

Updates to PTAB Trial Practice Guide Provide Better IPR Road Map

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Patent Trial and Appeal Board (PTAB) proceedings, such as inter partes reviews (IPRs), have become popular alternatives to patent litigation in federal courts. Recent updates to the PTAB's Trial Practice Guide provide welcome insight on how the PTAB will address certain procedural issues. For patent owners and patent challengers alike, the updates provide greater predictability. The new guidelines in three areas are particularly notable.

First, the PTAB generally presumes that a single petition challenging a patent should suffice. In its updated guidance, the PTAB acknowledges that, in some circumstances, parallel petitions challenging the same patent may be warranted. Appropriate circumstances may include a patent owner's assertion of a large number of claims during litigation or a patent priority dispute making different references relevant. The updated guidance explains that a petitioner filing multiple challenges to the same patent should rank the petitions and explain the differences between them.

Second, although a patent owner has always had the opportunity to amend claims in an IPR, very few have successfully amended claims. In the updated guidance, the PTAB encourages patent owners to make claim amendments. The PTAB explains the relevant standards and available processes. Importantly, the updated guidance notes that the petitioner, not the patent owner, bears the burden of demonstrating that amended claims are not patentable.

Third, while final decisions in IPRs are often appealed, IPRs are rarely remanded. For that reason, how the PTAB will address remanded IPRs remains largely unknown. The updated guidance explains that the parties must contact the PTAB within ten days of an IPR remand and should try to agree on how to proceed before conferring with the PTAB. The PTAB's goal is to issue new decisions within six months of remand.

The updated guidance is a welcome step toward predictability in PTAB proceedings. This guidance helps both petitioners and patent owners navigate once-murky procedures for achieving various goals. In short, the updated guidance makes patent challenges a fairer fight between petitioners and patent owners.