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2023 PTAB Annual Conference Takeaways

Choate attended the recent PTAB Bar Association Conference in Washington, DC to hear the latest updates and trends. The conference included a keynote speech by Chief Judge Scott Boalick, a “fireside chat” with Under Secretary of Commerce for IP and Director of the USPTO, Kathi Vidal, and the always enjoyable Judges’ Panel.

Below are the key takeaways from the conference.

Effective Use of an Expert in a PTAB Proceeding

Due to the technical nature of patent claims under review in PTAB proceedings, expert opinions on the relevant technology, prior art teachings, and patented claims can strongly influence PTAB proceeding outcomes. At the conference, a panel of experienced PTAB practitioners and Administrative Patent Judges (APJs) discussed key considerations and best practices for using experts in PTAB proceedings.

When selecting an expert for a PTAB proceeding, qualifications and experience are paramount. This is in contrast with district court trials where an expert’s demeanor and temperament play a much larger role in live testimony. In addition, while an expert needs to be a person of skill in the art in order to opine from the perspective of a skilled artisan, specific experience with the patented technology may be more credible to the PTAB as compared to an expert whose expertise is more general. This was highlighted in the recent Federal Circuit case *Kyocera Senco Indus. Tools, Inc. v. ITC*, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022), where the Board excluded an expert’s testimony for not being specific to the level of skill required. Some APJs at the conference noted they tend to see a recurring group of expert declarants, and that there is a need to diversify the pool of experts before the PTAB. The PTAB Bar Association has started an Expert Initiative with the USPTO to increase the diversity of expert witnesses before the PTAB in trial proceedings.

While limited word counts in petitions may tempt petitioners to liberally refer to an expert declaration, it cannot be incorporated by reference into the petition. Similarly, when crafting an expert declaration petitioners must take care not to simply copy portions of the petition into the declaration. *Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022–00624, Paper 9 (August 24, 2022), which was recently designated as precedential, underscores that an expert declaration that merely repeats conclusory assertions in the petition will be entitled to little weight. To be successful, petitioners need to strike a balance and offer some level of explanation in the petition while using an expert declaration to provide additional explanation, background, and evidence. One panelist pointed out that APJs have the technical expertise to review an expert’s source materials as part of their fact checking and credibility assessment.

Petition Tips and Persuasive POPRs

When drafting petitions and patent owner preliminary responses (POPRs), it is important to pay attention to word count limits while comprehensively addressing potential issues in pre-institution briefings.

Notably, the word count limit for IPR petitions is 14,000 words and Petitioners must to comply with that limit while sufficiently addressing a host of topics, including grounds for challenge, real-parties-in-interest, , claim construction, and arguments against any potential grounds for discretionary denials. APJs and practitioners discussed this tension, and offered the following practical tips to maximize the effect of petitions and POPRs:

Petitions

- Focus on the merits and analysis, and do not spend too much time on the “story”
- Prioritize claim construction, particularly when it may be dispositive
- When considering how much effort to put into discretionary denial arguments, be aware that institution rates are on the rise (PTAB instituted 66% of petitions in FY2022) and non-merits denials are declining
- Optimize word count by adding an appropriate appendix, filing a motion to exceed word count, or filing multiple petitions (but note any multiple petition approach must be carefully considered)

POPRs

- Give the POPR serious consideration to help gauge what the APJs are thinking and/or how well certain arguments will be received
- Use the POPR to identify statutory bars and grounds for discretionary denials
- Maintain a focused approach in attacking the petitioner’s strongest argument(s)
- Propose an alternative interpretation when refuting a petitioner’s claim construction
- Consider providing evidence of particularly compelling secondary considerations at the pre-institution phase

Consider Reissue and Ex Parte Reexamination

IPR is the first thing that comes to mind for many when thinking about post-grant proceedings, but it is important for both patent owners and patent challengers to remember that IPR is not the only type of post-grant proceeding available at the USPTO. Reissue and ex parte reexamination, often overlooked proceedings at the USPTO, also warrant strategic consideration as a defense by patent owners to address known issues with patent claims, while minimizing the ability of third parties to influence the proceeding.

Reissue and reexamination are also potential mechanisms for patent owners to rehabilitate patents damaged by an adverse outcome in a USPTO or district court proceeding. For example, adverse claim constructions and/or invalidity rulings may be satisfactorily addressed in a reissue or reexamination. For patent challengers, reexamination offers a cost-effective means to challenge the validity of a patent without time-constraints, albeit with minimal opportunity for involvement in the proceeding after request filing. Both patent owners and potential patent challengers should proactively consider the entire gamut of post-grant proceedings, each with its own pros and cons, when developing their overall enforcement or invalidity strategy.

Diversity Initiatives Update

The USPTO continues to implement initiatives to increase diversity at the office and externally, through programs such as the women entrepreneurship initiative, and programs that work with first-time patent filers who are small business owners and individual inventors. In particular, the PTAB continues to encourage:

1. Participation in the PTAB initiative LEAP, which provides training and oral advocacy opportunities for less experienced practitioners.
2. Ensuring that attorneys and practitioners who are practicing before USPTO – not just supervising practitioners – receive proper attribution to address the issue of misattribution, which disparately affects underrepresented members of the legal community.

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