

Response to WIPO Circular 8893 (July 17, 2019)

The Leahy-Smith America Invents Act (AIA) of 2011 established the Patent Trial and Appeal Board (PTAB) in the United States Patent and Trademark Office (USPTO).¹ Over the past couple of years, the Supreme Court of the United States has issued various opinions affecting PTAB practice. The USPTO has also reformulated various aspects of PTAB practice over the same period. Below is a brief summary of some developments, responsive to item (ii) of WIPO Circular 8893 (update to national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms).

Under the AIA, the PTAB oversees several types of post-grant proceedings, including: *inter partes* reviews (IPR); post-grant reviews (PGR); and covered business method reviews (CBM). Those three proceedings differ with respect to types of qualifying patents and/or scope of legal challenges. So far, IPRs are the most common form of those proceedings at the USPTO.² In 2018, the Supreme Court issued an opinion confirming the constitutionality of IPRs as a viable administrative procedure for challenging the validity of a patent.³ In a separate decision, the Supreme Court also found that instituted IPRs should address all challenged claims of a patent (rather than a subset of challenged claims).⁴ Finally, in 2019, the Supreme Court found that the U.S. government is not a “person” capable of petitioning for institution of an AIA review proceeding.⁵

Over the last year, the USPTO has made a number of revisions to AIA review procedures to enhance consistency, transparency, and certainty. For example, the USPTO changed PTAB rules directed to the claim construction standard applied during AIA proceedings. The USPTO replaced the “broadest reasonable interpretation” standard, the standard still used during examination of patent applications, with the claim construction standard used by federal courts to construe a claim in a civil action.⁶ As it relates to claim amendments, the PTAB began a new pilot program for motion to amend procedures in AIA cases.⁷ Regarding practice before the Board generally, the PTAB published updates to its AIA Trial Practice Guide containing additional detailed guidance.⁸ The PTAB also updated its standard operating procedures for paneling cases and issuing precedential (binding) and informative decisions. Following the new procedures, the USPTO recently designated a number of decisions as precedential or informative, providing further guidance to stakeholders. Information and documents relating to recent PTAB changes are readily available on the PTAB’s website at <https://www.uspto.gov/patents-application-process/patenttrialandappealboard>.

¹ § 7, 35 U.S.C. § 6 (replacing the Board of Patent Appeals and Interferences).

² PTAB, Trial Statistics (June 2019), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/statistics>.

³ *Oil States Energy Servs. v. Greene’s Energy Grp.*, 138 S. Ct. 1365, 1370 (2018).

⁴ *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356-57 (2018).

⁵ *Return Mail, Inc. v. U.S. Postal Serv.*, 139 S. Ct. 1853, 1871 (2019).

⁶ 83 FR 51340.

⁷ 84 FR 9497.

⁸ <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf> (Trial Practice Guide Update (July 2019)); https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (Trial Practice Guide Update (August 2018)).