



THE GILES S. RICH AMERICAN INN OF COURT

October 5, 2014
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September 2014 Meeting Recap

The first meeting of the 2014-2015 Giles S. Rich American Inn of Court was held on Wednesday, September 10, 2014, at the U.S. Court of Appeals for the Federal Circuit. The program presented, in a debate format, the America Invents Act (AIA) trials conducted by the Patent Trial and Appeal Board (PTAB). The presentation was moderated by Janet Gongola of the U.S. Patent and Trademark Office (USPTO). Acting PTAB AIA Trial Section Vice Chief Judge Scott Boalick and Lead Judge Susan Mitchell lead four topics debated by fellow panelists Erika Arner of Finnegan Henderson, Karl Renner of Fish & Richardson, Drew Sommer of Winston & Strawn, and Jon Wright of Sterne Kessler. The four AIA trial topics encompassed: the claim construction standard; discovery options; treatment of concurrent USPTO proceedings; and appealable issues. The panelists argued competing views on these topics and with audience members asking following up questions and ultimately voting on which side of the panel was most persuasive and should be of note to the PTAB.

The regular meeting was preceded by a gathering of new Inn members, including associates, pupils, and law clerks. Judge Richard Linn introduced new members to a brief history and the purpose of the American Inns of Court, the Giles Rich Inn, and the recent formation of the Linn Inn Alliance for IP.

President Raj Gupta opened the inaugural meeting by welcoming current and new members and reminding those in attendance of the importance of the Inn's mentoring program; a request was made for anyone interested in registering for the program as a mentor or mentee to complete an application or contact the mentoring chair, Adam Shartzter.



Judge Richard Linn, Giles Rich Inn President Raj Gupta (center), and new 2014-15 Inn members.



Current Giles Rich Inn President Raj Gupta presenting immediate past Inn President Kevin McCabe with a framed copy of the Giles. S. Rich American Inn of Court Charter (L-R).

Mr. Gupta then handed over the presentation to moderator Janet Gongola. Ms. Gongola introduced the panelists, provided the audience with their backgrounds and disclosed that their positions in the debate to follow did not necessarily represent their own or those of their respective organizations.

The presentation began with Ms. Gongola reviewing the AIA trial timeline, which illustrated the balance between expedited proceedings and the ability of each side to effectively respond and seek adequate discovery.

The first topic examined claim construction procedure and pendency during *inter partes* and post grant review. The debate focused on the merits of regulations requiring that a claim in an unexpired patent be given its broadest reasonable construction in light of the specification of the patent in which it occurs. Following a spirited discussion, the audience voted in favor of keeping the “broad construction” language, rejecting the purported advantages of narrower interpretation.

The second topic covered discovery in AIA proceedings, specifically: mandatory initial disclosure, limited discovery, and additional discovery. The panel discussed how AIA proceedings before the PTAB rely on either mandatory initial discovery agreements between parties or discovery by motion. In addition, discovery is limited to agreements between the parties unless it is routine or otherwise in the interest of justice (with the exception of post grant reviews where it must be related to previous factual assertions by either party). The panelists advanced arguments in favor and against the merits of so limiting discovery in *inter partes* and post-grant proceedings. Inn members voted overwhelmingly to adhere to limited discovery in the interests of efficiency.



Members of Pupilage Group One who presented the evening's topic.

The third topic covered management of AIA trials, specifically the topics of joinder (separation versus consolidation) of multiple concurrent related proceedings in both *inter partes* and post grant reviews into one proceeding, who may request such action, and the specific authorities granted to the USPTO to do so. Inn members strongly supported the consolidation of proceedings and voted in favor of such actions after hearing arguments in favor and against.

Due to time constraints, the fourth topic covering appealable issues was not debated. However, Inn members were treated to an in-depth discussion of new AIA proceedings before the PTAB and were afforded the opportunity to pose follow-up questions to the panelists on their positions prior to each audience vote.

Following the program, Inn members proceeded to a reception at the Tayloe House. We would like to thank our terrific guest panelists and Pupilage Group No. 1 setting up an informative presentation and discussion.

We look forward to seeing you at the next meeting of the Giles S. Rich American Inn of Court, to be held jointly with the Pauline Newman Inn at the U.S. Court of Appeals for the Federal Circuit on Wednesday, October 15, 2014. The topic will be *Alice and Section 101*.

Summary by Inn Co-Historian/Reporter Jeremiah J. Cottle and photographs courtesy of Co-Historian/Reporter Charles Rones.