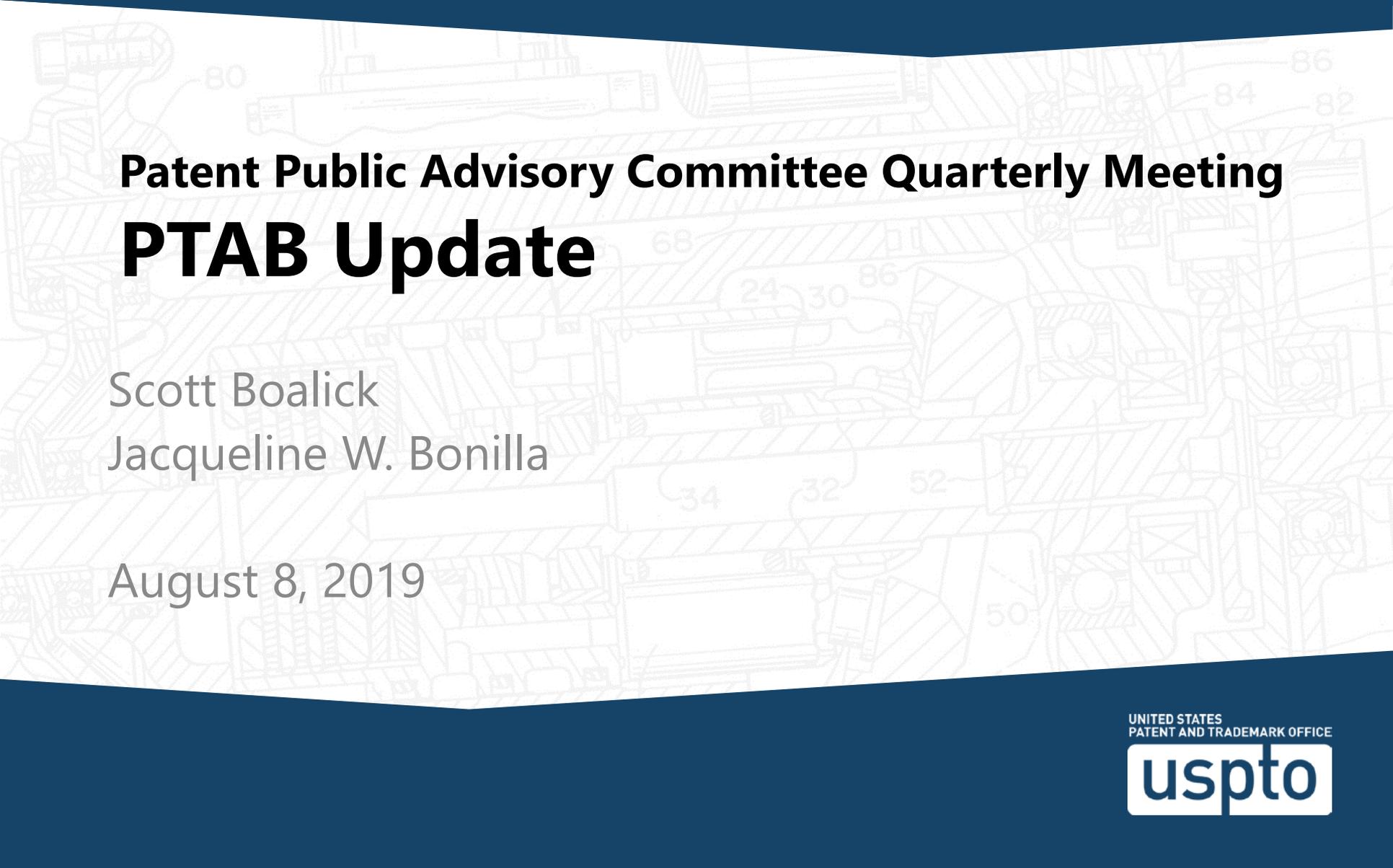


**UNITED STATES
PATENT AND TRADEMARK OFFICE**





Patent Public Advisory Committee Quarterly Meeting **PTAB Update**

Scott Boalick
Jacqueline W. Bonilla

August 8, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- POP cases
- Ratification decisions
- MTA Pilot Program status
- Updates

POP cases

Standard operating procedure 2

September 2018 update

- Provides new Precedential Opinion Panel (POP) for creating binding Board precedent on rehearing
- Provides notice to the parties when POP review takes place, as well as the identification of the POP members in a particular case
- Explains the standards, procedures, and timing for requesting POP review in a pending case on rehearing
- Provides for designation and de-designation of precedential opinions by the Director

Standard Operating Procedure 2



uspto UNITED STATES PATENT AND TRADEMARK OFFICE

About Us Jobs Contact Us MyUSPTO

Search uspto.gov

Patents Trademarks IP Policy Learning and Resources Find It Fast

Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board

Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.

Resources and guidance



Policies, procedures, rules, guides, tools and manuals associated with proceedings before the Patent Trial and Appeal Boards.

[Expand all](#) | [Collapse all](#)

> Appeals

> Trials

> Reexams and interferences

> Standard operating procedures

- [SOP 1 \(rev. 15\): Assignment of judges to panels](#) (20 Sept 2018)
- [SOP 2 \(rev. 10\): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure](#) (20 Sept 2018)
- [SOP 9 \(rev. 1\): Procedure for Decisions Remanded from the Federal Circuit](#)

> Guidance

> Statutes, rules, and references

> Rulemaking

> FAQs



Precedential Opinion Panel (POP)

- Outlined in PTAB standard operating procedure 2 (SOP2), available at <https://go.usa.gov/xPMqxx>
- Criteria:
 - Constitutional questions
 - Important questions regarding statutes, rules, regulations
 - Important issues regarding precedential case law
 - Issues of broad applicability to Board
 - Resolve conflicts between Board decisions
 - Promote certainty and consistency

Precedential Opinion Panel (POP)

- Default composition
 - Director
 - Commissioner for Patents
 - PTAB Chief Judge
- Issued first decision on March 13, 2019
 - *Proppant Express Investments v. Oren Technologies*, Case IPR2018-00914 (PTAB Mar. 13, 2019) (Paper 38)

POP decisions and orders

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Decided
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2018-00914, Paper 38	AIA - Joinder - 315(c)	Decided (POP)	3/13/2019

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Order Issued
<i>Hulu, LLC v. Sound View Innovations, LLC</i>	IPR2018-01039, Paper 15	AIA - Printed Publications	Pending (POP)	4/3/2019
<i>GoPro, Inc. v. 360Heros, Inc.</i>	IPR2018-01754, Paper 23	AIA - Time Bar - 315(b)	Pending (POP)	5/10/2019

Hulu, LLC v. Sound View Innovations, LLC

IPR2018-01039 (PTAB Apr. 3, 2019) (Paper 15)

- Precedential Opinion Panel (POP) ordered review to address the following issue:
 - What is required for a petitioner to establish that an asserted reference qualifies as “printed publication” at the institution stage?
- Oral hearing held on June 18, 2019.

GoPro, Inc. v. 360Heros, Inc.

IPR2018-01754 (PTAB May 10, 2019) (Paper 23)

- Precedential Opinion Panel (POP) ordered review to address the following issue:
 - Whether the service of a pleading asserting a claim alleging infringement, where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the 1 year time period for a petitioner to file a petition under 35 U.S.C. § 315(b).
- Oral hearing held on June 25, 2019.

Ratification decisions

Recent precedential and informative decisions

Precedential decisions (11)

- AIA - RPI - 312(a)(2), 315(b) (2)
- AIA - RPI - 322(a)(2) (1)
- AIA - Institution - 314(a) (1)
- AIA - Institution - 314(a), 325(d) (1)
- AIA - MTA - 316(d) (2)
- AIA - Oral Argument (2)
- AIA - Request for Rehearing (1)
- AIA - Witness Testimony (1)

Informative decisions (7)

- 101 (5)
- AIA - Institution - 314(a) (2)

Recent decisions designated precedential

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2017-01917, Paper 86	AIA - RPI - 312(a)(2), 315(b)	2/13/2019	4/16/2019
<i>Ventex Co., Ltd v. Columbia Sportswear North America, Inc.</i>	IPR2017-00651, Paper 152	AIA - RPI - 312(a)(2), 315(b)	1/24/2019	4/16/2019
<i>Adello Biologics LLC v. Amgen Inc.</i>	PGR2019-00001, Paper 11	AIA - RPI - 322(a)(2)	2/14/2019	4/16/2019
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i>	IPR2019-00062, -00063, -00084, Paper 11	AIA - Institution - 314(a)	4/2/2019	5/7/2019
<i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i>	IPR2018-00752 , Paper 8	AIA - Institution - 314(a), 325(d)	9/12/2018	5/7/2019
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i>	IPR2018-01129, -01130, Paper 15	AIA - MTA - 316(d)	2/25/2019	3/7/2019
<i>Amazon.com, Inc. v. Uniloc Luxembourg S.A.</i>	IPR2017-00948, Paper 34	AIA - MTA - 316(d)	1/18/2019	3/18/2019



Recent decisions designated precedential (cont.)

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>DePuy Synthes Prods., Inc. v. MEDIDEA, L.L.C.</i>	IPR2018-00315, Paper 29	AIA - Oral Argument	1/23/2019	3/18/2019
<i>K-40 Elecs., LLC v. Escort, Inc.</i>	IPR2013-00203, Paper 34	AIA - Oral Argument	5/21/2014	3/18/2019
<i>Huawei Device Co., Ltd. v. Optis Wireless Tech., LLC</i>	IPR2018-00816, Paper 19	AIA - Request for Rehearing	1/8/2019	4/5/2019
<i>Focal Therapeutics, Inc. v. SenoRx, Inc.</i>	IPR2014-00116, Paper 19	AIA - Witness Testimony	7/21/2014	7/10/2019



Valve Corp. v. Elec. Scripting Prods., Inc.

IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (Precedential)

- Designated precedential on May 7, 2019.
- Denied institution of *inter partes* review after applying the *General Plastic* factors.
- Explained that the Board's application of the *General Plastic* factors is not limited to instances when multiple petitions are filed by the same petitioner.
- When different petitioners challenge the same patent, the Board considers any relationship between those petitioners when weighing the *General Plastic* factors.

NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.

IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (Precedential)

- Designated precedential on May 7, 2019.
- Denied institution under 35 U.S.C. § 325(d) after applying *Becton, Dickinson* factors.
- Denied institution under 35 U.S.C. § 314(a) after determining that instituting review would be an inefficient use of Board resources where:
 - District court proceeding was nearing final stages, and
 - Board proceeding would involve:
 - same claim construction standard as in district court,
 - same prior art references as in district court, and
 - same arguments as in district court.



Focal Therapeutics, Inc. v. SenoRx, Inc.

IPR2014-00116 (PTAB July 21, 2014) (Paper 19) (Precedential)

- Designated precedential on July 10, 2019.
- Clarified the Board's Testimony Guidelines set forth in the Patent Trial Practice Guide at 77 Fed. Reg. 48756, 48772-48773 (Aug. 14, 2012) that provides:
 - *Once the cross-examination of a witness has commenced, and until cross-examination of the witness has concluded, counsel offering the witness on direct examination shall not: (a) consult or confer with the witness regarding the substance of the witness' testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a Board order; or (b) suggest to the witness the manner in which any questions should be answered.*
- Clarified that the prohibition of conferring with the witness ends once cross-examination concludes, and, if relevant, begins again when re-cross commences, and continues until re-cross concludes.



Recent decisions designated informative

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Deeper, UAB v. Vexilar, Inc.</i>	IPR2018-01310, Paper 7	AIA - Institution - 314(a)	1/24/2019	4/5/2019
<i>Chevron Oronite Company LLC v. Infineum USA L.P.</i>	IPR2018-00923, Paper 9	AIA - Institution - 314(a)	11/7/2018	4/5/2019
<i>Ex Parte Smith</i>	Appeal 2018-000064	101	2/1/2019	3/19/2019
<i>Ex Parte Olson</i>	Appeal 2017-006489	101	3/25/2019	7/1/2019
<i>Ex Parte Kimizuka</i>	Appeal 2018-001081	101	5/15/2019	7/1/2019
<i>Ex Parte Savescu</i>	Appeal 2018-003174	101	4/1/2019	7/1/2019
<i>Ex Parte Fautz</i>	Appeal 2019-000106	101	5/15/2019	7/1/2019

Ex Parte Olson

Appeal 2017-006489 (PTAB Mar. 25, 2019) (Informative)

- Designated informative on July 1, 2019.
- Applied the revised guidance published in the USPTO's January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*.
- Concluded that the claims recite a judicial exception, a mathematical concept, but that the claims recite additional elements that integrate the judicial exception into a practical application.

Ex Parte Kimizuka

Appeal 2018-001081 (PTAB May 15, 2019) (Informative)

- Designated informative on July 1, 2019.
- Applied the revised guidance published in the USPTO's January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*.
- Concluded that the claims recite a judicial exception, a mental process, and determined that the claims do not integrate the exception into a practical application or provide an inventive concept.

Ex Parte Savescu

Appeal 2018-003174 (PTAB Apr. 1, 2019) (Informative)

- Designated informative on July 1, 2019.
- Applied the revised guidance published in the USPTO's January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*.
- Concluded that the claims recite a judicial exception, a method of organizing human activity, and determined that the claims do not integrate the exception into a practical application or provide an inventive concept.

Ex Parte Fautz

Appeal 2019-000106 (PTAB May 15, 2019) (Informative)

- Designated informative on July 1, 2019.
- Applied the revised guidance published in the USPTO's January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*.
- Concluded that the claims recite a judicial exception, a mathematical concept, but that the claims recite additional elements that integrate the judicial exception into a practical application.

PTAB decisions

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions>

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

About Us | Jobs | Contact Us | MyUSPTO

Search uspto.gov

Patents | Trademarks | IP Policy | Learning and Resources | Find It Fast

Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board

Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.

Trials
Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.

Appeals
Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.

Decisions
Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.

Resources and guidance
Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.

Statistics
View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.

About PTAB
Discover the history of the PTAB and map out its modern structure and mission.

Trial Practice Guide July 2019 Update **NEW**

Notice regarding options for amendments through reissues or reexaminations **NEW**

New Pilot Program Concerning Motions to Amend **NEW**

Claim Construction Final Rule **NEW**

SOP 1 (rev. 15): Assignment of judges to panels **NEW**

SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure **NEW**

Decisions

Links to all public, final decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.

[Precedential and informative decisions](#)

Representative AIA trial orders, decisions, and notices

Search AIA-related cases

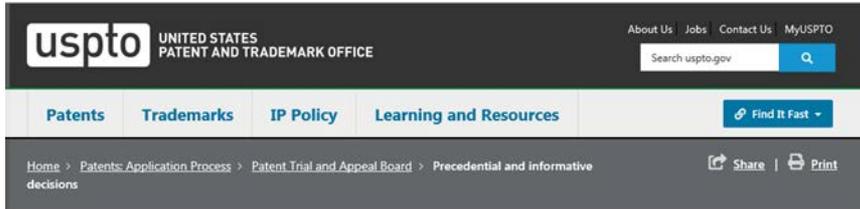
Search PTAB Final Decisions



NOTE: Some material listed on this page may require a [plug-in or viewer](#).

Precedential and informative decisions

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>



The header of the USPTO website features the logo on the left, navigation links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO' on the right, and a search bar. Below this is a secondary navigation bar with categories: 'Patents', 'Trademarks', 'IP Policy', 'Learning and Resources', and a 'Find It Fast' button. A breadcrumb trail at the bottom of the header reads: 'Home > Patents: Application Process > Patent Trial and Appeal Board > Precedential and informative decisions'. There are also 'Share' and 'Print' icons.

Decisions

Precedential and informative opinions

Representative AIA trial orders, decisions, and notices

Search final decisions

Search/browse the proceedings

Precedential and informative decisions

All PTAB precedential and informative decisions organized by subject matter are presented in the expandable table below. Archived decisions include those decisions that are not pertinent to or less pertinent to current PTAB practice. Links to alphabetical lists of the precedential and informative decisions are available at the bottom of this page. PTAB has retired the Excel workbooks that formerly contained all PTAB precedential and informative decisions.

* Recently designated decisions appear in the "Recently designated decisions" section of the expandable table and are identified in the appropriate subject matter section(s) with the label **NEW**

[Expand all](#) | [Collapse all](#)

> Recently designated decisions

- > Patent eligibility - 35 U.S.C. § 101
- > Anticipation - 35 U.S.C. § 102
- > Obviousness - 35 U.S.C. § 103
- > Specification and claim requirements - 35 U.S.C. § 112
- > Plant patents - 35 U.S.C. § 161
- > Reissue - 35 U.S.C. § 251
- > Claim construction
- > Issue preclusion
- > Non-functional descriptive material
- > Expert testimony
- > Expanded panels



MTA Pilot Program status

Request for comment on proposed changes to motion to amend (MTA) practice in AIA trials

- October 29, 2018 motion to amend (MTA) request for comments (RFC)
 - Proposed a new MTA process and pilot program
 - Sought input regarding burden of persuasion when determining patentability of substitute claims, after *Aqua Products*
 - Included 17 questions of interest, but also solicited feedback regarding MTA practice generally
- Office received 49 comments from stakeholders (as of Dec. 21, 2018)
- Office carefully considered all comments and revised pilot program in response

MTA pilot program notice

- In response to comments, the office issued a notice regarding a new pilot program concerning MTA practice and procedures in AIA trials.
- Published in Federal Register at [84 Fed. Reg. 9497 \(March 15, 2019\)](#)
- Notice also provides responses to comments
 - Topics include timelines, retroactivity of applying pilot, Board preliminary decision, opportunity to file a revised MTA, contingent MTAs, and opting-out of pilot
 - Comments also included requests for clarification regarding existing reissue and reexamination procedures at the USPTO
 - Stakeholder comments to October MTA RFC are available at <https://go.usa.gov/xEXS2>



Highlights of MTA pilot program

- New program provides patent owner (PO) with two options not previously available:
 1. PO may choose to receive preliminary guidance (PG) from Board on its MTA.
 2. PO may choose to file a revised MTA after receiving petitioner's opposition to initial MTA and/or after receiving Board's PG (if requested).

Highlights of MTA pilot program

- If PO does not elect either option:

AIA trial practice, including MTA procedure, is essentially unchanged from prior practice, especially regarding timing of due dates for already existing papers in an AIA trial

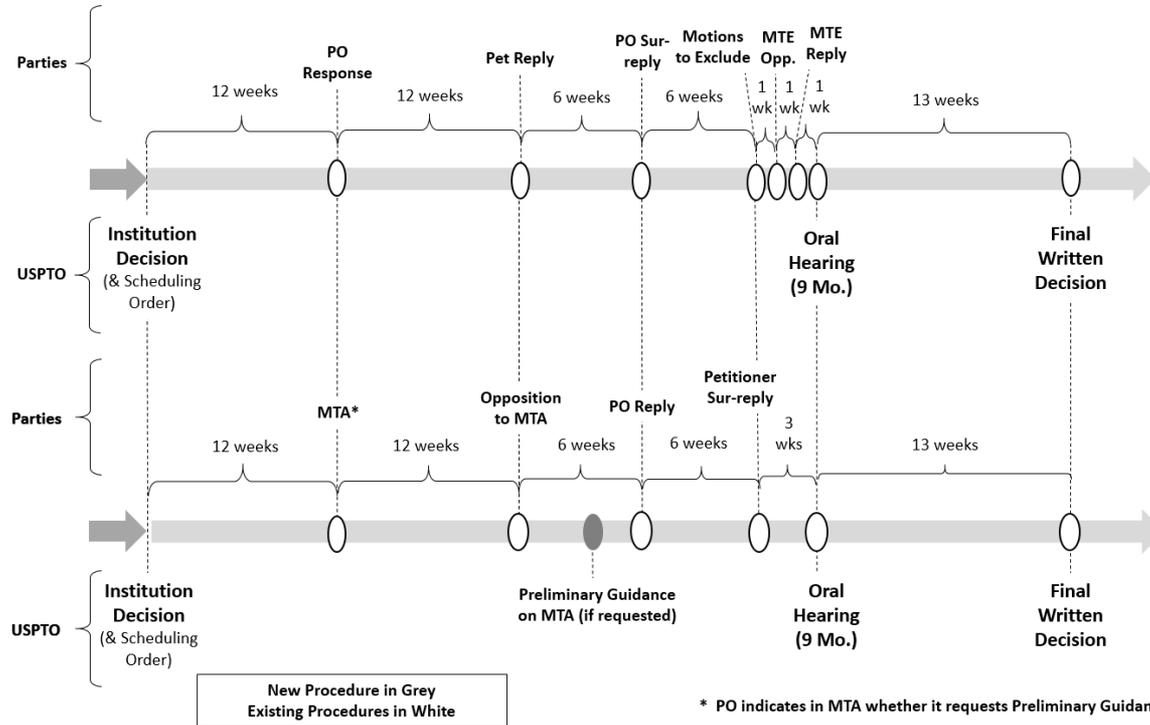
- One small exception: times between due dates for certain later-filed papers are extended slightly

Highlights of MTA pilot program

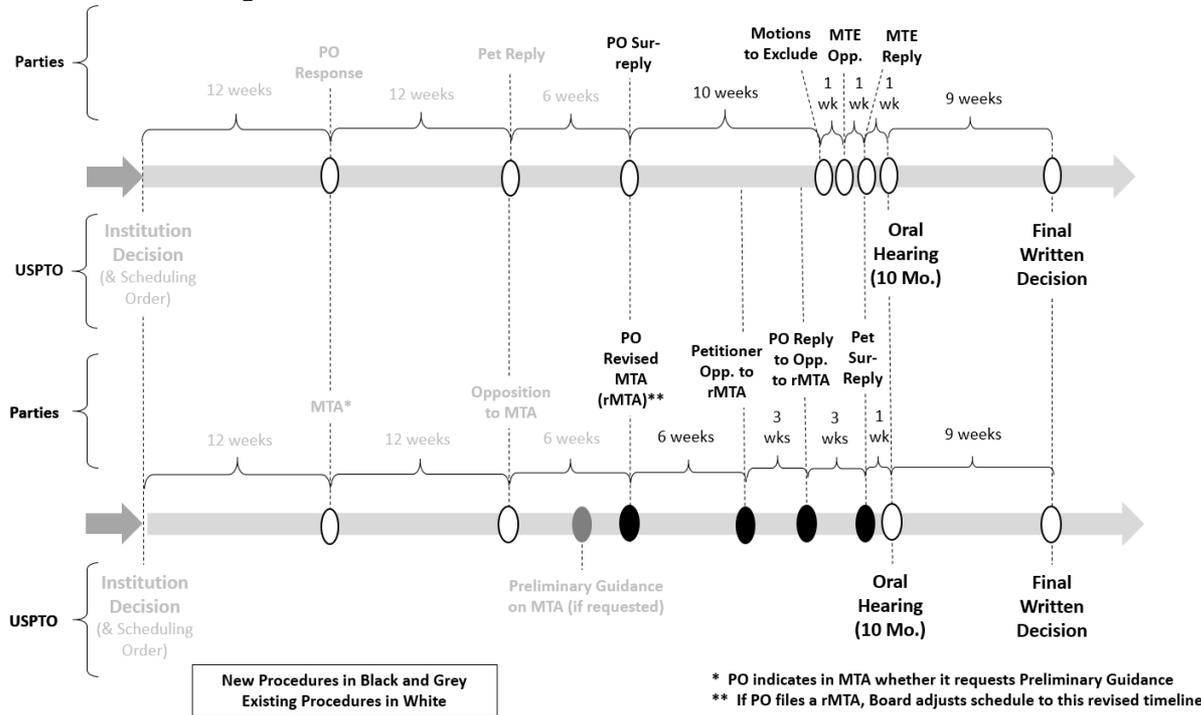
- Upon institution of an AIA trial, Board will issue the same scheduling order in every case
 - Due dates are similar to prior practice
 - Due dates are calculated in weeks
- If PO chooses to file a revised MTA after receiving petitioner's opposition and Board's PG (if requested), Board will issue a revised scheduling order soon thereafter

Schedule entered at institution

(Appendix 1A)



Revised schedule if revised MTA (Appendix 1B)



Highlights of MTA pilot program

- MTA and revised MTA are contingent unless PO indicates otherwise, e.g., by canceling original claims
- If PO does not request PG in initial MTA, no PG
- Changes if/after PO files a revised MTA:
 - One additional paper for each party
 - New briefing and oral hearing schedule to accommodate
- Final written decision addresses only substitute claims at issue in latest filed MTA

Pilot program implementation

- Effective date is publication date of notice (March 15, 2019)
- Applies to all AIA trials instituted on or after that date
- USPTO anticipates it will reassess pilot program approximately 1 year from effective date
 - Potentially may terminate program at any time or continue program (with or without modifications) depending on stakeholder feedback and effectiveness of program

MTA Pilot Program

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/new-pilot-program-concerning-motions>

The screenshot shows the USPTO website's Patent Trial and Appeal Board (PTAB) page. At the top, there is a navigation bar with the USPTO logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', and links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. A search bar is also present. Below the navigation bar, there are tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. The main content area features a breadcrumb trail: 'Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board'. The title 'Patent Trial and Appeal Board' is prominently displayed, followed by a brief description of the PTAB's functions. Below this, there are several columns of links and information:

- Trials:** Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.
- Appeals:** Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.
- Decisions:** Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.
- Hearings:** Review guidance, schedules, and inclement weather advisories for oral arguments for appeals, interferences, and trials.
- Resources and guidance:** Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.
- Statistics:** View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.
- PTAB Data Tools and IT Systems:** Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.
- PTAB Events:** Find where our judges are speaking and learn more about events sponsored by PTAB.
- About PTAB:** Discover the history of the PTAB and map out its modern structure and mission.

On the right side of the page, there are several 'NEW' callouts for recent updates:

- Trial Practice Guide July 2019 Update**
- Notice regarding options for amendments through reissues or reexaminations**
- New Pilot Program Concerning Motions to Amend** (highlighted with a red box)
- Claim Construction Final Rule**
- SOP 1 (rev. 15): Assignment of judges to panels**
- SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure**

New Pilot Program Concerning Motions to Amend

The United States Patent and Trademark Office (USPTO) has published a notice of a pilot program for motion to amend practice and procedures in trial proceedings under the America Invents Act (AIA) before the PTAB.

The pilot program provides patent owners with two options not previously available. The first option is that a patent owner may choose to receive preliminary guidance from the Board on its motion to amend. The second option is that a patent owner may choose to file a revised motion to amend after receiving petitioner's opposition to the original motion to amend and/or after receiving the PTAB's preliminary guidance (if requested). If a patent owner does not elect either of those options, the motion to amend practice is essentially unchanged from current practice. The notice sets forth the details of the pilot program, including motion to amend procedures that will be in effect for the duration of the pilot program.

The full text of the notice is [published in the Federal Register](#).

As of the closing date for comments (December 21, 2018), the USPTO received a total of 49 comments from individuals, corporations, and associations in response to its October 29, 2018, request for comments (RFC) on proposed procedure for motions to amend in AIA trials. The USPTO carefully considered all of the comments to the RFC when developing the pilot program. For example, several comments suggested the USPTO reconsider the timelines of due dates presented in the RFC. In response to this comment, the USPTO modified the proposal in the RFC to provide parties more time to prepare certain filings and evidence, among other things. The USPTO made other minor revisions as reflected in the final notice, and otherwise provides responses to the comments received as appropriate.

**Notice regarding options for amendments
through reissue or reexamination during
pending AIA proceeding**

Notice regarding options for reissue or reexamination during pending AIA proceeding

- Published in Federal Register at [84 Fed. Reg. 16654 \(April 22, 2019\)](#).
- Notice provides:
 - A summary of current practice regarding existing USPTO procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of same patent, after Board institutes a trial, and after Board issues a final written decision (FWD).
 - Summary information about factors currently considered when determining:
 - Whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding; and
 - When and whether to lift such a stay or suspension.

Options for amendments on PTAB

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/notice-regarding-options-amendments>

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

About Us | Jobs | Contact Us | MyUSPTO

Search uspto.gov

Patents | Trademarks | IP Policy | Learning and Resources | Find It Fast

Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board

Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.

- Trials**
Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.
- Appeals**
Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.
- Decisions**
Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.
- Hearings**
Review guidance, schedules, and implement weather advisories for oral arguments for appeals, interferences, and trials.
- Resources and guidance**
Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.
- Statistics**
View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.
- PTAB Data Tools and IT Systems**
Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.
- PTAB Events**
Find where our judges are speaking and learn more about events sponsored by PTAB.
- About PTAB**
Discover the history of the PTAB and map out its modern structure and mission.

Trial Practice Guide July 2019 Update **NEW**

Notice regarding options for amendments through reissues or reexaminations **NEW**

New Pilot Program Concerning Motions to Amend **NEW**

Claim Construction Final Rule **NEW**

SOP 1 (rev. 15): Assignment of judges to panels **NEW**

SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure **NEW**

Notice regarding options for amendments through reissue or reexamination

The United States Patent and Trademark Office (USPTO) has published a notice of information regarding existing office practice available to a patent owner during the pendency of a trial proceeding under the America Invents Act (AIA), pertaining to reissue and reexamination procedures available for amending claims involved in the trial.

This notice provides a summary of current practice regarding reissue and reexamination options in which patent owners may amend claims before and after the Patent Trial and Appeal Board (PTAB) issues a final written decision in an AIA trial proceeding. This notice also provides summary information about factors the USPTO currently considers when determining whether to stay or suspend a reissue proceeding, or stay a reexamination, that involves a patent involved in an AIA proceeding, and also when and whether to lift such a stay or suspension.

The full text of the notice is [published in the Federal Register](#).

On October 29, 2018, the USPTO published a notice requesting comments on proposed modifications to current motion to amend practice and procedures in AIA trial proceedings. In response to that notice, the USPTO received a number of comments and questions requesting clarification regarding existing reissue and reexamination procedures at the USPTO. The USPTO carefully considered those comments and questions and issued this notice of information in response.

July 2019 update

Trial Practice Guide

Trial Practice Guide July 2019 update

- **Guidance in the July 2019 update includes**
 - Factors that may be considered by the Board in determining when additional discovery will be granted
 - The revised claim construction standard to be used in IPR, PGR, and CBM proceedings
 - The submission of testimonial evidence with a patent owner preliminary response
 - Information to be provided by the parties if there are multiple petitions filed at or about the same time challenging the same patent
 - Motion to amend practice
 - Factors that may be considered by the Board in determining whether to grant a motion for joinder
 - Procedures to be followed when a case is remanded
 - Procedures for parties to request modifications to the default protective order

Trial Practice Guide update on PTAB webpage

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trial-practice-guide-july-2019-update>

The screenshot shows the USPTO Patent and Trademark Office website. The navigation bar includes 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The main content area is titled 'Patent Trial and Appeal Board' and contains several sections: Trials, Appeals, Decisions, Hearings, Resources and guidance, Statistics, PTAB Data Tools and IT Systems, PTAB Events, and About PTAB. A red box highlights the 'Trial Practice Guide July 2019 Update' link, which is marked as 'NEW'. Below this, other links like 'Notice regarding options for amendments through reissues or reexaminations' and 'New Pilot Program Concerning Motions to Amend' are also visible.

Trial Practice Guide July 2019 Update

In July 2019, the United States Patent and Trademark Office (USPTO) published a [second update](#) to the America Invents Acts (AIA) Trial Practice Guide containing additional guidance about trial practice before the Patent Trial and Appeal Board (PTAB).

Guidance included in the 2019 update

- Factors that may be considered by the Board in determining when additional discovery will be granted
- The revised claim construction standard to be used in IPR, PGR, and CBM proceedings
- The submission of testimonial evidence with a patent owner preliminary response
- Information to be provided by the parties if there are multiple petitions filed at or about the same time challenging the same patent
- Motion to amend practice
- Factors that may be considered by the Board in determining whether to grant a motion for joinder
- Procedures to be followed when a case is remanded
- Procedures for parties to request modifications to the default protective order

Trial Practice Guide resources and updates

- [Trial Practice Guide July 2019 update](#)
- [Trial Practice Guide August 2018 update](#)
- [Trial Practice Guide](#)

More information about AIA trials can be found on the [PTAB webpage](#).



Updates

Subscription Center

www.uspto.gov/subscribe



Subscribe, unsubscribe, or change your email preferences

To subscribe or get more information on the newsletter or email alerts below, enter your email address below and click "Submit." You will not be subscribed until you choose your subscriptions from the next page.

To unsubscribe to a newsletter or alert, enter your email address below and click "Submit." On the next page, choose the newsletters or alerts you no longer want to receive.

- Patent Alerts
- Trademark Alerts
- Copyright Alerts
- Patent Trial and Appeal Board**
- USPTO Regional Office Updates
- USPTO Press Releases
- USPTO Director's Forum Blog
- USPTO Monthly Review
- FYI at the USPTO
- Inventors Eye
- Intellectual Property for K-12 Educators
- USPTO Awards

Email address (required)

SUBMIT **CANCEL**

Your contact information is used to deliver requested updates or to access your subscriber preferences.

Sign up to receive the latest news and updates from the USPTO conveniently via e-mail



Questions and comments

Scott R. Boalick

Chief Administrative Patent Judge

(571) 272-9797

Scott.Boalick@USPTO.GOV

Jacqueline W. Bonilla

Deputy Chief Administrative Patent Judge

(571) 272-9797

Jacqueline.Bonilla@USPTO.GOV



