

October 30, 2020

## PTAB Reforms Under Director Iancu's Leadership

David McCombs, Eugene Goryunov, Clint Wilkins, Jonathan Bowser, and Angela Oliver<sup>1</sup>

Andrei Iancu was sworn in as Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office (PTO) on February 23, 2018, after being unanimously confirmed by the Senate.<sup>2</sup> During his nomination hearings, Mr. Iancu testified that he would take a hard look at the Patent Trial and Appeal Board (PTAB) and try to achieve what he viewed as the correct balance between fostering innovation and improving patent quality.<sup>3</sup> Shortly after his confirmation, Director Iancu stated that, under his leadership, the PTAB would “take a holistic approach to fully implement the intent” of the America Invents Act (AIA) so that PTAB trials would “be a true alternative to district court litigation, not a consistent multiple bite at the apple.”<sup>4</sup>

Change began swiftly under Director Iancu's leadership, whether as a necessary reaction to court decisions or as a concerted effort to update (or wholesale change) PTAB trial practice. And while many stakeholders have applauded the changes made to PTAB trial practice over the past few years, change, of course, is almost never without controversy. Regardless, PTAB trial practice has undergone substantial transformation with Director Iancu at the helm. This article summarizes the most significant changes.

### I. Changes/Actions Necessitated by Court Decisions

One of the first major changes to PTAB practice during Director Iancu's tenure was prompted not by any agency-initiated action, but by a significant U.S. Supreme Court decision. Shortly after the Senate confirmed Director Iancu, the Court decided *SAS Institute Inc. v. Iancu*.<sup>5</sup> There, the Court struck down the PTAB's “partial institution” practice—a practice where a panel could institute an inter partes review (IPR) on less than all challenged claims—holding that the petitioner, not the PTO, controls the scope of the petitioner's challenge. As a result, the PTAB must institute and issue a final written decision on all claims challenged by the petitioner, if the PTAB institutes an IPR trial.<sup>6</sup> Two days after the decision in *SAS Institute*, the PTO issued agency Guidance on the impact of *SAS Institute*. The PTO took an expansive view of *SAS Institute* and, as a policy matter, extended the Court's holding to require the PTAB to institute a PTAB trial on all challenged claims and all asserted grounds, or none at all.<sup>7</sup>

<sup>1</sup> This article reflects only the present personal considerations, opinions, and/or views of the authors, which should not be attributed to any of the authors' current or prior law firm(s) or former or present clients.

<sup>2</sup> <https://www.uspto.gov/about-us/news-updates/remarks-director-andrei-iancu-ceremonial-swearing-ceremony> (swearing in); <https://www.congress.gov/nomination/115th-congress/927> (unanimous confirmation).

<sup>3</sup> *Hearing to Consider Nominations Before the S. Comm. on the Judiciary: Sen Grassley's Written Questions for Andrei Iancu*, 115<sup>th</sup> Cong. 1 (2017), available at:

<https://www.judiciary.senate.gov/imo/media/doc/Iancu%20Responses%20to%20QFRs.pdf>.

<sup>4</sup> Remarks by Director Andrei Iancu at the American Enterprise Institute, available at:

<https://www.uspto.gov/about-us/news-updates/remarks-director-andrei-iancu-american-enterprise-institute> (June 21, 2018).

<sup>5</sup> 138 S. Ct. 1348 (2018).

<sup>6</sup> *Id.* at 1355.

<sup>7</sup> Guidance on the Impact of SAS on AIA Trial Proceedings, available at: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (April 26, 2018).

More recently, the Federal Circuit decided *Arthrex, Inc. v. Smith & Nephew, Inc.*<sup>8</sup> in which the court held that the appointment of the PTAB's administrative patent judges (APJs) violated the Appointments Clause of the Constitution. The court held that APJs are principal officers that must be nominated by the President and confirmed by the Senate. Because APJs, of course, do not go through the Senate confirmation process, the court held that the APJs were therefore not constitutionally appointed.<sup>9</sup> And, while the court corrected the constitutional infirmity in its decision by altering the removal protections previously enjoyed by APJs, the court nonetheless vacated many Board decisions issued prior to the decision in *Arthrex* and remanded those cases for decision by a new, constitutionally appointed panel.<sup>10</sup> In response to the large volume of cases remanded to the PTAB, on May 1, 2020, the PTAB issued a "General Order" indicating that the PTAB will hold in administrative abeyance all cases remanded under *Arthrex* "until the Supreme Court acts on a petition for *certiorari* or the time for filing such petitions expires."<sup>11</sup>

## II. Changes to PTAB Trial Practice and Introduction of a Motion to Amend Pilot Program

In addition to changes brought about by court decisions, the PTO has taken a hard look at PTAB trial practice and, under Director Iancu's supervision, proposed multiple sweeping rule changes over the past two years. First, mere weeks after Director Iancu took office, the PTO published a Notice of Proposed Rulemaking (NPRM) proposing to change the claim construction standard used in PTAB trials from the historically approved broadest reasonable interpretation standard to the *Phillips* standard used in U.S. district courts.<sup>12</sup> The PTO explained that the shift "could lead to greater uniformity and predictability of the patent grant," and "addresses the concern that potential unfairness could result from using an arguably broader standard in AIA trial proceedings." Following stakeholder feedback, the PTO published a final rules package implementing the change.<sup>13</sup>

Next, in early 2019, the PTO implemented a new, optional motion-to-amend pilot program.<sup>14</sup> The pilot program provides a patent owner with two new options: first, the patent owner may elect to receive preliminary guidance from the PTAB on its motion to amend after the petitioner files its opposition; and second, a patent owner may elect to file a revised motion to amend after receiving the petitioner's opposition or the PTAB's preliminary guidance. This new process results in an accelerated briefing schedule but, arguably, affords patent owners additional guidance in its amendment efforts. The pilot program is currently operational, but the PTO has yet to publish final rules regarding this program.

---

<sup>8</sup> 941 F.3d 1320, 1325, 1335 (Fed. Cir. 2019), *en banc reh'g denied*, 953 F.3d 760 (2020).

<sup>9</sup> *Id.* at 1327–28.

<sup>10</sup> *Id.* at 1340.

<sup>11</sup> <https://secureservercdn.net/184.168.47.225/9ac.02d.myftpupload.com/wp-content/uploads/2020/05/Order.pdf>.

<sup>12</sup> Notice of Proposed Rulemaking Regarding "Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board," 83 Fed. Reg. 21,221, 21,222–23 (May 9, 2018).

<sup>13</sup> Final Rule Regarding "Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board." 83 Fed. Reg. 51,340 (Oct. 11, 2018).

<sup>14</sup> Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497 (Mar. 15, 2019).

The PTO closed 2019 with an additional NPRM in which it proposed allocating burdens of proof where a patent owner files a motion to amend.<sup>15</sup> The proposed rules place the burden on the patent owner to show procedural compliance and on the petitioner to show that any proposed substitute claims are unpatentable. These proposed rules are consistent with the Federal Circuit's *en banc* decision in *Aqua Products, Inc. v. Matal*.<sup>16</sup> The PTO has yet to issue a final rules package.

Most recently, the PTO published one more NPRM proposing rules regarding three additional changes to PTAB trial practice.<sup>17</sup> First, to codify its Guidance on the impact of *SAS Institute*, the PTO proposed a rule change requiring the PTAB to institute an AIA trial on all challenged claims and all asserted grounds, or none at all. Second, and consistent with current practice, the PTO proposed to automatically authorize sur-replies to principal briefs (e.g., a patent owner sur-reply to a petitioner reply). Lastly, in what some have called a complete policy reversal, the PTO proposed eliminating current rules that establish a presumption that genuine issues of material fact resulting from conflicting testimonial evidence would be viewed in the light most favorable to the petitioner for purposes of institution only. The PTO has not yet issued final rules regarding these proposed changes.<sup>18</sup>

### III. Precedential PTAB Decisions

Another way in which PTAB practice has changed in the past few years is with respect to precedential guidance provided by the agency. Director Iancu testified during his nomination hearings that he would endeavor “to provide predictability and guidance to IPR stakeholders and the public” by increasing the number of PTAB precedential decisions.<sup>19</sup> By all measures, he has delivered on this promise.

As an initial step, the PTO, under Director Iancu's supervision, revised the PTAB's Standard Operating Procedure (SOP) 2 to establish the Precedential Opinion Panel (POP) and recalibrate the process for designating PTAB decisions as precedential or informative.<sup>20</sup> The POP—which empanels the Director, Commissioner for Patents, and PTAB's Chief Judge, or their delegates—is designed to “decide issues of exceptional importance” and “establish binding agency authority concerning major policy or procedural issues.” It may also decide whether a decision should be designated (or de-designated) precedential or informative.

To date, the POP has been convened to hear and decide important issues in four cases. The POP has also significantly increased the number of PTAB decisions designated precedential in AIA trials. To demonstrate the effectiveness of the POP, from 2012-2018, the PTAB designated a mere ten decisions as precedential. In 2019 alone, however, the POP designated 19 decisions as precedential (16 PTAB decisions were designated

---

<sup>15</sup> Notice of Proposed Rulemaking re “Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board.” 84 Fed. Reg. 56,401, 56,402 (Oct. 22, 2019).

<sup>16</sup> 872 F.3d 1290 (Fed. Cir. 2017) (*en banc*).

<sup>17</sup> Notice of Proposed Rulemaking re “PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence.” 85 Fed. Reg. 31728 at 31729-30 (May 27, 2020).

<sup>18</sup> Public comments in response to this NPRM can be viewed at: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/comments-proposed-rules-aia-trial>.

<sup>19</sup> *Hearing to Consider Nominations Before the S. Comm. on the Judiciary: Sen Grassley's Written Questions for Andrei Iancu*, 115th Cong. 1 (2017), available at: <https://www.judiciary.senate.gov/imo/media/doc/Iancu%20Responses%20to%20QFRs.pdf>.

<sup>20</sup> SOP 2 (rev. 10), available at: <https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>.

precedential, and an additional three POP decisions were automatically designated precedential). So far this year, the POP has designated five decisions as precedential (four PTAB decisions and an additional POP decision).

## A. POP Decisions

Use of the POP is reserved for important issues that impact the PTAB's overall trial practice; it is not intended to address routine matters. In its first decision, *Proppant Express Inves., LLC v. Oren Techs., LLC*, the POP held that 35 U.S.C. § 315(c) provides the PTAB with discretion to join an otherwise time-barred IPR petition (and any new issues the petition presents) to an IPR trial instituted on the same petitioner's earlier, non-time-barred petition (a practice commonly known as same-party joinder).<sup>21</sup> The POP explained, however, that the PTAB should exercise its discretion to allow this "only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party."<sup>22</sup>

After *Proppant Express*, the POP decided three additional issues. First, in *GoPro, Inc. v. 360Heros, Inc.*, the POP held that service of an infringement complaint triggers the one-year period for a petitioner to file an IPR petition even if the serving party lacks standing to sue or the pleading is otherwise deficient.<sup>23</sup> Second, in *Hulu, LLC v. Sound View Innovations, LLC*, the POP held that, at the institution stage, the petition must identify with particularity evidence sufficient to establish a reasonable likelihood that an asserted reference qualifies as a printed publication.<sup>24</sup> There is no presumption, at the institution stage, in favor of finding that an asserted reference is a printed publication if the issue is in dispute. Third, in *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, the POP held that the PTAB "may, in certain rare circumstances, raise a [new] ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims proposed in a motion to amend."<sup>25</sup>

## B. Other Precedential Decisions

In addition to the POP decisions, the PTAB has, under Director Iancu's oversight, designated 20 routine PTAB trial decisions as precedential in the last two years. These decisions cover a wide range of issues including:

- factors the PTAB should consider when deciding whether to exercise its institution discretion under § 314(a) or § 325(d),<sup>26</sup>

<sup>21</sup> IPR2018-00914, Paper 38 at 4 (PTAB Mar. 13, 2019) (precedential).

<sup>22</sup> After the POP's decision in *Proppant Express*, the Federal Circuit reached the opposite conclusion in *Facebook, Inc. v. Windy City Innovations, LLC*. 953 F.3d 1313 (Fed. Cir. 2020). The Federal Circuit, however, is currently considering whether the U.S. Supreme Court's subsequent decision in *Thryv, Inc. v. Click-to-Call Techs., LP* impacts the court's *Windy City* decision. In *Thryv*, the Supreme Court held that 35 U.S.C. § 314(d) precludes appeal of issues that are closely related to the PTAB's institution decision. 140 S. Ct. 1367 (2020).

<sup>23</sup> IPR2018-01754, Paper 38 at 6 (PTAB Aug. 23, 2019) (precedential).

<sup>24</sup> IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

<sup>25</sup> IPR2018-00600, Paper 67 at 4 (PTAB July 6, 2020) (precedential).

<sup>26</sup> *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (Apr. 2, 2019) (precedential) ("Valve I") (discretion under § 314(a)); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 (May 1, 2019) (precedential) ("Valve II") (discretion under § 314(a)); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (discretion under § 314(a)); *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (Sept. 12, 2018) (precedential) (discretion under § 325(d) and § 314(a)); *Oticon Medial AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 (Oct. 16, 2019) (precedential) (discretion under § 325(d) and 314(a)); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential)

- the legal framework for determining whether parties are privies or real parties-in-interest (RPIs) in the context of whether a party is time-barred under § 315(b),<sup>27</sup>
- authorization to update mandatory notices to identify additional RPIs,<sup>28</sup>
- statutory bar issues relating to actions of the petitioner or patent owner,<sup>29</sup>
- burdens and procedural requirements for a motion to amend,<sup>30</sup>
- challenges that may be raised against proposed substitute claims in a motion to amend,<sup>31</sup>
- the ability to confer with a witness in a deposition after cross-examination has concluded but before re-direct begins,<sup>32</sup>
- procedures for submitting new evidence in a rehearing request,<sup>33</sup>
- the requirement to file all collateral agreements under § 317(b) when requesting termination of a proceeding pursuant to settlement,<sup>34</sup> and
- live testimony at oral hearing when the witness did not previously provide a declaration.<sup>35</sup>

Practitioners should expect this trend to continue under Director Iancu's leadership.

#### IV. Discretionary Institution

Perhaps one of the most noticeable aspects of Director Iancu's tenure is the increased focus on the PTAB's discretion to institute or deny review. The AIA vests the PTAB with broad institution discretion which is usually implicated in one of three scenarios: (1) when multiple petitions are filed against the same patent; (2) when a co-pending district court case involving the same patent is at an advanced stage by the time the PTAB determines whether to institute review; and (3) when the same prior art or arguments presented to the PTAB were previously presented to the PTO in another proceeding. Each of these scenarios is discussed below.

##### A. Multiple Petitions Against the Same Patent

The PTAB began taking a hard look at the scope of its institution discretion even before Director Iancu's confirmation. As a first step, the PTAB designated *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha* as precedential.<sup>36</sup> There, the PTAB set out non-exclusive, discretionary factors that panels may consider when

---

(discretion under § 325(d)); *Adv. Bionics, LLC v. Med-Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential) (discretion under § 325(d)).

<sup>27</sup> *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 (Jan. 24, 2019) (precedential).

<sup>28</sup> *Proppant Express Inv., LLC v. Oren Techs., LLC*, IPR2017-01917, Paper 86 (Feb. 13, 2019) (precedential); *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (Feb. 14, 2019) (precedential).

<sup>29</sup> *Cisco Sys., Inc. v. Chromar Sys., Inc.*, IPR2018-01511, Paper 11 (Jan. 31, 2019) (precedential) (statutory bar under § 315(a)(1)); *Infiltrator Water Techs., LLC v. Presby Patent Trust*, IPR2018-00224, Paper 18 (Oct. 1, 2018) (precedential) (statutory bar under § 315(b)).

<sup>30</sup> *Lectrosomics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (Feb. 25, 2019) (precedential).

<sup>31</sup> *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (Jan. 18, 2019) (precedential).

<sup>32</sup> *Focal Therapeutics, Inc. v. SenoRx, Inc.*, IPR2014-00116, Paper 19 (July 21, 2014) (precedential).

<sup>33</sup> *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19 (Jan. 8, 2019) (precedential).

<sup>34</sup> *DTN, LLC v. Farms Tech., LLC*, IPR2018-01412, Paper 21 (June 14, 2019) (precedential).

<sup>35</sup> *DePuy Synthes Prods., Inc. v. Medldea, L.L.C.*, IPR2018-00315, Paper 29 (Jan. 23, 2019) (precedential).

<sup>36</sup> IPR2016-01357, Paper 19 (Sept. 6, 2017).

faced with a follow-on petition filed by the same petitioner against a patent the petitioner had previously challenged.

Under Director Iancu's oversight, the PTAB has expanded its focus on discretionary institution to identify other scenarios that may warrant further consideration. For example, panels may now consider whether multiple parallel petitions filed by the same petitioner against the same patent at or near the same time<sup>37</sup> or relationships between different petitioners that challenge the same patent<sup>38</sup> warrant the exercise of institution discretion.

## **B. Advanced Stage of Related District Court Trial**

A recent focus of the PTAB's discretionary institution case law is the state of a co-pending district court case involving the challenged patent. For example, in *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, the PTAB denied institution under § 314(a) because a co-pending district court case would proceed to trial six months before the PTAB would issue a final written decision. The district court trial, moreover, involved the same invalidity grounds at issue in the IPR.<sup>39</sup> This trend has continued in various routine PTAB decisions and, ultimately, culminated in *Apple Inc. v. Fintiv, Inc.*<sup>40</sup> There, the PTAB identified factors relevant to evaluating whether the state of a co-pending district court case weighs against institution, including whether the court would go to trial before the PTAB issues a final written decision, the likelihood the district court case will be stayed, and the extent of overlap in issues between the court and PTAB.

## **C. Prior Consideration of Art or Arguments Raised in Petition**

Institution discretion can also depend on whether the same or substantially the same prior art or arguments presented in a PTAB petition were previously presented to the PTO in another proceeding (such as during prosecution of the challenged patent). In *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, the PTAB advised panels regarding how to evaluate whether the same prior art or arguments warrant a discretionary denial of institution.<sup>41</sup> And in *Advanced Bionics, LLC v. Med-Elektromedizinische Geräte GmbH*, the PTAB explained that the discretionary institution analysis requires the PTAB to first determine whether a petitioner is presenting the same or substantially the same prior art arguments that were previously presented to the PTO. If so, the PTAB must then consider whether the petitioner has demonstrated that the PTO erred in a manner material to the patentability of the challenged claims.<sup>42</sup>

## **V. Updates to the Trial Practice Guide**

From a procedural perspective, the PTAB has, under Director Iancu's leadership, made several updates to the Trial Practice Guide, a document intended to provide context as to how the PTAB applies its rules of practice. The first Trial Practice Guide was published in 2012. Since Director Iancu took office, the PTO has issued two major updates to the Trial Practice Guide and, in November 2019, issued a Consolidated Trial Practice Guide that

---

<sup>37</sup> *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2019-00224, -00225, -00226, -00227, -0028, -0029, Paper 10 (PTAB Apr. 3, 2019).

<sup>38</sup> *Valve I*, IPR2019-00062, Paper 11 at 2.

<sup>39</sup> IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential).

<sup>40</sup> IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

<sup>41</sup> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential).

<sup>42</sup> IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

combines insights provided by all three prior documents.<sup>43</sup> Notable changes to the original 2012 Trial Practice Guide are identified below:

## August 2018 Update

- Encourages parties to address discretionary institution factors in their pre-institution filings, and the PTAB panel can evaluate the evidence and determine whether to exercise institution discretion;
- Confirms the PTO's Guidance on the impact of *SAS Institute*, explaining that the PTAB will institute on all challenged claims and all asserted grounds, or none at all.
- States that sur-replies are authorized as a matter of right, but clarified that sur-replies may not include new evidence other than deposition transcripts of reply declarants.
- Offers guidance on the proper procedure and grounds to challenge the admissibility of evidence.
- Introduces the availability of a pre-hearing conference to resolve pending objections and obtain panel guidance for the oral hearing if requested by the parties.
- Allows the patent owner to have the final word at the oral hearing.

## July 2019 Update

- Offers guidance on how panels will address multiple parallel petitions and includes a new requirement that the petitioner rank its multiple petitions in the order it wants the PTAB to consider them.
- Provides guidance on discretionary institution factors, including the effect of "follow-on" petitions filed by same and different petitioners; the impact of the state of a co-pending district court case; and proper consideration of § 325(d) factors.
- Describes the practical implications of the PTAB's switch from the broadest reasonable interpretation claim construction standard to the *Phillips* standard.
- Explains various details about the motion to amend Pilot Program.
- Offers guidance on discovery, protective orders, joinder, remands, and live testimony.

## VI. Conclusion

In short, Director Iancu has brought about numerous changes to PTAB trial practice—with respect to both procedural requirements and policy initiatives—during his relatively short tenure. The timeline below highlights some of the most significant events.

| Timeline of PTAB Events Under Director Iancu's Leadership<br>(February 2018 to July 2020) |  |
|---|--|
| Feb 2018  | Andrei Iancu becomes PTO Director  |
| Apr 2018  | Supreme Court Decides <i>SAS Institute Inc. v. Iancu</i> <ul style="list-style-type: none"> <li>• PTAB must institute on all challenged claims, or none at all.</li> </ul>   |
| Apr 2018  | <ul style="list-style-type: none"> <li>• PTO issues Guidance on the Impact of <i>SAS Institute</i>, stating that, as a policy matter, the PTAB will institute on all challenged claims and all asserted grounds, or none.</li> </ul> |
| Aug 2018  | PTO issues first Trial Practice Guide Update   |

<sup>43</sup> The original Trial Practice Guide, August 2018 Trial Practice Guide Update, July 2019 Trial Practice Guide Update, and November 2019 Consolidated Trial Practice Guide are available at: <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>.

| Timeline of PTAB Events Under Director Iancu's Leadership<br>(February 2018 to July 2020) |   |
|---|---|
|   | <ul style="list-style-type: none"> <li>Patent owners are permitted to file sur-replies as the final brief before the oral hearing.</li> <li>Patent owners are permitted to have the final word during the oral hearing.</li> </ul>  |
| Sept 2018   | SOP 2 revised to create the Precedential Opinion Panel (POP) and change precedential designation process  |
| Sept 2018   | SOP 1 revised to clarify procedure for assignment of administrative patent judges (APJs) to panels  |
| Oct 2018  | PTO issues rule change requiring the <i>Phillips</i> claim construction standard to be used in AIA trials (83 Fed. Reg. 51,340)   |
| Mar 2019  | First POP decision issued ( <i>Proppant Express Inv., LLC v. Oren Techs., LLC</i> ) <ul style="list-style-type: none"> <li>PTAB may exercise its discretion to allow a party to join a later-filed petition presenting new issues to an instituted IPR based on an earlier-filed petition filed by the same party.</li> </ul>   |
| Mar 2019  | PTO introduces a motion to amend pilot program authorizing patent owner to request preliminary feedback from the PTAB and opportunity to file a revised motion to amend   |
| April 2019  | <i>Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.</i> designated precedential <ul style="list-style-type: none"> <li>Specifies legal framework for determining if unnamed parties are privies or real parties-in-interest in the context of determining whether a party is time-barred under § 315(b))</li> </ul>   |
| May 2019  | <i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i> designated precedential <ul style="list-style-type: none"> <li>In addition to discretionary denial under § 325(d), a district court trial date scheduled before PTAB's deadline to issue final written decision with invalidity issues in common with IPR may impact the discretionary institution analysis under § 314(a).</li> </ul> |
| May 2019  | <i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> designated precedential <ul style="list-style-type: none"> <li>PTAB may consider any relationship between petitioners when assessing <i>General Plastic</i> factors for determining whether to exercise discretion to deny institution under § 314(a).</li> </ul>  |
| July 2019   | PTO issues second Trial Practice Guide Update <ul style="list-style-type: none"> <li>Noting that "multiple petitions by a petitioner are not necessary in the vast majority of cases" and requiring a paper from the petitioner ranking petitions if the petitioner files two or more petitions challenging the same patent.</li> </ul>   |
| Aug 2019  | <i>Becton, Dickinson &amp; Co. v. B. Braun Melsungen AG</i> designated precedential <ul style="list-style-type: none"> <li>Identifies factors for the PTAB to consider when determining whether to exercise its discretion to deny institution under § 325(d).</li> </ul>   |
| Aug 2019  | Second POP decision issued ( <i>GoPro, Inc. v. 360Heros, Inc.</i> ) <ul style="list-style-type: none"> <li>The § 315(b) time-bar begins to run from the date that an infringement complaint is filed, even if the complaint is voluntarily dismissed or the complaint is deficient.</li> </ul>  |
| Oct 2019  | PTO proposes rule changes on the allocation of burdens in motions to amend (84 Fed. Reg. 56,401) (pending)  |
| Oct 2019  | Federal Circuit decides <i>Arthrex, Inc. v. Smith &amp; Nephew, Inc.</i> <ul style="list-style-type: none"> <li>Appointment of PTAB Administrative Patent Judges (APJs) violates the Appointments Clause of the U.S. Constitution because APJs are principal</li> </ul>   |

| <b>Timeline of PTAB Events Under Director Iancu's Leadership<br/>(February 2018 to July 2020)</b> |   |
|---|---|
|   | <p>officers, rather than inferior officers, and therefore must be nominated by the President and appointed by the Senate.</p> <ul style="list-style-type: none"> <li>• To remedy constitutional infirmity, Federal Circuit severs Title 5 removal protections afforded to APJs, rendering APJs inferior officers.</li> <li>• Results in vacatur of numerous PTAB decisions. In response, PTAB issues a General Order staying remanded cases pending any consideration of <i>Arthrex</i> by the Supreme Court.</li> </ul>                |
| Nov 2019  | <p>PTO issues Consolidated Trial Practice Guide</p> <ul style="list-style-type: none"> <li>• Incorporates features of August 2018 and July 2019 Updates to original Trial Practice Guide.</li> </ul>  |
| Dec 2019  | <p>Third POP decision issued (<i>Hulu, LLC v. Sound View Innovations, LLC</i>)</p> <ul style="list-style-type: none"> <li>• A petitioner must show a reasonable likelihood that an asserted reference qualifies as a printed publication at the institution stage.</li> </ul>   |
| Mar. 2020   | <p><i>Adv. Bionics, LLC v. Med-Elektromedizinische Geräte GmbH</i> designated precedential</p> <ul style="list-style-type: none"> <li>• Consolidates <i>Becton Dickinson</i> factors into a two-part framework, in which a petitioner must show that the PTO erred in a manner material to patentability of the challenged claims when the petitioner relies on prior art or arguments that were previously presented to the PTO.</li> <li>• The two-part framework provides greater deference to previous PTO examinations.</li> </ul> |
| Apr 2020  | <p>Supreme Court decides <i>Thryv, Inc. v. Click-to-Call Techs., LP</i></p> <ul style="list-style-type: none"> <li>• Holds that § 314(d) precludes judicial review of the PTAB's time-bar determinations.</li> </ul>  |
| May 2020  | <p><i>Apple Inc. v. Fintiv, Inc.</i> designated precedential</p> <ul style="list-style-type: none"> <li>• Identifies factors for the PTAB to consider when determining whether to exercise discretion to deny institution based on the advanced state of a related trial involving the challenged patent.</li> </ul>  |
| May 2020  | <p>PTO proposes rule changes requiring institution on all claims and all grounds; authorization of sur-replies; and elimination of institution-stage presumption regarding factual disputes raised by parties' conflicting testimonial evidence (85 Fed. Reg. 31,728) (pending)</p>   |
| July 2020   | <p>Fourth POP decision issued (<i>Hunting Titan, Inc. v. DynaEnergetics Europe GmbH</i>)</p> <ul style="list-style-type: none"> <li>• The PTAB may, in rare instances, raise its own ground of challenge to proposed substitute claims submitted with a motion to amend based on the evidence of record.</li> </ul>   |