

**PROPOSED IMPLEMENTING REGULATIONS**  
**LEAHY-SMITH AMERICA INVENTS ACT**  
  
**SECTION 6 – POST-GRANT DISPUTES**

Submitted by:

Robert S. Lelkes  
U.S. Patent Attorney (Reg. No. 33,730)  
European Patent Attorney  
Geigenbergerstr. 3  
D-81477 Munich, Germany

Tel.: +49(89)23519710  
Fax: +49(89)23519711  
E-Mail: [robertlelkes@online.de](mailto:robertlelkes@online.de)



## Preliminary Remarks

The following proposed implementing regulations for Section 6 of the Leahy-Smith America Invents Act presuppose the following additional changes in Title 37, Chapter I, Subchapter A, of the Code of Federal Regulations (CFR):

- Deletion of Subpart H (*Inter partes* Reexamination) of Part 1;
- Replacement of Subpart E (Patent Interferences) of Part 41 with Subpart E (Derivation);  
and
- Redefinition of “Board” as referring to the Trial and Appeals Board.

In view of the foregoing, it is proposed that implementing regulations for *inter partes* review according to 35 U.S.C. §311 *et seq.* be inserted in Title 37, Chapter I, Subchapter A, Part 41 as:

- new Subpart F (*Inter partes* Review) and
- new Subpart G (Post-Grant Review).

## SUBPART F – *INTER PARTES* REVIEW

### §41.300 Procedure

- (a) An *inter partes* review is a contested case subject to the procedures set forth in subpart D of this part, except that 37 CFR §§41.102 and 41.150(b)(i) shall not apply.
- (b) The procedures under 37 CFR §§41.110 to 41.153 and 41.155 to 41.158 are not applicable prior to commencement of *inter partes* review.
- (c) Institution of *inter partes* review shall be determined and noticed by the Board.
- (d) *Inter partes* review shall be administered by the Board such that pendency before the Board is normally no longer than one year after the date on which the Board notices the institution of a review.

### §41.301 Definitions

In addition to the definitions in 37 CFR 41.2 [*to be amended*] and 41.100, the following definitions apply under this subpart:

*Patent* means an enforceable granted U.S. patent, and any reissue, reexamination, *inter partes* review or post-grant review thereof, contested via a petition for *inter partes* review.

*Contested patent* means a *patent* challenged under 35 U.S.C. §311.

*Patent owner* means each and every beneficial owner and title holder of a *contested patent* as indicated by the Office's Official records of assignment. Patent owner may be a sole owner or the owner of a partial interest in the patent.

*Petition* means a document or documents filed with the Office requesting institution of *inter partes* review of a *patent* under 35 U.S.C. §311.

*Petitioner* means a party who submits a *petition*.

*Lead counsel* means legal counsel admitted to practice before the U.S. PTO appointed by one or more parties for representation in *inter partes* review proceedings in accordance with 37 CFR §41.108.

*Real party in interest* means a party having a legitimate business interest in the outcome of the proceedings on the date that the *petition* is filed.

*Tribunal* means a three-member panel assigned to administer and decide the outcome of proceedings under 35 U.S.C. §311 with respect to a *contested patent*.

**§41.302 Petition for *inter partes* review**

- (a) Petitioner shall submit a petition in accordance with 35 U.S.C. §§311 and 312(a) which, in accordance with and further to the requirements of 35 U.S.C. §312(a), shall:
- (1) Identify the petitioner, and any lead counsel representing the same, by full legal name and address.
  - (2) Request *inter partes* review under 35 U.S.C. §311.
  - (3) Identify one, and only one, patent by U.S. patent number or reissue number.
  - (4) Provide a statement under 35 U.S.C. §312(a)(3) identifying with particularity each patent claim challenged and explaining, for each claim challenged, the grounds on which the challenge to each claim is based and the evidence that supports the grounds for the challenge to each claim.
  - (5) Provide copies of all evidence on which petitioner intends to rely on to challenge one or more claims in the patent, including all evidence referenced in the statement of preceding subparagraph (4). Such evidence shall be presented in accordance with 37 CFR §§41.154 and shall be provided without restriction on public availability. Evidence in a language other than English shall be accompanied by a certified English translation of the same.
  - (6) Provide a statement identifying each and every real party in interest to the extent necessary for third parties to determine whether that person is a privy.
  - (7) Provide a statement identifying each and every U.S. civil court proceeding and each and every proceeding under 35 U.S.C. §§135, 311 and 321 in which petitioner or its privy was, or is, a party to the proceedings wherein the patent identified in subparagraph (b)(2) of this rule was the subject of the proceeding or stating that petitioner and its privies have not been a party to such proceedings.
  - (8) Certify that petitioner is not an owner of the contested patent or privy with any undisclosed real party in interest and that petitioner and any lead counsel will not represent the interests of patent owner or any undisclosed real party in interest throughout the pendency of *inter partes* review of the contested patent.

- (9) Certify that 35 U.S.C. §315(a)(1), (b) and (e)(1) do not prohibit *inter partes* review.
  - (10) Be signed by petitioner or lead counsel appointed by petitioner.
  - (11) Certify that a copy of the petition as prescribed in preceding subparagraphs (1) to (10) has been served in its entirety on each patent owner at the address provided for in 37 CFR §1.33(c)[*to be amended to include inter partes review*]. The name and address of the party served must be indicated.
- (b) The petition shall be accompanied by the petition fee required under 37 CFR §1.[*to be determined*].

#### **§41.303 Formal admissibility review**

- (a) The Director shall check whether the petition contains parts conforming to the formal requirements of subparagraphs (1) to (11) of 37 CFR §41.302(a) and whether the petition fee of 37 CFR §41.302(b) has been paid. In the event that the petition is incomplete or the petition fee is unpaid, the Director shall notify petitioner in writing and set a one-month time period for response.
- (b) Any response to a notification under subparagraph (a) of this rule must be in writing and shall certify that the response has been served on the patent owner in accordance with §41.302(a)(11).
- (c) If petitioner fails to submit an unpaid petition fee or fails to file and serve on patent owner a response to the notification, including any missing or incomplete part of the petition noticed under subparagraph (a) of this rule, within the time period set by the notice, the parties shall be notified in writing that the petition is inadmissible. Any petition fee paid shall be refunded to the petitioner reduced by the processing fee authorized under 37 CFR §1.21(m).
- (c) If petitioner timely submits any unpaid petition fee and files a response to the notice, including all noticed missing parts, within the time period set by the notice of subparagraph (a) of this rule, the Director will notify the parties that the petition is formally admissible and will be made available to the public via the PALM system upon publication of a notice of petition for *inter partes* review in the *Official Gazette*.
- (d) The date on which the petition is formally admissible shall be the date of commencement of pendency of the proceedings under 35 U.S.C. §311 for the purpose of determining copendency under §§41.308.

- (e) The notice to patent owner that the petition is formally admissible shall be accompanied by an invitation according to §41.304.

#### **§41.304 Notice inviting patent owner to participate in the proceedings**

- (a) When a petition under 35 U.S.C. §311 is admitted under §41.303, the Office shall send a written invitation to patent owner at the address provided for in 37 CFR §1.33(c) requesting that the patent owner:
  - (1) identify each and every owner of the contested patent or confirm that it is the sole owner of the contested patent,
  - (2) provide the name and address of lead counsel appointed to represent patent owner in the *inter partes* review proceedings, together with an appropriate power of attorney, or provide a statement that lead counsel has not been appointed,
  - (3) if lead counsel has not been appointed, provide the name, address, and any additional contact details for one person to whom notices and correspondence relating to the review proceedings should be sent,
  - (4) certify that a copy of the reply has been served in its entirety on petitioner.
- (b) The invitation shall advise patent owner that any preliminary response to the petition under 35 U.S.C. §313 must be submitted within a time period to be noticed after expiration of 6 months from the date of publication of notice of the petition for *inter partes* review according to §41.305 and that submission prior to that time period will be deemed inadmissible.

#### **§41.305 Publication**

- (a) A notice of an admissible petition for *inter partes* review shall be published in the *Official Gazette*. The notice shall include the patent number, any reissue number, the name of the petitioner, the name of each real party in interest, and the name of the party served with the petition.
- (b) The entire petition, correspondence with the Office relating to the proceedings, and any evidence submitted to the Office in accordance with 35 U.S.C. §301 shall be made available to the public electronically via the public PALM system as of the date on which notice of the petition is published in the *Official Gazette*.

- (c) The parties shall be notified of third party submissions within one month of receipt thereof. Such notifications may direct the parties to information made available via the public PALM system in lieu of providing copies thereof.

#### **§41.306 Intervention by nonserved patent owner**

- (a) Within a 3 month time period commencing with publication of the notice of a request for *inter partes* review in the *Official Gazette* under §41.305, any person or legal entity may file a petition requesting recognition of that person or legal entity as a, or the, true owner of the contested patent.
- (b) A petition filed under subparagraph (a) of this rule shall:
  - (1) Identify the contested patent,
  - (2) Make reference to this rule in the caption,
  - (3) Provide documentary evidence supporting the claim of true ownership in accordance with 37 CFR §§41.154,
  - (4) Be signed by lead counsel appointed by petitioner or, if petitioner has not appointed lead counsel, each petitioner, and
  - (5) Certify that the petition has been served on the petitioner requesting *inter partes* review and the parties served with the petition for *inter partes* review.
- (c) The petition under this rule shall be accompanied by the fee prescribed under 37 CFR 1.17(f) for petitions under 37 CFR §1.182.
- (d) The Office shall determine the formal admissibility of the petition under this rule. In the event that the petition fee has not been paid or a formal requirement is not met, the Office shall notify the petitioner under this rule that the petition is rejected as inadmissible for reasons stated in the notice. In the event that the petition fee has been paid and the petition meets that formal requirements of this rule, the Office shall forward the petition to the parties and notify the parties of record that the facts alleged in the petition will be presumed true unless jointly contested by the parties of record via a motion under subparagraph (e) of this rule within a time period of one month from the date of the notice.
- (e) The patent owner of record and petitioner may file a joint motion under 37 CFR §1.121 within the time period specified in subparagraph (d) of this rule objecting to recognition of the petitioner under subparagraph (a) of this rule as a, or the, patent owner and requesting suspension of proceedings pending resolution of the dispute. In the absence of evidence that the motion is an abuse of procedure, the Tribunal

may grant the motion and set a reasonable time period for suspension of proceedings, which may be extended for just cause. The parties of record shall file and serve evidence regarding resolution of the patent ownership dispute prior to expiration of the stay.

- (f) The Office will determine the outcome of the petition under this rule upon recommencement of proceedings based on the facts alleged in the petition, the information recorded in the Office's assignment records and any evidence submitted by the parties. The outcome shall be noticed to all parties.
- (g) The determination under subparagraph (f) of this rule shall govern the remainder of the proceedings under 35 U.S.C. §311.
- (h) If the petition under this rule results in a change in, or addition to, the identity of the patent owner in the proceedings under 35 U.S.C. §311 and a patent owner is thereafter the same as a petitioner, proceedings with respect to each such petitioner shall be terminated *ab initio*. If other petitioners remain who are not the same as patent owner, the proceedings under 35 U.S.C. §311 may continue based on all the evidence of record. If no petitioners remain under this subparagraph, the proceedings under 35 U.S.C. §311 shall be terminated and notice of the termination of the proceeding shall be published in the Official Gazette.

#### **§41.307 Stay of proceedings pending outcome of derivation proceedings**

- (a) In the event that derivation proceedings under 35 U.S.C. §135 are pending concurrent with proceedings pursuant to an admissible petition requesting *inter partes* review, the Tribunal may stay the proceedings under 35 U.S.C. §311 until the derivation proceedings are terminated by a final decision in accordance with 35 U.S.C. §135(d) or settlement thereof in accordance with 35 U.S.C. §135(e). Publication of termination of derivation proceedings in the *Official Gazette* shall serve as constructive notice that the stay has been lifted.
- (b) The Tribunal shall notify the parties of the date on which the stay has been lifted and provide the parties with a reasonable time period, which shall be not less than one month, within which to request leave to amend submissions and file motions based on a change in circumstances resulting from the outcome of the derivation proceedings. The request for leave shall specify the change in circumstances due to the derivation proceedings and how the proposed amendment and/or motion is intended to address that change. Multiple parties may submit a joint request under this subparagraph.
- (c) The Tribunal shall provide an opportunity for parties who have not made, or joined in, a request for leave to oppose any requests for leave within a reasonable time

period, which shall not be less than one month. In the event that a request is opposed, each requester shall be given an opportunity to defend its request in writing within a reasonable time period, which shall not be less than one month.

- (d) After expiration of the time periods specified in the previous subparagraphs of this rule, the Tribunal shall determine whether or not to grant leave requested under subparagraph (b) of this rule and notify the parties regarding the outcome of the determination in view of all submissions by the parties. The Tribunal may reject a request for leave when the request is not reasonably related to a change in circumstances resulting from the outcome of the derivation proceedings or when grant of the request would more likely than not result in an abuse of process, unnecessary delay or unnecessary increase in the cost of the proceedings.
- (e) After the expiration of all time periods specified in the preceding paragraphs and subject to subparagraph (f) of this rule, the Tribunal shall reinstate the proceedings under 35 U.S.C. §311, provided that any unexpired time period for taking action under the rules governing proceedings under 35 U.S.C. §311 that is less than 1 month from the date on which the stay has been lifted under subparagraph (a) of this rule shall be automatically reset to a time period of 1 month.
- (f) If the patent owner is found to be the same as any petitioner due to the outcome of derivation proceedings, proceedings with respect to each such petitioner shall be terminated *ab initio*. If other petitioners remain who are not the same as patent owner, the proceedings under 35 U.S.C. §311 may continue based on all the evidence of record. If no petitioners remain under this subparagraph, the proceedings under 35 U.S.C. §311 shall be terminated and notice of the termination of the proceeding shall be published in the Official Gazette.

#### **§41.308 Concurrent proceedings**

- (a) In the event that multiple petitions for *inter partes* review are filed under 35 U.S.C. §311 with respect to the same patent, the Office shall determine admissibility of each petition in accordance with §41.303. For each admissible petition, the Board shall send the patent owner the invitation under §41.304 and the Office shall publish the petition in accordance with §41.305.
- (b) In the event that there are multiple admissible petitions for *inter partes* review pending prior to commencement of *inter partes* review, the Tribunal may stay proceedings in a later filed admissible petition for *inter partes* review pending the outcome of the earlier filed admissible petition for *inter partes* review or may merge the proceedings for *inter partes* review pertaining to the same patent.

- (c) In the event that post grant review proceedings, ex parte reexamination proceedings, supplemental examination or reissue proceedings are copending with an admissible *inter partes* review pertaining to the same patent, the Tribunal may stay one of the proceedings until one of the other proceedings is concluded or may merge two or more proceedings into one proceeding. In the event of merger of proceedings, the Tribunal shall advise the parties regarding the rules to be applied to the merged proceedings.
- (d) In the event that the Tribunal merges proceedings under a previous subparagraph of this rule, the Tribunal shall notify the parties regarding the expiration of time periods in the merged proceedings. Any time periods set in proceedings prior to merger shall be reset based on the date of notification of the decision to merge.
- (e) The rights of any petitioner in merged proceedings will be governed by the rules under which the petitioner filed its petition unless and until the Tribunal notifies petitioner otherwise.

#### **§41.309 Preliminary response**

- (a) After expiration of the six month time period following publication of the notice under §41.305 and the expiration of any other time periods set under §§41.306 to 41.308, the Office shall invite patent owner to file a preliminary response to the petition in accordance with 35 U.S.C. §313 setting forth reasons why no *inter partes* review should be instituted based upon the failure of the petition to meet any requirement of 35 U.S.C. §§311 to 315, including but not limited to failure to meet the threshold requirement of 35 U.S.C. §314(a).
- (b) The preliminary response shall:
  - (1) Identify the patent, each patent owner, and lead counsel appointed by patent owner, if any,
  - (2) Make reference to this rule in the caption,
  - (3) Set forth reasons why no *inter partes* review should be instituted based upon failure of the petition to meet any requirement of 35 U.S.C. 311 to 315 together with supporting evidence, if any,
  - (4) Certify that the preliminary response is filed on behalf of, and with the consent of, each patent owner identified in subparagraph (1) of this rule,
  - (5) Be signed by lead counsel or, if patent owner has not appointed lead counsel, each patent owner, and

- (6) Certify that the preliminary response was served on petitioner and any patent owner not joining the preliminary response.
- (c) The preliminary response shall comply with 37 CFR §41.300(a) and (b).
- (d) Amendments to the contested patent will not be entered or taken into consideration prior to commencement of *inter partes* review in accordance with 35 U.S.C. §314.

#### **§41.310 Threshold determination**

- (a) Within 3 months of the date on which patent owner timely filed a preliminary response under 37 CFR §41.309 or the expiration of the time period for filing the same, whichever time period expires earlier, the Tribunal shall make a determination of the threshold requirement under 35 U.S.C §314(a) based on the petition and any preliminary response.
- (b) In the event that the Tribunal determines that the threshold of 35 U.S.C. §314(a) has been met, the Tribunal shall prepare a written notice identifying each challenge to claims in the petition meeting the threshold requirement, advising the parties of the schedule provided in §41.311, and setting a date on which *inter partes* review shall commence, which date shall not be less than 3 months from the date of the notice. The notice shall be sent to each party and published in the *Official Gazette*. Publication in the *Official Gazette* shall serve as constructive notice to any party to the proceeding alleging lack of actual notice.
- (c) In the event that the Tribunal determines that there is no reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition, the Office shall prepare a written notification of the outcome. The notification shall be sent to the parties and published in the *Official Gazette*. The Office will thereafter refund 30% of the petition fee to each petitioner.

#### **§41.311 Conduct of *inter partes* review**

- (a) Patent owner may file a motion pursuant to §41.121 after the notice under §41.310(b) and on or before commencement of *inter partes* review addressing the grounds for challenging the claims. The motion may include proposed amendments to the patent, arguments regarding the patentability of the challenged claims or proposed amended claims, and evidence in support of patent owner arguments. The motion may request discovery under 37 CFR §41.150 with respect to evidence submitted by a petitioner, may request oral proceedings, and may request extension of the 1 year statutory time period for conducting *inter partes* review under 35

- U.S.C. §316(11). The motion shall certify that it has been served in its entirety on each petitioner.
- (b) If patent owner files a motion according to subparagraph (a) of this rule, each petitioner may file a motion pursuant to §41.121 opposing the patent owner motion. The motion in opposition may request discovery under 37 CFR §41.150 with respect to evidence submitted by patent owner, may request oral proceedings, and may request extension of the 1 year statutory time period for conducting *inter partes* review under 35 U.S.C. §316(11). Additional evidence will only be admissible at the Tribunal's discretion based on relevance to issues raised for the first time in the patent owner's motion, the interests of justice and procedural economy. Any motion in opposition under this subparagraph shall be filed in a time period expiring 3 months from the filing date of patent owner motion under subparagraph (a) of this rule. The motion shall certify that it has been served in its entirety on each patent owner.
- (c) After the date on which the last motion due under subparagraphs (a) and (b) of this rule was filed or, if no motion was filed, after commencement of *inter partes* review, the Tribunal shall notice its intent to schedule a conference with the parties to announce preliminary rulings on motions and discovery requests, schedule commencement and closure of discovery, prescribe the timing, nature and scope of discovery, schedule final motions, and schedule oral proceedings. The notice shall propose a date for the conference. Unless the parties propose an alternative date for the conference acceptable for the Tribunal within 10 business days after the date of the notice under this subparagraph, the parties shall be summoned to attend the conference on the proposed date.
- (d) The conference of subparagraph (c) of this rule shall be called to order by the Tribunal. The date of the conference and parties' representatives in attendance shall be recorded and the conference shall be held in a manner that all parties in attendance have simultaneous access to the discussion and each party has an opportunity to be heard on each subject of discussion prior to announcing the result of the same. Facilities shall be provided to allow parties to attend remotely via teleconferencing when a party or its representative cannot attend in person. Minutes of the conference shall be prepared by the Tribunal and distributed to all parties as soon as possible after the conference is adjourned.
- (e) Parties who choose not to attend the conference of subparagraph (d) shall be deemed to have waived its right to participate. Such parties shall be bound by the outcome of the conference.
- (f) The Tribunal may, in the interests of justice or to avoid unnecessary delay, order sanctions under 37 CFR§41.128 for failure to comply with any rulings made at the

conference and failure to comply with any rule pertaining to the conduct of the proceedings. The use of sanctions shall be preceded by a warning regarding the sanction to be applied and an opportunity to be heard and take corrective action.

#### **§41.312 Amendments to the contested patent**

- (a) Patent owner may propose amendments to the patent as of right upon commencement of *inter partes* review and only with leave from the Tribunal thereafter. The determination of whether amendments to the patent are admissible after commencement of *inter partes* review shall take into consideration whether the amendments address new arguments and evidence presented after commencement of *inter partes* review, the extent to which the amendments raise new issues or resolve ambiguities, and the overall economy of the proceedings.
- (b) Amendments to the patent shall address at least one ground upon which the patent has been challenged. Any proposed amendment that does not address a ground upon which the patent has been challenged may only be made with leave from the Tribunal.
- (c) Amendments to the patent shall comply with 35 U.S.C. §§112 and 135 and shall comply with the formal requirements of 37 CFR §1.530 applied by analogy.
- (d) Amendments to the patent may be submitted in the alternative. When submitting amendments in the alternative, patent owner shall present the amendments in all inclusive sets in the order in which patent owner intends to have them considered. The first set of amendments shall be captioned “Main Request” and any subsequent requests shall be captioned as subsidiary requests with an indication of their order, such as “First Subsidiary Request”, “Second Subsidiary Request”, “Third Subsidiary Request”, etc., or “Subsidiary Request 1”, “Subsidiary Request 2”, “Subsidiary Request 3”, etc. The patent owner must obtain leave of the Tribunal to obtain consideration of 10 or more subsidiary requests. Determination of whether to allow more than 10 subsidiary requests shall take into consideration the extent to which the additional request resolves pending issues and the timeliness of the request. Each request shall be self-contained and shall be referenced by the parties in any statements, motions and arguments filed in the proceedings or made during oral argument.

#### **§41.313 Citations and statements submitted under 35 U.S.C. §301**

- (a) The parties may request leave to rely on any citation of prior art or written statement filed under 35 U.S.C. §301 with respect to the contested patent during a time period up to and including the date set for closure of discovery under §41.311(d).

- (b) The request for leave shall certify under oath or declaration that the party submitting the request and its privies were not aware of the citation or the availability of the written statement prior to the date on which the 35 U.S.C. §301 submission was filed with the Office. The certification shall acknowledge that willful false statements are subject to sanctions under 37 CFR §41.128.

#### **§41.314 Determination of admissibility of evidence into the proceedings**

- (a) The parties may object to the admissibility of evidence submitted by another party to the proceedings under 37 CFR §41.155 in accordance with 37 CFR §41.152. An objection will not serve to exclude evidence unless the objection is preserved by serving a motion to exclude or motion in limine on the party seeking to introduce the challenged evidence within five business days of the date on which the objection was made.
- (b) The party served with a motion to exclude or motion in limine under subparagraph (a) of this rule may serve a motion opposing the motion to exclude or motion in limine on the moving party within five business days.
- (c) The moving party may serve a reply to the opposition to its motion within five business days.
- (d) The moving party and the opposing party shall file their respective motions with the Tribunal within 30 days of the date on which the motion to exclude or motion in limine was served on an adverse party.
- (e) The Tribunal shall rule on the motions filed and served under this rule and notify the parties of its rulings on or before the date on which the Tribunal invites the parties to submit final motions under §41.315.

#### **§41.315 Final motions**

- (a) The parties shall be provided with an opportunity to file final motions in the proceedings via a notification by the Tribunal. The notification shall set a time period for filing final motions, which shall not be less than one month from the date of notification. Final motions shall state which prior motions, grounds and requests are maintained by the respective parties and shall reference the arguments and evidence relied upon. Any further arguments shall be based on the evidence previously admitted into the proceedings.
- (b) Final motions may not rely on, or introduce, evidence not admitted into the proceedings as of the date of the Tribunal's invitation to submit final motions,

unless the parties mutually agree in writing to admission of additional evidence into the proceedings or the evidence became available for the first time via a submission under 35 U.S.C. §301 in accordance with §41.314.

- (c) Final motions shall confirm any request for oral proceedings. In the absence of confirmation, it will be assumed that the party no longer maintains its request for oral proceedings. In the event that a party confirms its request for oral proceedings, the party shall:
  - (1) Identify all persons who plan to attend the proceedings on behalf of that party.
  - (2) If necessary, request that the Tribunal order adverse party to produce certain witnesses or experts for cross-examination at the oral proceeding together with arguments and evidence to substantiate the request.
- (d) In the event that at least one party confirms a request for oral proceedings, the Tribunal shall send the parties a reminder of the date for oral proceedings at least one month prior to that date accompanied by optional preliminary comments concerning issues to be addressed at the oral proceedings. Unless specified otherwise, oral proceedings shall be scheduled for one day beginning at 9:00 a.m.
- (e) In the event that no party confirms a request for oral proceedings, the Tribunal shall notify the parties that the date for oral proceedings is cancelled due to lack of a standing request for the same and that any joint motion to terminate the proceedings due to settlement under 35 U.S.C. §318 shall be filed within a time period set by the Tribunal, which time period shall be not less than one month from the date of the notice.

#### **§41.316 Oral proceedings**

- (a) At the scheduled date and time for commencement of oral proceedings, the Tribunal shall call the hearing to order, establish who is present at the hearing, and establish who will speak on behalf of each party in attendance. A member of the Tribunal shall take minutes of the oral proceedings.
- (b) The Tribunal shall invite the parties to submit any motion under 35 U.S.C. §317. Any petitioner or patent owner may respond to the invitation by submitting a joint motion to terminate proceedings as between them under 35 U.S.C. §317(a) and a copy of the underlying agreement under 35 U.S.C. §317(b).
  - (1) In the event that the underlying agreement is confidential, the movants may move to treat the agreement as confidential under 35 U.S.C. §317(b) and

request that the agreement be considered in limine, which motion will normally be granted.

- (2) The Tribunal shall determine whether the motion satisfies the requirements of 35 U.S.C. §317. If necessary, the Tribunal may request confirmation of the authenticity of the underlying agreement.
  - (3) If the Tribunal grants the motion, the Tribunal shall record the same in the minutes and release each petitioner who joined the 35 U.S.C. §317 motion from participation in *inter partes* review. If there are no remaining petitioners, the Tribunal shall adjourn the oral proceedings without rendering any further rulings or decisions.
- (c) In the event that proceedings are not terminated under 35 U.S.C. §317 in accordance with subparagraph (b) of this rule, the Tribunal shall:
- (1) Announce the order in which issues will be addressed at the proceedings,
  - (2) request each party to confirm its requests or advise which requests are no longer maintained, and
  - (3) allow each party a reasonable period of time to present arguments, witnesses and expert testimony in response to each issue, which shall generally be limited to 20 minutes per presentation.

The party bearing the burden of proof shall generally be the first and last party to present arguments with respect to each issue to be decided. The parties and any witnesses or experts will only be permitted to speak when called upon by the Tribunal.

- (d) In the event that a party is accompanied by one or more witnesses or expert witnesses:
- (1) Each party shall be entitled to cross-examine an adverse party's witness or expert attending the hearing within the scope of testimony produced by direct examination of the same when it is that party's turn to speak. The party who produced the witness or expert may conduct redirect examination within the scope of cross-examination. Cross-examination after redirect examination shall be within the scope of redirect examination.
  - (2) The Tribunal may prescribe the time allotted for cross-examination and redirect examination and the number of cross-examination iterations.
  - (3) The Tribunal may ask any witness or expert attending oral proceedings to answer additional questions within the scope of cross-examination and may

order termination of cross-examination if, in the Tribunal's judgment, such testimony would be redundant or otherwise not necessary for resolving the issues to be decided.

- (e) The Tribunal shall announce its intention to rule on the issue to be decided and provide each party with an opportunity to withdraw one or more requests prior to announcing its ruling. In the event that petitioner withdraws its request for judgment on the issue in question, the Tribunal will record the withdrawal and proceed to the next issue on the agenda, if any. In the event that patent owner withdraws one or more requests under consideration, the Tribunal will record the withdrawal and continue the proceedings based on patent owner's next available subsequent subsidiary request.
- (f) For each issue for which the parties maintain their respective requests, the Tribunal shall call a recess, convene amongst themselves to determine its ruling, reconvene oral proceedings, announce its ruling on the issue, and proceed to the next issue on the agenda.
- (g) The oral proceedings shall continue until each party has been heard with respect to each and every contested issue maintained by the parties in accordance with the preceding subparagraphs.
- (h) Oral proceedings shall be administered by the Tribunal in a manner such that rulings are announced for all contested issues by no later than 5:00 p.m. on the same day. In the event that the Tribunal anticipates that oral proceedings will not be concluded by noon that day, the Tribunal may grant a 1 hour recess between 11:30 a.m. and 2:00 p.m. and shall grant a request for such a recess if requested by a party to the oral proceedings, provided that the request is made by a party when it is permitted to address the Tribunal.
- (i) When the condition of subparagraph (g) of this rule is met, the Tribunal shall announce the result of oral proceedings, announce that a written decision will follow and adjourn oral proceedings.

### §41.317 Request for joinder under 35 U.S.C. §316(c)

- (a) When a new petition for *inter partes* review of a patent is filed during *inter partes* review of the same patent, the petitioner(s) that filed the new petition may request joinder with the pending *inter partes* review. The time period for requesting joinder shall be from the date of filing the new petition until expiration of the time period for filing a preliminary response in response to the new petition specified in §41.309.
- (b) The request for joinder shall be made by each petitioner in a separate writing certifying under oath or declaration that petitioner is not a patent owner and that petitioner is not in privity with any petitioner in the pending *inter partes* review. The request under this subparagraph shall also acknowledge acceptance of the conditions specified in subparagraphs (c) to (e) of this rule.
- (c) Consideration of the request for joinder under subparagraph (b) shall be contingent on a determination by the Board that the third party's petition meets the threshold for instituting *inter partes* review under 35 U.S.C. §314(a). The Board shall determine whether or not to grant the request for joinder and will notify the requester prior to commencement of *inter partes* review based on the requestor's new petition. If the request for joinder is granted, each petitioner shall receive a 30% refund of the petition fee.
- (d) Upon grant of the request for joinder, the petitioner which filed the new petition will be joined with the petitioner(s) of the earlier pending *inter partes* review. The party joining the earlier pending *inter partes* review shall have the same rights and status as the petitioner(s) of the earlier pending *inter partes* review.
- (e) Time periods in the earlier pending *inter partes* review which expired prior to joinder shall not apply to the joined new party. The joined new party shall not be entitled to reconsideration of matters which were determined or decided prior to joinder.

### §41.318 Settlement

- (a) Unless provided otherwise in this Subpart, a petitioner and patent owner may file a joint motion for termination of *inter partes* review based on an agreement between petitioner and patent owner. At the request of the parties, the agreement shall be treated as business confidential.
- (b) Any agreement which is to be treated as confidential under 35 U.S.C. §317(b) shall be submitted separate from the joint motion under 35 U.S.C. §317(a) in an envelope marked "BUSINESS CONFIDENTIAL – DO NOT SCAN" and labeled to permit

identification of the envelope with the joint motion under 35 U.S.C. §317(a). The envelope shall contain a copy of the signed agreement having a cover sheet marked and labeled in the same manner as the envelope together with a copy of the joint motion.

- (c) If the joint motion and underlying agreement submitted under subparagraph (a) of this rule satisfy 35 U.S.C. §317, the Tribunal shall grant the motion and notify the movants accordingly.
- (d) If any petitioners remain after grant of a motion under subparagraph (c) of this rule, the remaining petitioners shall be notified regarding grant of the motion and shall be advised that they are entitled to rely on all arguments, grounds and evidence of record submitted by any petitioner who is no longer a party to the proceedings, provided that such evidence is not protected from disclosure to the remaining parties.
- (e) If grant of a joint motion to terminate proceedings under subparagraph (c) of this rule results in termination of *inter partes* review with respect to all petitioners who are parties to the proceedings at the time of grant, the proceedings shall be dismissed without issuance of a final written decision under §41.321. Notification of termination of the proceedings under 35 U.S.C. §317 shall be published in the *Official Gazette*.

#### **§41.319 Failure to file a timely**

- (a) When a party files an untimely, inappropriate or incomplete petition, request, motion, opposing motion or reply to an opposing motion or fails to timely serve other parties to the proceedings, the Tribunal may refuse consideration of the same in the proceedings with respect to the purpose for which they were submitted.
- (b) The Tribunal may exceptionally consider an untimely filed or served petition, request, motion, opposing motion or reply to an opposing motion when the party submits a petition under 37 CFR 1.182 and fee presenting clear and convincing admissible evidence showing that the delay was unavoidable due to circumstances beyond the party's control and when entry of the petition, request, motion, opposing motion or reply to an opposing motion may be made without violating the applicable statutory provisions and without unduly prejudicing any other party to the proceedings.
- (b) Evidence and admissions against interest in, or accompanying, an untimely petition, request, motion, opposing motion or reply to an opposing motion may be taken into consideration when relied upon by any party adverse to the party who submitted the

same regardless of whether or not the Tribunal refuses consideration under subparagraph (a) of this rule.

#### **§41.320 Transfer of real party in interest status**

- (a) Participation in proceedings under 35 U.S.C. §311 may not be transferred to another party unless the transfer is part of a transaction involving the transfer of the entire business, or business unit, of the real party in interest identified in the petition which formed the basis for considering that party a real party in interest.
- (b) When the entire business, or business unit, of the real party in interest on which the real party in interest status is based is transferred to another party, petitioner shall diligently file and serve a motion requesting transfer of real party status based on evidence showing the nature of the transfer and the relationship between the transferred assets and real party in interest status. The motion may be opposed by another party to the proceedings under 35 U.S.C. §311 by filing and serving a counter-motion within 10 business days from the date of service. A reply to the counter-motion shall be filed and served within 5 business days of service of the counter-motion.
- (c) The Tribunal shall decide whether to grant or deny the motion under subparagraph (b) of this rule within one month of the date on which the motion was served on all the parties based on the preponderance of the evidence standard.
- (d) In the event of a delay between transfer of the business and recognition of the transfer as a transfer of status as a real party in interest in the proceedings, the Tribunal may require that the transferee ratify the actions of the transferor taken in the interim as a condition for recognition of the transfer.

#### **§41.321 Final written decision and certificate**

- (a) When *inter partes* review is instituted and not dismissed under this Subpart, the Tribunal shall issue a final decision to the parties within a time period specified in 35 U.S.C. §316(a)(11) with respect to the patentability of each and every claim challenged by the petitioner(s) and any new claim added pursuant to 35 U.S.C. §316(d). The decision shall provide an opinion explaining the basis for its conclusions. Notice of the decision shall be published in the *Official Gazette*.
- (b) In the event that the time period for filing an appeal against the decision under 35 U.S.C. §319 expires without a timely appeal or an appeal from the decision, if any, has terminated, the Office shall issue and publish a certificate in accordance with 35 U.S.C. §318(b). The certificate shall be mailed to the patent owner(s) and a copy of

the certificate will be mailed to each petitioner. Notification of the certificate shall published in the *Official Gazette*.



## SUBPART G – POST-GRANT REVIEW

### §41.400 Procedure

- (a) An post-grant review is a contested case subject to the procedures set forth in subpart D of this part, except that 37 CFR §§41.102 and 41.150(b)(i) shall not apply.
- (b) The procedures under 37 CFR §§41.110 to 41.153 and 41.155 to 41.158 are not applicable prior to commencement of post-grant review.
- (c) Institution of post-grant review shall be determined and noticed by the Board.
- (d) Post-grant review shall be administered by the Board such that pendency before the Board is normally no longer than one year after the date on which the Board notices the institution of a review.

### §41.401 Definitions

In addition to the definitions in 37 CFR 41.2 [*to be amended*] and 41.100, the following definitions apply under this subpart:

*Patent* means an enforceable granted U.S. patent, and any reissue or reexamination thereof, contested via a petition for post-grant review.

*Contested patent* means a *patent* challenged under 35 U.S.C. §321.

*Patent owner* means each and every beneficial owner and title holder of a *contested patent* as indicated by the Office's Official records of assignment. Patent owner may be a sole owner or the owner of a partial interest in the patent.

*Petition* means a document or documents filed with the Office requesting institution of post-grant review of a *patent* under 35 U.S.C. §321.

*Petitioner* means a party who submits a *petition*.

*Lead counsel* means legal counsel admitted to practice before the U.S. PTO appointed by one or more parties for representation in post-grant review proceedings in accordance with 37 CFR §41.108.

*Real party in interest* means a party having a legitimate business interest in the outcome of the proceedings on the date that the *petition* is filed.

*Tribunal* means a three-member panel assigned to administer and decide the outcome of proceedings under 35 U.S.C. §321 with respect to a *contested patent*.

#### **§41.402 Petition for post-grant review**

- (a) Petitioner shall submit a petition in accordance with 35 U.S.C. §§321 and 322(a) which, in accordance with and further to the requirements of 35 U.S.C. §322(a), shall:
- (1) Identify the petitioner, and any lead counsel representing the same, by full legal name and address.
  - (2) Request post-grant review under 35 U.S.C. §321.
  - (3) Identify one, and only one, patent by U.S. patent number or reissue number.
  - (4) Provide a statement under 35 U.S.C. §322(a)(3) identifying with particularity each patent claim challenged and explaining, for each claim challenged, the grounds on which the challenge to each claim is based and the evidence that supports the grounds for the challenge to each claim.
  - (5) Provide copies of all evidence on which petitioner intends to rely on to challenge one or more claims in the patent, including all evidence referenced in the statement of preceding subparagraph (4). Such evidence shall be presented in accordance with 37 CFR §41.154 and shall be provided without restriction on public availability. Evidence in a language other than English shall be accompanied by a certified English translation of the same.
  - (6) Provide a statement identifying each and every real party in interest to the extent necessary for third parties to determine whether that person is a privy.
  - (7) Provide a statement identifying each and every U.S. civil court proceeding and each and every proceeding under 35 U.S.C. §§135, 311 and 321 in which petitioner or its privy was, or is, a party to the proceedings wherein the patent identified in subparagraph (b)(2) of this rule was the subject of the proceeding or stating that petitioner and its privies have not been a party to such proceedings.
  - (8) Certify that petitioner is not an owner of the contested patent or privy with any undisclosed real party in interest and that petitioner and any lead counsel will not represent the interests of patent owner or any undisclosed real party in interest throughout the pendency of post-grant review of the contested patent.
  - (9) Certify that 35 U.S.C. §325(a)(1), (e)(1) and (f) do not prohibit post-grant review.
  - (10) Be signed by petitioner or lead counsel appointed by petitioner.

(11) Certify that a copy of the petition as prescribed in preceding subparagraphs (1) to (10) has been served in its entirety on each patent owner at the address provided for in 37 CFR §1.33(c)[*to be amended to include* post-grant review]. The name and address of the party served must be indicated.

(b) The petition shall be accompanied by the petition fee required under 37 CFR §1.[*to be determined*].

### **§41.403 Formal admissibility review**

- (a) The Director shall check whether the petition contains parts conforming to the formal requirements of subparagraphs (1) to (11) of 37 CFR §41.402(a) and whether the petition fee of 37 CFR §41.402(b) has been paid. In the event that the petition is incomplete or the petition fee is unpaid, the Director shall notify petitioner in writing and set a one-month time period for response.
- (b) Any response to a notification under subparagraph (a) of this rule must be in writing and shall certify that the response has been served on the patent owner in accordance with §41.402(a)(11).
- (c) If petitioner fails to submit an unpaid petition fee or fails to file and serve on patent owner a response to the notification, including any missing or incomplete part of the petition noticed under subparagraph (a) of this rule, within the time period set by the notice, the parties shall be notified in writing that the petition is inadmissible. Any petition fee paid shall be refunded to the petitioner reduced by the processing fee authorized under 37 CFR §1.21(m).
- (c) If petitioner timely submits any unpaid petition fee and files a response to the notice, including all noticed missing parts, within the time period set by the notice of subparagraph (a) of this rule, the Director will notify the parties that the petition is formally admissible and will be made available to the public via the PALM system upon publication of a notice of the petition for post-grant review in the *Official Gazette*.
- (d) The date on which the petition is formally admissible shall be the date of commencement of pendency of the proceedings under 35 U.S.C. §321 for the purpose of determining compliance with 35 U.S.C. §321(c) and copendency under §§41.408.
- (e) Subject to subparagraph (f), the notice to patent owner that the petition is formally admissible shall be accompanied by an invitation according to §41.404.

- (f) In the event that the date on which the petition is formally admissible does not comply with 35 U.S.C. §321(c), the Office shall notify the petitioner and invite the petitioner to request conversion of the request for post-grant review to a request for *inter partes* review setting a period of 1 month for reply.
- (1) If the petitioner fails to timely accept the invitation, the petition shall be rejected as untimely and any petition fee paid will be refunded to the petitioner reduced by the processing fee authorized under 37 CFR §1.21(m).
  - (2) Grant of a request for conversion shall make the petition subject to the statute and rules for *inter partes* review. Upon conversion, all references to post-grant review shall retroactively be interpreted to mean *inter partes* review.
  - (3) After conversion, the petitioner shall receive the invitation under §41.304.

**§41.404 Notice inviting patent owner to participate in the proceedings**

- (a) When a petition under 35 U.S.C. §321 is admitted under §41.403, the Office shall send a written invitation to patent owner at the address provided for in 37 CFR §1.33(c) requesting post-grant review of the contested patent and requesting that the patent owner:
- (1) identify each and every owner of the contested patent or confirm that it is the sole owner of the contested patent,
  - (2) provide the name and address of lead counsel appointed to represent patent owner in the post-grant review proceedings, together with an appropriate power of attorney, or provide a statement that lead counsel has not been appointed,
  - (3) if lead counsel has not been appointed, provide the name, address, and any additional contact details for one person to whom notices and correspondence relating to the review proceedings should be sent,
  - (4) certify that a copy of the reply has been served in its entirety on petitioner.
- (b) The invitation shall advise patent owner that any preliminary response to the petition under 35 U.S.C. §323 must be submitted within a time period to be noticed after expiration of 6 months from the date of publication of notice of the petition for post-grant review according to §41.405 and that submission prior to that time period will be deemed inadmissible.

#### **§41.405 Publication**

- (a) A notice of an admissible petition for post-grant review shall be published in the *Official Gazette*. The notice shall include the patent number, any reissue number, the name of the petitioner, the name of each real party in interest, and the name of the party served with the petition.
- (b) The entire petition, correspondence with the Office relating to the proceedings, and any evidence submitted to the Office in accordance with 35 U.S.C. §301 shall be made available to the public electronically via the public PALM system as of the date on which notice of the petition is published in the *Official Gazette*.
- (c) The parties shall be notified of third party submissions within one month of receipt thereof. Such notifications may direct the parties to information made available via the public PALM system in lieu of providing copies thereof.

#### **§41.406 Intervention by nonserved patent owner**

- (a) Within a 3 month time period commencing with publication of the notice of a request for post-grant review in the *Official Gazette* under §41.405, any person or legal entity may file a petition requesting recognition of that person or legal entity as a, or the, true owner of the contested patent.
- (b) A petition filed under subparagraph (a) of this rule shall:
  - (1) Identify the contested patent,
  - (2) Make reference to this rule in the caption,
  - (3) Provide documentary evidence supporting the claim of true ownership in accordance with 37 CFR §§41.154,
  - (4) Be signed by lead counsel appointed by petitioner or, if petitioner has not appointed lead counsel, each petitioner, and
  - (5) Certify that the petition has been served on the petitioner requesting post-grant review and the parties served with the petition for post-grant review.
- (c) The petition under this rule shall be accompanied by the fee prescribed under 37 CFR 1.17(f) for petitions under 37 CFR §1.182.
- (d) The Office shall determine the formal admissibility of the petition under this rule. In the event that the petition fee has not been paid or a formal requirement is not met, the Office shall notify the petitioner under this rule that the petition is rejected as inadmissible for reasons stated in the notice. In the event that the petition fee has

been paid and the petition meets that formal requirements of this rule, the Office shall forward the petition to the parties and notify the parties of record that the facts alleged in the petition will be presumed true unless jointly contested by the parties of record via a motion under subparagraph (e) of this rule within a time period of one month from the date of the notice.

- (e) The patent owner of record and petitioner may file a joint motion under 37 CFR §1.121 within the time period specified in subparagraph (d) of this rule objecting to recognition of the petitioner under subparagraph (a) of this rule as a, or the, patent owner and requesting suspension of proceedings pending resolution of the dispute. In the absence of evidence that the motion is an abuse of procedure, the Tribunal may grant the motion and set a reasonable time period for suspension of proceedings, which may be extended for just cause. The parties of record shall file and serve evidence regarding resolution of the patent ownership dispute prior to expiration of the stay.
- (f) The Office will determine the outcome of the petition under this rule upon recommencement of proceedings based on the facts alleged in the petition, the information recorded in the Office's assignment records and any evidence submitted by the parties. The outcome shall be noticed to all parties.
- (g) The determination under subparagraph (f) of this rule shall govern the remainder of the proceedings under 35 U.S.C. §321.
- (h) If the petition under this rule results in a change in, or addition to, the identity of the patent owner in the proceedings under 35 U.S.C. §321 and a patent owner is thereafter the same as a petitioner, proceedings with respect to each such petitioner shall be terminated *ab initio*. If other petitioners remain who are not the same as patent owner, the proceedings under 35 U.S.C. §321 may continue based on all the evidence of record. If no petitioners remain under this subparagraph, the proceedings under 35 U.S.C. §321 shall be terminated and notice of the termination of the proceeding shall be published in the Official Gazette.

**§41.407 Stay of proceedings pending outcome of derivation proceedings**

- (a) In the event that derivation proceedings under 35 U.S.C. §135 are pending concurrent with proceedings pursuant to an admissible petition requesting post-grant review, the Tribunal may stay the proceedings under 35 U.S.C. §321 until the derivation proceedings are terminated by a final decision in accordance with 35 U.S.C. §135(d) or settlement thereof in accordance with 35 U.S.C. §135(e). Publication of termination of derivation proceedings in the *Official Gazette* shall serve as constructive notice that the stay has been lifted.
- (b) The Tribunal shall notify the parties of the date on which the stay has been lifted and provide the parties with a reasonable time period, which shall be not less than one month, within which to request leave to amend submissions and file motions based on a change in circumstances resulting from the outcome of the derivation proceedings. The request for leave shall specify the change in circumstances due to the derivation proceedings and how the proposed amendment and/or motion is intended to address that change. Multiple parties may submit a joint request under this subparagraph.
- (c) The Tribunal shall provide an opportunity for parties who have not made, or joined in, a request for leave to oppose any requests for leave within a reasonable time period, which shall not be less than one month. In the event that a request is opposed, each requester shall be given an opportunity to defend its request in writing within a reasonable time period, which shall not be less than one month.
- (d) After expiration of the time periods specified in the previous subparagraphs of this rule, the Tribunal shall determine whether or not to grant leave requested under subparagraph (b) of this rule and notify the parties regarding the outcome of the determination in view of all submissions by the parties. The Tribunal may reject a request for leave when the request is not reasonably related to a change in circumstances resulting from the outcome of the derivation proceedings or when grant of the request would more likely than not result in an abuse of process, unnecessary delay or unnecessary increase in the cost of the proceedings.
- (e) After the expiration of all time periods specified in the preceding paragraphs and subject to subparagraph (f) of this rule, the Tribunal shall reinstate the proceedings under 35 U.S.C. §321, provided that any unexpired time period for taking action under the rules governing proceedings under 35 U.S.C. §321 that is less than 1 month from the date on which the stay has been lifted under subparagraph (a) of this rule shall be automatically reset to a time period of 1 month.
- (f) If the patent owner is found to be the same as any petitioner due to the outcome of derivation proceedings, proceedings with respect to each such petitioner shall be

terminated *ab initio*. If other petitioners remain who are not the same as patent owner, the proceedings under 35 U.S.C. §321 may continue based on all the evidence of record. If no petitioners remain under this subparagraph, the proceedings under 35 U.S.C. §321 shall be terminated and notice of the termination of the proceeding shall be published in the Official Gazette.

#### **§41.408 Concurrent proceedings**

- (a) In the event that multiple petitions for post-grant review are filed under 35 U.S.C. §321 with respect to the same patent, the Office shall determine admissibility of each petition in accordance with §41.403. For each admissible petition, the Board shall send the patent owner the invitation under §41.404 and the Office shall publish the petition in accordance with §41.405.
- (b) In the event that there are multiple admissible petitions for post-grant review pending prior to commencement of post-grant review, the Tribunal may merge the proceedings for post-grant review pertaining to the same patent.
- (c) In the event that post grant review proceedings, ex parte reexamination proceedings, supplemental examination or reissue proceedings are copending with an admissible post-grant review pertaining to the same patent, the Tribunal may stay one of the proceedings until one of the other proceedings is concluded or merge two or more proceedings into one proceeding. In the event of merger of proceedings, the Tribunal shall advise the parties regarding the rules to be applied to the merged proceedings.
- (d) In the event that the Tribunal merges proceedings under a previous subparagraph of this rule, the Tribunal shall notify the parties regarding the expiration of time periods in the merged proceedings. Any time periods set in proceedings prior to merger shall be reset based on the date of notification of the decision to merge.
- (e) The rights of any petitioner in merged proceedings will be governed by the rules under which the petitioner filed its petition unless and until the Tribunal notifies petitioner otherwise.

#### **§41.409 Preliminary response**

- (a) After expiration of the six month time period following publication of the notice under §41.405 and the expiration of any other time periods set under §§41.406 to 41.408, the Office shall invite patent owner to file a preliminary response to the petition in accordance with 35 U.S.C. §323 setting forth reasons why no post-grant review should be instituted based upon the failure of the petition to meet any

requirement of 35 U.S.C. §§321 to 325, including but not limited to failure to meet the threshold requirement of 35 U.S.C. §324(a).

- (b) The preliminary response shall:
  - (1) Identify the patent, each patent owner, and lead counsel appointed by patent owner, if any,
  - (2) Make reference to this rule in the caption,
  - (3) Set forth reasons why no post-grant review should be instituted based upon failure of the petition to meet any requirement of 35 U.S.C. 321 to 325 together with supporting evidence, if any,
  - (4) Certify that the preliminary response is filed on behalf of, and with the consent of, each patent owner identified in subparagraph (1) of this rule,
  - (5) Be signed by lead counsel or, if patent owner has not appointed lead counsel, each patent owner, and
  - (6) Certify that the preliminary response was served on petitioner and any patent owner not joining the preliminary response.
- (c) The preliminary response shall comply with 37 CFR §41.400(a) and (b).
- (d) Amendments to the contested patent will not be entered or taken into consideration prior to commencement of post-grant review in accordance with 35 U.S.C. §324.

#### **§41.410 Threshold determination**

- (a) Within 3 months of the date on which patent owner timely filed a preliminary response under 37 CFR §41.409 or the expiration of the time period for filing the same, whichever time period expires earlier, the Tribunal shall make a determination of the threshold requirements under 35 U.S.C §324(a) and (b) based on the petition and any preliminary response.
- (b) In the event that the Tribunal determines that the threshold of 35 U.S.C. §324(a) or (b) has been met, the Tribunal shall prepare a written notice identifying each challenge to claims in the petition and/or each novel or unsettled legal question meeting the threshold requirement, advising the parties of the schedule provided in §41.411, and setting a date on which post-grant review shall commence, which date shall not be less than 3 months from the date of the notice. The notice shall be sent to each party and published in the *Official Gazette*. Publication in the *Official*

*Gazette* shall serve as constructive notice to any party to the proceeding alleging lack of actual notice.

- (c) In the event that the Tribunal determines that there is no reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition or with respect to a novel or unsettled legal question, the Office shall prepare a written notification of the outcome. The notification shall be sent to the parties and published in the *Official Gazette*. The Office will thereafter refund 30% of the petition fee to each petitioner.

#### **§41.411 Conduct of post-grant review**

- (a) Patent owner may file a motion pursuant to §41.121 after the notice under §41.410(b) and on or before commencement of post-grant review addressing the grounds for challenging the claims. The motion may include proposed amendments to the patent, arguments regarding the patentability of the challenged claims or proposed amended claims, and evidence in support of patent owner arguments. The motion may request discovery under 37 CFR §41.150 with respect to evidence submitted by a petitioner, may request oral proceedings, and may request extension of the 1 year statutory time period for conducting post-grant review under 35 U.S.C. §326(11). The motion shall certify that it has been served in its entirety on each petitioner.
- (b) If patent owner files a motion according to subparagraph (a) of this rule, each petitioner may file a motion pursuant to §41.121 opposing the patent owner motion. The motion in opposition may request discovery under 37 CFR §41.150 with respect to evidence submitted by patent owner, may request oral proceedings, and may request extension of the 1 year statutory time period for conducting post-grant review under 35 U.S.C. §326(11). Additional evidence will only be admissible at the Tribunal's discretion based on relevance to issues raised for the first time in the patent owner's motion, the interests of justice and procedural economy. Any motion in opposition under this subparagraph shall be filed in a time period expiring 3 months from the filing date of patent owner motion under subparagraph (a) of this rule. The motion shall certify that it has been served in its entirety on each patent owner.
- (c) After the date on which the last motion due under subparagraphs (a) and (b) of this rule was filed or, if no motion was filed, after commencement of post-grant review, the Tribunal shall notice its intent to schedule a conference with the parties to announce preliminary rulings on motions and discovery requests, schedule commencement and closure of discovery, prescribe the timing, nature and scope of discovery, schedule final motions, and schedule oral proceedings. The notice shall

propose a date for the conference. Unless the parties propose an alternative date for the conference acceptable for the Tribunal within 10 business days after the date of the notice under this subparagraph, the parties shall be summoned to attend the conference on the proposed date.

- (d) The conference of subparagraph (c) of this rule shall be called to order by the Tribunal. The date of the conference and parties' representatives in attendance shall be recorded and the conference shall be held in a manner that all parties in attendance have simultaneous access to the discussion and each party has an opportunity to be heard on each subject of discussion prior to announcing the result of the same. Facilities shall be provided to allow parties to attend remotely via teleconferencing when a party or its representative cannot attend in person. Minutes of the conference shall be prepared by the Tribunal and distributed to all parties as soon as possible after the conference is adjourned.
- (e) Parties who choose not to attend the conference of subparagraph (d) shall be deemed to have waived its right to participate. Such parties shall be bound by the outcome of the conference.
- (f) The Tribunal may, in the interests of justice or to avoid unnecessary delay, order sanctions under 37 CFR§41.128 for failure to comply with any rulings made at the conference and failure to comply with any rule pertaining to the conduct of the proceedings. The use of sanctions shall be preceded by a warning regarding the sanction to be applied and an opportunity to be heard and take corrective action.

#### **§41.412 Amendments to the contested patent**

- (a) Patent owner may propose amendments to the patent as of right upon commencement of post-grant review and only with leave from the Tribunal thereafter. The determination of whether amendments to the patent are admissible after commencement of post-grant review shall take into consideration whether the amendments address new arguments and evidence presented after commencement of post-grant review, the extent to which the amendments raise new issues or resolve ambiguities, and the overall economy of the proceedings.
- (b) Amendments to the patent shall address at least one ground upon which the patent has been challenged. Any proposed amendment that does not address a ground upon which the patent has been challenged may only be made with leave from the Tribunal.
- (c) Amendments to the patent shall comply with 35 U.S.C. §§112 and 135 and shall comply with the formal requirements of 37 CFR §1.530 applied by analogy.

- (d) Amendments to the patent may be submitted in the alternative. When submitting amendments in the alternative, patent owner shall present the amendments in all inclusive sets in the order in which patent owner intends to have them considered. The first set of amendments shall be captioned “Main Request” and any subsequent requests shall be captioned as subsidiary requests with an indication of their order, such as “First Subsidiary Request”, “Second Subsidiary Request”, “Third Subsidiary Request”, etc., or “Subsidiary Request 1”, “Subsidiary Request 2”, “Subsidiary Request 3”, etc. The patent owner must obtain leave of the Tribunal to obtain consideration of 10 or more subsidiary requests. Determination of whether to allow more than 10 subsidiary requests shall take into consideration the extent to which the additional request resolves pending issues and the timeliness of the request. Each request shall be self-contained and shall be referenced by the parties in any statements, motions and arguments filed in the proceedings or made during oral argument.

#### **§41.413 Citations and statements submitted under 35 U.S.C. §301**

- (a) The parties may request leave to rely on any citation of prior art or written statement filed under 35 U.S.C. §301 with respect to the contested patent during a time period up to and including the date set for closure of discovery under §41.411(d).
- (b) The request for leave shall certify under oath or declaration that the party submitting the request and its privies were not aware of the citation or the availability of the written statement prior to the date on which the 35 U.S.C. §301 submission was filed with the Office. The certification shall acknowledge that willful false statements are subject to sanctions under 37 CFR §41.128.

#### **§41.414 Determination of admissibility of evidence into the proceedings**

- (a) The parties may object to the admissibility of evidence submitted by another party to the proceedings under 37 CFR §41.155 in accordance with 37 CFR §41.152. An objection will not serve to exclude evidence unless the objection is preserved by serving a motion to exclude or motion in limine on the party seeking to introduce the challenged evidence within five business days of the date on which the objection was made.
- (b) The party served with a motion to exclude or motion in limine under subparagraph (a) of this rule may serve a motion opposing the motion to exclude or motion in limine on the moving party within five business days.
- (c) The moving party may serve a reply to the opposition to its motion within five business days.

- (d) The moving party and the opposing party shall file their respective motions with the Tribunal within 30 days of the date on which the motion to exclude or motion in limine was served on an adverse party.
- (e) The Tribunal shall rule on the motions filed and served under this rule and notify the parties of its rulings on or before the date on which the Tribunal invites the parties to submit final motions under §41.415.

#### **§41.415 Final motions**

- (a) The parties shall be provided with an opportunity to file final motions in the proceedings via a notification by the Tribunal. The notification shall set a time period for filing final motions, which shall not be less than one month from the date of notification. Final motions shall state which prior motions, grounds and requests are maintained by the respective parties and shall reference the arguments and evidence relied upon.
- (b) Final motions may not rely on, or introduce, evidence not admitted into the proceedings as of the date of the Tribunal's invitation to submit final motions, unless the parties mutually agree in writing to admission of additional evidence into the proceedings.
- (c) Final motions shall confirm any request for oral proceedings. In the absence of confirmation, it will be assumed that the party no longer maintains its request for oral proceedings. In the event that a party confirms its request for oral proceedings, the party shall:
  - (1) Identify all persons who plan to attend the proceedings on behalf of that party.
  - (2) If necessary, request that the Tribunal order adverse party to produce certain witnesses or experts for cross-examination at the oral proceeding together with arguments and evidence to substantiate the request.
- (d) In the event that at least one party confirms a request for oral proceedings, the Tribunal shall send the parties a summons to oral proceedings at least one month prior to the date set for oral proceedings accompanied by any order to produce witnesses and/or experts for cross-examination and optional preliminary comments concerning issues to be addressed at the oral proceedings. Unless specified otherwise, oral proceedings shall be scheduled for one day beginning at 9:00 a.m.
- (e) In the event that no party confirms a request for oral proceedings, the Tribunal shall notify the parties that the date for oral proceedings is cancelled due to lack of a standing request for the same and that any joint motion to terminate the proceedings

due to settlement under 35 U.S.C. §328 shall be filed within a time period set by the Tribunal, which time period shall be not less than one month from the date of the notice.

#### **§41.416 Oral proceedings**

- (a) At the scheduled date and time for commencement of oral proceedings, the Tribunal shall call the hearing to order, establish who is present at the hearing, and establish who will speak on behalf of each party in attendance. A member of the Tribunal shall take minutes of the oral proceedings.
- (b) The Tribunal shall invite the parties to submit any motion under 35 U.S.C. §327. Any petitioner or patent owner may respond to the invitation by submitting a joint motion to terminate proceedings as between them under 35 U.S.C. §327(a) and a copy of the underlying agreement under 35 U.S.C. §327(b).
  - (1) The Tribunal shall determine whether the motion satisfies the requirements of 35 U.S.C. §327. If necessary, the Tribunal may request confirmation of the authenticity of the underlying agreement.
  - (2) In the event that the underlying agreement is confidential, the movants may move to treat the agreement as business confidential under 35 U.S.C. §327(b), which motion will normally be granted.
  - (3) If the Tribunal grants the motion, the Tribunal shall record the same in the minutes and release each petitioner who joined the 35 U.S.C. §327 motion from participation in post-grant review. If there are no remaining petitioners, the Tribunal shall adjourn the oral proceedings without rendering any further rulings or decisions.
- (c) In the event that proceedings are not terminated under 35 U.S.C. §327 in accordance with subparagraph (b) of this rule, the Tribunal shall:
  - (1) Announce the order in which issues will be addressed at the proceedings,
  - (2) invite each party to confirm its requests or advise which requests are no longer maintained, and
  - (3) allow each party a reasonable period of time to present arguments, witnesses and expert testimony in response to each issue, which shall generally be limited to 20 minutes per presentation unless the Tribunal specifies otherwise.

The party bearing the burden of proof shall generally be the first and last party to present arguments with respect to each issue to be decided. The parties and any

witnesses or experts will only be permitted to speak when called upon by the Tribunal.

- (d) In the event that a party is accompanied by one or more witnesses or experts:
- (1) Each party shall be entitled to cross-examine an adverse party's witness or expert attending the hearing within the scope of testimony produced by direct examination of the same when it is that party's turn to speak. The party who produced the witness or expert may conduct redirect examination within the scope of cross-examination. Any further cross-examination after redirect examination shall be within the scope of redirect examination.
  - (2) The Tribunal may prescribe the time allotted for cross-examination and redirect examination and the number of cross-examination or redirect iterations.
  - (3) The Tribunal may ask any witness or expert attending oral proceedings to answer questions within the scope of cross-examination.
  - (4) The Tribunal may order termination of cross-examination if, in the Tribunal's judgment, further testimony would be redundant or otherwise not necessary for resolving the issues to be decided.
- (e) The Tribunal shall announce its intention to rule on each issue to be decided and provide each party with an opportunity to withdraw one or more requests prior to announcing its ruling. In the event that petitioner withdraws its request for judgment on the issue in question, the Tribunal will record the withdrawal and proceed to the next issue on the agenda, if any. In the event that patent owner withdraws one or more requests under consideration, the Tribunal will record the withdrawal and continue the proceedings based on patent owner's subsequent subsidiary request.
- (f) For each issue for which the parties maintain their respective requests, the Tribunal shall call a brief recess, determine its ruling, reconvene oral proceedings, announce its ruling on the issue, and proceed to the next issue on the agenda.
- (g) The oral proceedings shall continue until each party has been heard with respect to each and every contested issue maintained by the parties in accordance with the preceding subparagraphs.
- (h) Oral proceedings shall be administered by the Tribunal in a manner such that rulings are announced for all contested issues by no later than 5:00 p.m. on the same day. The Tribunal may grant recesses and suspensions of oral proceedings as it deems appropriate.

- (i) When the condition of subparagraph (g) of this rule is met, the Tribunal shall announce the result of oral proceedings, announce that a written decision will follow and adjourn oral proceedings.

#### **§41.417 Request for joinder under 35 U.S.C. §326(c)**

- (a) When a new petition for post-grant review of a patent is filed during post-grant review of the same patent, the petitioner(s) that filed the new petition may request joinder with the pending post-grant review. The time period for requesting joinder shall be from the date of filing the new petition until expiration of the time period for filing a preliminary response in response to the new petition specified in §41.409.
- (b) The request for joinder shall be made by each new petitioner in a separate writing certifying under oath or declaration that petitioner is not a patent owner and that petitioner is not in privity with any petitioner in the pending post-grant review. The request under this subparagraph shall also acknowledge acceptance of the conditions specified in subparagraphs (c) to (e) of this rule.
- (c) Consideration of the request for joinder under subparagraph (b) shall be contingent on a determination by the Board that the third party's petition meets the threshold for instituting post-grant review under 35 U.S.C. §324(a) or (b). The Board shall determine whether or not to grant the request for joinder and will notify the requester prior to commencement of post-grant review based on the requestor's new petition. If the request for joinder is granted, each petitioner shall receive a 30% refund of the petition fee.
- (d) Upon grant of the request for joinder, the petitioner which filed the new petition will be joined with the petitioner(s) of the earlier pending post-grant review. The party joining the earlier pending post-grant review shall have the same rights and status as the petitioner(s) of the earlier pending post-grant review.
- (e) Time periods in the earlier earlier pending post-grant review which expired prior to joinder shall not apply to the joined new party. The joined new party shall not be entitled to reconsideration of matters which were determined or decided prior to joinder.

#### **§41.418 Settlement**

- (a) Unless provided otherwise in this Subpart, a petitioner and patent owner may file a joint motion for termination of post-grant review based on an agreement between

petitioner and patent owner. At the request of the parties, the agreement shall be treated as business confidential.

- (b) Any agreement which is to be treated as confidential under 35 U.S.C. §327(b) shall be submitted separate from the joint motion under 35 U.S.C. §327(a) in an envelope marked “BUSINESS CONFIDENTIAL – DO NOT SCAN” and labeled to permit identification of the envelope with the joint motion under 35 U.S.C. §327(a). The envelope shall contain a copy of the signed agreement having a cover sheet marked and labeled in the same manner as the envelope together with a copy of the joint motion.
- (c) If the joint motion and underlying agreement submitted under subparagraph (a) of this rule satisfy 35 U.S.C. §327, the Tribunal shall grant the motion and notify the movants accordingly.
- (d) If any petitioners remain after grant of a motion under subparagraph (c) of this rule, the remaining petitioners shall be notified regarding grant of the motion and shall be advised that they are entitled to rely on all arguments, grounds and evidence of record submitted by any petitioner who is no longer a party to the proceedings, provided that such evidence is not protected from disclosure to the remaining parties.
- (e) If grant of a joint motion to terminate proceedings under subparagraph (c) of this rule results in termination of post-grant review with respect to all petitioners who are parties to the proceedings at the time of grant, the proceedings shall be dismissed without issuance of a final written decision under §41.421. Notification of termination of the proceedings under 35 U.S.C. §327 shall be published in the *Official Gazette*.

#### **§41.419 Failure to file a timely**

- (a) When a party files an untimely, inappropriate or incomplete petition, request, motion, opposing motion or reply to an opposing motion or fails to timely serve other parties to the proceedings, the Tribunal may refuse consideration of the same in the proceedings with respect to the purpose for which they were submitted.
- (b) The Tribunal may exceptionally consider an untimely filed or served petition, request, motion, opposing motion or reply to an opposing motion when the party submits a petition under 37 CFR 1.182 and fee presenting clear and convincing admissible evidence showing that the delay was unavoidable due to circumstances beyond the party’s control and when entry of the petition, request, motion, opposing motion or reply to an opposing motion may be made without violating the

applicable statutory provisions and without unduly prejudicing any other party to the proceedings.

- (b) Evidence and admissions against interest in, or accompanying, an untimely petition, request, motion, opposing motion or reply to an opposing motion may be taken into consideration when relied upon by any party adverse to the party who submitted the same regardless of whether or not the Tribunal refuses consideration under subparagraph (a) of this rule.

#### **§41.420 Transfer of real party in interest status**

- (a) Participation in proceedings under 35 U.S.C. §321 may not be transferred to another party unless the transfer is part of a transaction involving the transfer of the entire business, or business unit, of the real party in interest identified in the petition which formed the basis for considering that party a real party in interest.
- (b) When the entire business, or business unit, of the real party in interest on which the real party in interest status is based is transferred to another party, petitioner shall diligently file and serve a motion requesting transfer of real party status based on evidence showing the nature of the transfer and the relationship between the transferred assets and real party in interest status. The motion may be opposed by another party to the proceedings under 35 U.S.C. §321 by filing and serving a counter-motion within 10 business days from the date of service. A reply to the counter-motion shall be filed and served within 5 business days of service of the counter-motion.
- (c) The Tribunal shall decide whether to grant or deny the motion under subparagraph (b) of this rule within one month of the date on which the motion was served on all the parties based on the preponderance of the evidence standard.
- (d) In the event of a delay between transfer of the business and recognition of the transfer as a transfer of status as a real party in interest in the proceedings, the Tribunal may require that the transferee ratify the actions of the transferor taken in the interim as a condition for recognition of the transfer.

#### **§41.421 Final written decision and certificate**

- (a) When post-grant review is instituted and not dismissed under this Subpart, the Tribunal shall issue a final decision to the parties within a time period specified in 35 U.S.C. §326(a)(11) with respect to the patentability of each and every claim challenged by the petitioner(s) and any new claim added pursuant to 35 U.S.C. §326(d) and with respect to each and every legal question addressed under 35

U.S.C. §324(b). The decision shall provide an opinion explaining the basis for its conclusions. Notice of the decision shall be published in the *Official Gazette*.

- (b) In the event that the time period for filing an appeal against the decision under 35 U.S.C. §329 expires without a timely appeal or an appeal from the decision, if any, has terminated, the Office shall issue and publish a certificate in accordance with 35 U.S.C. §328(b). The certificate shall be mailed to the patent owner(s) and a copy of the certificate will be mailed to each petitioner. Notification of the certificate shall be published in the *Official Gazette*.