To file documents, users must register with PTAB E2E. Information regarding how to register with and use PTAB E2E is available at the Board Web site.



Notice of Defective Petition

Trials@uspto.gov
571-272-7822

Paper No. 3

IPR2021-00275
Patent 10,237,577

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

DOLBY LABORATORIES LICENSING CORPORATION,
Patent Owner.

Case IPR2021-00275
Patent 10,237,577

Mailed: December 23, 2020

Before STEVEN M. AMITRANI, *Trial Paralegal*

NOTICE OF FILING DATE ACCORDED TO PETITION
AND
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review in the above proceeding has been accorded the filing date of December 11, 2020.

A review of the petition identified the following defect(s):

Exhibit 1016 is referenced on Petition page 34 and listed in E2E as “Redline comparison of US Application 14/609,472 and US Application 13/877,253.” However, the exhibit lacks both redlining and identifying information. Please file the correct exhibit as “Corrected Exhibit 16.”

Petitioner must correct the defect(s) within **FIVE BUSINESS DAYS** from this notice. Failure to correct the defect(s) may result in an order to show cause as to why the Board should institute the trial. No substantive changes (e.g., new grounds) may be made to the petition.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is limited to setting forth the reasons why the requested review should not be instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), which is available on the Board Web site at <http://www.uspto.gov/PTAB>.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under





Notice of Incomplete Petition

Trials@uspto.gov
571-272-7822

Paper No. 5

Case IPR2016-00061
Patent 9,165,593

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUTOMOTIVE DATA SOLUTIONS, INC. and
AUDIONICS SYSTEM, INC.,
Petitioner,

v.

AAMP OF FLORIDA, INC.,
Patent Owner.

Case IPR2016-00061
Patent 9,165,593

Mailed: October 30, 2015

Before BRECK A. REITTER, *Trial Paralegal*

NOTICE OF INCOMPLETE PETITION

The petition for *inter partes* review filed on October 20, 2015 in the above proceeding has not been accorded a filing date due to the following deficiencies:

Petitioner does not include the patent at issue, US 9,165,593, as an exhibit. Under 37 C.F.R. § 42.6(c), "... Each exhibit must be filed with the first document in which it is cited ..."

Petitioner does not serve Patent Owner by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®. Under 37 C.F.R. § 42.6(e)(1), "... Service may be by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®."

Petitioner does not state the date of service or the name and address of every person served in the Certificate of Service. Under 37 C.F.R. § 42.6(e)(4)(iii), "[t]he certificate of service must state: (A) The date and manner of service and (B) The name and address of every person served."

Under 37 C.F.R. § 42.106(b), Petitioner may correct the deficiencies within ONE MONTH from the date of this notice. If the statutory deficiency is corrected (and no other deficiency is introduced) within one month, the petition will be accorded the filing date of the supplemental submission. The incomplete petition will be retained for one month such that Petitioner need not resubmit previously submitted documents in any supplemental submission. If the deficiency is not corrected within one month, the petition will be dismissed.

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in the Patent Review Processing System (PRPS), accessible from the Board Web site at <http://www.uspto.gov/PTAB>.

If there are any questions pertaining to this notice, please contact Breck A. Reitter at 571-272-5866 or the Patent Trial and Appeal Board at 571-272-7822.





Motions in Response to Notices

Petitioner may also file a motion to correct a clerical or typographical mistake without changing the filing date of the petition (37 C.F.R. § 42.104(c)). Must explain:

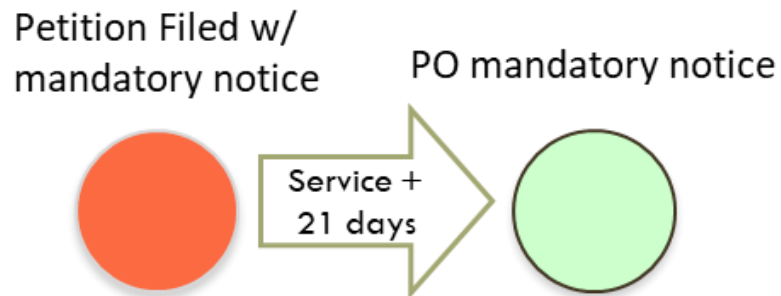
- The nature of the error, and whether the petitioner provides adequate explanation for how the error occurred and was discovered.
- The amount of time between learning of the error and bringing the error to the Board's attention.
- Prejudice to the patent owner, if any, by allowing the proposed corrections.
- Whether the proposed corrections have any impact on the proceeding.

Corrections cannot add “substantive new evidence” (*Sweegen, Inc. v. Purecircle Sdn Bhd*, PGR2020-00070, Paper 9 at 5 (PTAB September 22, 2020)).



Patent Owner's Disclosures (Mandatory)

Patent Owner **must** file the same mandatory notices within **21 days of service**, and parties must, when the information in the notice changes, file revised mandatory notices within **21 days of the change**.





Patent Owner's Appearances (Mandatory)

Patent owners may proceed pro-se, but organizations must be represented by counsel.

Parties must designate lead, as well as back-up counsel. (37 C.F.R. § 42.10(a))

- Lead counsel expected to participate in all proceedings, but back-up counsel expected to participate when lead counsel cannot.
- Either lead or back up counsel may conduct actions not before the USPTO.

Power of attorney must be filed with the designation of counsel, unless the designated counsel is already counsel of record. (37 C.F.R. § 42.10(b))

Pro hac vice:

- Board may recognize counsel *pro hac vice*.
- Lead counsel must be a registered practitioner (37 C.F.R. § 42.10(c)).



Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
 - T-6 Months: The Petition
 - T-6+ Months: Initial Post Filing Activity
 - T-6 Months to T-3 Months: Initial Disclosures





Initial Disclosures

Two Options for Mandatory Initial Disclosures:

No Agreement Reached

Agreement Reached

Petition Filed





No Agreement Reached

While Parties may reach an agreement as to initial disclosures, the most likely scenario is that they do not. Parties may file motions as to obtain the discovery they seek (see 37 C.F.R. § 42.51(a)(2)).





Agreement Reached

Once the petition is filed, the parties may begin negotiating the scope of mandatory initial disclosures.



Agreement Reached

Option 1

Modeled after the Federal Rule of Civil Procedure (FRCP) 26(a)(1)(A) and requires a basic exchange of information, such as:

- the names, addresses, and telephone numbers of individuals likely to have discoverable information; and
- copies of documents that a party may use to support its position.

Option 2

Includes:

- the disclosures from Option 1;
- additional contact information of individuals with knowledge of non-published prior art if the petition seeks to cancel claims based on a non-published disclosure; and
- additional information regarding secondary considerations of non-obviousness if the petition seeks to cancel claims based on obviousness.

Trial Practice Guide, 77 Fed. Reg. at 48762 and *Carestream Health, Inc. v. Smartplates, LLC*, IPR2013-00600, Paper 8 (PTAB Dec. 26, 2013)





Agreement Reached

If the parties agree to the scope of initial disclosures, they must submit that agreement by the earlier of:

- The time the patent owner files its preliminary response.
- The preliminary response due date (T-3 months).



NY CLE CODE

Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
 - T-6 Months: The Petition
 - T-6+ Months: Initial Post Filing Activity
 - T-6 Months to T-3 Months: Initial Disclosures
 - T-3 Months: PO Preliminary Response (POPR)





T-3 Months: POPR (optional)

Response Timing

Response Details

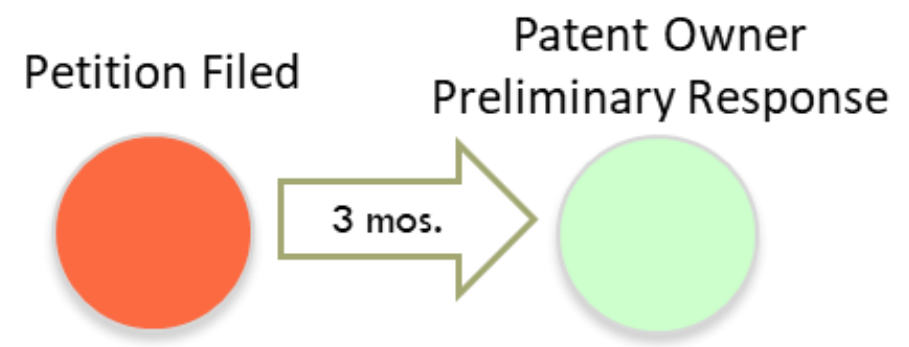
Reply to POPR

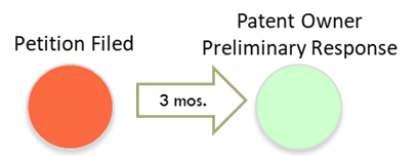
Sur-Reply



Response Timing

The patent owner may elect to file a POPR to a petition within three months of the PTAB's notice according a filing date to the petition.





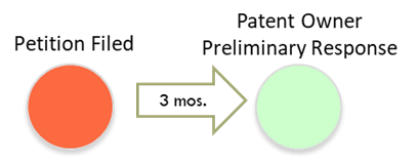
POPR Details

Limited to stating the reasons why the PTAB should not institute a trial. Patent owner:

- May present supporting evidence, including new testimonial testimony (for example, expert declaration).
- May not include any amendment.
- May disclaim challenged patent claims, which precludes review of those claims (see *General Elec. Co. v. United Techs. Corp.*, 2017 WL 2891110 (PTAB July 6, 2017)(precedential) (challenged claims disclaimed under 37 C.F.R. 42.107(e)).

Arguments commonly undercut the petitioner’s prior art, characterize the petitioner’s proposed claim construction as unreasonable, and otherwise attempt to demonstrate how the threshold for institution is not met.

37 C.F.R. §§ 42.107, 42.207, Trial Practice Guide, 77 Fed. Reg. at 48764 and PTAB Trial Practice Guide July 2019 Update at 19



POPR Details

POPRs are limited to:

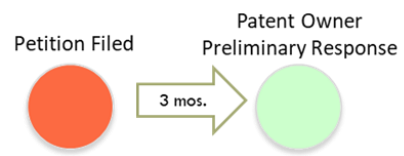
- 14,000 words for IPRs.
- 18,700 words for PGRs.

Word count limits do not include:

- Table of Contents
- Table of Authorities
- Mandatory Notices
- Certificates of service or word count
- Appendix of exhibits or claim listings

Preliminary response may contain an expert declaration ((37 C.F.R. §§ 42.107(a) and 207(a))

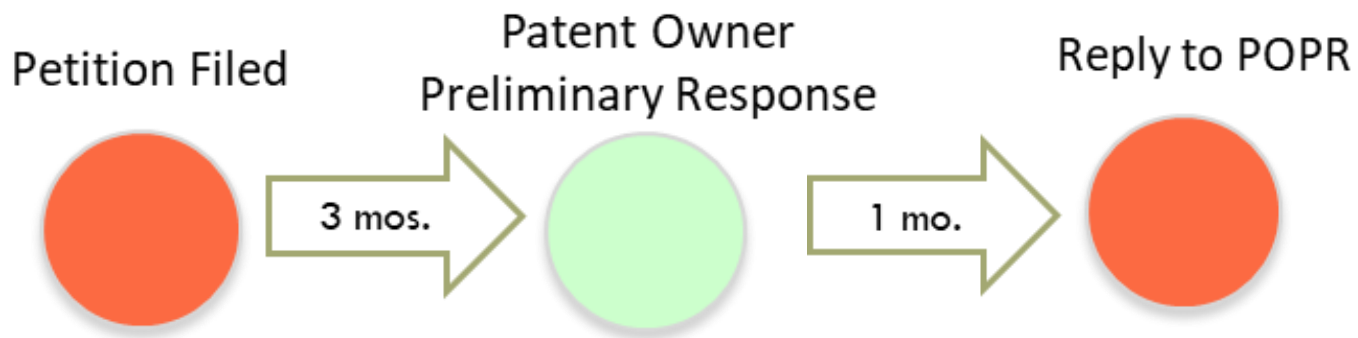




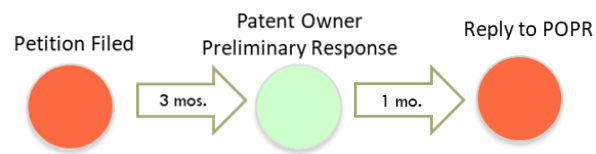
Reply to POPR

Petitioners may seek leave to file a reply to the POPR, which the board may grant upon a showing of good cause. Replies are limited to arguments raised in the POPR. The reply to POPR is limited to 5600 words in length.

A reply is due **one month** after service of the POPR. This period can be, and often is, shortened.



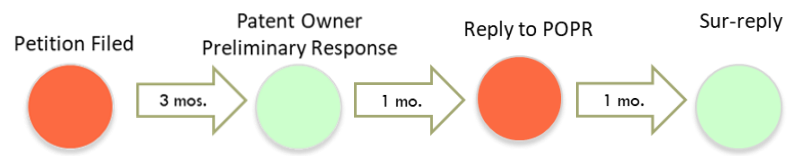
37 C.F.R. §§ 42.23,24, 42.108



Reply to POPR

Replies are limited to 5600 words, which does not include:

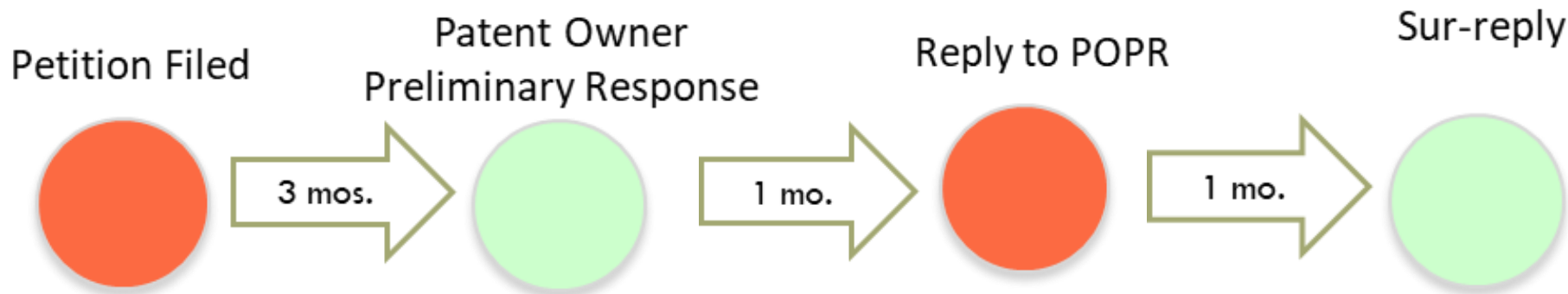
- table of contents
- a table of authorities
- a listing of facts that are admitted, denied, or cannot be admitted or denied
- a certificate of service or word count
- an appendix of exhibits.

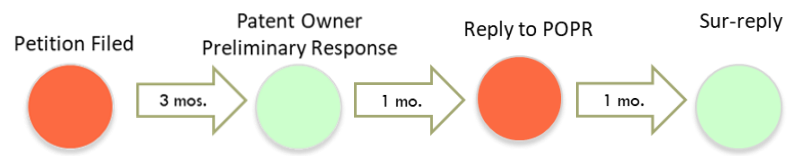


Sur-Reply to POPR

Patent Owners may seek to file a sur-reply to the POPR. Sur-replies may only address arguments raised in the reply to the POPR and may not include any new evidence other than any deposition transcripts of the cross-examination of any reply witness. The sur-reply to POPR is limited to 5600 words in length.

A reply is due **one month** after service of the reply to the POPR. This period can be, and often is, shortened.





Sur-Reply to POPR

Sur-replies are limited to 5600 words, which does not include:

- table of contents
- a table of authorities
- a listing of facts that are admitted, denied, or cannot be admitted or denied
- a certificate of service or word count
- an appendix of exhibits.



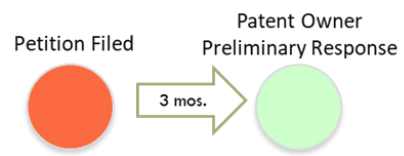
Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- **Decision on Institution**



Agenda

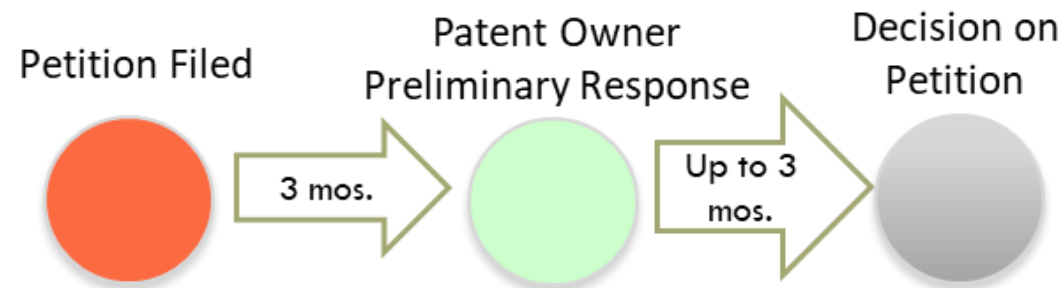
- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
 - Timing
 - Institution Threshold
 - Discretionary Denials
 - Factors Considered

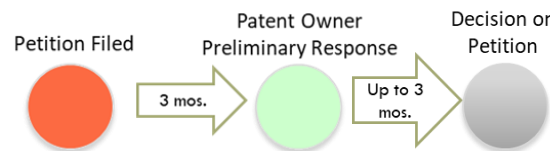


Timing

The PTAB must determine whether to institute a trial **within three months** of the earlier of:

- The patent owner's preliminary response filing
- The preliminary response due date





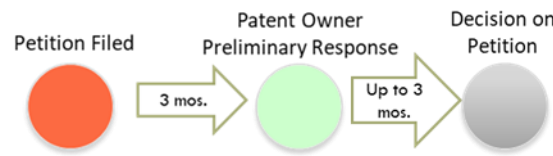
Institution Threshold

Threshold for IPR

The petition and any preliminary response must show that there is a reasonable likelihood that the petitioner would prevail on at least one of the challenged claims (35 U.S.C. § 314(a)).

Threshold for PGR

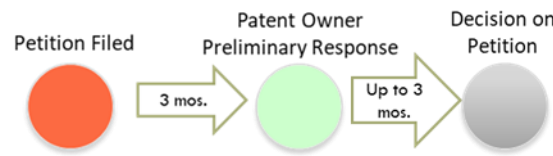
The petition and any preliminary response must show that it is more likely than not (greater than 50%) that at least one of the challenged claims is unpatentable. The petition also may satisfy the “more likely than not” standard if it raises a novel or unsettled legal question that is important to other patents or patent applications (35 U.S.C. § 324(a)).



Institution Threshold – All Claims

Institution Threshold:

- A petitioner “is entitled to a final written decision addressing all of the claims it has challenged.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1358 (2018).
- The Board will also proceed on all grounds of unpatentability for each challenged claim when instituting a trial (37 C.F.R. §§ 42.108(a), 208(a)).



Institution Threshold - SAS

Adjusting Your Strategies in Preparing and Responding to Petitions Before the PTAB after *SAS Inst. Inc. v. Iancu*

Moderated by:
Peter G. Thurlow
Polsinelli PC

Speakers:
Charles R. Macedo
Amster, Rothstein & Ebenstein LLP
Christopher Lisiewski
Amster, Rothstein & Ebenstein LLP

Special Guest:
William M. Fink
Vice Chief Administrative Patent Judge USPTO
Kenneth R. Adamo
Kirkland & Ellis LLP
Brian Murphy
Haug Partners LLP

Agenda

Background

Petitioner's Perspective

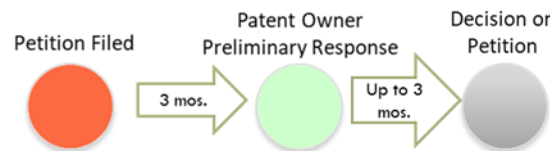
Patent Owner's Perspective

Former PTAB Judge's Perspective

- Background of *SAS Institute Inc. v. Iancu*
- Petitioner's Perspective After SAS
- Patent Owner's Perspective After SAS
- Former PTAB Judge's Perspective After SAS
- PTAB's Perspective After SAS

For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/assnfe/ev.asp?ID=1433>

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Discretionary Denials

Cuozzo Speed Technologies, LLC v. Lee, 136 S. Ct. 2131, 2140 (2016)

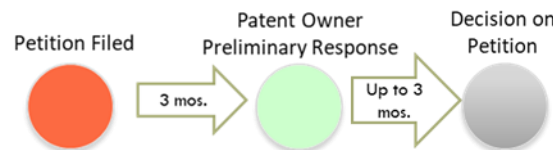
The Patent Office's decision to initiate inter partes review is "preliminary," not "final." *Ibid.* And the agency's decision to deny a petition is a matter committed to the Patent Office's discretion. See § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review); see also *post*, at 2153, and n. 6.

Oil States Energy v. Greene's Energy Group, 138 S. Ct. 1365, 1371 (2018)

The decision whether to institute inter partes review is committed to the Director's discretion. See *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. , , 136 S.Ct. 2131, 2140, 195 L.Ed.2d 423 (2016).

For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/assnfe/ev.asp?ID=1433>

Be sure to follow NYIPLA on LinkedIn to stay up-to-date on the latest webinars!



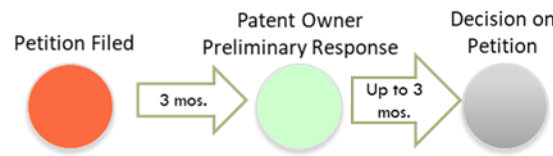
General Plastic Factors

Factors PTAB considers in exercising discretion:

- Whether the same petitioner previously filed a petition directed to the same claims of the same patent.
- Whether, when the petitioner filed the first petition, it knew, or should have known, of the prior art asserted in the second petition.
- Whether, when the petitioner filed the second petition, it already received the patent owner's preliminary response to the first petition or received the PTAB's decision on whether to institute review on the first petition.
- The time period between when the petitioner learned of the prior art asserted in the second petition and the filing of the second petition.
- Whether the petitioner provides an adequate explanation for the delay between the filing of multiple petitions directed to the same claims of the same patent.
- The PTAB's resources.
- The requirement for the PTAB to issue a final determination not later than one year after the date of institution.

General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha, 2017 WL 3917706 (PTAB Sept. 6, 2017) (precedential) and Consolidated Trial Practice Guide (November 2019)



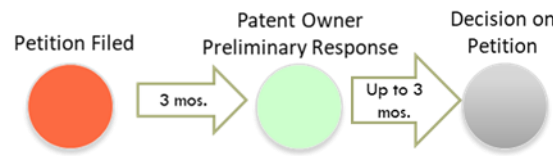


Beckton Dickinson Factors

When presented with prior art which is similar to prior art previously cited, the PTAB considers:

- The similarities and material differences between the asserted art and the prior art previously evaluated.
- The cumulative nature of the asserted art and the prior art previously evaluated.
- The extent to which the asserted art was previously evaluated.
- The extent of the overlap between the previous arguments and the manner in which the petitioner relies on or the patent owner distinguishes the prior art.
- Whether the petitioner sufficiently explained how the USPTO erred in evaluating the prior art.
- The extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson and Co. v. B. Braun Melsungen AG, 2017 WL 6405100 (PTAB Dec. 15, 2017)(precedential) and Consolidated Trial Practice Guide (November 2019)

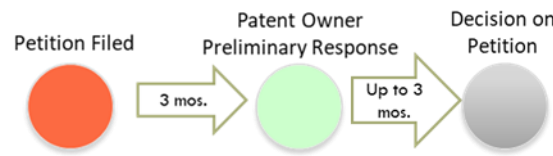


Fintiv Factors

For Proceedings in parallel with District Court litigation, the PTAB considers:

- Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.
- Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.
 - The PTAB considers the speed with which the district court case may come to trial and be resolved. If median time-to-trial is around the same time or after the projected statutory deadline for the PTAB’s final written decision, the PTAB weights this factor against denying institution under *Fintiv*.
- Investment in the parallel proceeding by the court and the parties.
- Overlap between issues raised in the petition and in the parallel proceeding.
- Whether the petitioner and the defendant in the parallel proceeding are the same party.
- Other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential as of May 5, 2020)
USPTO Press Release 22-14 (June 22, 2022)

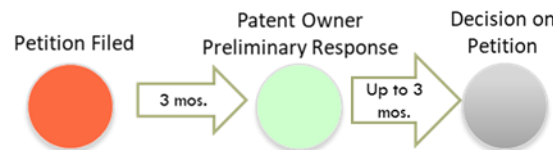


Fintiv Factors – Clarified by USPTO

Fintiv is limited to the facts of that case. Therefore, the PTAB will not deny institution of an IPR or PGR under *Fintiv* when

- i. The "petition presents compelling evidence of unpatentability"
- ii. The "request for denial under *Fintiv* is based on a parallel ITC proceeding"
- iii. A "petitioner stipulates not to pursue in a parallel district court proceeding" the grounds in the petition or that could have reasonably been raised in the petition (see *Sotera Wireless, Inc v. Masimo Corp.*, IPR2022-01019, Paper 12 (PTAB Dec. 1, 2020))

USPTO Press Release 22-14 (June 22, 2022) (citing Director K.K. Vidal, Memorandum on Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022))



Update on Latest PTAB Rules

The 2022 clarification by the USPTO is interim guidance until further notice. The USPTO expects to replace the interim guidance after formal rulemaking.

For more information, visit the NYIPLA site for a copy of the presentation:

<https://www.nyipla.org/assnfe/ev.asp?ID=1433>

To observe the PTAB's Boardside Chat (July 7, 2022), see <https://www.uspto.gov/about-us/events/learn-about-discretionary-denials-aia-post-grant-proceedings-parallel-litigation>

For the USPTO's study of *Fintiv* statistics, visit

https://www.uspto.gov/sites/default/files/documents/ptab_parallel_litigation_study_20220621_.pdf

Director K.K. Vidal, Memorandum on Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)



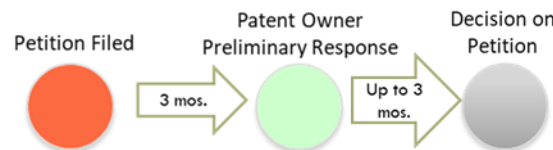
Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution

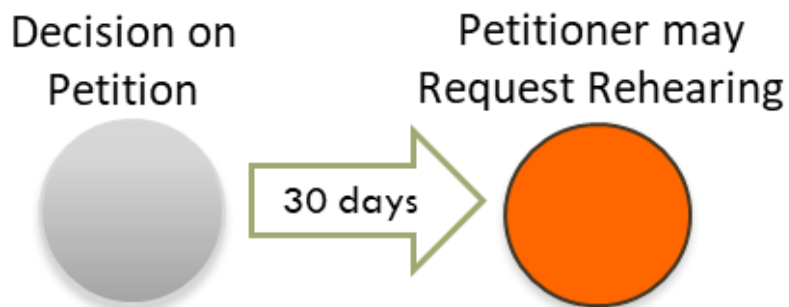


Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
 - Decision Not to Institute Trial



T+30 Days – Rehearing Request



For decisions not to institute trial, the petitioner may file a rehearing request, without the PTAB’s prior authorization, **within 30 days** of the PTAB’s entry of its decision (37 C.F.R. § 42.71(d)(2))

The rehearing request must specifically identify:

- All matters the PTAB misapprehended or overlooked.
- Where each matter was previously addressed in a motion, opposition, or reply.

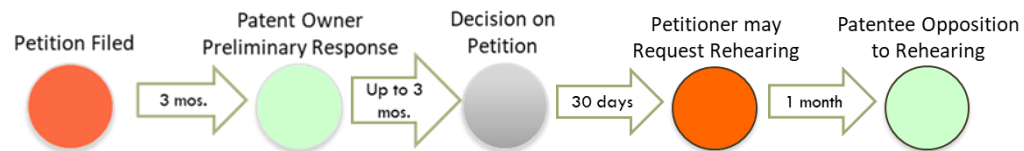
(See 37 C.F.R. § 42.71(d) and *MicroStrategy, Inc. v. Zillow, Inc.*, 2013 WL 6327763 (PTAB Apr. 22, 2013))



T + 2 months – Patent Owner Opp.

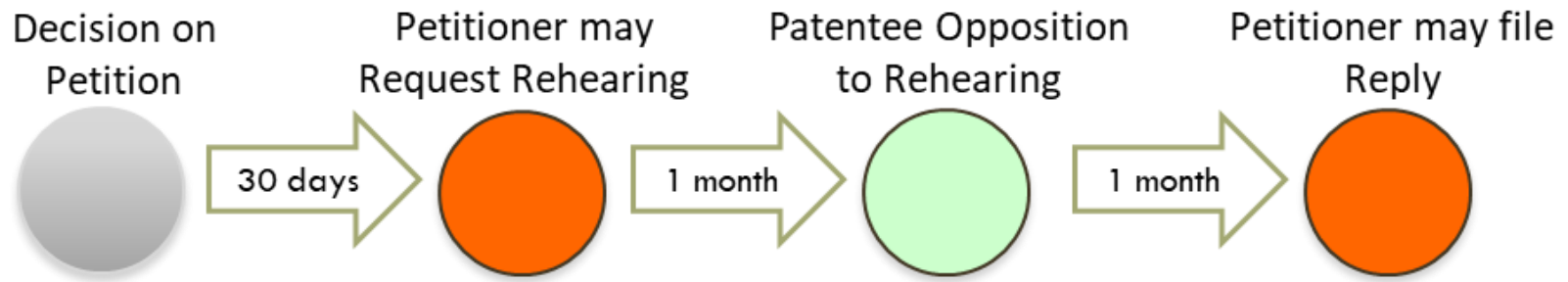
A patent owner's opposition to a rehearing request is due **one month after service** of the rehearing request (37 C.F.R. § 42.25). This requires PTAB authorization, and the PTAB may decline to consider any unauthorized requests.





T + 3 months – Pet. Reply Brief

A petitioner’s reply brief is due **one month after service** of the opposition (37 C.F.R. § 42.25). Again, this requires PTAB authorization, and the PTAB may decline to consider any unauthorized requests.



Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
 - Decision Not to Institute Trial
 - Decision to Institute Trial



T + 15 days – Rehearing Request



Unlike for a decision not to institute a trial, for a decision to institute a trial, a party must file any rehearing request within **14 days** of the PTAB’s entry of the decision (37 C.F.R. § 42.71(d)(1)).

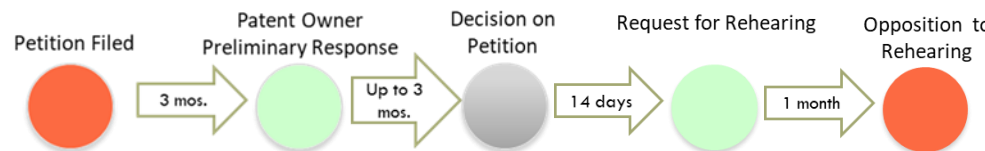
The rehearing request must specifically identify all matters the PTAB misapprehended or overlooked and where the matter was previously addressed in the record (37 C.F.R. § 42.71(d) and Trial Practice Guide, 77 Fed. Reg. at 48768).



T+1.5 Months: Petitioner Opp.

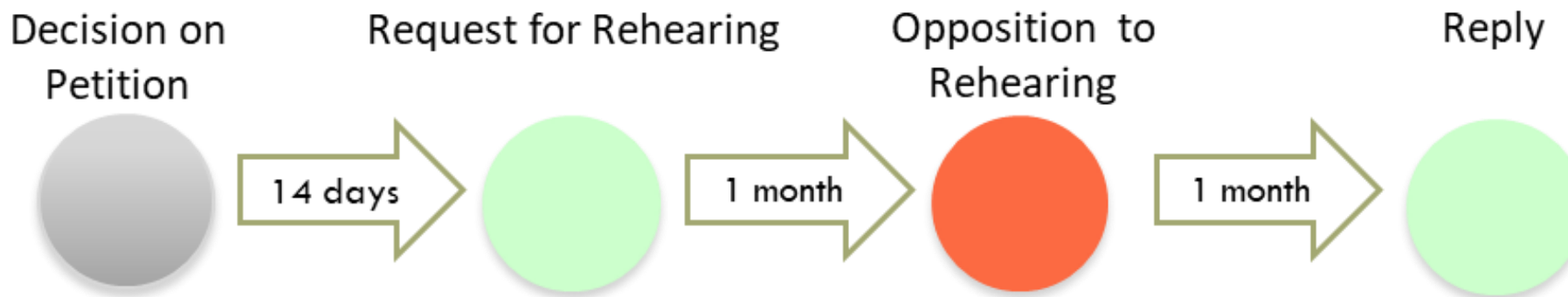
As with other oppositions, authorization is required. If authorization is received, opposition by petitioner is due **one month** after service of the rehearing request (37 C.F.R. § 42.25).

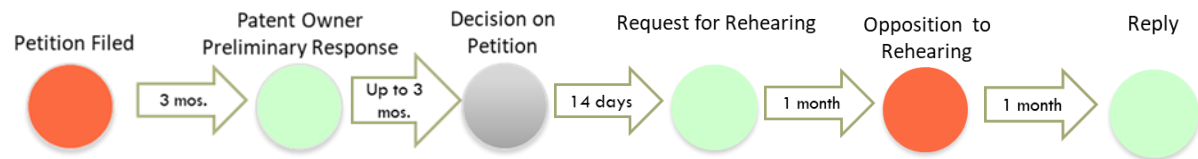




T+2.5 Months: Patent Owner Reply

As with other reply, authorization is required. If authorization is received, reply by patent owner is due within **one month** after service of petitioner's opposition (37 C.F.R. § 42.25).

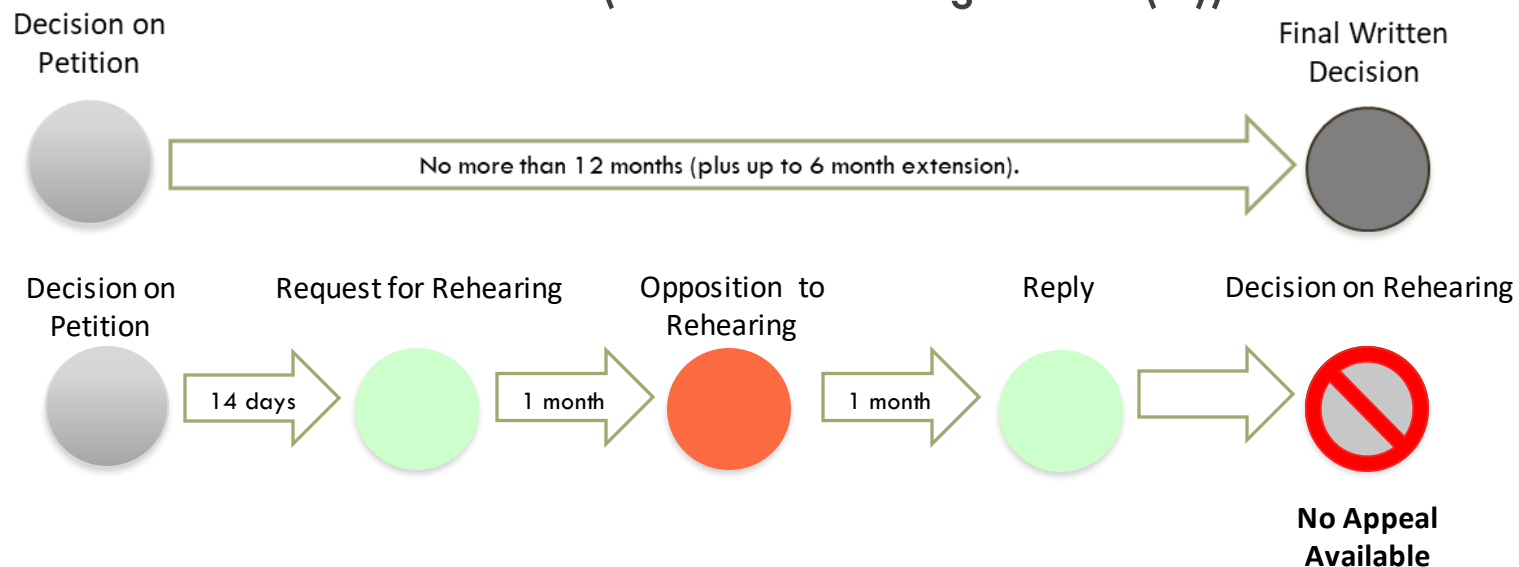


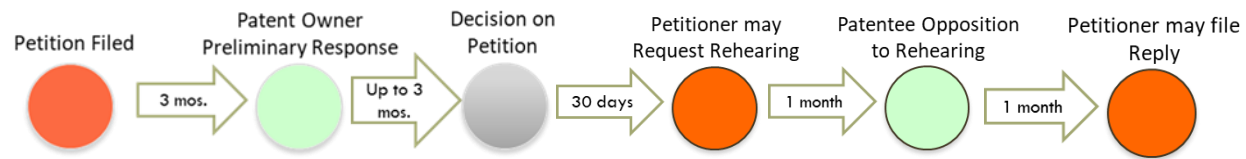


T > 2.5 months: Decision on Rehearing

The PTAB determines whether to grant rehearing any time after the parties have either exhausted or been denied their requested rehearing filings.

The trial will continue in parallel with the request for rehearing, and the request for rehearing does not toll the decision (see 37 C.F.R. § 42.71(d)).

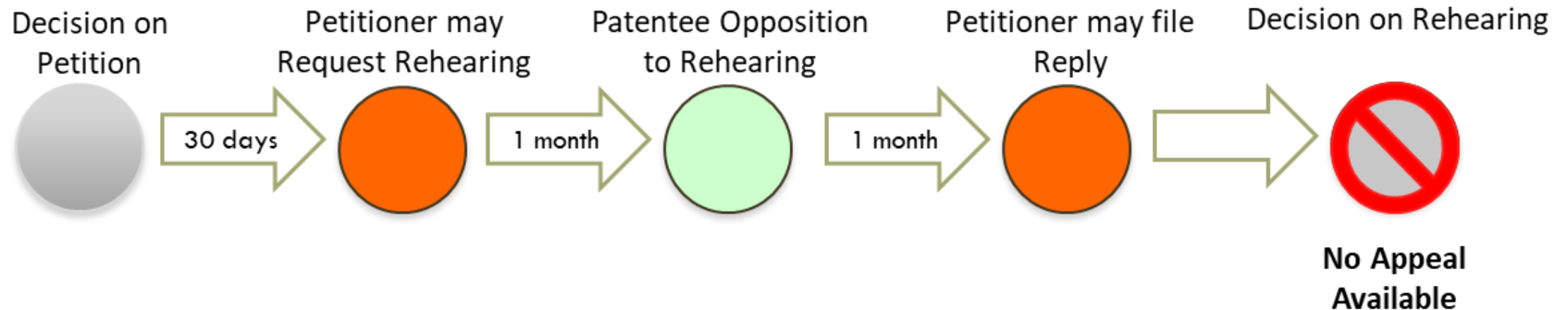


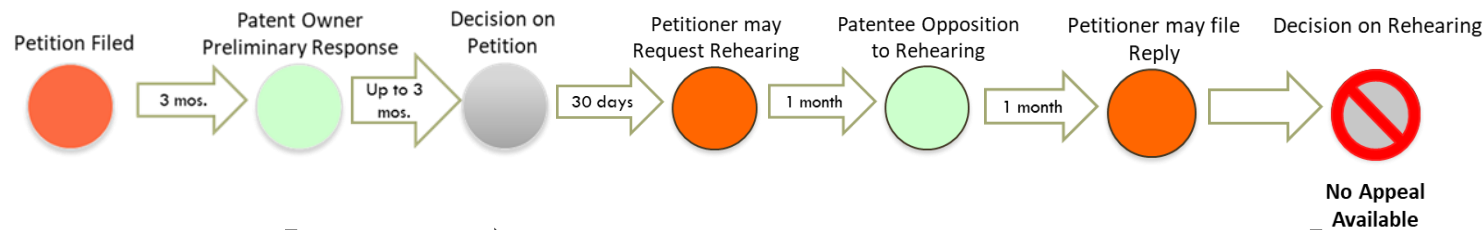


Effect of *Cuozzo* and *Thryv* (2020)

Cuozzo held that “§ 314(d) bars review at least of matters closely tied to the application and interpretation of statutes related to the institution decision.” *Thryv, Inc. v. Click-to-Call Technologies, Inc.*, 140 S. Ct. 1367, 1368 (2020) (citing *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. 261, 274-75 (2016) (slip op., at 11)) (internal quotes omitted).

Thryv held that this includes rejections of arguments based on the 315(b) time limitation.

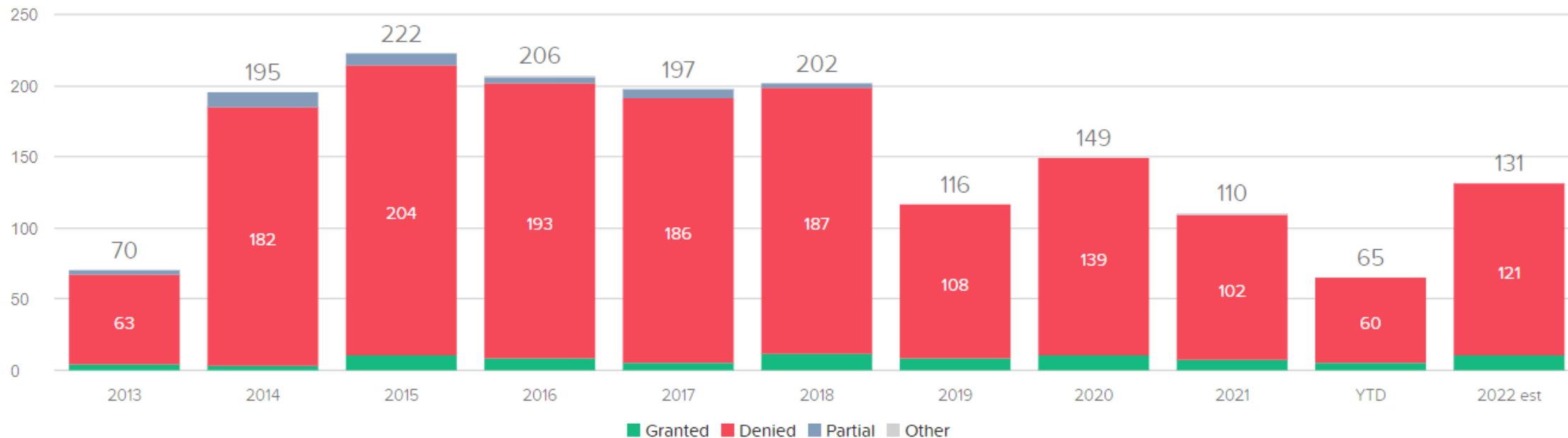




Docket Navigator— Rehearing Success Rate

Motion Success by Year

Data provided by Docket Navigator



For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/asnfe/ev.asp?ID=1433>

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Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing

Agenda

- Proceedings Leading to the Hearing
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB

T-0 Months: Scheduling Order

Decision on
Petition





Scheduling Order

DUE DATE 1: Patent owner response to the petition and authorized motion to amend (three month default time).

DUE DATE 2: Petitioner reply to the patent owner's response and opposition to patent owner's motion to amend (three month default time).

DUE DATE 3: Patent owner sur-reply to reply and reply to the petitioner's opposition (one month default time).

DUE DATE 4: Petitioner sur-reply to reply to opposition to motion to amend and parties' motion to exclude evidence (one month default time).

DUE DATE 5: Opposition to motion to exclude and request for prehearing conference (one week default time).

DUE DATE 6: Reply to opposition to motion to exclude (one week default time).

DUE DATE 7: Oral argument (one week default time).

The parties may:

Stipulate different dates for DUE DATES 1-5, but no later than DUE DATE 6.

Not stipulate to an extension of DUE DATES 6-7 or to the requests for oral hearing.

Agenda

- Proceedings Leading to the Hearing
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner





Discovery by P.O.

Decision on
Petition



Discovery by PO

Discovery includes:

- The information the parties exchange through agreed-upon initial disclosures and mandatory notices
- Routine discovery
 - Scheduling order will specify timeline
- Additional discovery
 - Parties must either agree (rare) or patent owner must file a motion.



3 mos.

Discovery by PO

Depositions (Cross-Examination) and Uncompelled Testimony

Parties may depose declarants that submit affidavit testimony.

- A party seeking a deposition must file a notice at **least ten business days** before the deposition.
- Cross-examination should take place after any supplemental evidence is due and should conclude **more than one week before** the filing date for any paper in which the parties expect to cite the cross-examination testimony
- Testimony, such as a deposition transcript, must be filed as an exhibit, but either party may file the testimony





Discovery by PO

Objections to Evidence

Objections to deposition evidence must be made during the deposition.

Objections to evidence other than deposition must be filed **within five business days** of service of the evidence, except that objections to evidence submitted before institution should be made **within ten business days** of institution of the trial.

Parties may file supplemental evidence in response to objection **within ten business days** of service of the objection.



Agenda

- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response





Discovery by PO

T+3 Months: Patent Owner Response

Decision on
Petition

PO Response & Motion to
Amend Claims



Discovery by PO

Patent Owner may file, **within 3 months** of institution, a response to the challenger to substantively challenge the claims.

35 U.S.C. §§ 316(a)(8) and 326(a)(8);
37 C.F.R. §§ 42.120 and 42.220



Discovery by PO

T+3 Months: Patent Owner Response

Responses are limited to:

- 14,000 words for IPRs.
- 18,700 words for PGRs.

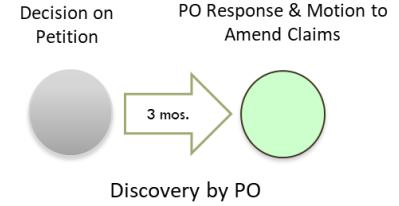
Word count limits do not include:

- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listings

The response may contain exhibits or claim listings attached as appendices.

37 C.F.R. §42.24(b)





T+3 Months: Patent Owner Response

Examples of Patent Owner Exhibits

Ex2001 Declaration of PO Expert

Ex2002 CV of PO Expert

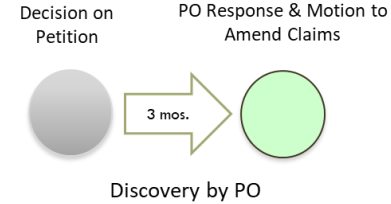
Ex2003 Deposition of Petitioner's Expert

Ex2004 Document Relied on by PO

Agenda

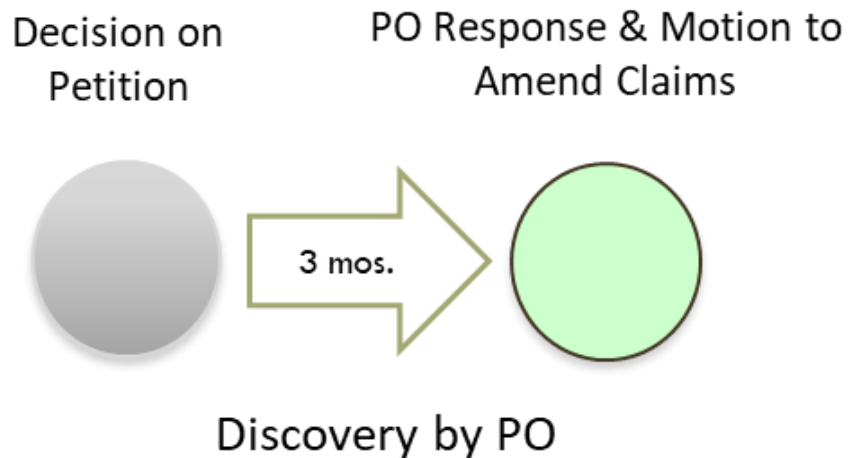
- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: **Motion to Amend Claims**





Motion to Amend Claims (optional)

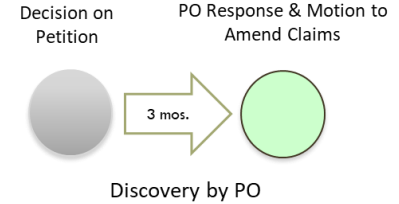
A patent owner may file a motion to amend instituted claims, which is typically due **three months** after a trial is instituted along with the patent owner's response to the petition (37 C.F.R. §§ 42.121(a) and 42.221(a)).



A motion to amend:

- May not enlarge claim scope or add new matter.
- Must clearly identify the support for the amended claims in the original patent disclosure.

(See 35 U.S.C. §§ 316(d)(3) and 326(d)(3))



Motion to Amend Claims (optional)

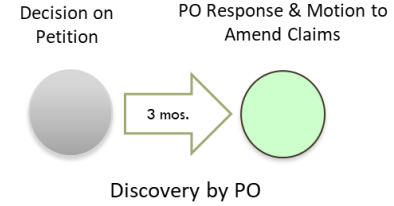
Motions to Amend are limited to:

- 25 pages

Page limits do not include:

- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listings

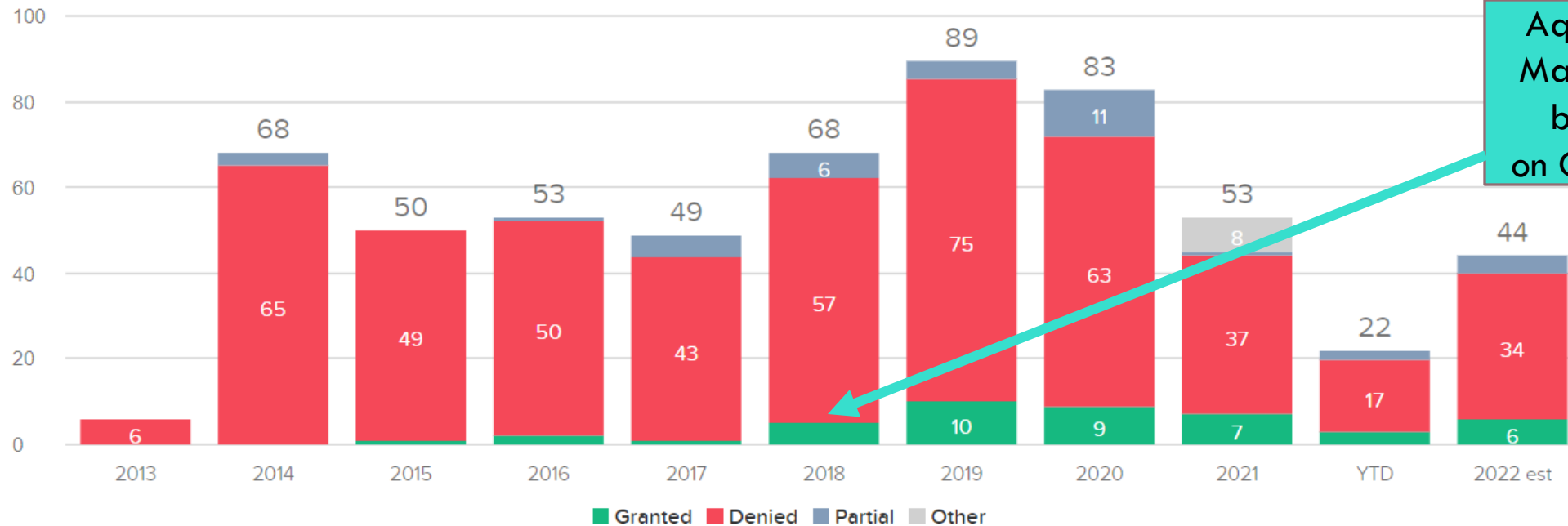
Patent Owners may also choose an option under the pilot program (discussed later) (84 Fed. Reg. 9497 (Mar. 15, 2019))



Aqua Products & Motions to Amend

Motion Success by Year

Data provided by  Docket Navigator



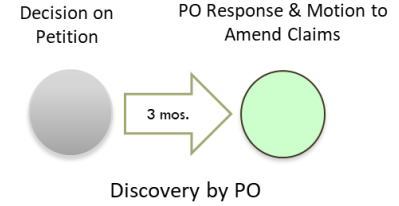
Aqua Prods. V. Matal (Decided by Fed. Cir. on Oct. 4, 2017)

For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/asnfe/ev.asp?ID=1433>

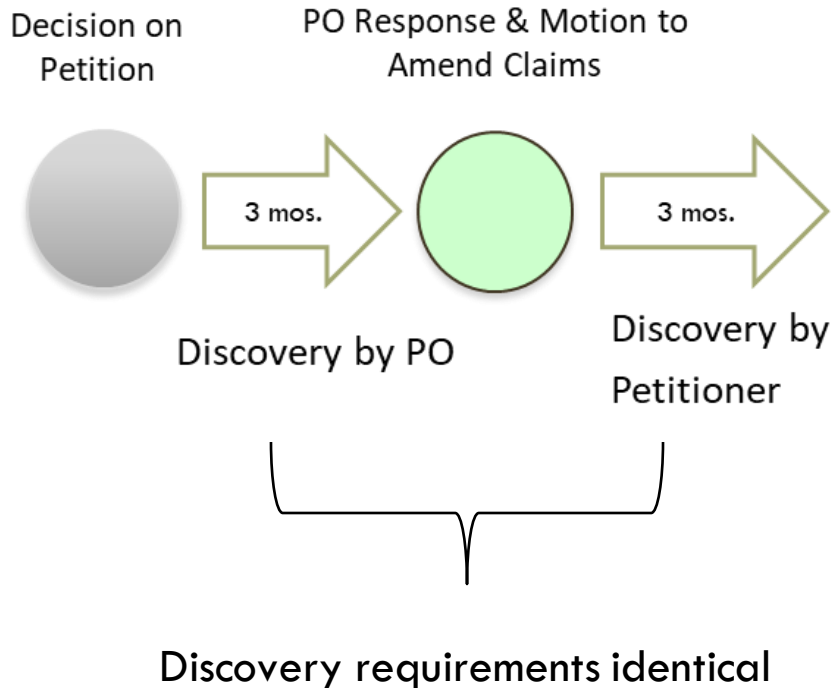
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Agenda

- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner

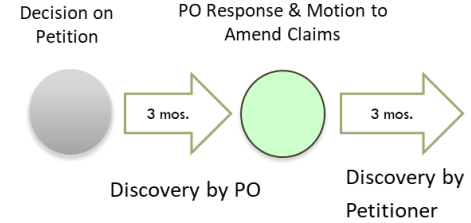


Petitioner Discovery



Discovery includes:

- The information the parties exchange through agreed-upon initial disclosures and mandatory notices
- Routine discovery
 - Scheduling order will specify timeline
- Additional discovery
 - Parties must either agree (rare) or patent owner must file a motion.

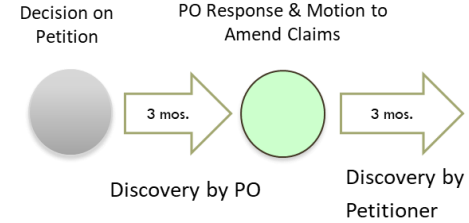


Depositions (Cross-Examination) and Uncompelled Testimony

Parties may depose declarants that submit affidavit testimony.

- A party seeking a deposition **must file a notice at least ten business days before** the deposition.
- Cross-examination should take place **after any supplemental evidence is due** and should **conclude more than one week before the filing date for any paper** in which the parties expect to cite the cross-examination testimony
- Testimony, such as a deposition transcript, must be filed as an exhibit, but either party may file the testimony





Objections to Evidence

Objections to deposition evidence must be made during the deposition.

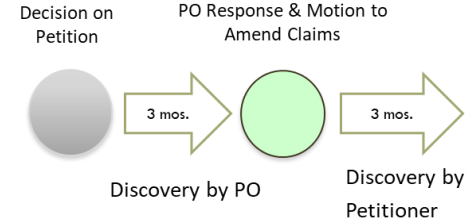
Objections to evidence other than deposition must be filed **within five business days** of service of the evidence, except that objections to evidence submitted before institution should be made **within ten business days** of institution of the trial.

Parties may file supplemental evidence in response to objection **within ten business days** of service of the objection.

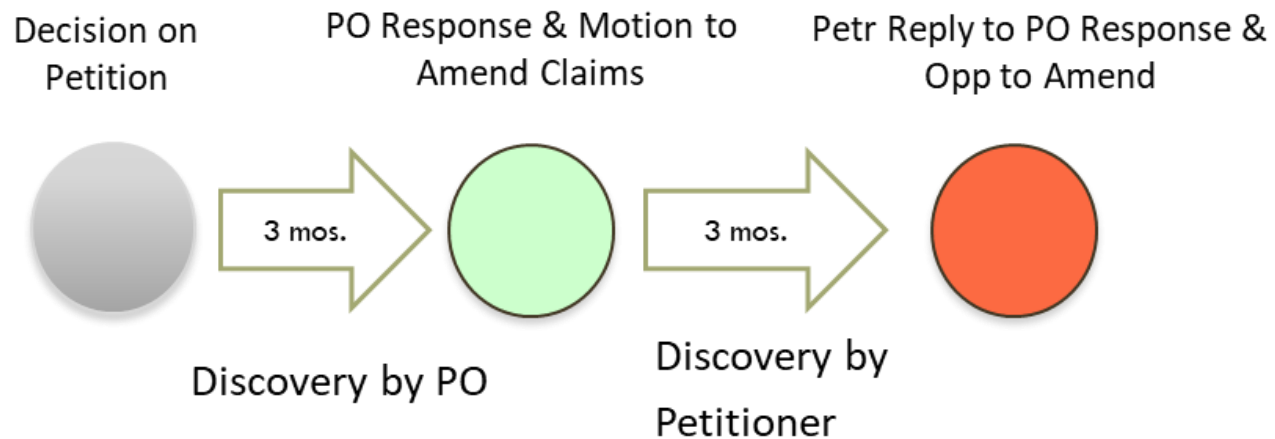
Agenda

- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition



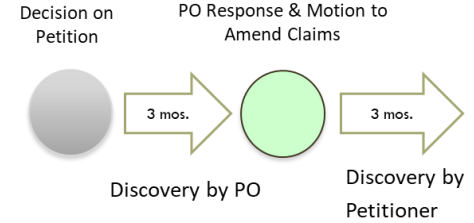


Pet. Reply to P.O. Response

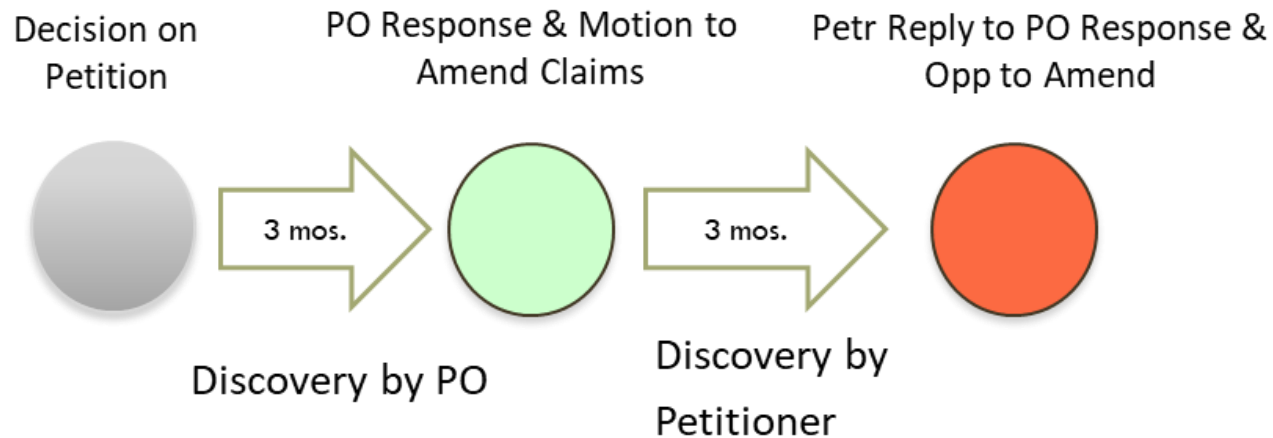


The scheduling order may provide up to **three months** for the petitioner to reply to any patent owner response.

Trial Practice Guide, 77 Fed. Reg. at 48757 and 37 C.F.R. §§ 42.120, 42.220



Pet. Reply to P.O. Response



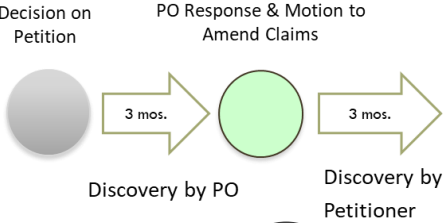
The scheduling order may provide up to **three months** for the petitioner to reply to any patent owner response.

Replies to the response are limited to **5600 words**. Sur-replies are likewise limited.

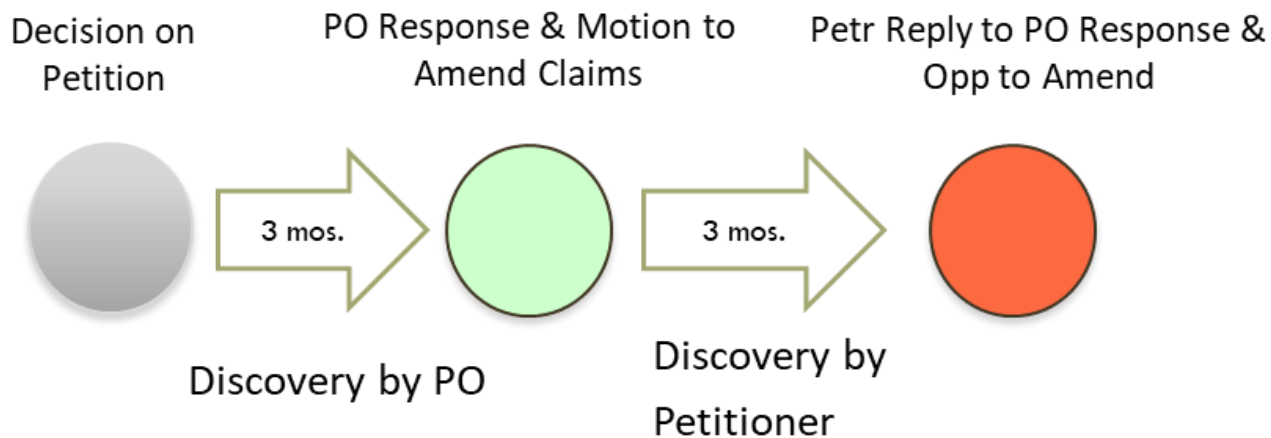
Trial Practice Guide, 77 Fed. Reg. at 48757, and 37 C.F.R. §§ 42.24(c)(3), 42.120, 42.220

Agenda

- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition
 - T+6 Months: Petitioner's Reply to M.A.

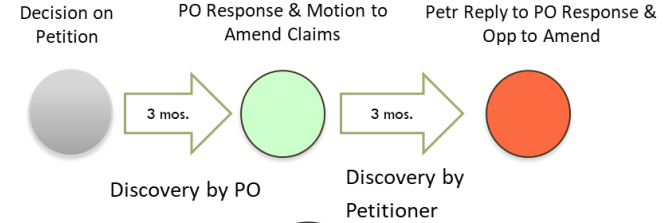


Opp. To Motion to Amend



A petitioner may file an opposition to a motion to amend without the PTAB's authorization. The opposition may respond to new patentability issues arising from the patent owner's proposed substitute claims (35 U.S.C. §§ 316(a) and 326(a); and Trial Practice Guide, 77 Fed. Reg. at 48767).

The Burden of proof is on the petitioner (*Aqua Products v. Matal*, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017, O'Malley, K.)).



Opp. To Motion to Amend

Motions are limited to:

- 25 pages

Page limits do not include:

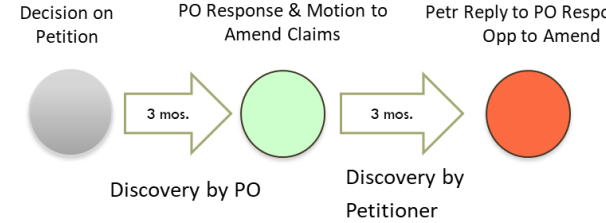
- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listing

Consider asking the board for a waiver of the 25 pages of the opposition-brief.

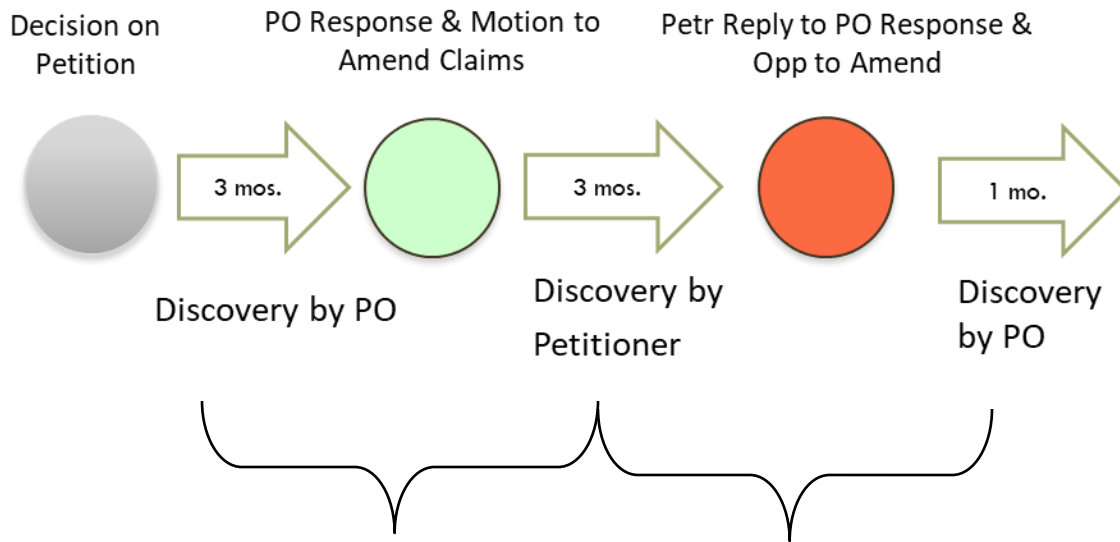
Agenda



- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition
 - T+6 Months: Petitioner's Reply to M.A.
 - T+6 to T+7 Months: P.O. 2nd Discovery Period



Second Patent Owner Discovery



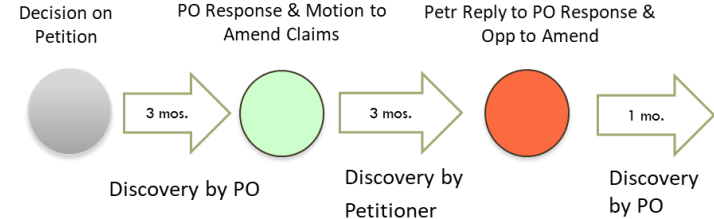
After the petitioner has filed any reply to the patent owner's response and any opposition to the patent owner's motion to amend, the patent owner typically has **one month** to conduct any further discovery relating to the petitioner's opposition, including deposing the petitioner's declarants.

Trial Practice Guide, 77 Fed. Reg. at 48757-48758 and *Respironics, Inc., v. Zoll Med. Corp.*, IPR2013-00322, Paper 26, at 3 (PTAB May 7, 2014)).

Agenda



- **Proceedings Leading to the Hearing**
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 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition
 - T+6 Months: Petitioner's Reply to M.A.
 - T+6 to T+7 Months: P.O. 2nd Discovery Period
 - T+6 to T+7 Months: **MTA Pilot Program**



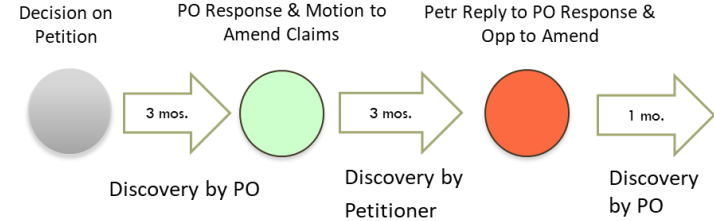
Motion to Amend Pilot Program

Under a pilot program effective March 15, 2019, renewed through September 16, 2022, the patent owner may choose to:

1. Receive non-binding preliminary guidance from the PTAB on its motion to amend. The PTAB will provide the preliminary guidance no later than **four weeks** after the filing of an opposition to the motion (or the due date for the petitioner's opposition if none is filed), including an initial discussion of whether:

- the motion to amend meets statutory and regulatory requirements with reasonable likelihood; and
- the petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable.

84 Fed. Reg. 9497 (Mar. 15, 2019)
86 Fed. Reg. 51,656 (Sep. 16, 2021)



Motion to Amend Pilot Program

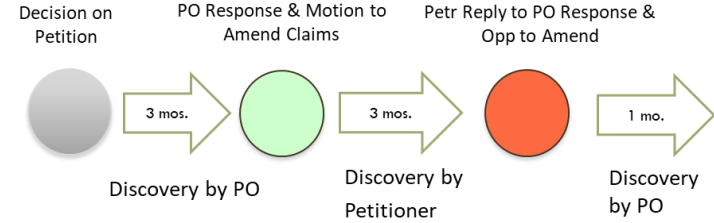
Under a pilot program effective March 15, 2019, renewed through September 16, 2022, the patent owner may choose to:

[...]

2. File a revised motion to amend after receiving:

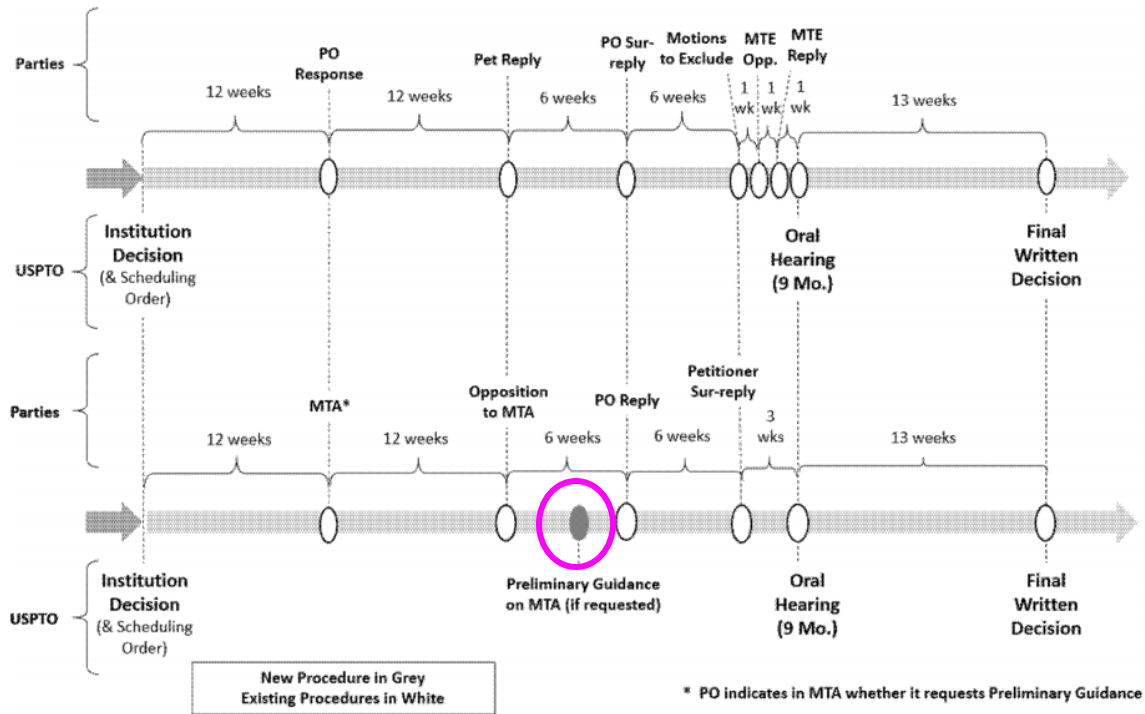
- the petitioner's opposition to the original motion to amend; and/or
- the PTAB's preliminary guidance, if requested.

84 Fed. Reg. 9497 (Mar. 15, 2019)

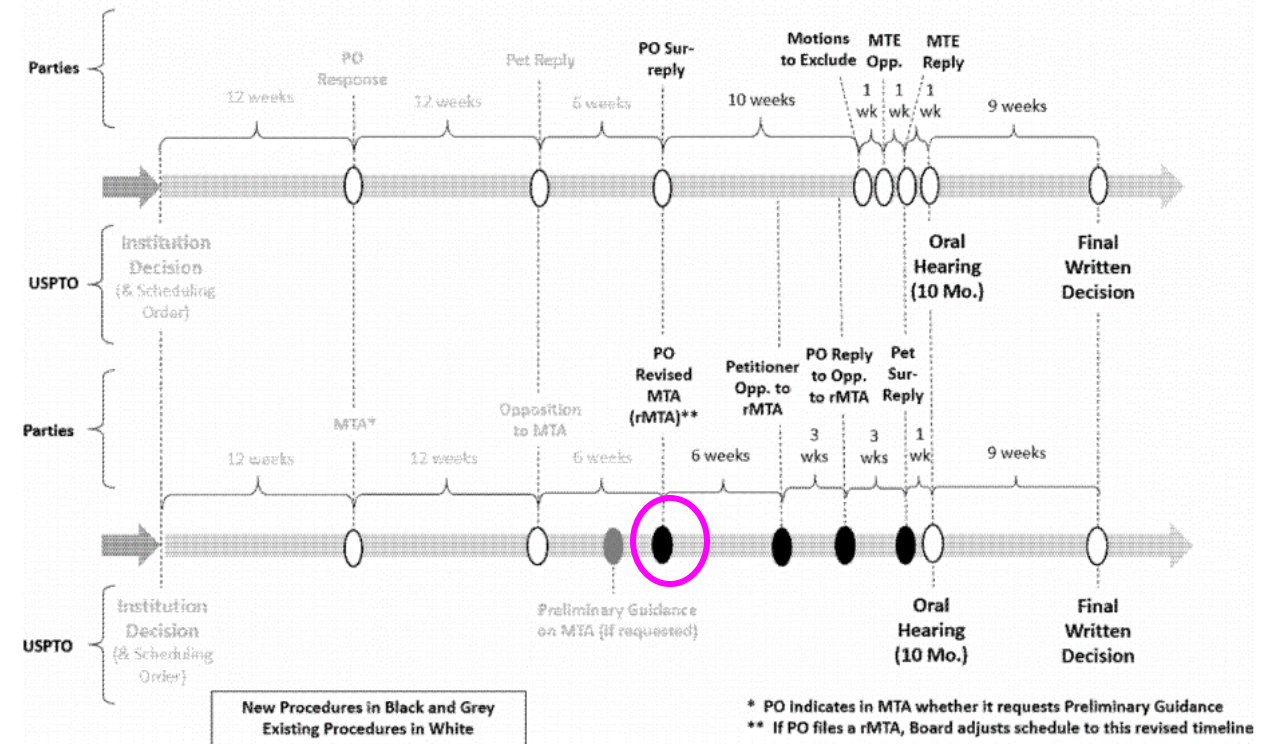


Motion to Amend Pilot Program

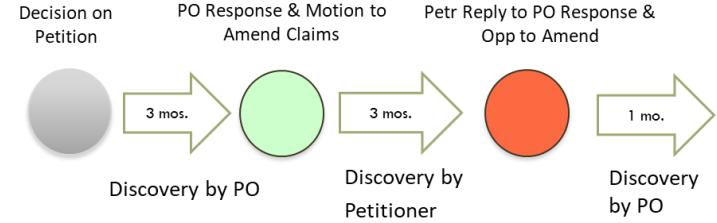
Preliminary Guidance Requested



Revised Motion Filed

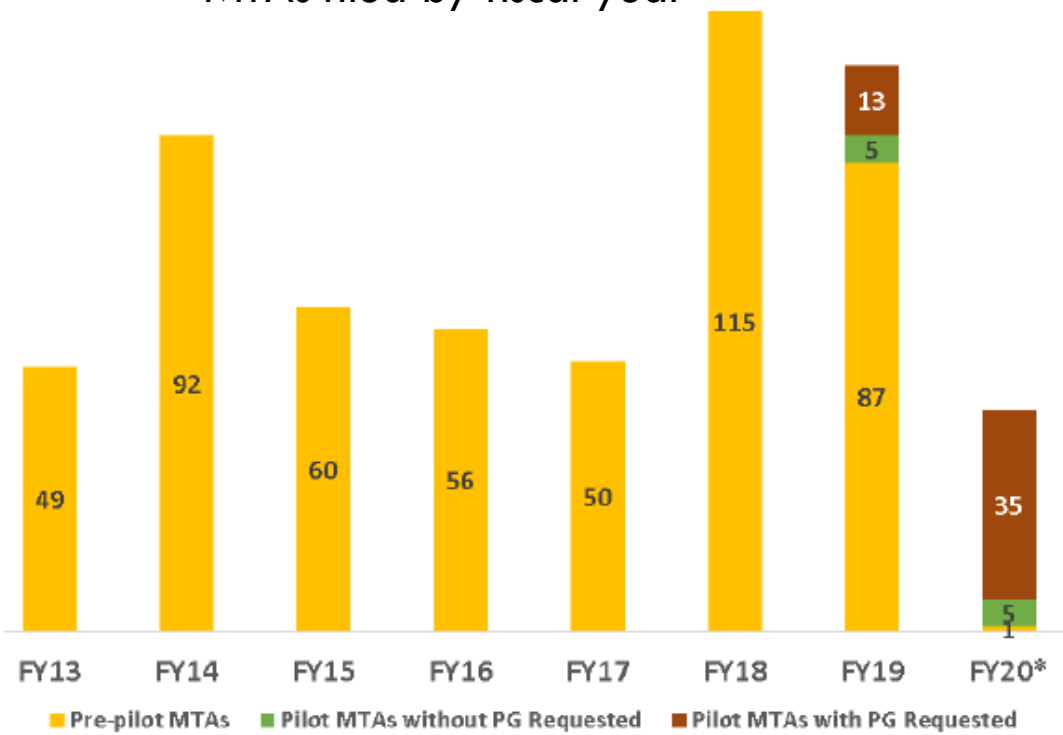


84 Fed. Reg. 9497 (Mar. 15, 2019)



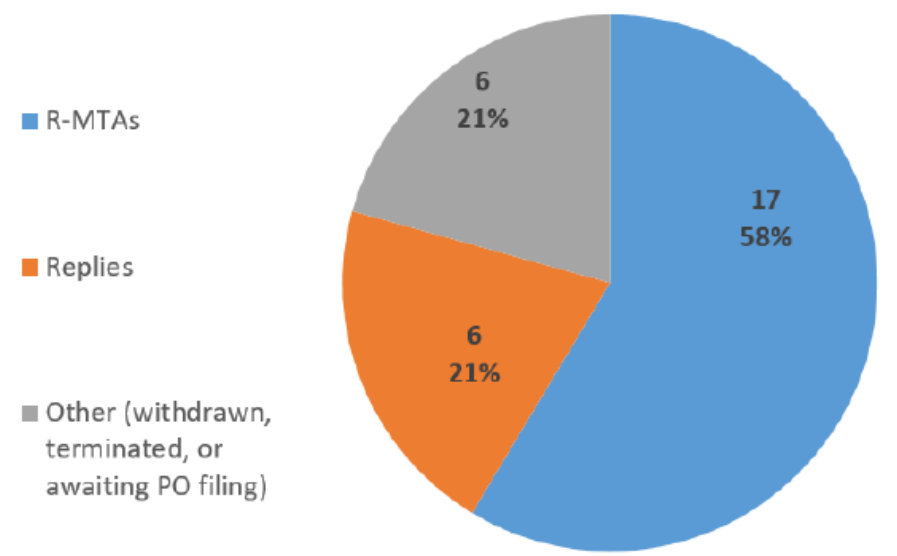
Motion to Amend Pilot Program

MTAs filed by fiscal year



* The one pre-pilot MTA filed in FY20 is a corrected MTA of an MTA originally filed in FY19. FY20 data is through March 31, 2020.

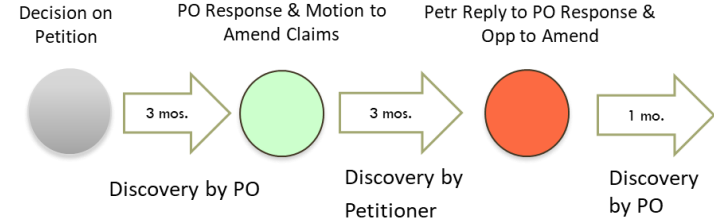
PO filings after preliminary guidance



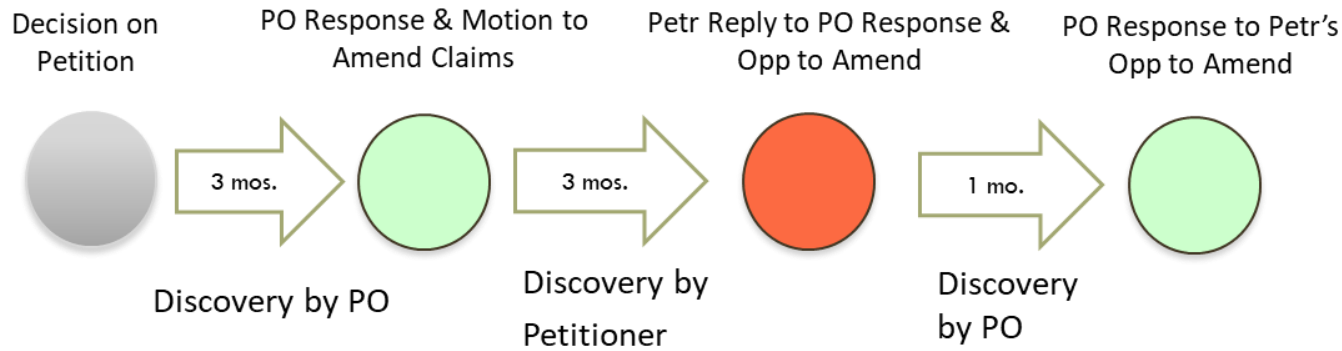
Agenda



- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition
 - T+6 Months: Petitioner's Reply to M.A.
 - T+6 to T+7 Months: P.O. 2nd Discovery Period
 - T+6 to T+7 Months: M.A. Pilot Program
 - T+7 Months: P.O. reply to Opp. on M.A. and Sur-Reply

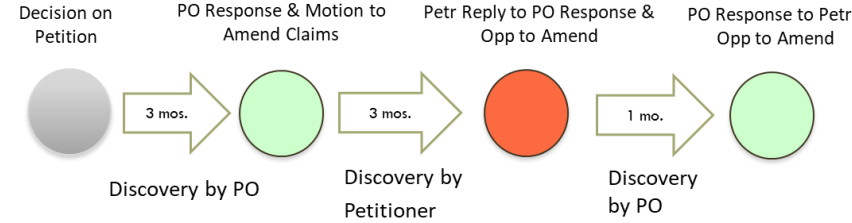


Patent Owner Reply to Opposition to Motion to Amend



There is a **1-month** limit to file any reply to the petitioner's opposition to a motion to amend. 37 C.F.R. §§ 42.23(b) and 42.25(a)(2)).

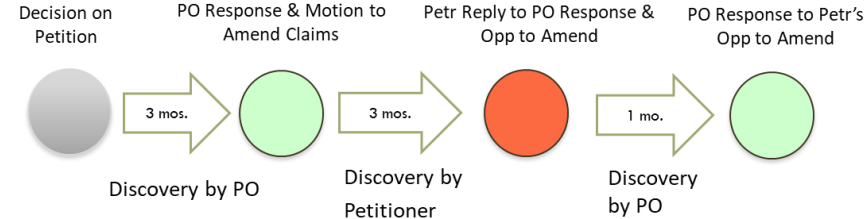
As in all reply briefs, arguments should address each point of the petitioner.



Sur-Reply to Motion to Amend

Replies to oppositions to motions to amend are limited to 12 pages (37 C.F.R. § 42.24(c)(3)).

Sur-replies, if authorized and unless the PTAB orders otherwise, are limited to 12 pages (Consolidated Trial Practice Guide (November 2019)).



T+7 Months: Sur-Reply

Sur-replies responding to:

- Motions are not generally permitted, but may be authorized on a case-by-case basis.
- Principle briefs are normally authorized by the scheduling order.

The sur-reply:

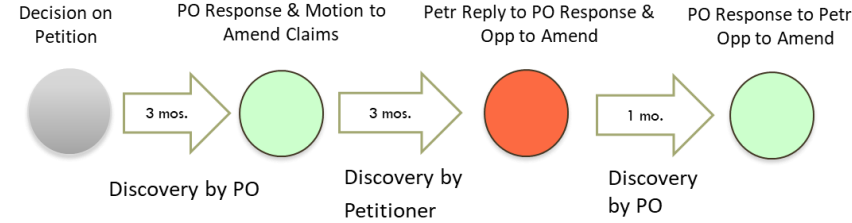
- May not be accompanied by new evidence other than deposition transcripts of any reply witness' cross-examination.
- Should only:
 - respond to arguments made in reply briefs;
 - comment on reply declaration testimony; or
 - point to cross-examination testimony.
- May address the institution decision if necessary to respond to the petitioner's reply.

Agenda

- **Proceedings Leading to the Hearing**
 - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
 - T+0 to T+3 Months: Discovery by Patent Owner
 - T+3 Months: Patent Owner Response
 - T+3 Months: Motion to Amend Claims
 - T+3 to T+6 Months: Discovery by Petitioner
 - T+6 Months: Petitioner's Reply to P.O. Opposition
 - T+6 Months: Petitioner's Reply to M.A.
 - T+6 to T+7 Months: P.O. 2nd Discovery Period
 - T+6 to T+7 Months: M.A. Pilot Program
 - T+7 Months: P.O. reply to Opp. on M.A. and Sur-Reply
- **Pre-hearing proceedings**

Agenda

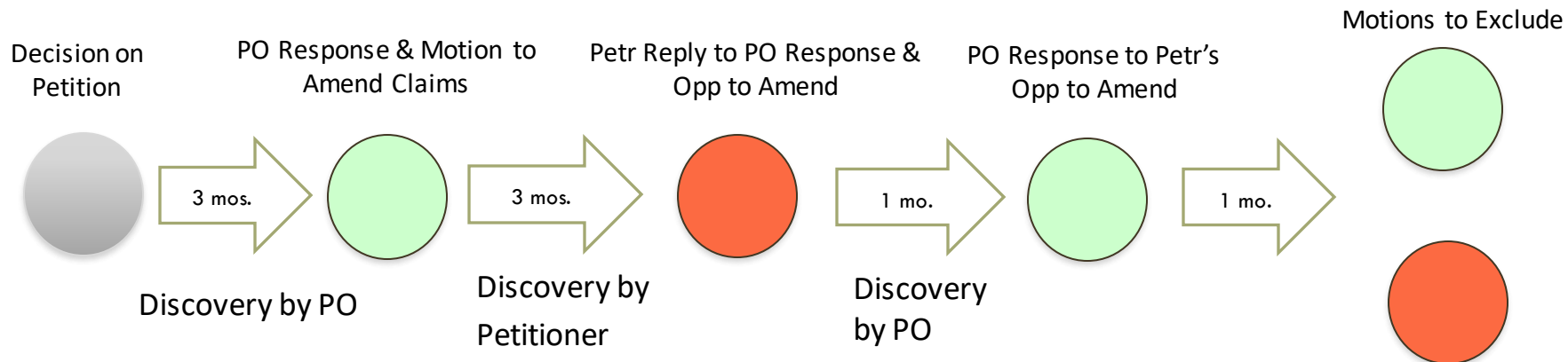
- Proceedings Leading to the Hearing
 - Pre-hearing proceedings
 - Objections to Evidence and Motions to Exclude

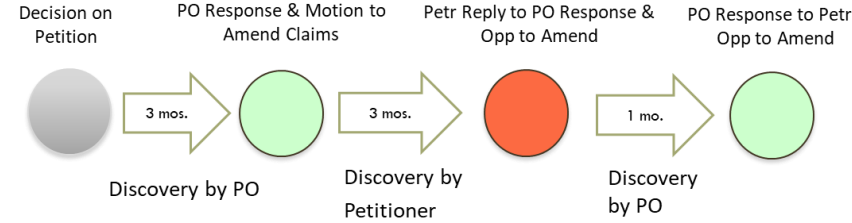


Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after PO reply in support of motion to amend.

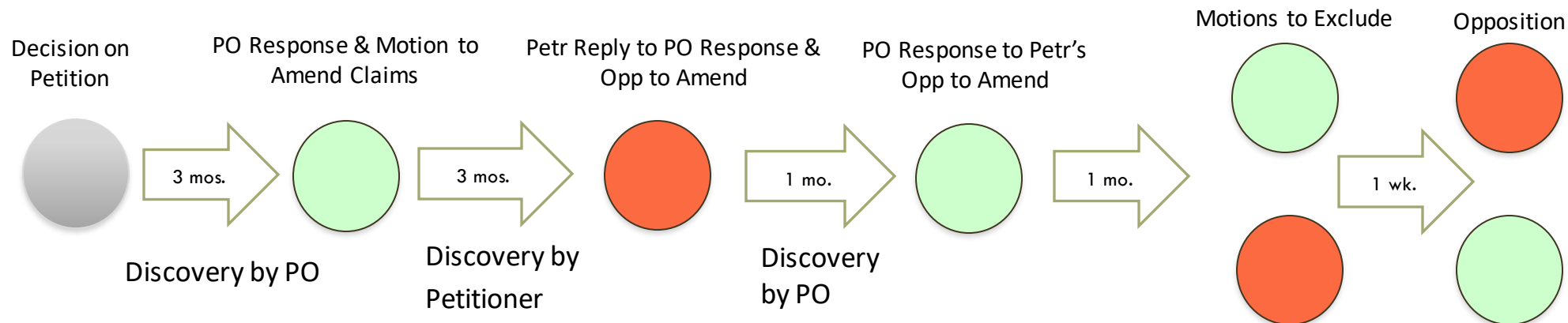


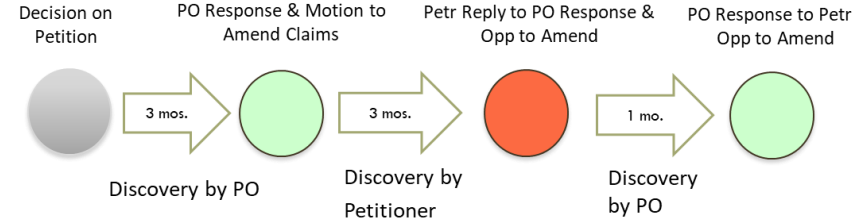


Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after P.O. reply in support of motion to amend.
- Any opposition is typically due one week later.

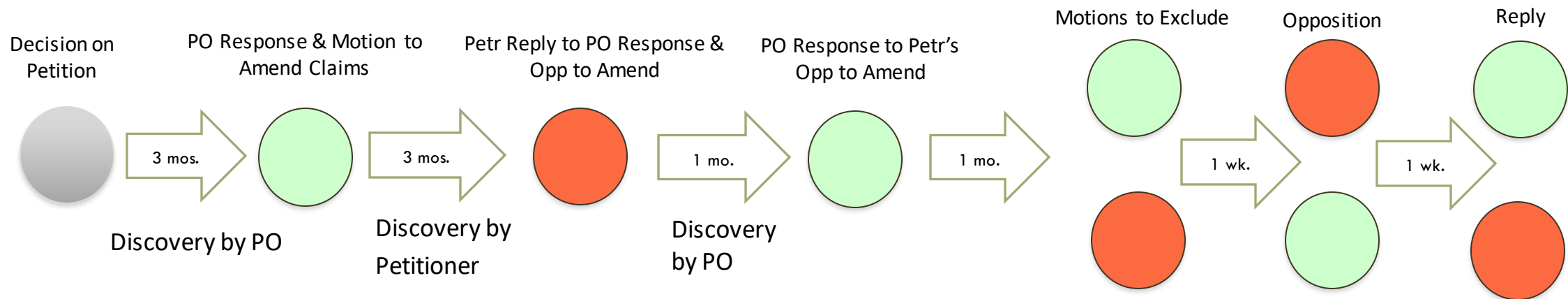


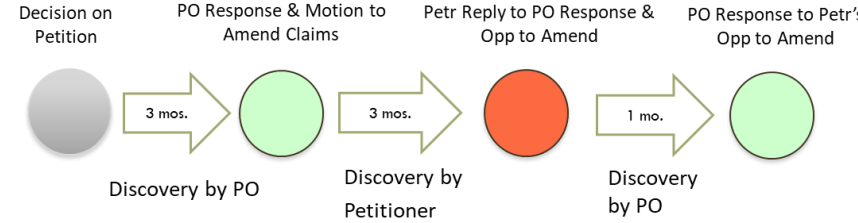


Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after P.O. reply in support of motion to amend.
- Any opposition is typically due one week later.
- Any reply to opposition due one week after that.

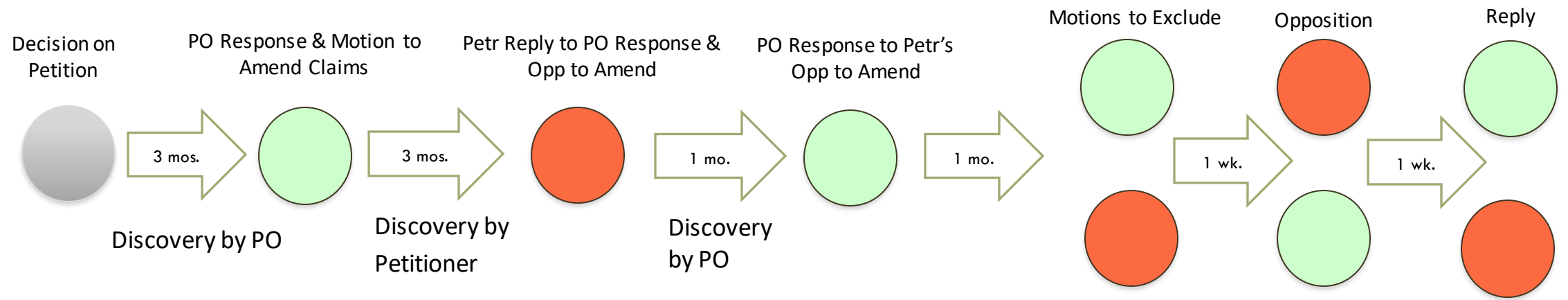




Motions to Exclude

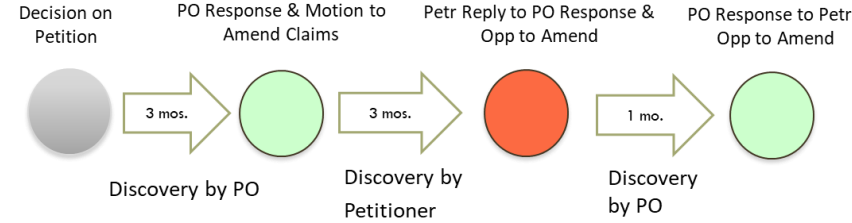
A motion to exclude evidence must:

- Identify where in the record the objection originally was made.
- Identify where in the record the evidence sought to be excluded was relied on by an opponent.
- Address objections to exhibits in numerical order.
- Explain each objection.



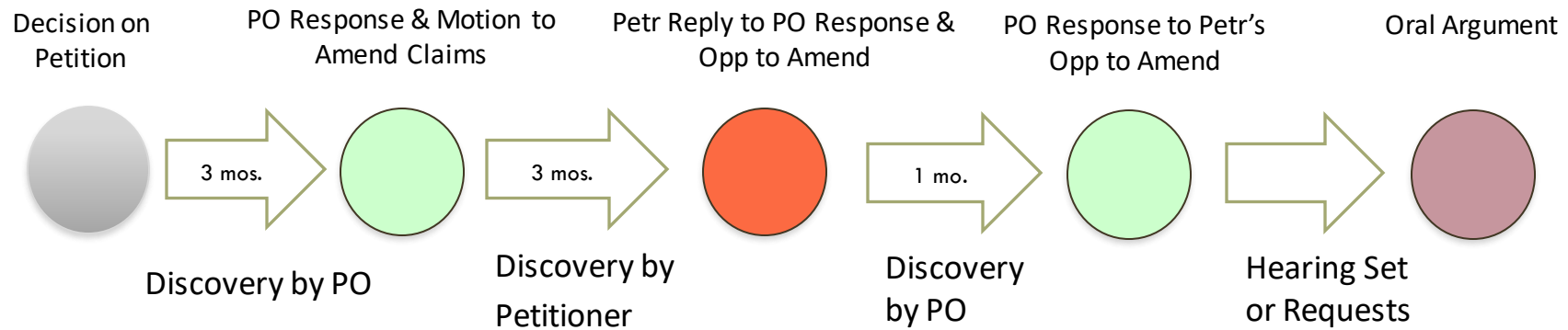
Agenda

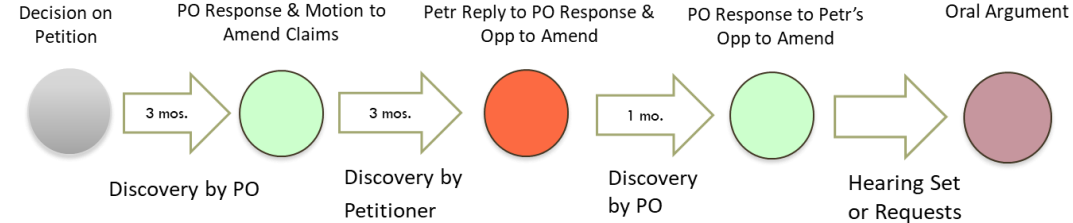
- Proceedings Leading to the Hearing
 - Pre-hearing proceedings
 - Objections to Evidence and Motions to Exclude
 - Oral Argument



Oral Argument

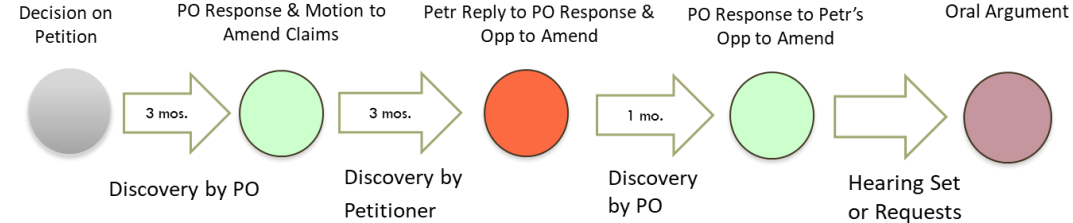
- (a) A party may request oral argument on an issue raised in a paper at a time set by the Board. The request must be filed as a separate paper and must specify the issues to be argued.
- (b) Demonstrative exhibits must be served at least **seven business** days before the oral argument and filed no later than the time of the oral argument.





Oral Argument

Either party may request a pre-hearing conference call before the oral argument to preview the issues to be discussed at the oral argument and seek the PTAB's guidance on any particular issue the PTAB would like the parties to address. The pre-hearing conference call will generally occur no later than three business days prior to the oral hearing. The time for making the request to the PTAB generally will be no later than the due date set for a reply to an opposition to motion to exclude.



Legal Experience and Advancement Program (LEAP)

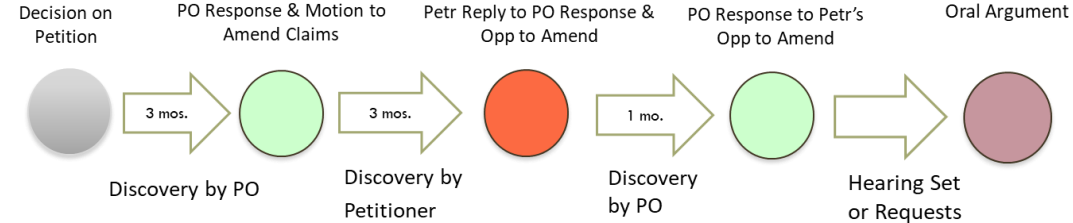
Launched on May 15, 2020

Goal: To foster the advancement of the next generation of patent practitioners through skills development and oral advocacy opportunities at the PTAB

Targeting patent agents and attorneys newer to the practice of law or to the PTAB

A party with a LEAP practitioner arguing at oral hearing typically receives 15 minutes of additional argument time

More experienced counsel may provide some assistance to the LEAP practitioner, if necessary, and may make limited clarifications on the record

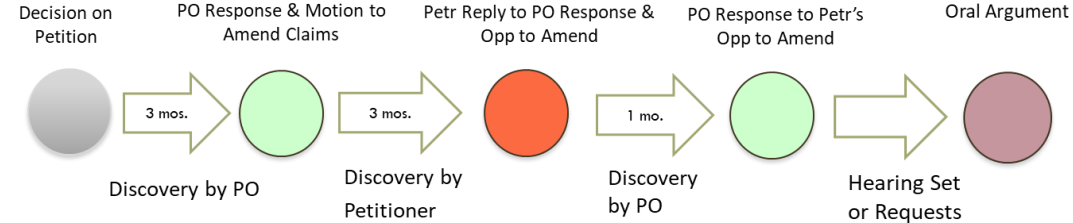


Legal Experience and Advancement Program (LEAP)

ELIGIBILITY REQUIREMENTS:

To qualify for LEAP, a patent agent or attorney must have:

1. three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB, *and*
2. seven (7) or fewer years of experience as a licensed attorney or registered patent agent



Legal Experience and Advancement Program (LEAP)

How to Apply:

Apply for a specific proceeding, after a hearing date is established

Email PTABHearings@uspto.gov at least five (5) business days before the hearing

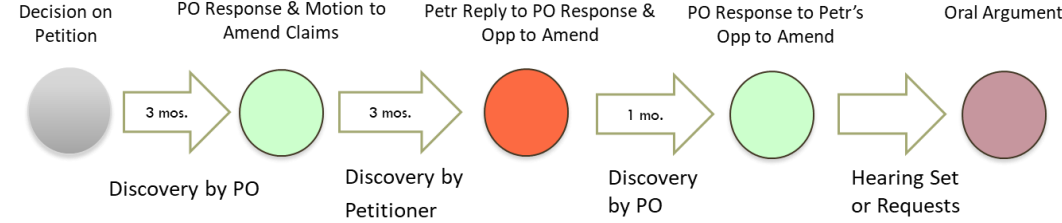
Submit a Request and Verification Form

See <https://www.uspto.gov/patents/ptab/leap>, “LEAP participation requests,” for a sample combined form

Agenda

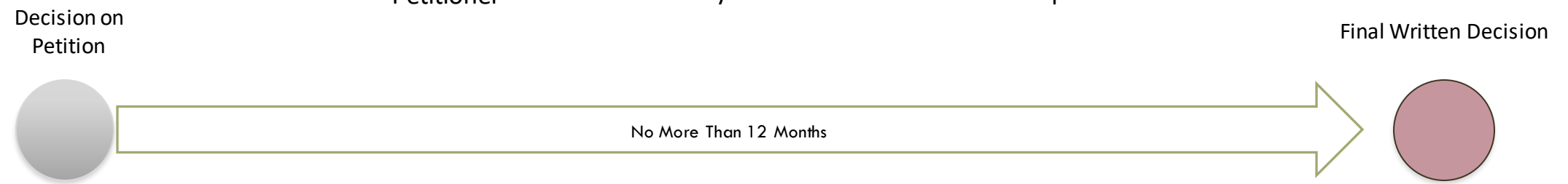
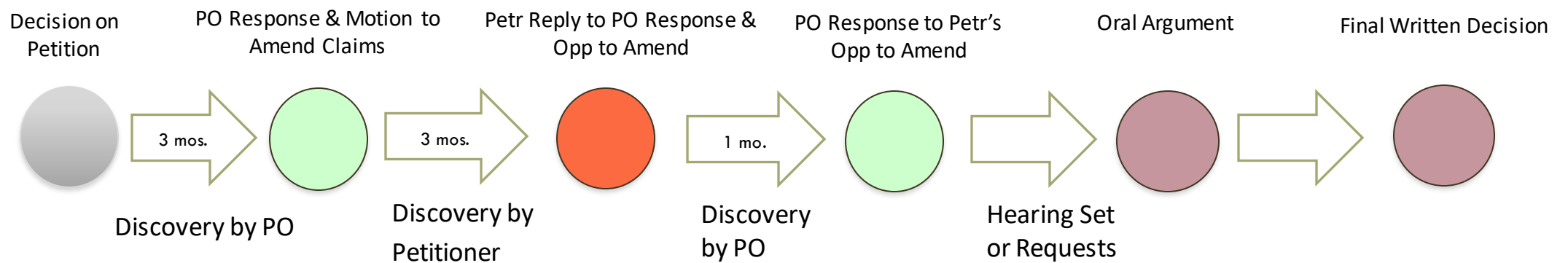
- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing
- **Final Written Decision**
 - Timing
 - Decision itself
 - Director Review



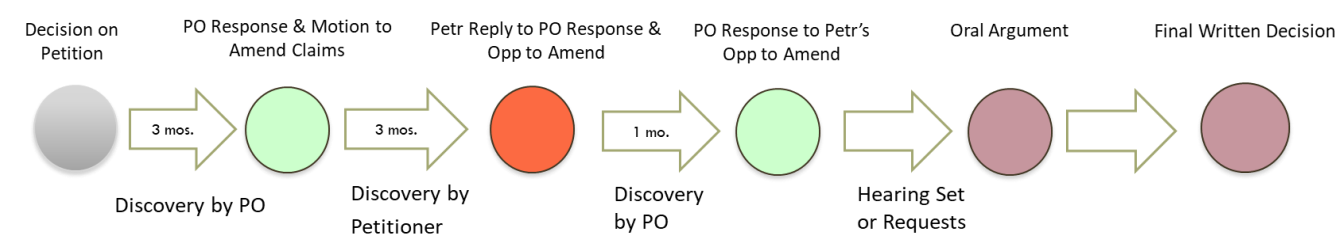


Final Written Decision: Timing

The PTAB must enter a final written decision no later than one year after instituting trial. The Director may extend the one-year period by not more than 6 months in a case for good cause shown.



35 U.S.C. §§ 316(a)(11) and 326(a)(11)



Final Written Decision

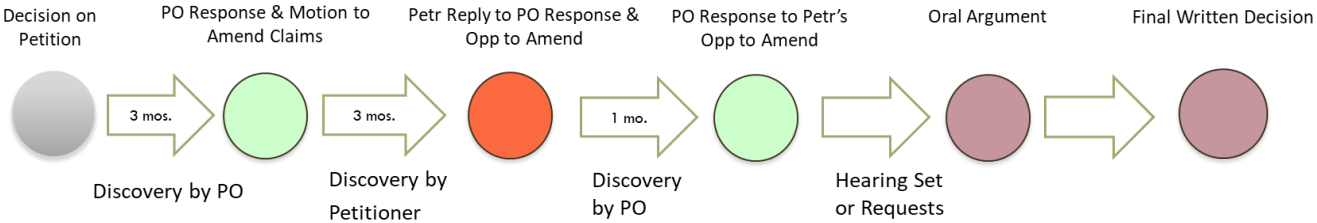
In its final written decision, the PTAB may cancel all or some of the reviewed claims based on the permissible patentability challenges.

In an IPR, the PTAB may cancel claims as anticipated under 35 U.S.C. § 102 or obvious in view of prior art under 35 U.S.C. § 103 (see, for example, *Illumina Inc. v. Columbia Univ.*, 2014 WL 1252940 (PTAB Mar. 6, 2014) (cancelling claims as obvious and denying the patent owner’s motion to amend)).

In PGR and CBM reviews, the PTAB may cancel claims as anticipated or obvious, failing to claim patent eligible subject matter under 35 U.S.C. § 101, or failing to satisfy the enablement or written description requirements of 35 U.S.C. § 112 or the reissue requirements of 35 U.S.C. § 251.

PTAB may also choose not to cancel claims or to incorporate into the patent any new or amended claim determined to be patentable.

35 U.S.C. §§ 318(a)-(b) and 328(a)-(b)



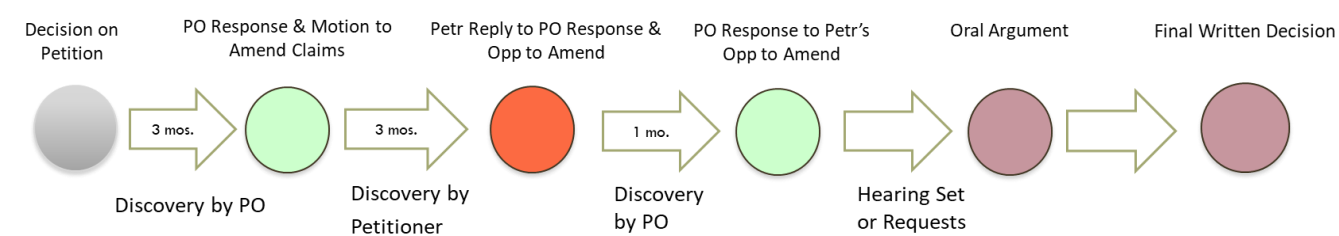
Interim Director Review Process

The USPTO implemented the interim Director review process in response to *United States v. Anthrex, Inc.*, 141 S. Ct. 1970 (2021):

- A Director may sua sponte initiate a review of a PTAB final written decision
- A party to the PTAB proceeding may request the Director review the final written decision within **30 days** of the entry of a final written decision or decision granting rehearing
- Director review requests are publicly available within a week of receipt of the request.
- Denial of requests are usually provided 4-6 weeks after submission; grants often 6 weeks or longer

The USPTO plans to create a permanent Director review process in the future.

*USPTO updates webpages on interim process for Director review
 Status of Director review requests
 Interim process for Director review*



Interim Director Review Process

A party submitting a Request for Rehearing by the Director must (1) file the Request in the PTAB E2E and (2) email the USPTO at Director_PTABDecision_Review@uspto.gov and copying counsel for all parties.

- The request may not introduce new evidence or arguments
- Limit of 15 pages
- Email should contain a priority-ranked list of issues being raised and a brief explanation of the issue and prioritization

Issues that may warrant Director review are below. Parties should raise any additional issues sparingly.

- intervening change in the law or USPTO procedures or guidance; novel issues of law or policy
- material errors of fact or law
- matters that the PTAB misapprehended or overlooked; issues on which PTAB panel decisions are split
- issues of particular importance to the Office or patent community; inconsistencies with Office procedures, guidance, or decisions

*USPTO updates webpages on interim process for Director review
 Status of Director review requests
 Interim process for Director review*

Questions?

For more information, please contact:

Charles R. Macedo
Christopher Lisiewski
Devin Garrity
Roland Rivera-Santiago
Lourania Oliver

Jennifer Rea Deneault

Ken Adamo

Robert Rando

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www.arelaw.com

www.paulweiss.com

<http://kradamo.com/>

www.gmlaw.com

Resources

NYIPLA Events:

Insights on Ethics Issues at the USPTO, PTAB Committee with USPTO, May 4, 2020,
https://www.linkedin.com/posts/nyipla_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B

Adjusting Your Strategies in Preparing and Responding to Petitions Before the PTAB after SAS Inst. Inc. v. Iancu, NYIPLA, October 4, 2018, <https://www.nyipla.org/assnfe/ev.asp?ID=1265>

Discretionary Denials at the PTAB, PTAB Committee, December 1, 2020
<https://www.nyipla.org/assnfe/ev.asp?ID=1363>

Explore PTAB Successes, Outcomes and Results with Docket Navigator, PTAB Committee with Amy Powell, June 1, 2020, <https://www.nyipla.org/assnfe/ev.asp?ID=1397>

Update on Latest PTAB Rules and Precedential Decisions, PTAB Committee, January 5, 2021,
<https://www.nyipla.org/assnfe/ev.asp?ID=1364>

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