UNITED STATES
PATENT AND TRADEMARK OFFICE

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APPLE 1033

Patent Trial and Appeal Board (PTAB) Boardside Chat: Interim processes relating to institution in AIA proceedings

Janet Gongola, Chief Communications Officer (Acting)
Michelle Ankenbrand, Senior Legal Advisor (Acting)
Kalyan Deshpande, Vice Chief Administrative Patent Judge

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Question/comment submission

To send in questions or comments during the webinar, please email:

- PTABBoardsideChat@uspto.gov

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Agenda

1. New interim processes for PTAB workload management overview (“Interim processes”)
2. Interim processes operations and filing director discretionary denial briefing
3. Q&A

Interim processes for PTAB workload management

Interim processes

- Acting Director Stewart issued interim processes memorandum on March 26, 2025.
  - www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf
- The USPTO is planning to begin notice and comment rulemaking after some experience with the interim processes.

Interim processes (cont'd)

- Decisions on whether to institute an AIA trial will be bifurcated between:
  - discretionary considerations and
  - merits and other non-discretionary considerations

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Interim processes (cont'd)

- The Director (in consultation with at least three senior PTAB judges) will determine whether discretionary denial of institution is appropriate.
- If not appropriate, a Board panel will address the merits and other non-discretionary considerations and determine whether to institute.

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Interim processes (cont'd)

- Processes go into effect in cases where the deadline to file a patent owner preliminary response (POPR) had not yet passed—i.e., it does not apply in cases where a patent owner filed a POPR (or date for filing one has passed)—as of March 26, 2025.
- Processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings.

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Interim processes (cont'd)

- To facilitate, the USPTO will permit both parties to file a separate briefing on requests for discretionary denial of institution.
  - A patent owner may file a discretionary denial brief after the PTAB issues a Notice of Filing Date Accorded (or a Notice of Defective Petition) and the PTAB accepts patent owner's Mandatory Notice.
  - A petitioner may file an opposition brief in P-TACTS after the patent owner files its discretionary denial brief.

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Interim processes (cont'd)

- Consistent with existing precedent and guidance, parties are permitted to address all relevant discretionary considerations, including:
  - Whether PTAB or another forum has already adjudicated validity or patentability of the challenged claims;
  - Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
  - The strength of the unpatentability challenge;
  - The extent of the petition's reliance on expert testimony;
  - Settled expectations of parties, such as the length of time the claims have been in force;
  - Compelling economic, public health, or national security interests; and
  - Any other considerations bearing on the Director's discretion.

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Question/comment submission

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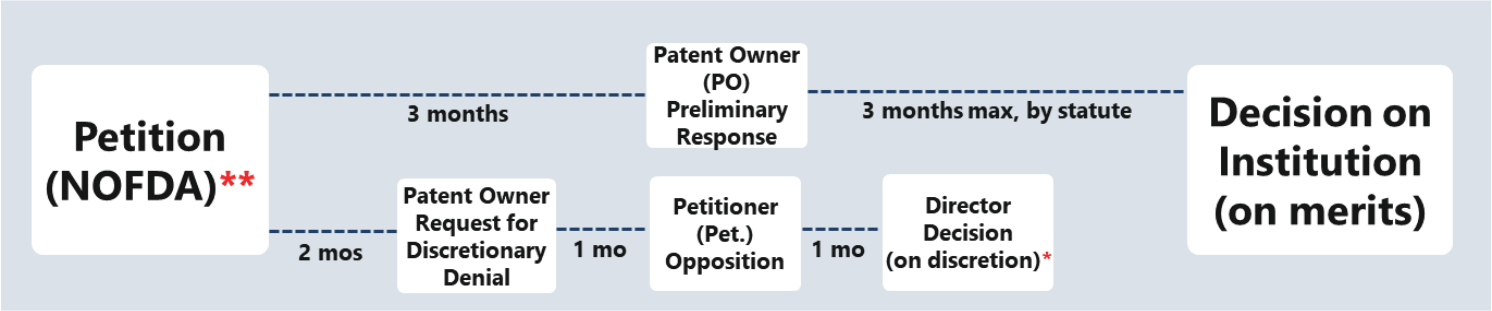
Interim Processes Operations

Timeline: AIA proceedings

Interim processes (March 26, 2025 memorandum)

Preliminary Phase



** Notice of filing date accorded

* If the Director does not exercise discretion to deny institution, a Board panel determines whether to institute based on merits

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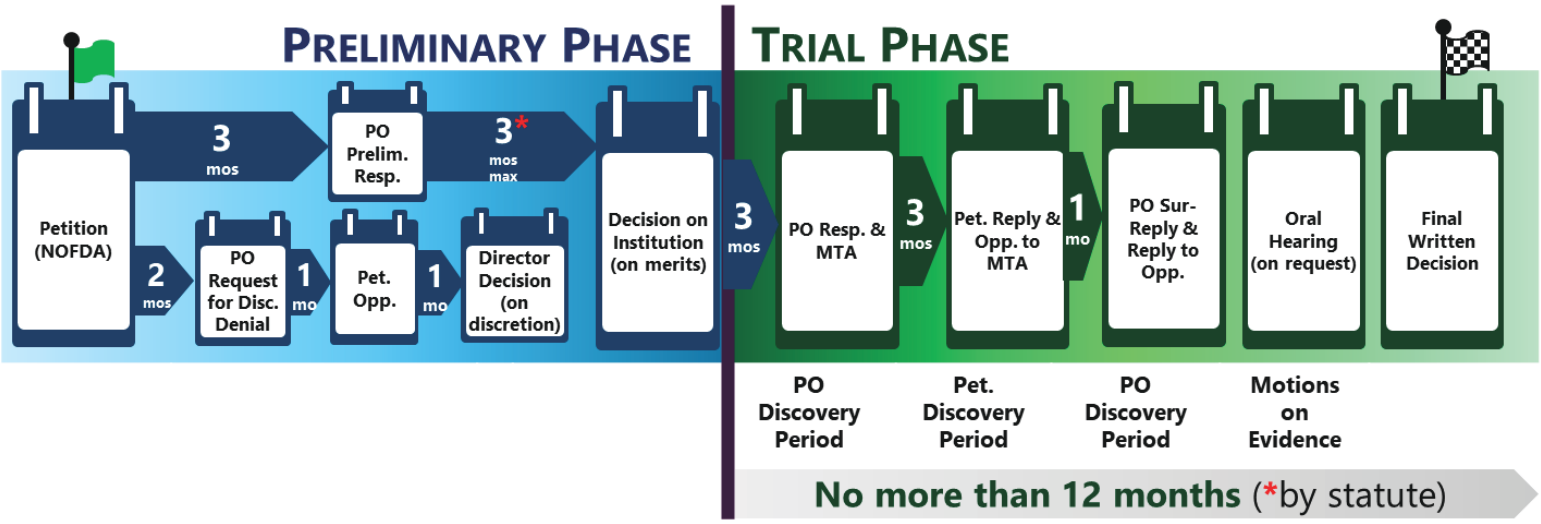
Timeline: AIA proceedings

Interim processes (March 26, 2025 memorandum)



Interim processes

- The bifurcated process is available in cases in which the patent owner files a preliminary response, or the deadline for the patent owner to file a preliminary response occurs, after March 26, 2025.
- In cases where the time for filing a discretionary denial brief has not yet elapsed but will elapse in 1 month or less after March 26, 2025, the Board has or will issue a notice extending the deadline.
  - The patent owner's brief will be due no later than 1 month of the date of the notice.
  - The petitioner's brief will be due no later than 1 month after the patent owner files its brief.

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Interim processes (cont'd)

- In cases where the time for filing a discretionary denial brief has elapsed, but the deadline for filing a patent owner preliminary response had not yet passed as of March 26, 2025.
  - As the March 26 memorandum states, the patent owner's brief will be due within one month of the date of the memorandum.
  - The petitioner's brief will be due no later than one month after the patent owner files its brief.

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Filing discretionary considerations briefs in P-TACTS

- On April 11, the PTAB introduced two new paper types in P-TACTS:
  - PO Discretionary Denial Brief
  - PET Opposition to Discretionary Denial Brief
- For timely consideration, parties should use these new paper types to file discretionary considerations briefs.
- If you filed a discretionary considerations brief before April 14, please email Director_Discretionary_Decision@USPTO.gov:
  - The email should identify the IPR or PGR number and the date the brief was filed
  - The email should copy counsel for all parties

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Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a patent owner discretionary denial brief:
  - Log into P-TACTS.
  - Go to My Docket and select the AIA Review case number to open Case Viewer.
  - Select the "+Add Document" button and File Other Document modal from the menu option.
  - Select "PO Discretionary Denial Brief" from the list of paper types.
  - Enter information into all required fields marked by a red asterisk beginning with paper type.
  - Select "PO Discretionary Denial Brief"; and
  - Click on "Add to List" and then "Submit."

Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a petitioner opposition to a discretionary denial brief:
  - Log into P-TACTS.
  - Go to My Docket and select the AIA Review case number to open Case Viewer.
  - Select the "+Add Document" button and File Other Document modal from the menu option.
  - Select "PET Opposition to Discretionary Denial Brief" from the list of paper types.
  - Enter information into all required fields marked by a red asterisk beginning with paper type.
  - Select "PET Opposition to Discretionary Denial Brief"; and
  - Click on "Add to List" and then "Submit."

Questions

Questions

For any questions, please email:

Director_Discretionary_Decision@uspto.gov or

call 571-272-7822.

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DEPARTMENT OF COMMERCE