

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



The Basics of AIA Trials

James Worth, lead administrative patent judge

Alyssa Finamore, administrative patent judge

Thursday, November 21, 2019

UNITED STATES
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Question/comment submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov

Agenda

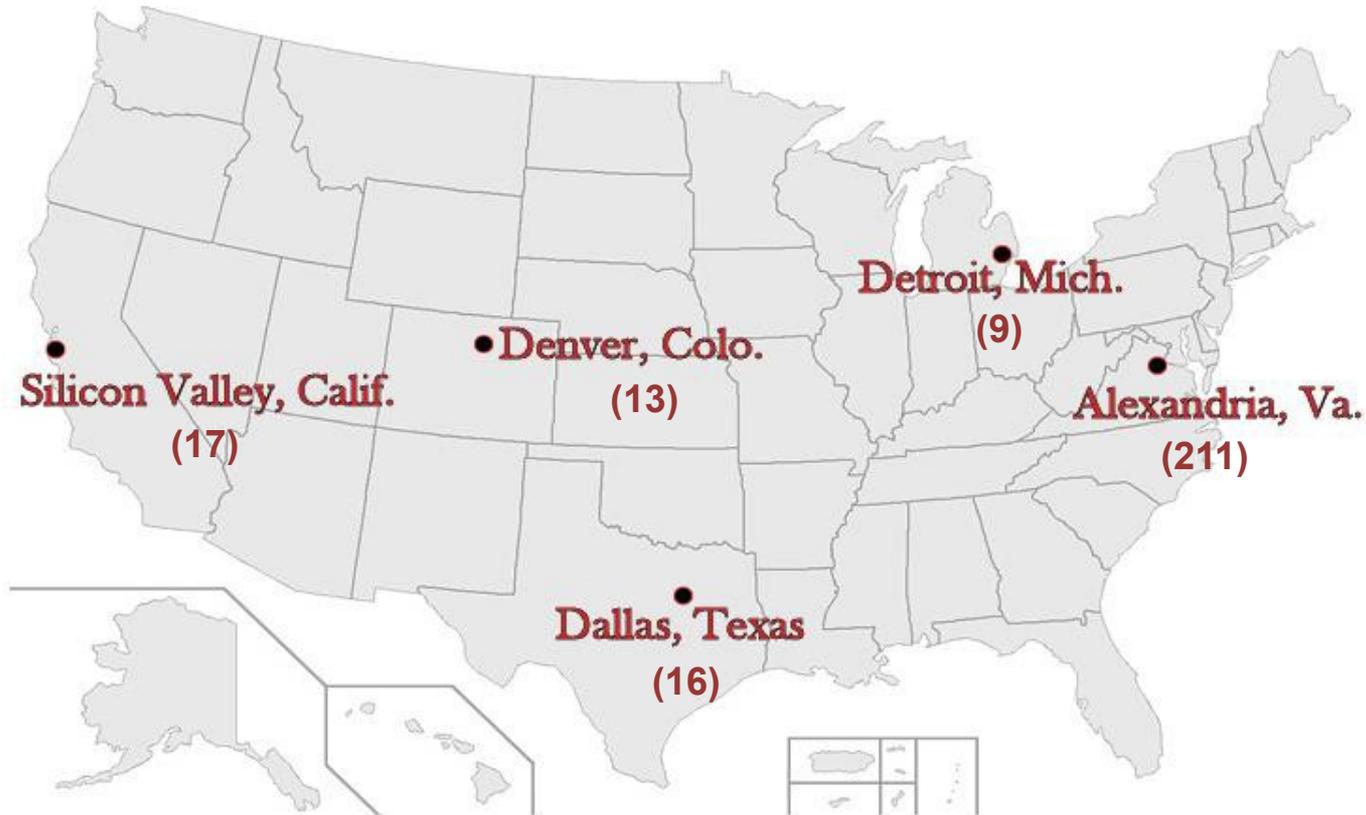
- Composition of PTAB
- AIA Trials
- Resources

Composition of PTAB

The Board

- The Board is created by statute (35 U.S.C. § 6):
 - The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board
- Original “board of disinterested persons” provided for in Patent Act of 1836
- Patent Act of 1861 formed the permanent Board of Appeals of “persons of competent legal knowledge and scientific ability”
 - President Lincoln appointed George Harding of Philadelphia as the first “Examiner-in-Chief”

Locations of PTAB judges



*Alexandria, Va. count includes judges who participate in TEAPP.

Types of PTAB proceedings

- **Type 1:** Review of examiner's work product
 - Appeals in *ex parte* patent applications
 - Appeals in reexamination proceedings and reissue applications
- **Type 2:** AIA trials
- **Type 3:** Interferences and derivations

AIA trials

Parties to AIA trials

- Petitioner = third party
 - Files challenge against a patent
 - Carries legal burdens throughout proceeding
- Patent owner
 - Has several opportunities to represent their interests

Types of AIA trials

- *Inter partes* review (IPR)
- Post grant review (PGR)
- Covered business method review (CBM)

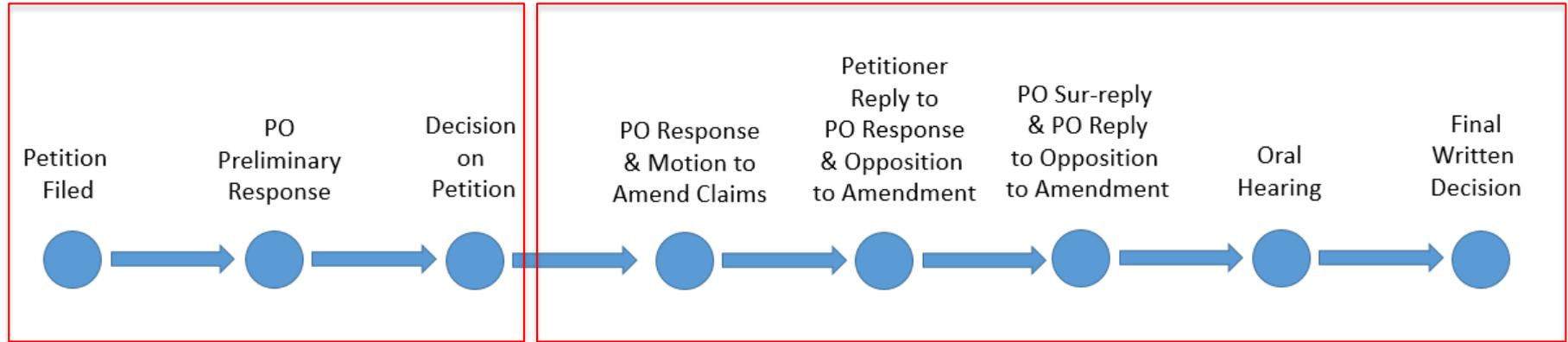
Availability of AIA trials

- **IPR:** from 9 months after patent grant throughout the life of the patent
- **PGR:** from patent grant through 9 months
- **CBM:** same as PGR, but must be a “covered business method” patent
 - Claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of *a financial product or service*
 - Does not include “technological inventions”

Scope of grounds in petition

- **IPR:** only on § 102 and § 103 grounds, and only on basis of prior art consisting of patents and printed publications
- **PGR/CBM:** on any grounds for invalidity (except best mode)

Phases of a PTAB Trial



First Phase: Institution

6 months

Second Phase: Trial

12 months

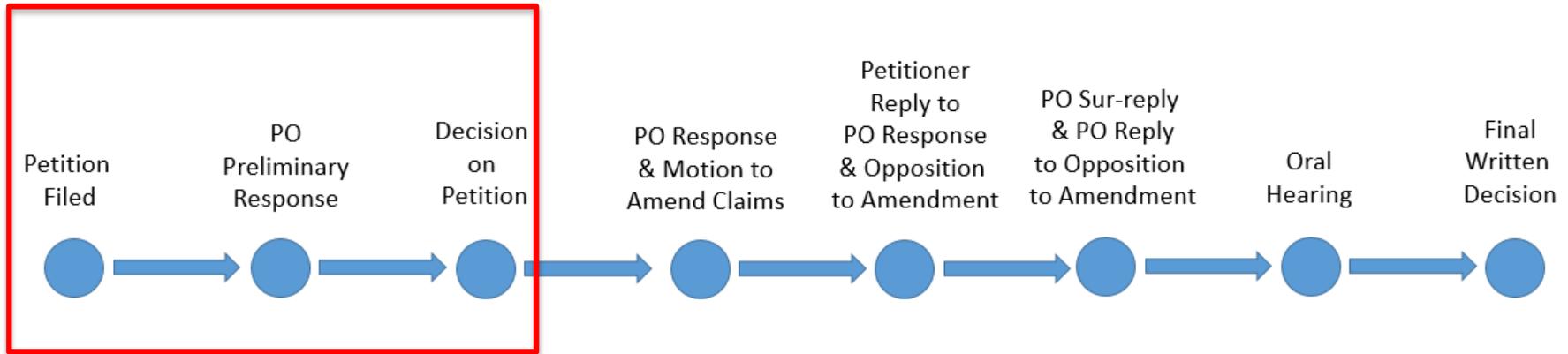
6 month good cause extension possible

Trial process: 10 steps

- **Step 1:** Petition
- **Step 2:** Preliminary Response
- **Step 3:** Decision on Institution and Scheduling Order
- **Step 4:** Patent Owner Response
- **Step 5:** Petitioner Reply
- **Step 6:** Patent Owner Sur-reply
- **Step 7:** Hearing
- **Step 8:** Final Written Decision
- **Step 9:** Request for rehearing (*optional*)
- **Step 10:** Decision on rehearing (*if requested*)

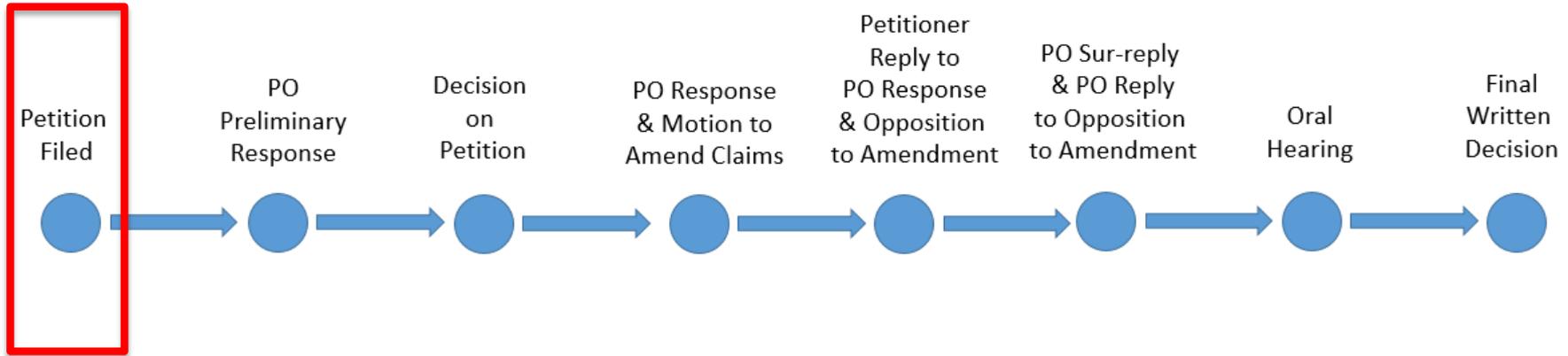
First Phase of a PTAB Trial (Institution Phase)

Institution phase



First Phase: Institution

Step 1: petition



Step 1: petition

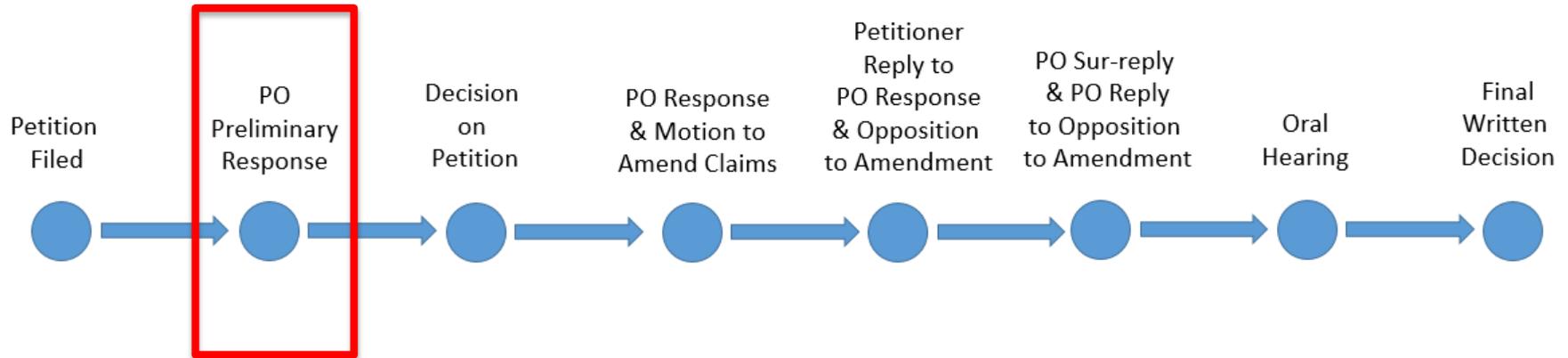
- A member of the public who is not the patent owner can file a petition challenging the patentability of an issued patent
 - If a patent owner sues a party in district court for infringement, that party may bring a petition at the PTAB challenging the patent
 - An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent

Step 1: petition

- Petitioner must identify:
 - each claim that it is challenging
 - the basis for the challenge (known as the “grounds”)
 - the evidence that supports each ground

Sources: 35 U.S.C. §§ 311, 312(a)(3)

Step 2: preliminary response



Step 2: preliminary response

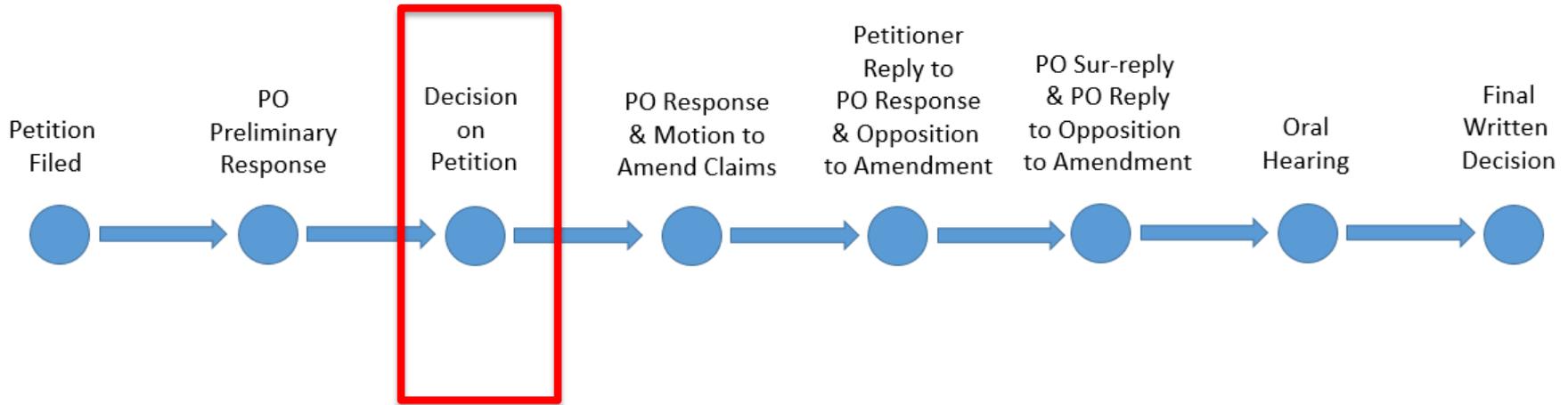
- A patent owner may file a preliminary response to the petition (optional) to persuade the PTAB not to institute a trial based on the petition. Response may be based on:
 - **Merits:** Patent owner may argue that the petition's evidence or reasoning is insufficient or mistaken
 - **Time bar:** Patent owner may also point out if the petitioner is barred from filing a petition
 - **Board's discretion.** See next slide.
- The preliminary response is due no later than 3 months from the date that the PTAB issues a Notice According a Filing Date to the petition

Sources: 35 U.S.C. §§ 313, 315(a)(1), (b), (e)(1), 325(d); 37 CFR 42.107(b)

Board's discretion to deny institution

- 3 statutes: 35 U.S.C. ____
 - **314(a)**: Director “may” institute a review based on a petition
 - Board has issued precedential decisions enumerating factors to be considering in deciding whether to institute. Factors include, for example, number of petitions, timing of petitions, judicial economy.
 - **316(b)**: effect on the efficient administration of the Office, and the ability of the Office to timely complete proceedings
 - **325(d)**: petition raises the same or substantially the same art or arguments previously considered by the Office

Step 3: decision on institution



Step 3: decision on institution

- PTAB will issue a decision on whether to institute a trial within 3 months of the preliminary response
 - PTAB will decide whether the petition has established that the standard for instituting review is met
 - If yes, then PTAB may institute a trial

Source: 35 U.S.C. § 314



Standard for initiating review

- **IPR:** “a reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- **CBM/PGR:** “more likely than not that at least one claim is unpatentable” or the petition raises “a novel or unsettled legal question that is important to other patents or applications”

Step 3: scheduling order

- If PTAB institutes a trial, it will also issue a scheduling order, with a list of due dates for the remaining papers and a hearing date
- PTAB may issue a revised scheduling order later in the proceeding depending on the types of motions filed
- The parties may also agree to move certain dates
- Any party may request an initial conference call with PTAB to discuss the schedule

Source: Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012) (“Trial Practice Guide”); Trial Practice Guide Update (August 2018), available at

https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf



Scheduling Order Example

IPR2012-00001
Patent 6,778,074

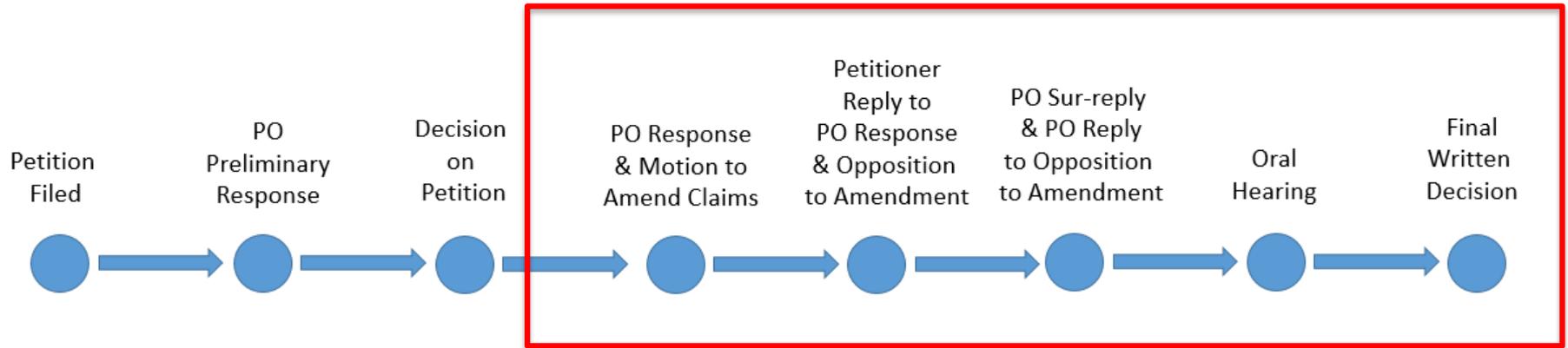
DUE DATE APPENDIX

DUE DATE 1.....	I	March 11, 2013
Patent owner's response to the petition		
Patent owner's motion to amend the patent		
DUE DATE 2.....		May 21, 2013
Petitioner's reply to Patent Owner's response to petition		
Petitioner's opposition to Patent Owner's motion to amend		
DUE DATE 3.....		June 21, 2013
Patent Owner's reply to Petitioner's opposition to Patent Owner's motion to amend		
DUE DATE 4.....		July 12, 2013
Petitioner's motion for observation regarding cross-examination of reply witness		
Motion to exclude evidence		
Request for oral argument		
DUE DATE 5.....		July 26, 2013
Patent Owner's response to observation		
Opposition to motion to exclude evidence		
DUE DATE 6.....		August 2, 2013
Reply to opposition to motion to exclude evidence		

Questions

Second Phase of a PTAB Trial (Trial Phase)

Trial phase



Second Phase: Trial

Standard of proof

- Preponderance of the evidence

Second phase: evidence

- Petitioner and patent owner should support their positions with evidence
- Petitioner and patent owner are responsible for obtaining their own evidence
- There are tools for obtaining evidence:
 - Declarations
 - Discovery
 - Depositions

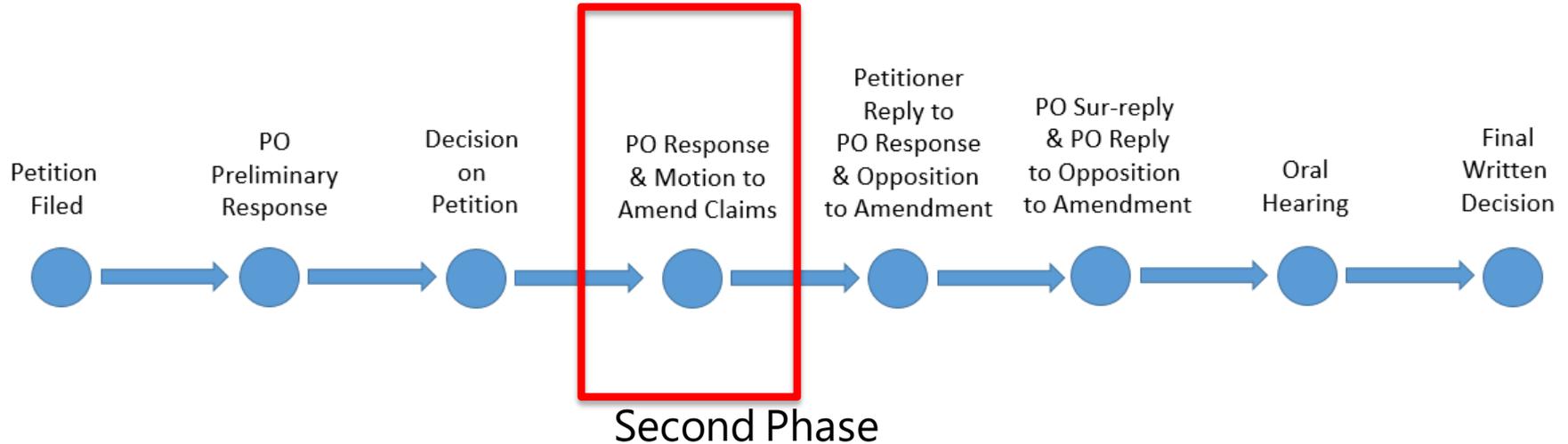
Source: 37 CFR 42.51(b)(1)(ii), (b)(2)

Second phase: evidence

- A declaration is a written witness statement made under penalty of perjury
- During discovery, each side may ask the other side to produce evidence in their possession
 - The discovery process can become complicated if parties are in disagreement about what is involved or whether information is confidential or privileged
 - If you are asking for information, the other side will typically be doing the same
- A deposition is an out-of-court proceeding where a witness gives sworn testimony
 - During depositions, a party may cross-examine a witness
 - Cross-examination is when a lawyer questions a witness about his or her testimony

Source: 37 CFR 42.51(b)(1)(ii), (b)(2)

Step 4: patent owner response



Step 4: patent owner response

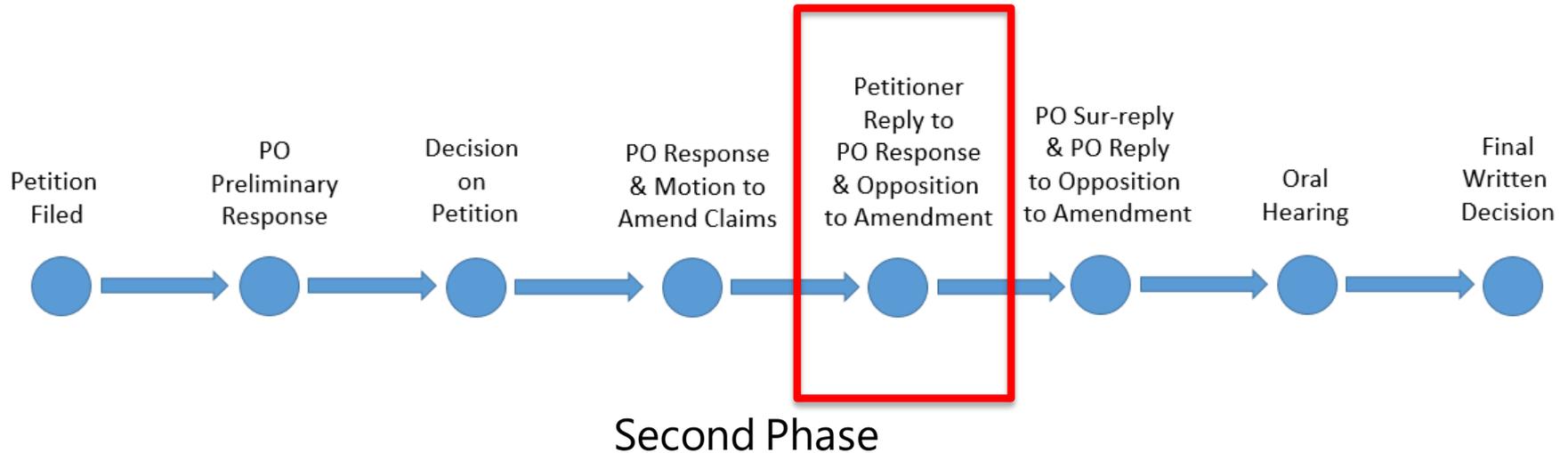
- Whether or not patent owner filed a preliminary response before institution, after institution, patent owner may file a response to the petition (and to the PTAB's Institution Decision)
- Patent owner typically files evidence in support of its position (e.g., a declaration)

Source: Trial Practice Guide, 77 Fed. Reg. at 48,766 and Appendix D

Second phase: motion to amend

- Patent owner may amend its claims during the trial phase to narrow the scope of the claims
 - For example, in some cases, the Board may cancel the original claims but conclude that amended claims can be obtained
- If you'd like to amend claims, more information can be found in
 - Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,766
 - Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures, 84 Fed. Reg. 9497 (Mar. 15, 2019)
<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/new-pilot-program-concerning-motions>

Step 5: petitioner reply



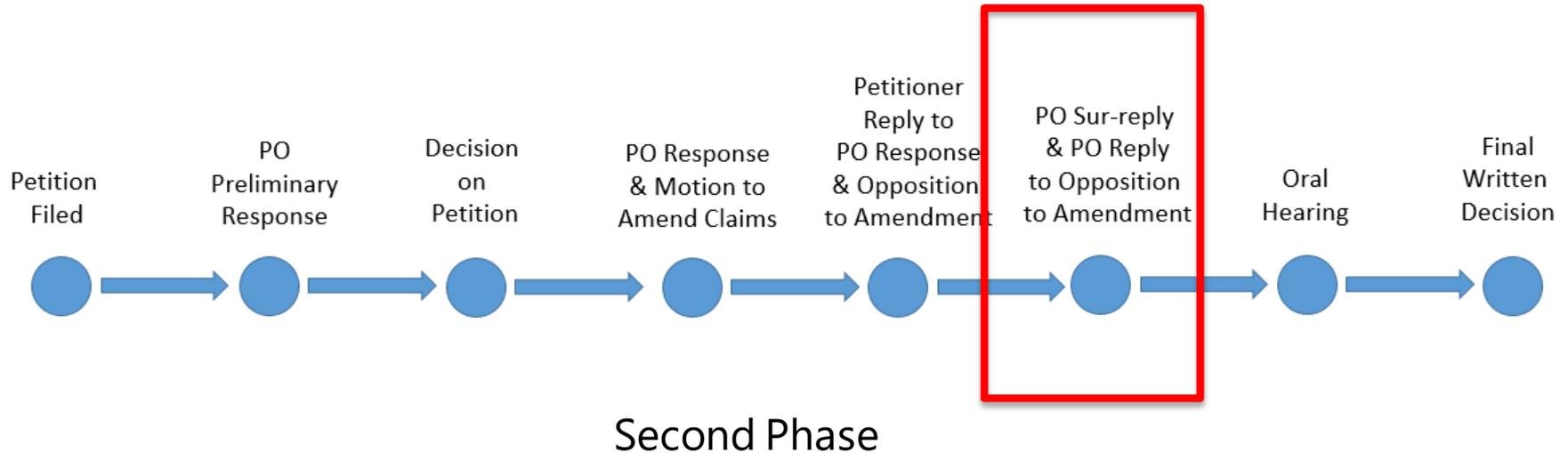
Step 5: petitioner reply

- Petitioner may file a reply to patent owner response
- Petitioner may still enter new evidence at this time
 - As an example, petitioner may file a second declaration at this time

Sources: Scheduling Order; Trial Practice Guide, 77 Fed. Reg. at 48,767



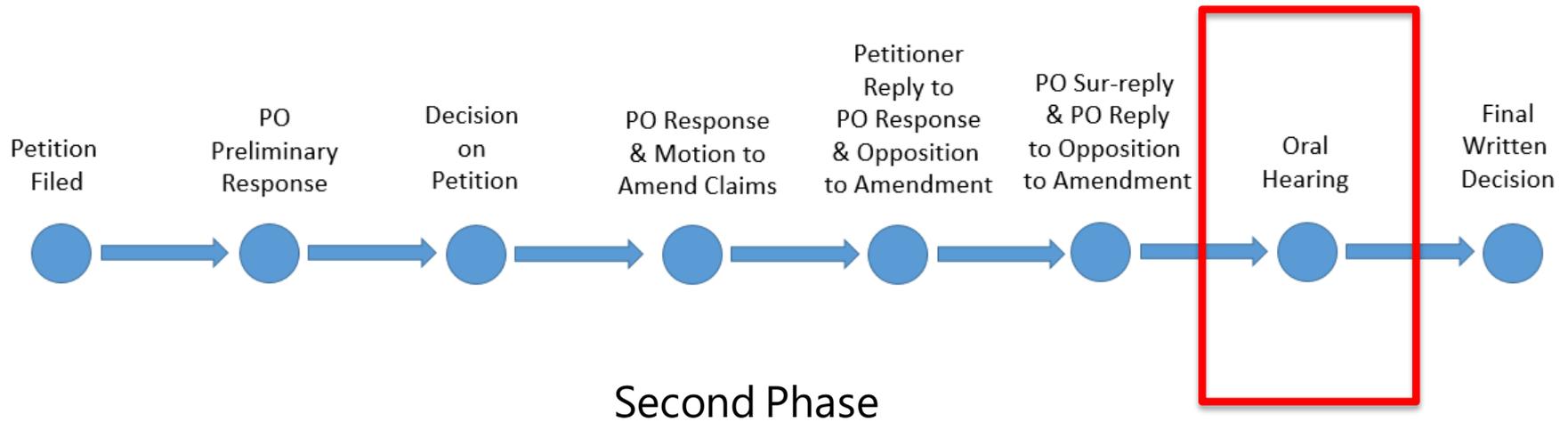
Step 6: patent owner sur-reply



Step 6: patent owner sur-reply

- Patent owner may file a sur-reply to petitioner's reply
- No new evidence may be filed at this time other than a deposition transcript
 - If counsel for patent owner have cross-examined the petitioner's witness about the contents of a second declaration, the deposition transcript may be filed at this time

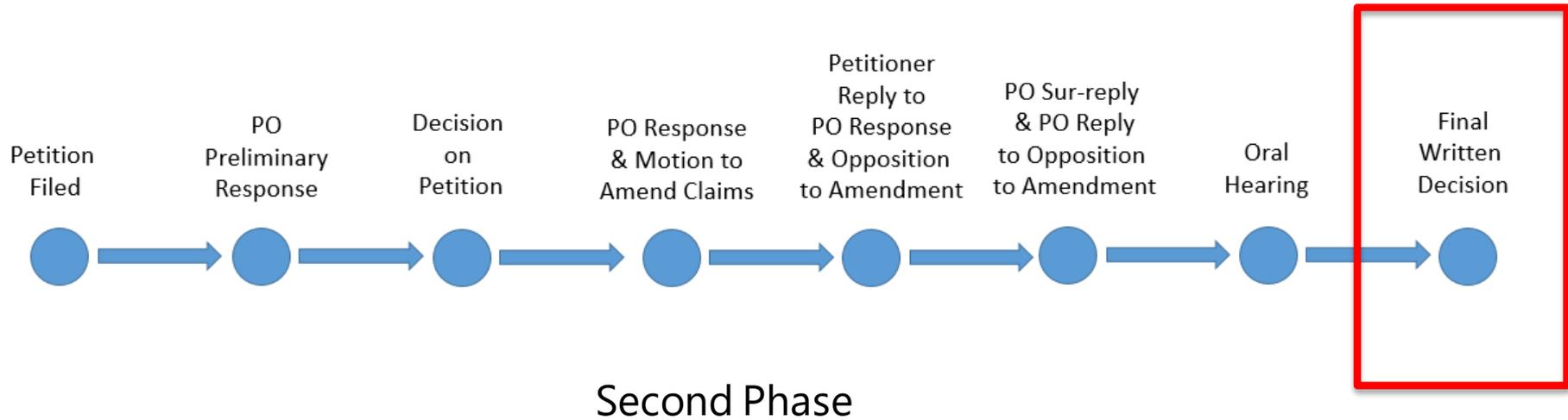
Step 7: hearing



Step 7: hearing

- If requested, PTAB will generally hold an oral hearing
 - The date for a possible hearing is listed in the scheduling order
 - Parties must still request a hearing
- Hearings may be held in Alexandria, Virginia or in one of the regional offices, depending on where judges on the panel are located and where hearing rooms are available
- Under a new program, parties may request that visitors be able to view a hearing remotely from one of the regional offices
- For inventor to testify at oral hearing, certain conditions apply:
 - Inventor previously must have submitted a declaration with the Patent Owner Response and/or Motion to Amend; and
 - Panel must authorize live testimony at hearing

Step 8: final written decision



Step 8: final written decision

- PTAB will issue a final written decision for all trials that are instituted, unless there is a termination (settlement)
- PTAB will rule on the patentability of each claim
 - PTAB will either uphold a claim or find a claim to be unpatentable
- If PTAB finds claims to be unpatentable, it will order cancellation of those claims
 - That means that those claims will not be enforceable anymore

Source: 35 U.S.C. § 318

After a Final Written Decision

After a final written decision

- The party adversely affected by a final written decision may:
 - Request that PTAB reconsider a decision if they believe there was a matter that the Board overlooked or misapprehended
 - File a timely appeal to the U.S. Court of Appeals for the Federal Circuit

Source: 37 CFR 42.71(d)

Additional options for patent owner after a final written decision

- Patent owners may avail themselves of a reissue application or a request for reexamination before, during, or after an AIA trial concludes with a final written decision
 - Under certain circumstances, the Office will proceed after the Board issues a final written decision relating to the same patent, including during an appeal of the final written decision at the Federal Circuit
 - Considerations: if timely filed and raises issues different than those previously considered in the AIA proceeding
- Notice regarding options for reissue or reexamination during pending AIA proceeding, 84 Fed. Reg. 16654 (April 22, 2019)
<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/notice-regarding-options-amendments>

Questions

Resources

Additional Trial Resources

- 35 U.S.C. §§ 311-329
(laws governing IPRs and PGRs)
 - <https://uscode.house.gov/browse/prelim@title35&edition=prelim>
- 37 C.F.R. §§ 42.1-42.412
(rules for trials in general, and IPRs, PGRs, and CBMs):
 - https://www.ecfr.gov/cgi-bin/text-idx?&tpl=/ecfrbrowse/Title37/37tab_02.tpl
- Consolidated Trial Practice Guide, Nov. 2019:
 - <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>

PTAB Website, Trials

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<https://www.uspto.gov/patents-application-process/patenttrialandappealboard>

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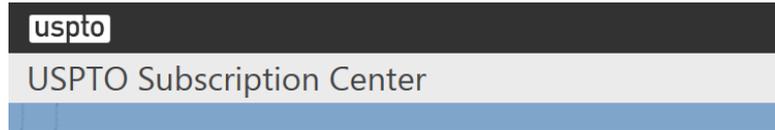
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Questions

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