

# Practice before the Patent Trial and Appeals Board Part Three

Practicing Law Institute  
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**Michael P. Tierney**

**Lead Administrative Patent Judge**

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# Oral Argument

- *Oral Argument* - each party will be afforded an opportunity to present their case before at least three members of the Board
  - *No new evidence and arguments are permitted*
- *Live testimony* - parties may file a motion for live testimony in appropriate situations



# Umbrella Rules: Final Decision and Request for Rehearing

- Board will issue a final written decision that addresses the patentability of any claim challenged and any new claim added
- Request for rehearing must be filed within:
  - 14 days of the entry of a non-final decision or a decision to institute a trial or
  - 30 days of the entry of a final decision or a decision not to institute a trial
- Party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit



# Umbrella Rules: Petitioner Estoppels

## Petitioner Estoppels After Final Written Decision

- A petitioner in an IPR/PGR/CBM may not request or maintain a proceeding before the **USPTO** with respect to any claim on any ground raised or reasonably could have been raised before the USPTO, 35 U.S.C. 315(e)(1), 325(e)(1); § 42.73(d)(1)
- A petitioner in an IPR/PGR/CBM may not assert in **district court or the ITC** that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised in the trial before the USPTO, 35 U.S.C. 315(e)(2), 325(e)(2); §18(a)(1)(D) of AIA



# Umbrella Rules: Patent Owner Estoppel

## Patent Owner Estoppel (§ 42.73(d)(3))

- A patent owner is precluded from taking action inconsistent with the adverse judgment including obtaining in any patent:
  - A claim that is patentably indistinct from a finally refused or canceled claim
  - An amendment of a specification or drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description



# Appeal

- A party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit, 35 U.S.C. 319, 329
- A party dissatisfied with a final decision in a derivation may appeal to the Federal Circuit, 35 U.S.C. 141(d), or have remedy by a civil action, 35 U.S.C. 146; § 90.2
- The determination by the Director whether to institute an IPR, PGR, or CBM shall be final and nonappealable, 35 U.S.C. 314(d) and 324(e)

# Thank You

