**Rich Inn of Court**

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

**September 16, 2015**

**AGENDA**

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| **Time** | **Topic** | **Speaker** |
| 6:15 pm | Welcome | Judge Richard Taranto |
| 6:30 pm | Program Introduction | Janet Gongola |
| 6:35 pm | Honored Guest Remarks | Russ Slifer |
| 6:45 pm | Discussion of Proposed  AIA Trial Rules | Panelists |

**6:45 to 6:50: Overview of AIA Rulemaking and Status of Trial Usage—Scott Boalick**

**6:50 to 7:00 pm: Patent Owner Preliminary Response & New Testimonial Evidence—Steve Baughman**

*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).

*Discussion Questions:*

1. A lot of the discussion we see in connection with this proposed rule seems to focus on trying to balance a Patent Owner’s ability to frame a robust substantive argument for the threshold decision of whether to institute trial, on the one hand, and two different groups of competing concerns on the other: first, issues about Petitioner’s ability to challenge (or at least address) new evidence that may be considered in this non-reviewable institution decision, and, second, concerns about creating what might resemble an extra “trial” before the trial.  If a Patent Owner’s submission might lead (with leave from the Board) to a Petitioner reply brief – maybe even with the possibility of submitting reply evidence in appropriate cases – and this might be followed by further requests from the Patent Owner, is there a worry about where it is all likely to end?  How much is enough, and how much is too much?  Even if this can be managed on a case-by-case basis, what would this change do to costs to the parties and burdens on the Board, given the focus on providing an efficient and less expensive alternative to district court litigation?
2. Over time – at events like this, in road shows, and so on – we’ve heard both practitioners and Board judges suggest that Patent Owner’s should not try to “do everything” in their preliminary response. The proposed new rules expand the scope of what a Patent Owner can submit in connection with its preliminary response, but they also indicate that (as proposed) questions of fact that are material to the institution decision will be resolved in favor of the petitioner. (The rule proposal indicates this is, among other things, to preserve the petitioner’s right to challenge statements made by the Patent Owner’s declarant.)  What does this suggest to you about what – and how much – a patent owner should be trying to accomplish in a preliminary response?

**7:00 to 7:10 pm: Claim Construction Standard—Grace Obermann**

*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.

*Discussion Questions:*

1. How difficult may it be for a petitioner to ascertain, prior to filing a petition, the likely date of patent expiration and the likely date of final decision?  Should the Board require a petitioner, who believes that the patent will expire prior to issuance of the final decision, to address both the *Phillips*-type and BRI approach in the petition, or state that either approach yields the same result?
2. Why shouldn’t the rule also apply to unexpired patents subject to a terminal disclaimer prior to final decision?  Is there a workable solution that would allow a Patent Owner unilaterally to forego any opportunity to amend, and thereby “opt-in” to a *Phillips*-type construction?  What solution would allow a petitioner adequate time to amend the petition to reflect the different claim construction?

**7:10 to 7:20 pm: What’s Not in the Proposed Rules—Scott McKeown**

Claim amendment practice: to be developed through PTAB decisions

*Discussion Questions:*

1. Will the changes in the motion page count (quick fix), appendix usage and necessary showings (informative opinions) result in more motions to amend being filed in FY 2016?
2. Given the motion requirement that amendments distinguish over “prior art known to the patent owner,” what should patentees be doing to ensure that they are satisfying their Duty of Candor?
   1. Is PTAB amendment practice an invitation to an inequitable conduct charge?