

# **Webinar: Request for Comments on AIA Trial Proceedings Before the PTAB July 29, 2014**



**Scott Boalick, Vice Chief Judge (Acting)  
Patent Trial and Appeal Board  
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# AIA Trial Feedback

- Nationwide listening tour conducted in April and May 2014
- Federal Register Request for Comments published in June 2014
  - <http://www.gpo.gov/fdsys/pkg/FR-2014-06-27/pdf/2014-15171.pdf>
- Submit comments to [TrialsRFC2014@uspto.gov](mailto:TrialsRFC2014@uspto.gov) by September 16, 2014



# PTAB

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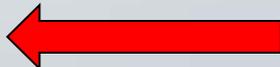
- [Administrative Patent Judges - Apply Online](#)
- [APJ Recruitment brochure \[PDF\]](#)

🔍 Events

- Webinar on Request for Comments about AIA Trials, July 29, 2014, noon to 1 pm ET
  - Acting Vice Chief Judge Scott Boalick will address the 17 questions that the Board posed in the Federal Register Request for Comments about the AIA trials.
  - WEBINAR ACCESS INFORMATION:
    - <https://uspto-events.webex.com/uspto-events/onstage/g.php?t=a&d=990690901>
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- [Joint 5x5 Relay and Swearing-in Ceremony, July 21, 2014 in San Jose \[PDF\]](#)
- [Administrative Patent Judge \(APJ\) Speaking Engagements \[PDF\]](#)

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- [Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board \(FR Doc. 2014-15171\)](#)
- **PTAB Articles**
  - [USPTO Message From PTAB: How to Make Successful Claim Amendments in an AIA Trial Proceeding \(05MAY2014\)](#)





# Request for Comments

- 2 parts:
  - Response to non-rule specific comments from listening tour; and
  - Questions about trial proceedings for public comment



# Non-rule Specific Comments

- Requiring the parties to engage in settlement discussions
- Service of Notice of Appeal from PTAB final trial decision
- Fairness of trial continuance if parties settle
- Scope of estoppel



# Non-rule Specific Comments (cont.)

- PTAB issuance of precedential and informative decisions
- Availability of oral argument audio files and transcripts
- Notice of PTAB trial decisions
- Availability of trial statistics



# Questions for Comment

- 17 questions posed for public input on many topics
- Question 1: Claim Construction Standard
  - Under what circumstances, if any, should the Board decline to construe a claim in an unexpired patent in accordance with its broadest reasonable construction in light of the specification of the patent in which it appears?
- Question 2: Motion to Amend
  - What modifications, if any, should be made to the Board's practice regarding motions to amend?
- Question 3: Patent Owner Preliminary Response
  - Should new testimonial evidence be permitted in a Patent Owner Preliminary Response?



# Questions for Comment

- Question 4: Obviousness
  - Under what circumstances should the Board permit discovery of evidence of non-obviousness held by the petitioner, for example, evidence of commercial success for a product of the petitioner? What limits should be placed on such discovery to ensure that the trial is completed by the statutory deadline?
- Question 5: Real Party in Interest
  - Should a patent owner be able to raise a challenge regarding a real party in interest at any time during a trial?
- Question 6: Additional Discovery
  - Are the factors enumerated in the Board's decision in Garmin v. Cuozzo, IPR2012-00001, appropriate to consider in deciding whether to grant a request for additional discovery? What additional factors, if any, should be considered?



# Questions for Comment

- Questions 7 to 13: Multiple proceedings
  - How should multiple proceedings before the USPTO involving the same patent be coordinated? Multiple proceedings before the USPTO include, for example: (i) two or more separate AIA trials; (ii) an AIA trial and a reexamination proceeding; or (iii) an AIA trial and a reissue proceeding?
  - What factors should be considered in deciding whether to stay, transfer, consolidate, or terminate an additional proceeding involving the same patent after a petition for AIA trial has been filed?
  - Under what circumstances, if any, should a copending reexamination proceeding or reissue proceeding be stayed in favor of an AIA trial? If a stay is entered, under what circumstances should the stay be lifted?
  - Under what circumstances, if any, should an AIA trial be stayed in favor of a copending reexamination proceeding or reissue proceeding? If a stay is entered, under what circumstances should the stay be lifted?
  - Under what circumstances, if any, should a copending reexamination proceeding or reissue proceeding be consolidated with an AIA trial?
  - How should consolidated proceedings be handled before the USPTO? Consolidated proceedings include, for example: (i) consolidated AIA trials; (ii) an AIA trial consolidated with a reexamination proceeding; or (iii) an AIA trial consolidated with a reissue proceeding.
  - Under what circumstances, if any, should a petition for an AIA trial be rejected because the same or substantially the same prior art or arguments previously were presented to the USPTO in a different petition for an AIA trial, in a reexamination proceeding or in a reissue proceeding?



# Questions for Comment

- Question 14: Extension of 1 Year Period to Issue Final Determination
  - What circumstances should constitute a finding of good cause to extend the 1-year period for the Board to issue a final determination in an AIA trial?
- Questions 15 and 16: Oral Hearing
  - Under what circumstances, if any, should live testimony be permitted at the oral hearing?
  - What changes, if any, should be made to the format of the oral hearing?
- Question 17: General
  - What other changes can and should be made in AIA trial proceedings? For example, should changes be made to the Board's approach to instituting petitions, page limits, or request for rehearing practice?



# Thank You