June 5, 2018

***SAS* Q&As**

A. Effect of *SAS* on AIA proceedings generally

A1. Q: How will *SAS* impact PTAB's procedure for AIA trial proceedings?

A: PTAB will institute on all challenges raised in the petition or not institute at all (i.e., it will be a binary decision). There will be no partial institution based on claims. There will be no partial institution of grounds.

A2. Q: How will the Board address instituted proceedings in light of *SAS*?

A: If a Decision instituting on all challenges has issued already, the trial will proceed without any changes. For a Decision instituting on fewer than all challenges, the Board will take action to address all challenges. If a Decision denying institution has issued, no additional action will be necessary.

A3. Q: Does the USPTO intend to change its procedure through rulemaking?

A: The Office is considering revising 37 CFR §§ 42.108 and 42.208 to institute on all claims in a petition, as well as other rule changes that may be warranted in response to *SAS*.

B. Effect of *SAS* on *on-going* partially-instituted proceedings

B1. Q: Will the Board re-start the trial process in view of *SAS* on the claims/grounds initially denied institution, including re-starting the 12-month statutory clock?

A: No. As explained below, depending on the specific facts of a case and its procedural posture, an order instituting on all claims and all grounds presented in the petition and an order for the parties to meet and confer will be entered. A panel may also authorize additional briefing, evidence, and a supplemental hearing, as well as extend procedural dates.

B2. Q: If the Board has instituted already on only some challenges raised in a petition, how will the Board and parties address *SAS*?

A: In order to address *SAS*, the panel may:

a. Issue an order instituting on all claims and all grounds presented in the petition and order the parties to meet and confer;
b. Depending on the stage of the trial proceeding, the Board may authorize additional briefing, evidence, and a supplemental hearing, as well as extend procedural dates;
c. Receive a joint request filed by the parties for rehearing to waive additional claims and/or grounds; or
d. Receive a joint motion to limit claims and/or grounds.

B3. Q: If the proceeding has been instituted but it is before a Patent Owner has filed its Response, how will the Board and parties address *SAS*?

A: In order to address *SAS*, the panel may:

a. Issue an order extending the due date for the Patent Owner Response to allow the Patent Owner to address additional claims and/or grounds; and
b. Adjust other procedural dates as necessary.

B4. Q: If the proceeding has been instituted and it is after the Patent Owner Response but it is before a Petitioner has filed its Reply, how will the Board and parties address *SAS*?

A: In order to address *SAS*, the panel may:

a. Issue an order extending the due date for a Petitioner Reply if Patent Owner requests to supplement Patent Owner Response and provide evidence to address additional claims and/or grounds; and
b. Adjust other procedural dates as necessary.

B5. Q: If the proceeding has been instituted and it is after the Petitioner Reply but it is before the Hearing, how will the Board and parties address *SAS*?

A: In order to address *SAS*:

a. Either party may request a conference call with the panel to discuss additional briefing and/or evidence to address additional claims and/or grounds;
b. Petitioner is permitted responsive briefing but must request authorization before filing additional evidence;
c. The panel may adjust other procedural dates, including the hearing date, as necessary; and
d. Under certain circumstances, depending on the parties and panel's availability, the hearing may proceed as scheduled with additional SAS issues being addressed by post-hearing briefing and/or a supplemental hearing.

B6. Q: If the proceeding has been instituted and it is after the Hearing but before the issuance of a Final Written Decision, how will the Board and parties address *SAS*?

A: In order to address *SAS*:

a. Either party may request a conference call with the panel to discuss additional briefing, evidence, and/or a supplemental hearing to address additional claims and/or grounds;
b. The Petitioner is permitted responsive briefing and may request a supplemental hearing, but the Petitioner must request authorization before filing additional evidence; and
c. The Board may extend the 12 month statutory deadline on a case-by-case basis, but extensions beyond the statutory deadline are not automatic.

B7. Q: Are there circumstances in which the Board would split the proceeding and issue a Final Written Decision on the claims that were originally in the proceeding and then set a separate schedule for a decision on the additional claims and/or grounds added as a result of *SAS*?

A: No. The panel will not enter separate decisions; however, the Board may extend the statutory deadline if necessary to address the added claims and/or grounds.

B8. Q: How will the Board determine when to extend the statutory deadline for a Final Written Decision?

A: After the parties have conferred, the panel will consider the stage of the proceeding, the parties' requests for additional briefing, and time needed by the parties and the panel to address additional claims and/or grounds in a proceeding. Based on the panel's assessment of the parties' requests and the time remaining before the statutory deadline, the panel will decide if an extension is warranted and will make a recommendation to the Chief Judge.

B9. Q: If the proceeding has been instituted and the Final Written Decision has already issued, but the deadline for a Request for Rehearing has not passed, how will the Board and the parties address *SAS*?

A: Either party can file a rehearing request to raise *SAS*-issues regarding all claims and/or all grounds challenged in the petition. The panel may extend the rehearing deadline if a party requests such an extension and the panel determines it is needed.

B10. Q: If the Final Written Decision has already issued and the deadline for a Request for Rehearing has passed but not the deadline to appeal the case to the Federal Circuit, how will the Board and the parties address *SAS*?

A: Either party may request a conference call with the panel to discuss additional briefing and/or evidence to address additional claims and/or grounds. The panel may extend or waive the rehearing deadline.

B11. Q: If a Final Written Decision has issued in a proceeding and the case is on appeal to the Federal Circuit, will the Board reopen the case to address *SAS*?

A: No. The Board cannot reopen a case on appeal or after the trial certificate has issued.

B12. Q: If the parties cannot agree to waive additional claims, is there anything a party can do on its own to limit the scope of the proceeding?

A: Yes.

a. The Patent Owner can disclaim claims at any time.
b. The Petitioner can request adverse judgment on claims and/or grounds at any time.

B13. Q: Will the Board relieve Patent Owner from responding to frivolous grounds given a panel will institute on all challenges or none?

A: The panel will assess the merits of the Petitioner's challenges in view of the complete record as necessary to decide the patentability of claims in the final written decision. Nevertheless, depending on the case, it may be in the Patent Owner's interest to point out deficiencies in the Petitioner's case.

B14. Q: If the Patent Owner does not take the opportunity to supplement its Response, will the Petitioner be allowed to say anything in response to the newly instituted claims and/or grounds given that the Board may have previously found no reasonable likelihood as to those claims and/or grounds?

A: Yes, the Petitioner generally will receive a limited opportunity for supplemental briefing, to respond to the Institution Decision, regardless of whether Patent Owner says anything about the claims or grounds added to the proceeding.

B15. Q: If the Board found no reasonable likelihood as to certain claims and/or grounds, then why is the Board allowing additional briefing on them?

A: Because a panel's determination is preliminary, the Petitioner may be able to direct the panel to information in the record that it overlooked or misunderstood. The panel will consider whether the Petitioner's briefing is outside the scope of a permissible rebuttal to the Institution Decision.

B16. Q: Will a party be able to retake a deposition to address claims and/or grounds that were originally denied?

A: The Board envisions that, under certain circumstances, a witness may need to be deposed again for the limited purpose of addressing claims and/or grounds that have now been added to the proceeding. The Board expects the parties to meet and

confer to resolve discovery issues arising from supplemental institution of claims and/or grounds.

C. Effect of *SAS* on instituted challenges previously denied for statutory reasons

C1. Q: 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)?

A: No, at this time the Board does not anticipate vacating prior institution decisions under these circumstances. Although challenges subjected to § 325(d) will be addressed in the Final Written Decision, panels will take into account evidence that the same or substantially the same art or argument was previously before the Office and give such evidence due weight in addressing the challenge.

C2. Q: 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)?

A: No, at this time the Board does not anticipate vacating prior institution decisions under these circumstances. Depending on the circumstances, panels may allow parties additional briefing to (1) provide a sufficient construction, (2) address how the panel should proceed to apply the prior art to the claim limitation even if insufficient structure has been identified, and (3) address how the panel should reach a determination with respect to that claim in the Final Written Decision.

C3. Q: How will the Board address institution of additional claims, where those claims were originally denied institution on the basis of estoppel under section 315(e)?

A: The panel will add such claims to the proceeding. However, section 315(e) states that a petitioner may not "maintain a proceeding" as to estopped claims. Therefore, even though such claims are technically in the proceeding, the panel will decide such claims in favor of the Patent Owner. This may not preclude a different petitioner from challenging the same claims.

D. Effect of *SAS* on future challenges that could be denied for statutory reasons

D1. Q: 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?

A: The panel will evaluate the challenges and determine whether § 325(d) is sufficiently implicated that its statutory purpose would be undermined by instituting on all challenges. If so, the panel will evaluate whether the entire petition should be denied.

D2. Q: 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?

A: The panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (*see* 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).

D3. Q: Will the Board institute a petition based on the percentage of claims and grounds that meet the reasonable likelihood standard, e.g., 50%?

A: No. The Board does not contemplate a fixed threshold for a sufficient number of challenges for which it will institute. Instead, the panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (*see* 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).

D4. Q: 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)?

A: The panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (*see* 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).

E. Content of institution decisions post-*SAS*

E1. Q: Will the Board change how it does institution decisions as a result of *SAS*? For example, will the Board's institution decisions address one claim and one ground?

A: The Board will endeavor to provide details to the parties. For example, a panel generally will try to provide information responding to the Patent Owner's arguments (assuming the Patent Owner filed a Preliminary Response) to help the parties understand the panel's preliminary view of the merits of the parties' arguments.

E2. Q: Will the Board's institution decisions continue to find when challenges do not meet the reasonable likelihood standard?

A: To the extent a panel finds certain challenges do not meet the reasonable likelihood standard at the institution stage in view of the parties' arguments, the panel will indicate its view in the decision to institute, even if the result is to institute on all challenges.

E3. Q: 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?

A: The Board is not prohibited from providing its preliminary assessment regarding the Petitioner's challenges. A panel's view of a patent owner's arguments at the time of institution may provide valuable insight to the parties to put them on notice as to the panel's view of the arguments at that stage, so that they have a full and fair opportunity to develop a record for the trial portion of the proceeding. This could help streamline proceedings and help the parties and the panel to focus on key disputes.

E4. Q: How can the Board provide its view that the 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?

A: The Board's institution decision is a preliminary finding based on an incomplete record and before the parties have had a full opportunity to be heard. Panels frequently institute based on a reasonable likelihood standard and then ultimately find the claims not unpatentable based on a preponderance of the evidence, once the complete record has been developed. Therefore, the opposite is also possible.

F. For additional questions about *SAS*

F1. Q: If a party has additional questions regarding the implications of *SAS* for a specific trial, what should the party do?

A: Submit case-specific questions (e.g., request a call with the Board) via email to trials@uspto.gov

F2. Q: If a member of the public has a general question regarding *SAS*, but does not have a case pending before the Board, what should the party do?

A: Submit general *SAS* related questions via email to trials@uspto.gov