

IP HOT TOPIC

CONNECT:  [Contact Us](#)

 [Visit our Website](#)

[Download PDF](#)

USPTO RELEASES A SECOND UPDATE TO THE PTAB TRIAL PRACTICE GUIDE

July 29, 2019

By: [Pratibha Khanduri, Ph.D.](#) and [Jon E. Wright](#)

On July 15, 2019, the USPTO released a [second update](#) to Trial Practice Guide for AIA proceedings. The 64-page update reflects some of the recent opinions that the Board has designated as precedential and includes helpful guidelines. We list below the notable topics in the update.

- 1. Multiple petitions challenging the same patent filed at or about the same time.** The updated guide states that one petition should be sufficient to challenge a patent in most situations. But, in certain situations when multiple petitions are necessary, the guide instructs the petitioner to 1) rank the petitions in the order in which the Board should consider the merits; and 2) provide a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should institute additional petitions. In response, the patent owner may explain why the Board should not institute multiple petitions. These explanations may be included in the petition or patent owner preliminary response, or in a separate 5-page paper filed with the petition or preliminary response.
- 2. Testimonial evidence submitted with the patent owner preliminary response.** The updated guide sets forth guidelines for testimonial evidence submitted with a patent owner preliminary response. Since 2016, a patent owner may submit testimonial evidence with its preliminary response. The updated guide now allows the patent owner to affirmatively withdraw any testimony submitted with the preliminary response if the trial is instituted. If the patent owner withdraws the testimony, the declarant is usually not subject to deposition on the withdrawn declaration. If, however, the patent owner does not withdraw the testimony, the declaration may be relied upon during the trial and the declarant will usually be subject to discovery and deposition.
- 3. Additional discovery.** The updated guide sets forth factors that the Board may consider in deciding additional discovery requests. It also recognizes different standards for granting additional discovery: the “interest of justice” standard in an IPR and derivation proceeding, versus the “slightly more liberal ‘good cause’” standard in a PGR and CBM proceeding.
- 4. Remand procedures.** The updated guide details the procedure on remand and sets forth a goal of issuing decisions on remand within six months of receiving the Federal Circuit’s mandate. For example, the guide notes that an oral hearing will not be authorized in most cases; encourages the parties to set up a conference call with the

Board within ten days after the Federal Circuit issues the mandate; and stresses that, absent good cause, a proceeding on remand generally will not be stayed even when a party appeals to the Supreme Court.

5. **Claim construction.** As of November 13, 2018, the Board has shifted the claim construction standard applied in IPRs, PGRs, and CBMs from “broadest reasonable interpretation” to the standard used by Article III federal courts and the ITC (*Phillips* standard). The updated guide reflects this change and details the procedure for raising claim construction arguments. For example, the guide requires the petitioner who believes a claim term needs express construction to include a statement in the petition identifying the proposed construction along with any supporting evidence. Alternatively, the petitioner may, but is not required to, include a statement that the claim terms require no express construction. The patent owner may then respond to the petitioner’s positions and/or propose additional terms for construction, with corresponding statements on construction and supporting evidence. In reply, the petitioner may respond to new construction issues raised by the patent owner, but cannot raise a new issue that was not previously raised in the petition. While offering an express construction is generally optional, it is mandatory when the claim language may be construed under 35 U.S.C. § 112(f), as required under 37 C.F.R. § 42.104. If the Board raises a claim construction issue *sua sponte*, both parties will be afforded an opportunity to respond before a final written decision is issued. The updated guide also notes that the Board will consider a prior claim construction determination from a district court or the ITC if it is timely made of record.

In addition to the above topics, the updated guide details motion to amend procedure, including the new [Pilot Program](#) issued on March 15, 2019; discusses factors the Board may consider when determining whether to grant a motion for joinder; provides guidelines on motions to seal and entry of protective orders, including procedure for requesting a modified protective order; and includes guidance regarding court reporters on conference calls with the Board and live testimony during oral hearing.

For more information, please contact:



Pratibha Khanduri, Ph.D.

Associate

pkhanduri@sternekessler.com



Jon E. Wright

Director

jwright@sternekessler.com

The information contained in this IP hot topic is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this IP hot topic is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2019 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

Technical Minds. Legal Muscle.