

AIA TRIAL PATENT OWNER’S [PRELIMINARY] RESPONSE TEMPLATE GUIDANCE¹

A proceeding under the America Invents Act (“AIA”) before the Patent Trial and Appeal Board (“PTAB” or the “Board”) may result in a trial known as, for example, an *inter partes* review (“IPR”) or a post-grant review (“PGR”). Such a proceeding is initiated by a person or entity, other than the owner of the patent, filing a petition challenging the patentability of one or more claims of an issued United States patent. *See* 35 U.S.C. § 311 (addressing IPR), § 321 (addressing PGR); *see also* TPG at Part II.B (Petition); 37 C.F.R. § 42.24. “In an [AIA trial proceeding], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)). This burden of persuasion never shifts to the patent owner. *See Dynamic Drinkware, LLC v.*

¹ The information in this Guidance is primarily based on three sources, which you should familiarize yourself with before preparing and filing a preliminary response and/or a response. The first source is the U.S. Patent Act, codified at Title 35 of the U.S. Code (cited below as “35 U.S.C. § [xxx]”). The code provisions for *inter partes* reviews (IPRs) are at 35 U.S.C. §§ 311–319 and those for post grant reviews (PGRs) are at 35 U.S.C. §§ 321–329. The second source is the rules for “Trial Practice Before the Patent Trial and Appeal Board,” available at Part 42 of Title 37 of the Code of Federal Regulations (cited below as “37 C.F.R. § 42.[xxx]”). There are separate rules for IPRs and PGRs; however, they are similar and we may refer at times to only the IPR rules, as illustrative. The third source is the “Patent Trial and Appeal Board Trial Practice Guide” (“TPG”), www.uspto.gov/patents/ptab/trial-practice-guide (web version). In addition to these sources, you should consult the PTAB’s precedential and informative decisions, available at www.uspto.gov/patents/ptab/precedential-informative-decisions. Precedential decisions are binding authority on the Board and may relate to, for example, major policy or procedural issues. Informative decisions provide Board norms on recurring issues or other helpful guidance.

Nat'l Graphics, Inc., 800 F.3d 1375, 1378 (Fed. Cir. 2015). Thus, a patent owner may, but is not required to, file a preliminary response and a response; however, failure to present arguments in the response after institution may waive arguments. 35 U.S.C. §§ 316(a)(8), 326(a)(8); 37 C.F.R. §§ 42.107, 42.120; *see also* TPG at Parts II.C, II.F, App'x A-1 (subpart B).

A patent owner may timely file a preliminary response to the petition within three months after the Notice of Filing Date Accorded to Petitioner.² *See* TPG at Part II.C; 37 C.F.R. §§ 42.107, 42.207. The Board or Director will consider the preliminary response in deciding whether to institute trial. If a trial is instituted, a patent owner may then file a response to the petition (and the Board's institution decision). *See* 37 C.F.R. § 42.120; TPG at Part II.F. There may be substantial overlap between a patent owner's preliminary response and response—this template guidance addresses both filings and identifies where certain material is specifically appropriate for one or the other, as does the companion Microsoft Word template (“the template”) itself. Note that arguments made in a preliminary response, but not made subsequently in a patent owner's post-institution response, are generally deemed waived. TPG at Part II.C; *In re NuVasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016).

This Guidance and the companion template are intended to assist a patent owner in preparing a preliminary response and/or response; **they are resources**

² Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of an *inter partes* review and, similarly, under § 324(a), of a post-grant review. 35 U.S.C. §§ 314(a), 324(a); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016). Current Office procedures require discretionary denial issues to be handled separately from petitions and preliminary responses. *See* <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> for more information.

only and their use is optional. The template for a preliminary response and/or response may be found here: www.uspto.gov/sites/default/files/documents/aia-trial-response-template.docx.³ A preliminary response and/or response is not limited to the specific sections set forth in the template; content and format may vary by case.

All documents in AIA proceedings must be filed electronically in the Office's Patent Trial and Appeal Case Tracking System ("P-TACTS"). 37 C.F.R. § 42.6. Detailed information about how to file in P-TACTS is available at www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20221007.pdf.

Below, this Guidance addresses the typical sections of a preliminary response and/or response, as provided in the associated template. **This Guidance and the companion template are for general informational purposes only and do not constitute legal advice.**

COVER PAGE

A sample cover page is shown on the first page of the template.⁴ The cover page identifies the name of the petitioner(s), the name of the patent owner(s), the (full) number of the United States patent challenged in the petition, and the case number assigned by the Office to the proceeding (for example, IPR202[x]-01234 or PGR202[x]-01234). The patent number and the case number are also included as a header on each subsequent page of the preliminary response or response.

³ A similar guidance document and companion template for a petition may be found here: www.uspto.gov/patents/ptab/ptab-help/guidance-and-templates-aia-proceedings.

⁴ The Board expects all briefing will include page numbering, beginning with page "1." Page numbering typically starts on the first page after the Table of Contents, Table of Authorities, and Table of Exhibits.

TABLE OF CONTENTS

A preliminary response and/or response should include a Table of Contents for ease of reference by the Board and public. 37 C.F.R. § 42.24(b) (table of contents does not count toward word count limits).⁵ The Table of Contents identifies each section in the preliminary response and/or response by name and the page number where the section begins. Provided below are the various sections shown in the Table of Contents in the template.

TABLE OF AUTHORITIES

A preliminary response and/or response should include a Table of Authorities. 37 C.F.R. § 42.24(b) (table of authorities does not count toward word count limits). The Table of Authorities identifies the legal authorities cited in the preliminary response or response. This table includes all case law, statutes, rules, and other reference material, such as treatises, cited in the preliminary response and/or response. *See* 37 C.F.R. § 42.13. The Table of Authorities identifies the page number(s) of the preliminary response and/or response where each of the cited authorities appears.

TABLE OF EXHIBITS

When a patent owner files a preliminary response and/or response, it must file all evidence relied on to support its arguments, if not previously filed (e.g., by the petitioner; the petitioner's exhibits may be cited by patent owner). *See* TPG at Parts II.C, II.F; 37 C.F.R. § 42.107(a). Evidence may consist of documents (e.g., the challenged patent, asserted prior art, scientific references), declarations (written witness testimony), transcripts of depositions of witnesses, and (rarely, but

⁵ The preliminary response and/or response for IPRs are each limited to 14,000 words; the preliminary response and response for PGRs are each limited to 18,700 words. 37 C.F.R. § 42.24(a).

sometimes) things. 37 C.F.R. § 42.63. All evidence must be filed in the form of a properly formatted exhibit.⁶ 37 C.F.R. §§ 42.6, 42.63(d). Our rules require that the preliminary response and/or response include a list of the exhibits with a brief description of each exhibit. 37 C.F.R. § 42.63(a)–(e); *see also* 37 C.F.R. § 42.24(b) (table/appendix of exhibits does not count toward word count limits).

If evidence filed with the preliminary response and/or response contains confidential information, a patent owner can file that evidence on a confidential basis along with a motion to seal the confidential portion of the brief and the confidential exhibits when filing the brief. 37 C.F.R. § 42.55; TPG at Part I.E. A motion to seal should be accompanied by a proposed protective order, such as the Board’s default protective order. 37 C.F.R. § 42.54. The Board will not enter a

⁶ Exhibits are to be filed as searchable PDF files (to submit evidence in any other format; email the Board at Trials@uspto.gov for instructions or contact the Board from 8:30 a.m. to 5 p.m. ET, at 571-272-9797). *See* 37 C.F.R. § 42.6. When filing an exhibit in the P-TACTS system, in addition to entering its exhibit number, provide a short, descriptive name (e.g., “Declaration of Jane Doe, Ph.D.”; “Jones Co. v. Smith Inc. Claim Construction Order”; “U.S. Patent No. 9,876,543”) for the exhibit for easy identification. Using the word “Exhibit” followed by the exhibit number for the descriptive name of the exhibit when filing an exhibit in P-TACTS generally is not helpful because there is a separate field for the exhibit number. Witness testimony in declarations normally includes paragraph numbering. Optical character recognition (“OCR”) converts scanned images of text, such as in as PDF files, into machine-readable text that can be searched, copied, edited, and highlighted. All evidence submitted as a PDF should normally be OCR’d (or an equivalent) and have electronically recognizable text that can be searched and copied, and should be cited in briefing (and in any declaration) by exhibit number rather than some other name. Exhibit PDF files may be marked with consecutive page numbers for citation, rather than citing any page numbers that appear in the original document, if necessary. **Submissions that do not meet these expectations may be refused.**

protective order by default, but only upon the grant of a motion. *Id.*; TPG at Part I.E.

INTRODUCTION⁷

This section of the preliminary response and/or response provides an opportunity to briefly summarize the underlying technology, the claimed invention, procedural history, and your response to the arguments made in the petition.

BACKGROUND

This may be a separate section from the Introduction, or the two sections may be combined into one.

A patent owner may include an overview of the claimed invention and relevant disclosures (i.e., in the specification or, possibly, the prosecution history) of the challenged patent to help the Board understand the issues involved in the case. If included, this section normally contains a short explanation of the invention recited in the independent claims and any key dependent claims at issue, a discussion of the relevant portions of the patent’s written description (i.e., the specification), and a discussion of other relevant information, such as key events from the prosecution history of the patent or related patents. For example, if

⁷ For petitioners, a petition must include mandatory notices including the disclosure of the real party(ies) in interest, related matters, lead and backup counsel, and service information. *See* TPG at Part I.D. For patent owners, mandatory notices are made in a filing separate from their preliminary response and/or response. 37 C.F.R. § 42.8(a)(2). For more information on mandatory notices generally, *see* TPG at Part I.D, as well as the section on “Mandatory Notices” in the Guidance for the companion template for a petition, which may be found here:

www.uspto.gov/sites/default/files/documents/aia_trial_petition_template_guidance.pdf. Also note that mandatory notices, including those relating to real parties in interest, must be updated within 21 days, as necessary during the proceeding if changes in circumstances warrant it. 37 C.F.R. § 42.8(a)(3).

certain claim language is expressly defined in the specification or explained during prosecution, this section may be used to introduce this disclosure.

As a part of this section, or as a preceding section, the preliminary response and/or response may include an overview of the relevant technology and background of the field of the invention, which may be useful to the Board.

If the priority (effective filing) date of the challenged patent is at issue, it is helpful to address the matter in this section (if the issue is particularly complex, it also may be discussed in a separate section of the brief).

PROCEDURAL DENIAL OF INSTITUTION

There are statutory and regulatory conditions and requirements for institution of an AIA trial. *See, e.g.*, 35 U.S.C. §§ 311, 312, 315, 321, 322; 37 C.F.R. §§ 42.101, 42.102, 42.201, 42.202. If a patent owner wishes to argue that institution should be denied on the basis of one or more of these statutory or regulatory conditions/requirements, unrelated to the merits of the petitioner's challenges and unrelated to the Board's exercise of discretion to deny institution (discussed below), such arguments may be made in this section of the preliminary response.

If a patent owner believes the petition is time barred under 35 U.S.C. § 315 (for example, because a real party in interest or privy of the petitioner was served with a complaint for infringement of the challenged patent more than one year before the filing of the petition), arguments in this regard can be made in the preliminary response and/or after institution of a trial in a response. That said, it is best practice to raise such arguments as soon as the patent owner becomes aware of them (i.e., prior to a decision on institution, when possible).

ORDINARY SKILL IN THE ART

The level of ordinary skill in the art and the hypothetical person of ordinary skill in the art are concepts relevant to several possible patentability issues raised in

AIA proceedings, for example, in construing the language of the claims and in determining obviousness. *See generally* TPG; *see also* 35 U.S.C. § 103 (introducing the term). In this section of the preliminary response or response, the patent owner may agree with the petitioner’s definition or expressly identify how the person of ordinary skill in the art, as of the time of the invention or as of the effective filing date of the claimed invention, should be defined. For example, this section can identify the education and experience, relevant knowledge, and specialized skills such an ordinarily skilled artisan would have had as of date of the invention or as of the effective filing date of the claimed invention.

CLAIM CONSTRUCTION

A petitioner is required to provide a statement of how the challenged claims are to be construed, and “[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. [§] 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. §§ 42.104(b)(3), 42.204(b)(3); TPG at Part II.B.3 (Specific Requirements for Petition); *see also* TPG at II.B.5 (claim charts may be included). A patent owner is advised to include any claim construction argument in a designated section of the preliminary response and/or response to the extent that a patent owner has a specific position on how the challenged claims are to be construed, and especially if the patent owner disagrees with any aspects of the petitioner’s claim construction.

If a patent owner believes the Board must expressly construe claim language, the patent owner must include a statement identifying the proposed construction and corresponding support, for example, in the specification of the patent. A patent owner may also include a statement that the claim language requires no express construction. *See* TPG at Part II.B.5. If a patent owner

chooses the latter option, the patent owner should not provide arguments, express or implied, in other parts of the preliminary response and/or response that certain claim interpretations are required or desired to support patent owner's positions on the merits of petitioner's challenges.

OPPOSITION TO PETITIONER'S GROUNDS OF UNPATENTABILITY

In this section, a patent owner should present its arguments about the merits of the petitioner's asserted grounds of unpatentability.

IPRs may only include patentability challenges based on anticipation or obviousness (under 35 U.S.C. §§ 102 and/or 103, respectively) in view of prior art patents and printed publications. *See* 35 U.S.C. §§ 311(b), 312(a)(3), 314(a). In PGRs, patentability challenges may be asserted under any ground of unpatentability under paragraph (2) or (3) of 35 U.S.C. § 282(b), which expands the permissible statutory bases to include, for example, 35 U.S.C § 101 (e.g., subject matter eligibility), § 102 (prior offer for sale), and § 112 (written description, enablement, definiteness). *See* 35 U.S.C. §§ 321(b), 322(a)(3), 324(a). Whether for an IPR or PGR, the petition must lay out, in detail and with particularity, the petitioner's grounds for unpatentability, the supporting rationale, and the supporting evidence. 35 U.S.C. §§ 312(a)(3), 322(a)(3); 37 C.F.R. §§ 42.104, 42.204; TPG at Parts II.B, II.D.

Under the rules, the petition must contain “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. § 42.22(a)(2). Arguments that a patent owner makes in the preliminary response may be deemed waived after institution of a trial if they are not made again in the response. However, the patent owner should “avoid submitting a repository of all the information that a judge could possibly consider, and instead

focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” TPG at Part II.A.3.

A patent owner’s strategy in organizing the arguments is its own, but in general, a patent owner should consider presenting the strongest arguments first or exclusively. Weaker arguments can distract or detract from stronger arguments, so a patent owner should consider whether weaker arguments are necessary.

There are no specific organizational requirements, but best practices suggest identifying each argument on the merits under a separate heading. Subheadings are also useful and add clarity when multiple issues must be addressed.

Claims are best argued individually (a single argument, however, might apply to multiple claims). If, when arguing a specific claim, you refer back to prior arguments for another claim, ensure that the cross-reference specifically identifies the prior arguments. Although a patent owner may cross-reference arguments within a preliminary response and/or response, understand that “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Excessive internal references within a brief may be confusing.

Supportive citations to and explanation of relevant case law will benefit a patent owner’s arguments (*see* 37 C.F.R. § 42.13), but “unless there is a dispute over the applicable law, extended discussions of general patent law principles may not be necessary.” TPG at Part II.A.3.

OBJECTIVE INDICIA OF NON-OBVIOUSNESS OR OBVIOUSNESS

When the obviousness of a claim is at issue, evidence pertaining to objective indicia of non-obviousness (or obviousness), such as commercial success, industry praise, long-felt but unmet need, etc., may be relevant. “In determining whether the subject matter of a claim would have been obvious over the prior art, the Board

will review any objective evidence of nonobviousness proffered by the patent owner where appropriate.” TPG at Part II.A.6.

CONCLUSION

A preliminary response and/or response may include a conclusion that summarizes the important points and relief requested.

CERTIFICATE OF COMPLIANCE WITH WORD COUNT LIMITS

Under 37 C.F.R. § 42.24(d), “[a]ny paper whose length is specified by type-volume limits must include a certification stating the number of words in the paper. A party may rely on the word count of the word-processing system used to prepare the paper.” *See also* TPG at Part II.A.3. An IPR preliminary response and/or response are each limited to 14,000 words and a PGR preliminary response and response are each limited to 18,700 words. *See* 37 C.F.R. § 42.24.

As stated in the TPG:

Parties should not abuse the process. Excessive words in figures, drawings, or images, deleting spacing between words, or using excessive acronyms or abbreviations for word phrases, in order to circumvent the rules on word count, may lead to a party’s brief not being considered. *See, e.g., PiNet Int’l, Inc. v. JPMorgan Chase & Co.*, 600 F. App’x 774 (Fed. Cir. 2015). Except in cases of obvious abuse, the Board will generally accept a party’s certification of compliance with word count limits.

TPG at Part II.A.3.

As an example, such a certification may state:

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the foregoing [Preliminary] Response complies with the type-volume limitation of 37 C.F.R. § 42.24 permitting a [preliminary] response of up to [14,000 words (for *inter partes* review/18,700 words (for post grant review))], because, exclusive of the exempted portions, it contains [##,###] words as counted by the word processing program used to prepare the paper.

Such a certification should be dated and signed. The above language is not specifically required, but is merely an example, and other language may be used.

CERTIFICATE OF SERVICE

“Each document [including the preliminary response and/or response], other than an exhibit, must include a certificate of service at the end of that document. Any exhibit filed with the document may be included in the certification for the document.” 37 C.F.R. § 42.6(e)(4). As an example, a certificate of service for an IPR may state:

In accordance with 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that true and correct copies of Patent Owner’s [Preliminary] Response, and Exhibits 2001–2[###], were served on [date] via [manner of service] on Petitioner at the correspondence address of record for Petitioner:

[petitioner’s address(es)]

Such a certification should be dated and signed. The above language is not specifically required, but is merely an example, and other language may be used.

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