

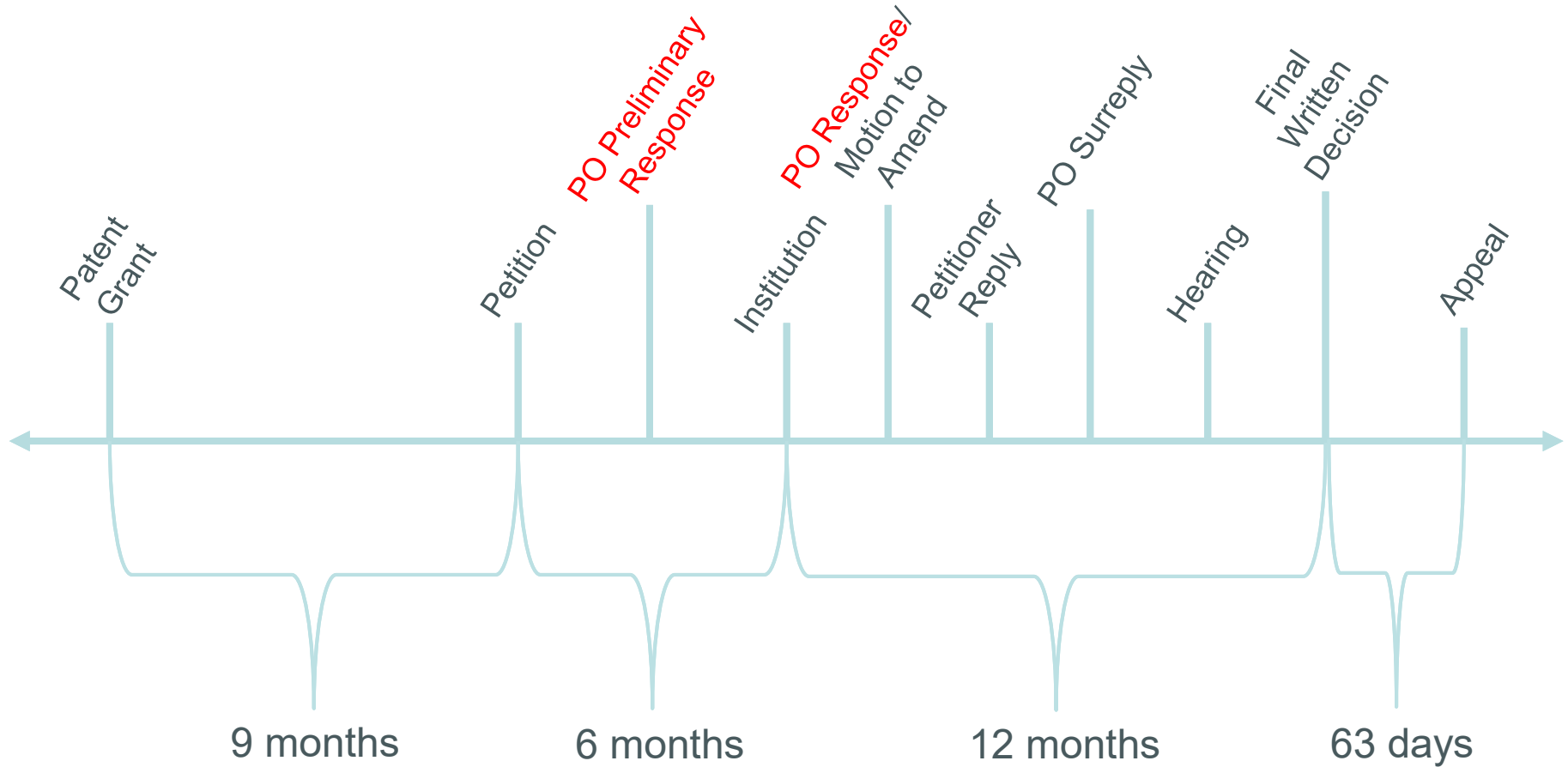
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# **A Guide to Patent Owner Responses**

PTAB Bar Association Young Lawyers & Agents  
Committee Nuts & Bolts Series

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# Overview of Patent Owner Responses



# Differences between POPR and POR: POPRs

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- 37 CFR § 42.107 Preliminary response to petition.
  - (a) The patent owner may file a preliminary response to the petition. The response is limited to setting forth the reasons why no *inter partes* review should be instituted under 35 U.S.C. 314 and can include supporting evidence. The preliminary response is subject to the word count under § 42.24.
    - *Optional, not mandatory – “may file”*
    - *Can include supporting evidence – including:*
      - *New declarations*
      - *Deposition transcripts, trial transcripts, expert reports, etc. from other proceedings.*
    - *Word count: 14,000 words (IPR)*

# Differences between POPR and POR: POPRs

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- 37 CFR § 42.107 Preliminary response to petition.
  - (b) Due date. The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date. A patent owner may expedite the proceeding by filing an election to waive the patent owner preliminary response.
    - *Due 3 months after PTAB assigns a filing date to the petition.*
    - *Patent Owner may expedite proceeding by waiving POPR.*

# Differences between POPR and POR: POPRs

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- 37 CFR § 42.107 Preliminary response to petition.
  - (d) No amendment. The preliminary response shall not include any amendment.
  - (e) Disclaim Patent Claims. The patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.
    - *Amendment not available at POPR stage.*
    - *Patent Owner can file statutory disclaimer – potentially powerful tool to eliminate grounds or defeat entire petition.*

# Differences between POPR and POR: POPRs

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- Types of Potential Challenges
  - Jurisdiction Challenges
    - Did petitioner meet 1 year statutory bar?
    - Did petitioner file a declaratory judgment complaint prior to petition?
    - Real party in interest/privity: does estoppel apply?
    - Has the Petition named all real parties in interest?
  - Claim Construction Challenges
  - Discretionary Challenges
    - § 314(a) Parallel district court litigation
    - § 314(a) Multiple petitions
    - § 325(d) “Substantially the Same Art or Arguments”
  - Substantive Challenges

# Differences between POPR and POR: PORs

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- 37 CFR § 42.120 Patent owner response.
  - (a) Scope. A patent owner may file a single response to the petition and/or decision on institution. A patent owner response is filed as an opposition and is subject to the page limits provided in § 42.24.
  - (b) Due date for response. If no time for filing a patent owner response to a petition is provided in a Board order, the default date for filing a patent owner response is three months from the date the inter partes review was instituted.
    - *Word count: 14,000 words*
    - *Generally due 3 months after institution BUT check the scheduling order (it could be less)*

# Differences between POPR and POR: PORs

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- Types of Potential Challenges
  - Missing claim elements
  - Claim construction
  - Status of references as prior art
  - Anticipation arguments
    - Inherency
  - Obviousness arguments
    - Motivation? Sufficient explanation?
    - Secondary indicia of non-obviousness



# Differences between POPR and POR

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- Same word limit for both
  - 14,000 words (used to be page limited)
  - Counsels toward use of figures, particularly in POR
- POR must include all arguments that will inform FWD
  - Sur-reply is responsive with no new evidence
- POPR not part of trial record, so remake arguments
- POR can be filed with motion to amend, but those are generally contingent, so still need POR

# Differences between POPR and POR

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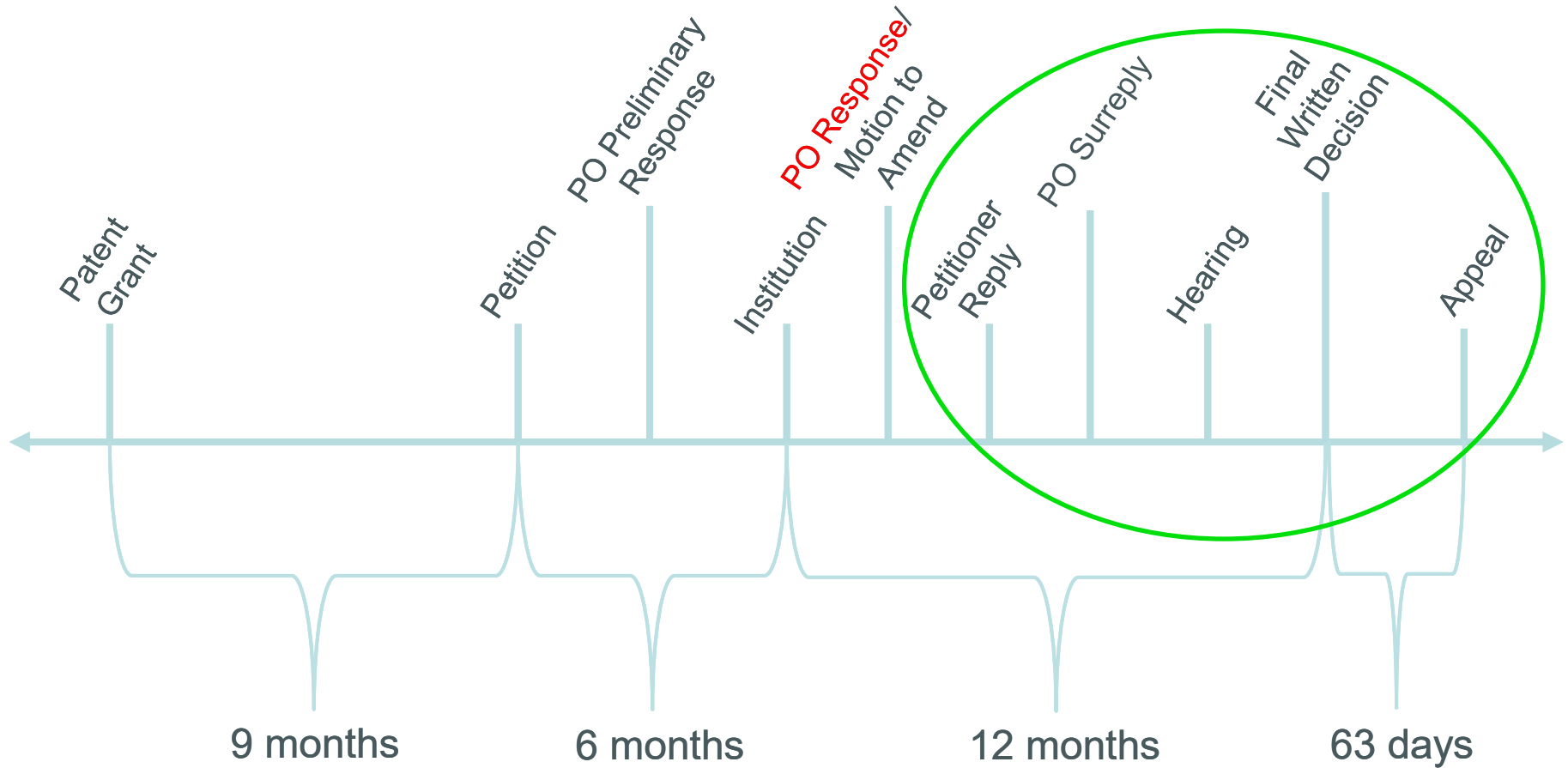
- POR arguments often much more factual
- Discovery – Deposition(s)
- Petitioner gets a reply
  - Replies to POPRs can be requested from the Board but must be accompanied by showing of good cause.  
37 CFR § 42.108(c)
- Appeal ultimately available

# Gathering Evidence

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- Start early!
- Deposition to support POR
  - When?
    - Must take place more than a week before filing the POR. 37 CFR § 42.53(d)(2).
    - Party seeking deposition must file a notice of deposition at least ten days before the deposition. 37 CFR § 42.53(d)(4).
  - Goals: key admissions, explanation of confusing testimony, cut off future counter-arguments
- Supporting declaration from one or more experts
- Supportive evidence (textbooks, etc.) can be very impactful, but know the whole reference
- Additional discovery needed?

# What's Next?



# PO Sur-reply

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- § 42.23 Oppositions, replies, and sur-replies.
  - (b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution. A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.
    - *Sur-reply to Petitioner's Reply now a matter of right*
    - *No new evidence except deposition transcripts (if any)*
    - *Word limit: 5,600 words*

# Additional PTAB Materials

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- The PTO has more information about PTAB Trials:  
<https://www.uspto.gov/patents/ptab/trials>
- PTAB Trial Practice Guide available at:  
<https://www.uspto.gov/patents/ptab/resources>
- Other Nuts & Bolts Presentations available at:  
[https://www.ptabbar.org/young\\_lawyers\\_and\\_agents\\_commi.php](https://www.ptabbar.org/young_lawyers_and_agents_commi.php)
- My firm, Fish & Richardson, has post-grant materials available at:  
<https://www.fr.com/services/post-grant/>

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*Questions?*