Chat with the Chief

Chief Judge David Ruschke
Vice Chief Judge Tim Fink

June 5, 2018
**Agenda**

- **Part 1**: Notice of Proposed Rulemaking for Claim Construction

- **Part 2**: Motion to Amend
  - Order
  - Study, Installment 4: Updated through March 30, 2018

- **Part 3**: Implications of SAS

- **Part 4**: Q&A
Webinar Slides and Materials

https://www.uspto.gov/patents-application-process/patenttrialandappealboard
Notice of Proposed Rulemaking (NPRM) for Claim Construction
Proposed 42.100(b), 42.200(b), 42.300(b):

“In an [AIA trial] proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the inter partes review proceeding will be considered.”
**Claim Construction NPRM**  
*83 Fed. Reg. 21,221 (May 9, 2018)*

- USPTO intends that any proposed rule changes adopted in a final rule would be applied to all pending AIA trial proceedings.

- Public comments due on or before July 9 to:  
  [PTABNPR2018@uspto.gov](mailto:PTABNPR2018@uspto.gov)

- Federal Register Notice:  
Motion to Amend Order
Western Digital v. SPEX Techs.
IPR2018-00082 -00084 (PTAB Apr. 25, 2018) (Paper 13) (Informative)

- Order provides guidance and information regarding statutory and regulatory requirements for a motion to amend in light of Federal Circuit case law (e.g., Aqua Products), including on:
  - contingent motions to amend;
  - burden of persuasion that the Office applies when considering the patentability of substitute claims;
  - requirement that a patent owner propose a reasonable number of substitute claims;
  - requirement that the amendment respond to a ground of unpatentability involved in the trial;
  - scope of the proposed substitute claims;
  - requirement that a patent owner provide a claim listing with its motion to amend;
  - default page limits that apply to motion to amend briefing; and
  - duty of candor
MasterImage and Idle Free

- PTAB has de-designated as authority:
Motion to Amend Study
Installment 4: Updated through March 31, 2008
Reasons for Denying Entry of Substitute Claims
(FY13 to FY18: 10/1/2012-3/31/2018)

* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.
<table>
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<tr>
<th>Fiscal Year</th>
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<tr>
<td>FY13</td>
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Filings in the first half of FY18 (post-\textit{Aqua Products}) have exceeded the entire previous fiscal year.
Motions to Amend Filed by Fiscal Quarter
(FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of 2018 (post-Aqua Products) exceeded any other two consecutive quarters.
Implications of SAS
On-Going Partially-Instituted Proceedings

• **Question**: How will the Board determine when to **extend** the statutory deadline for a final written decision?

• **Question**: If a Final Written Decision issued in a proceeding but the case is on appeal to the CAFC, will the Board **reopen** the case to address SAS?

• **Question**: If the Board found no reasonable likelihood as to certain claims and/or grounds, then why is the Board allowing **additional briefing** on them?

• **Question**: Will a party be able to retake a **deposition** to address claims and/or grounds that were originally denied?
Challenges Denied for Statutory Reasons

• **Question**: Will the Board vacate its prior institution decision if including all claims and/or grounds would bring in challenges that were initially denied under 35 USC § 325(d)?

• **Question**: Will the Board vacate its prior institution decision if including all claims and/or grounds would bring in claims that were initially denied because the petitioner did not provide a construction under 35 USC § 112(f)?

• **Question**: How will the Board address institution of additional claims, where those claims were originally denied institution on the basis of estoppel under 35 USC 315(e)?
Institution Decisions Post-SAS

• **Question**: Will the Board’s institution decisions continue to find when challenges do not meet the *reasonable likelihood standard*?

• **Question**: If SAS requires only 1 claim and 1 ground to be sufficient for institution of all challenges, isn’t anything else the Board says at the time of institution akin to an *advisory opinion*?

• **Question**: How can the Board provide its view that petitioner has *not met* the reasonable likelihood standard *at institution* and then reverse itself and find *claims unpatentable in the final written decision* based on a preponderance of the evidence?
Challenges that Could Be Denied for Statutory Reasons

• **Question**: In view of the Office’s policy to institute on all challenges or none, how will the Board handle 35 USC § 325(d) in situations where only some of the challenges fall within its scope?

• **Question**: In view of the Office’s policy to institute on all challenges or none, how will the Board handle petitions that contain *voluminous or excessive grounds for institution* in light of the Office’s policy of instituting on all claims?

• **Question**: Will the Board institute a petition based on the **percentage** of claims and grounds that meet the reasonable likelihood standard, e.g., 50%?

• **Question**: How will the Board handle petitions where, prior to SAS, some claims would have been denied because the petitioner does not provide a construction under 35 USC § 112(f)?
Questions about SAS Implications

• To Trials@uspto.gov email box for both case-specific questions (e.g., request call with panel) and general questions
Questions
## Upcoming PTAB Webinars

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<td>Boardside Chat</td>
<td>June 7, 2018</td>
<td>“Let It Go” Motions to Exclude and Motions to Strike in AIA Administrative Trials, Including Strategies for Handling Demonstrative Exhibits</td>
<td>Justin Arbes, Kevin Cherry</td>
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<td>PTAB on Patent Quality</td>
<td>June 12, 2018</td>
<td>Best Practices Before the Patent Trial and Appeals Board</td>
<td>Kalyan Deshpande, Susan Mitchell, Michael Zecher</td>
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<td>Boardside Chat</td>
<td>Oct 4, 2018</td>
<td>Motions to Seal, Protective Orders, and Confidential Information in AIA Trials</td>
<td>Mike Kim, Amanda Wieker</td>
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Judicial Conference Schedule

- Thursday, June 28, 9 am to 4:30 pm: Alexandria
- Monday, July 9: Detroit
- Wednesday, July 11: Denver
- Thursday, July 26: San Jose
- Tuesday, July 31: Dallas
## Judicial Conference Agenda

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<td>9 to 9:10 am</td>
<td>Opening Remarks</td>
<td>Vice Chief Janet Gongola</td>
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<td>9:10 to 9:20 am</td>
<td>Director Remarks</td>
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<td>9:20 to 10 am</td>
<td>Best Practices for Written and Oral Advocacy</td>
<td>Judge Panel with Moderator Judge Bruce Wieder</td>
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<td>10 to 11 am</td>
<td>Practicum: Written Advocacy</td>
<td>Lead Judges Aaron Moore and Georgianna Braden</td>
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<td>11:15 am to 12:15 pm</td>
<td>Practicum: Oral Advocacy</td>
<td>Judge Meredith Petravick</td>
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<td>State of the Board</td>
<td>Deputy Chief Scott Boalick</td>
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<td>Small Group Discussion: Hot Topic 1</td>
<td>Lead Judge Jessica Kaiser</td>
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<td>3:00 to 3:50 pm</td>
<td>Small Ground Discussion: Hot Topic 2</td>
<td>Lead Judge Melissa Haapala</td>
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<td>3:50 to 4:30 pm</td>
<td>Interview with the Chief</td>
<td>Chief David Ruschke</td>
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Thank You