

Implementing the America Invents Act: Administrative Trials

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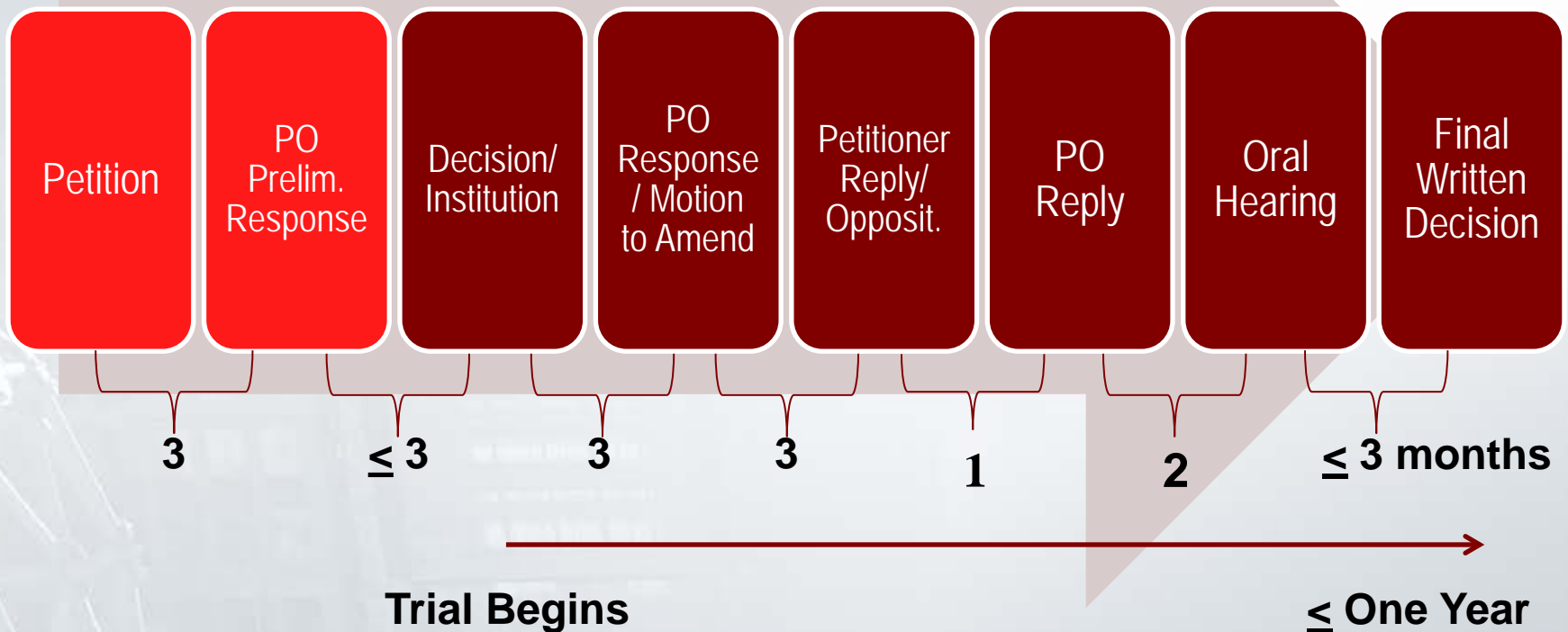
Lead Administrative Patent Judge

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Timing of AIA Trial Proceedings

Representative timeline:





Who may practice

Practice Before the Board in the Trial Proceedings

- **The lead counsel must be a registered practitioner.**
- The Board may recognize counsel pro hac vice during a proceeding upon a showing of good cause, subject to the Office's Code of Professional Responsibility and any other conditions as the Board may impose. § 42.10(c).
 - *E.g.*, counsel is an experienced litigation attorney and has a familiarity with subject matter at issue.
- Similarly, the Board may take action to revoke pro hac vice status, taking into account various factors, including incompetence, unwillingness to abide by the Office's Code of Professional Responsibility, and incivility. § 42.10.



Page length requirements

- **The final rule provides the following (§ 42.24):**

IPR

60 pages

**For a petition,
preliminary
response, and PO
response**

PGR/CBM

80 pages

**For a petition,
preliminary
response, and PO
response**

Derivation

60 pages

**For a petition and
opposition to
petition**

- **For claim charts, single spacing is permitted. § 42.6(a)(2)(iii).**
- **Statement of material facts in a petition or motion is optional. § 42.22(c).**



Threshold Standards for Institution

IPR

Petition must demonstrate a **reasonable likelihood** that petitioner would prevail as to at least one of the claims challenged.

PGR/CBM

Petition must demonstrate that it is **more likely than not** that at least one of the claims challenged is unpatentable.

PGR/CBM: Greater than 50% chance

IPR: May encompass a 50/50 chance



Discovery

Testimony and document production is permitted

- AIA authorizes the Office to set standards and procedures for the taking of discovery. 35 U.S.C. 316(a)(5) & 326(a)(5).
- Discovery rules allow parties to agree to discovery between themselves. § 42.51(a)(1) & (b)(2).
- The final rules provide for mandatory initial disclosures routine discovery, and additional discovery § 42.51.



Routine Discovery

- Routine discovery – reduces costs to parties by making basic information readily available at the outset of the proceeding. Routine discovery may assist the parties to assess the merits of their respective positions, to avoid harassment in the proceeding, or to reach settlement. § 42.51(b)(1).
 - Routine discovery includes documents cited, cross-examination for submitted testimony, and information inconsistent with positions advanced during the proceeding.
 - Proposed rule on inconsistent statements has been modified to limit both scope and number of individuals subject to the rule. § 42.51(b)(1)(iii).



Additional Discovery

Additional discovery

- The parties may agree to additional discovery between themselves. Otherwise, a party must request any discovery beyond routine discovery.
- A party seeking additional discovery in IPR and derivation must demonstrate that the additional discovery is in the interests of justice. 35 U.S.C. 316(a)(5) for IPR; § 42.51(c).
- A party seeking additional discovery in PGR and CBM will be subject to the lower good cause standard. 35 U.S.C. 326(a)(5) for PGR; § 42.224.

Questions?



Thank You



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