

Chat with the Chief on SAS

Chief Judge David Ruschke

Vice Chief Judge Tim Fink

Vice Chief Judge Scott Weidenfeller

April 30, 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Part 1: Overview of *Oil States* and SAS Supreme Court decisions
- Part 2: Practical Implications
- Part 3: Q&A

Oil States and SAS

SAS: Issue Presented

- Whether PTAB is required under federal law to issue a final written decision on all claims challenged in the IPR petition (as opposed to a subset of the challenged claims using a claim-by-claim approach)

SAS Guidance

Guidance on the impact of SAS on AIA trial proceedings

Release date: April 26, 2018

On April 24, 2018, the U.S. Supreme Court issued *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, (U.S. Apr. 24, 2018). In light of this decision, the Patent Trial and Appeal Board (PTAB) will proceed in the following fashion at this time. The PTAB will continue to assess the impact of this decision on its operations and will provide further guidance in the future if appropriate.

As required by the decision, the PTAB will institute as to all claims or none. At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.

For pending trials in which a panel has instituted trial on all of the challenges raised in the petition, the panel will continue with the proceeding in the normal course. By contrast, for pending trials in which a panel has instituted trial only on some of the challenges raised in the petition (as opposed to all challenges raised in the petition), the panel may issue an order supplementing the institution decision to institute on all challenges raised in the petition.

Additionally, for pending trials in which a panel enters an order supplementing the institution decision pursuant to this notice, the panel may take further action to manage the trial proceeding, including, for example, permitting additional time, briefing, discovery, and/or oral argument, depending on various circumstances and the stage of the proceeding. For example, if the panel has instituted a trial and the case is near the end of the time allotted for filing the Patent Owner Response, the panel may extend the due date for the Patent Owner Response to enable the patent owner to address any additional challenges added to the proceeding.

Implementation of SAS

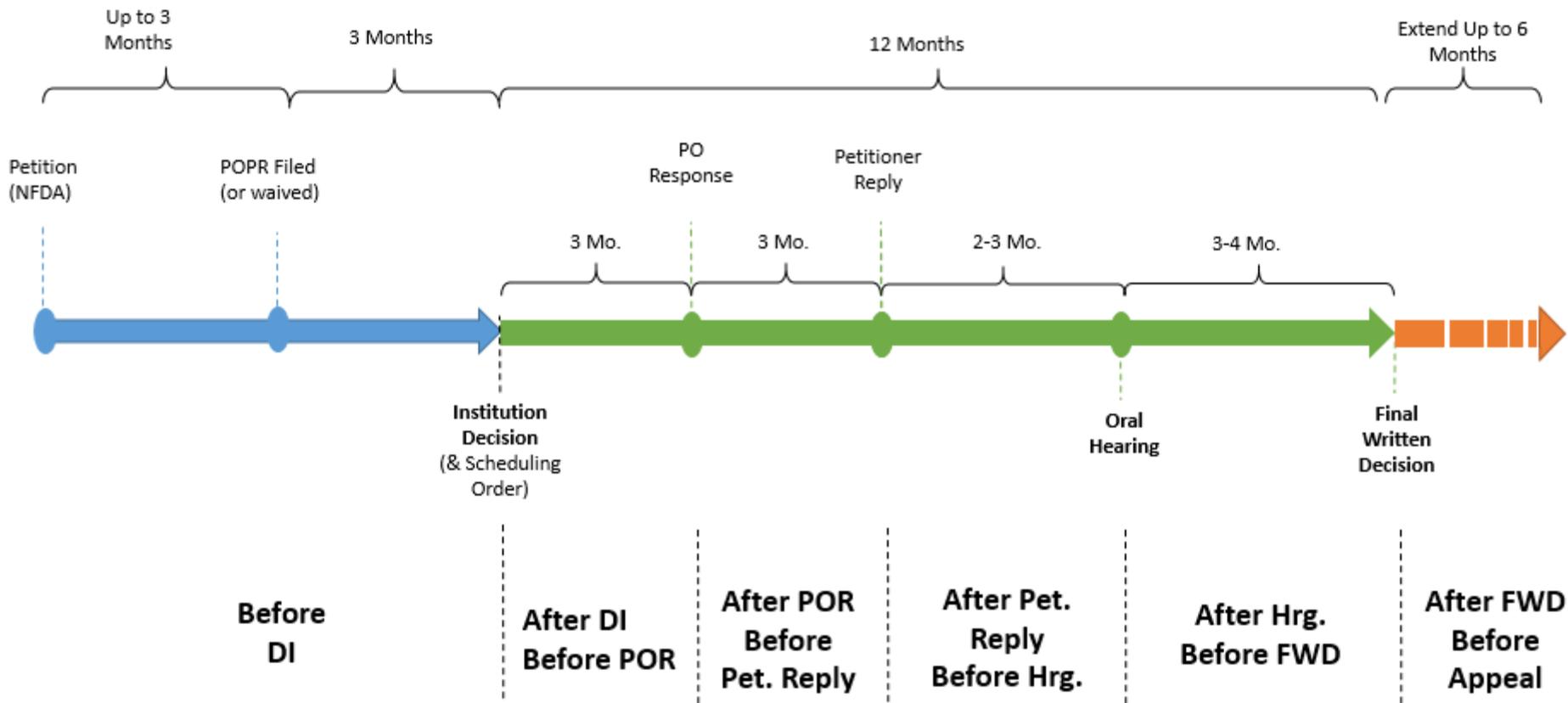
- PTAB will institute on all challenges raised in the petition or not institute at all (i.e., binary decision)
- If panel has issued a DI instituting on all challenges, panel will proceed as normal
- If panel has denied a DI on challenges, no additional action

Implementation of SAS

- If panel has instituted on only some challenges raised in the petition, panel may at this time:
 - Issue order instituting on all challenges; or
 - Receive joint request filed by the parties to terminate

Practical Implications

AIA Procedural Timeline



Before DI

- At this time:
 - No partial institution based on claims
 - No partial institution of grounds

After DI if Previous Partial Institution

- Order to issue instituting on all claims and all grounds presented in the petition and order parties to meet and confer
- Additional action may be needed depending on the stage of the trial proceeding, e.g., allow additional briefing, evidence, and hearing as well as extend procedural dates
- Parties may jointly file request for rehearing to waive additional claims and/or grounds

After DI & Before PO Response

- Due date for Patent Owner Response may be extended to allow Patent Owner to address additional claims and/or grounds
- Adjust other procedural dates as necessary

After PO Response & Before PET Reply

- Due date for Petitioner's reply may be extended if Patent Owner requests to supplement Patent Owner Response and provide evidence to address additional claims and/or grounds
- Adjust other procedural dates, including Petitioner Reply, as necessary

After PET Reply & Before Hearing

- Either party may request a conference call with the panel to discuss additional briefing and/or evidence to address additional claims and/or grounds
- Petitioner is permitted responsive briefing but must request authorization before filing additional evidence
- Adjust other procedural dates, including hearing date, as necessary

After Hearing & Before FWD

- Either party may request a conference call with the panel to discuss additional briefing, evidence, and/or supplemental hearing to address additional claims and/or grounds
- Petitioner is permitted responsive briefing and hearing but must request authorization before filing additional evidence
- May extend 12- month statutory deadline on case-by-case basis

Post FWD & Before Request for Rehearing

- Either party can file rehearing request to raise SAS-issues regarding all claims and/or all grounds challenged in petition
- May extend rehearing deadline if needed or waive rehearing deadline if time has passed

After Request for Rehearing & Before CAFC Appeal

- Either party may request a conference call with the panel to discuss additional briefing and/or evidence to address additional claims and/or grounds
- May extend rehearing deadline if needed or waive rehearing deadline if time has passed

Questions/Comments

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

Questions

Upcoming PTAB Events: Webinars

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



PTAB Judicial Conference

- Thursday, June 28, 2018 in Alexandria
- Highlights include:
 - Remarks from Director Andrei Iancu
 - Oral and written advocacy practicum
 - Small group discussion of “hot topics” facilitated by judges
 - Interview with Chief Judge David Ruschke

