

# **Chat with the Chief**

***Chief Judge David Ruschke***  
***Vice Chief Judge Tim Fink***

**June 5, 2018**

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# ***Agenda***

- Part 1: Notice of Proposed Rulemaking for Claim Construction
- Part 2: Motion to Amend
  - Order
  - Study, Installment 4: Updated through March 30, 2018
- Part 3: Implications of SAS
- Part 4: Q&A

# Webinar Slides and Materials

<https://www.uspto.gov/patents-application-process/patenttrialandappealboard>

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## 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.



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[Notice of Proposed Rulemaking of Claim Construction Standard used in PTAB AIA Trial Proceedings](#) NEW

### Upcoming PTAB events

[Impact of SAS, Motion to Amend Practice, and Claim Construction in Trial Proceedings](#)

Jun 5, 2018 12:00 PM ET

[Motions to Exclude and Motions to Strike in AIA Trial Proceedings](#)

Jun 7, 2018 12:00 PM ET

[PTAB/TTAB Stadium Tour at University of San Diego School of Law](#)

Sep 20, 2018 10:00 AM PT  
San Diego, CA



***Notice of Proposed Rulemaking  
(NPRM) for Claim Construction***

# ***Claim Construction NPRM***

***83 Fed. Reg. 21,221 (May 9, 2018)***

Proposed 42.100(b), 42.200(b), 42.300(b):

“In an [AIA trial] proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the inter partes review proceeding will be considered.”

# ***Claim Construction NPRM***

***83 Fed. Reg. 21,221 (May 9, 2018)***

- USPTO intends that any proposed rule changes adopted in a final rule would be applied to all pending AIA trial proceedings
- Public comments due on or before July 9 to:  
[PTABNPR2018@uspto.gov](mailto:PTABNPR2018@uspto.gov)
- Federal Register Notice:  
<https://www.federalregister.gov/documents/2018/05/09/2018-09821/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>

# ***Motion to Amend Order***

# ***Western Digital v. SPEX Techs.***

***IPR2018-00082 -00084 (PTAB Apr. 25, 2018) (Paper 13) (Informative)***

- Order provides guidance and information regarding statutory and regulatory requirements for a motion to amend in light of Federal Circuit case law (e.g., *Aqua Products*), including on:
  - contingent motions to amend;
  - burden of persuasion that the Office applies when considering the patentability of substitute claims;
  - requirement that a patent owner propose a reasonable number of substitute claims;
  - requirement that the amendment respond to a ground of unpatentability involved in the trial;
  - scope of the proposed substitute claims;
  - requirement that a patent owner provide a claim listing with its motion to amend;
  - default page limits that apply to motion to amend briefing; and
  - duty of candor



# ***MasterImage and Idle Free***

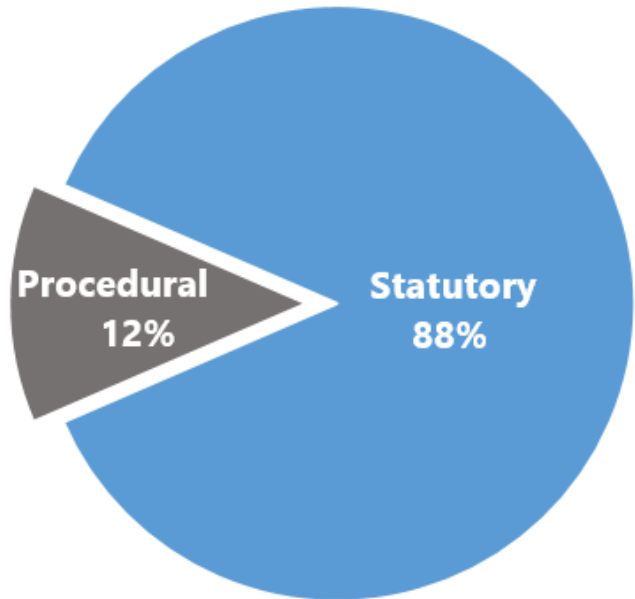
- PTAB has de-designated as authority:
  - *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (precedential)
  - *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (June 11, 2013) (Paper 26) (informative)

***Motion to Amend Study  
Installment 4: Updated  
through March 31, 2008***

# Reasons for Denying Entry of Substitute Claims

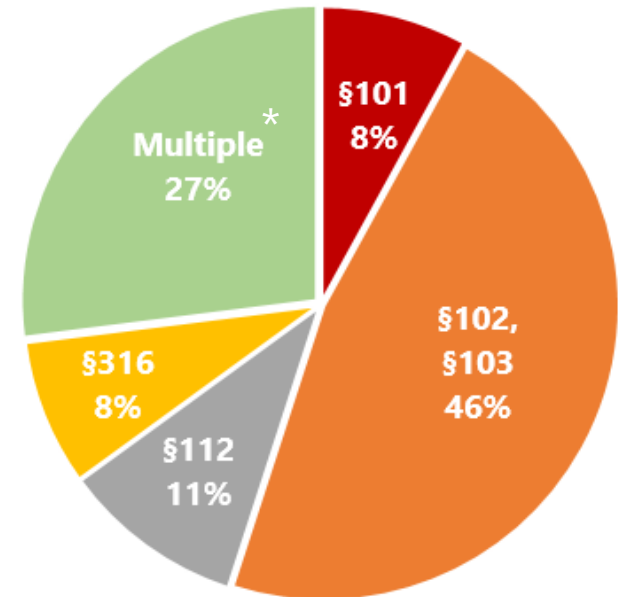
(FY13 to FY18: 10/1/2012-3/31/2018)

All Reasons



Statutory Reasons

Statutory Reasons

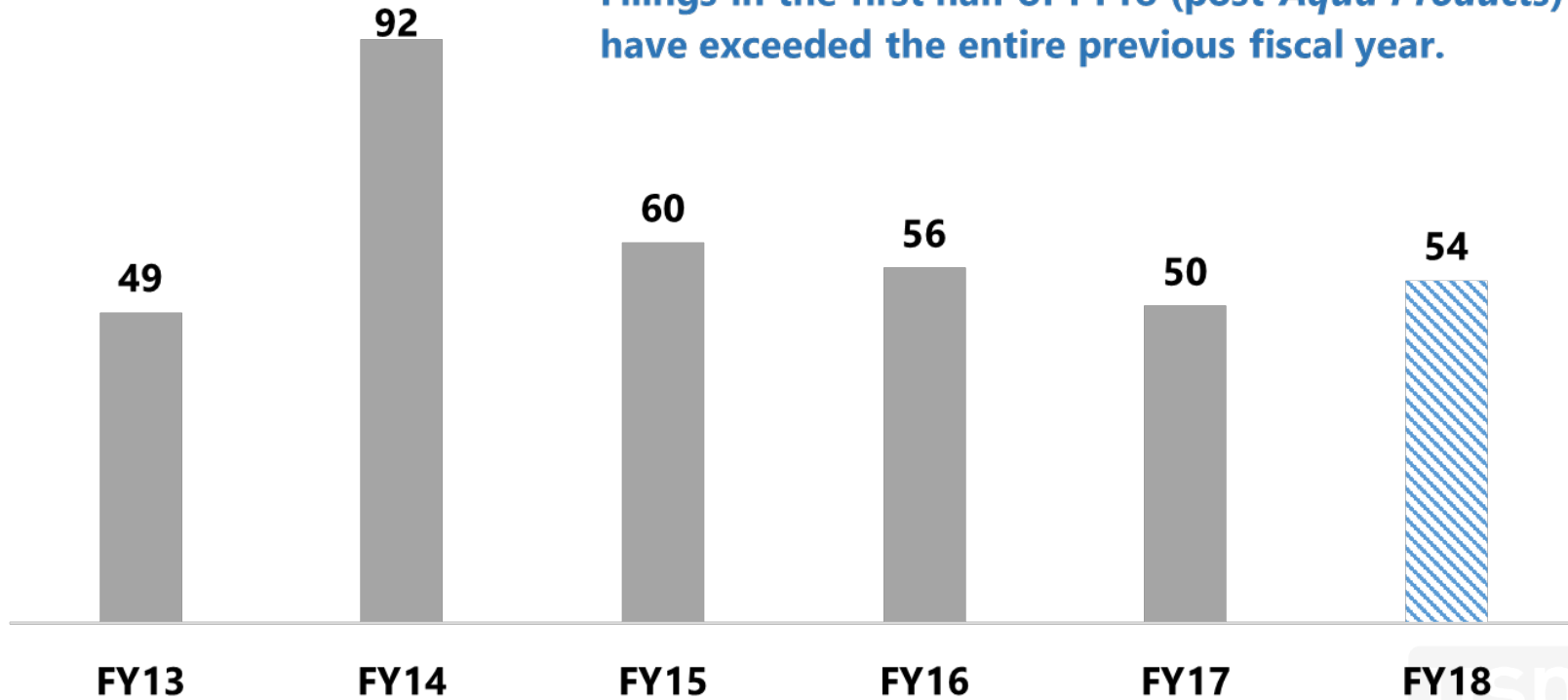


\* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.

# Motions to Amend Filed by Fiscal Year

(FY13 to FY18: 10/1/12 to 3/31/18)

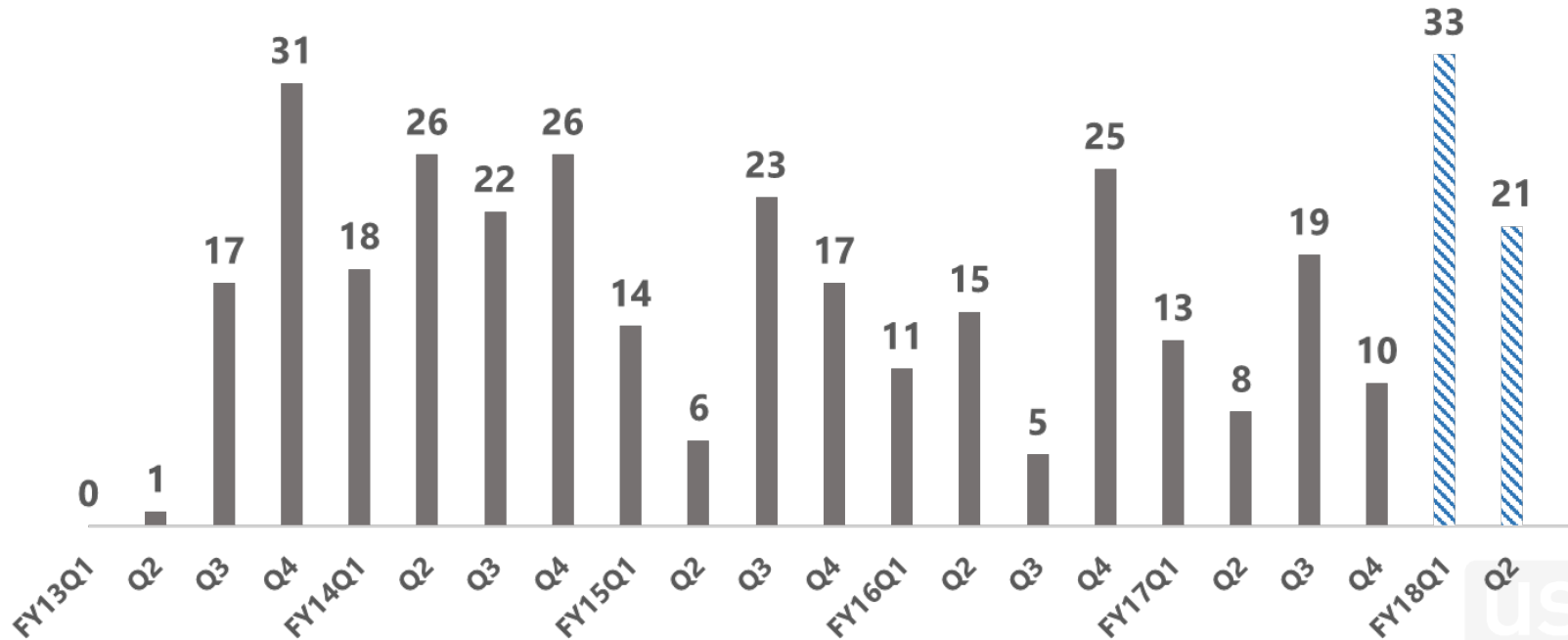
Filings in the first half of FY18 (post-Aqua Products) have exceeded the entire previous fiscal year.



# Motions to Amend Filed by Fiscal Quarter

(FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of 2018 (post-Aqua Products) exceeded any other two consecutive quarters.



# ***Implications of SAS***

# ***On-Going Partially-Instituted Proceedings***

- **Question**: How will the Board determine when to **extend** the statutory deadline for a final written decision?
- **Question**: If a Final Written Decision issued in a proceeding but the case is on appeal to the CAFC, will the Board **reopen** the case to address SAS?
- **Question**: If the Board found no reasonable likelihood as to certain claims and/or grounds, then why is the Board allowing **additional briefing** on them?
- **Question**: Will a party be able to retake a **deposition** to address claims and/or grounds that were originally denied?

# ***Challenges Denied for Statutory Reasons***

- **Question**: Will the Board vacate its prior institution decision if including all claims and/or grounds would bring in challenges that were initially denied under 35 USC **§ 325(d)**?
- **Question**: Will the Board vacate its prior institution decision if including all claims and/or grounds would bring in claims that were initially denied because the petitioner did not provide a construction under 35 USC **§ 112(f)**?
- **Question**: How will the Board address institution of additional claims, where those claims were originally denied institution on the basis of estoppel under 35 USC **315(e)**?



# ***Institution Decisions Post-SAS***

- **Question**: Will the Board's institution decisions continue to find when challenges do not meet the **reasonable likelihood standard**?
- **Question**: If SAS requires only 1 claim and 1 ground to be sufficient for institution of all challenges, isn't anything else the Board says at the time of institution akin to an **advisory opinion**?
- **Question**: How can the Board provide its view that petitioner has **not met** the reasonable likelihood standard **at institution** and then reverse itself and find **claims unpatentable in the final written decision** based on a preponderance of the evidence?

# ***Challenges that Could Be Denied for Statutory Reasons***

- **Question**: In view of the Office's policy to institute on all challenges or none, how will the Board handle 35 USC **§ 325(d)** in situations where only some of the challenges fall within its scope?
- **Question**: In view of the Office's policy to institute on all challenges or none, how will the Board handle petitions that contain **voluminous or excessive grounds for institution** in light of the Office's policy of instituting on all claims?
- **Question**: Will the Board institute a petition based on the **percentage** of claims and grounds that meet the reasonable likelihood standard, e.g., 50%?
- **Question**: How will the Board handle petitions where, prior to SAS, some claims would have been denied because the petitioner does not provide a construction under 35 USC **§ 112(f)**?

# *Questions about SAS Implications*

- To [Trials@uspto.gov](mailto:Trials@uspto.gov) email box for both case-specific questions (e.g., request call with panel) and general questions

# *Questions*

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# Upcoming PTAB Webinars

Event	Date	Topic	Judge Speakers
Boardside Chat	June 7, 2018	<b>“Let It Go” Motions to Exclude and Motions to Strike in AIA Administrative Trials, Including Strategies for Handling Demonstrative Exhibits</b>	<b>Justin Arbes Kevin Cherry</b>
PTAB on Patent Quality	June 12, 2018	Best Practices Before the Patent Trial and Appeals Board	Kalyan Deshpande Susan Mitchell Michael Zecher
Boardside Chat	Oct 4, 2018	Motions to Seal, Protective Orders, and Confidential Information in AIA Trials	Mike Kim Amanda Wieker

# Judicial Conference Schedule

- Thursday, June 28, 9 am to 4:30 pm: Alexandria
- Monday, July 9: Detroit
- Wednesday, July 11: Denver
- Thursday, July 26: San Jose
- Tuesday, July 31: Dallas

July 2018 						
Su	Mo	Tu	We	Th	Fr	Sa
1	2	3	<u>4</u>	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

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# Judicial Conference Agenda

Time	Topic	Speakers
9 to 9:10 am	Opening Remarks	Vice Chief Janet Gongola
9:10 to 9:20 am	Director Remarks	Director Iancu
9:20 to 10 am	Best Practices for Written and Oral Advocacy	Judge Panel with Moderator Judge Bruce Wieder
10 to 11 am	Practicum: Written Advocacy	Lead Judges Aaron Moore and Georgianna Braden
11 am to 11:15 am	BREAK	
11:15 am to 12:15 pm	Practicum: Oral Advocacy	Judge Meredith Petravick
12:15 to 1:30 pm	LUNCH	
1:30 to 2:00 pm	State of the Board	Deputy Chief Scott Boalick
2:00 to 2:50 pm	Small Group Discussion: Hot Topic 1	Lead Judge Jessica Kaiser
2:50 to 3:00 pm	BREAK	
3:00 to 3:50 pm	Small Ground Discussion: Hot Topic 2	Lead Judge Melissa Haapala
3:50 to 4:30 pm	Interview with the Chief	Chief David Ruschke



***Thank You***

