**Rich Inn of Court**

**Program 1: Patent Trial and Appeal Board**

**September 16, 2015**

**PROGRAM MATERIALS**



**Topic 1: Patent Owner Preliminary Response & Submission of New Testimonial Evidence**

*Proposed Rule 42.107(a):* The patent owner may file a preliminary response to the petition. The response may set forth the reasons why no *inter partes* review should be instituted under 35 U.S.C. 314 and can include supporting evidence. The preliminary response is subject to the word count under
§ 42.24.

*Proposed Rule 42.108(c):* *Inter partes* review shall not be instituted for a ground of unpatentability unless the Board decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable. The Board's decision will take into account a patent owner preliminary response where such a response is filed, but supporting evidence concerning disputed material facts will be viewed in the light most favorable to the petitioner for purposes of deciding whether to institute an *inter partes* review. If the patent owner submits supporting evidence with its preliminary response, the petitioner may seek leave to file a reply to the preliminary response in accordance with § 42.24(c).

**Topic 2: Claim Construction Standard**

*Proposed Rule 42.300(b):* A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.

**Topic 3: What’s Not in the Proposed Rules**

Claim amendment practice: to be developed through PTAB decisions

* Idle Free Systems, Inc. v. Bergstrom, Inc., IPR2012-00027, Paper 26, June 11, 2013
* MasterImage 3D, Inc. v. RealD Inc., IPR2015-00040, Order re Motion to Amend, Paper 42,
July 15, 2015