

Joe Matal in IP Law Daily: 'USPTO Adopts Revised Trial Practice Rule Relating to AIA Institution Decisions'

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PRACTICES Patent Litigation, Patent Office Trials, Patents, Intellectual Property

Haynes Boone Partner Joe Matal talked with *IP Law Daily* about the potential effects of the U.S. Patent and Trademark Office's (USPTO's) revised rule related to America Invents Act (AIA) decisions.

Below is an excerpt:

The USPTO has adopted a final rule amending the rules of practice for instituting an inter partes review (IPR), post-grant review (PGR), and the transitional program for covered business method patents (CBM) proceedings before the Patent Trial and Appeal Board (PTAB).

The final rule codifies three current PTAB trial practices — instituting review on all claims and all grounds in accordance with the Supreme Court's direction and Federal Circuit mandate, authorizing parties to address issues raised in the institution decision, and permitting the filing of sur-replies in response to principal briefs. However, the new rule implements a substantial change to standard practice by eliminating the presumption in favor of the petitioner at institution when there is conflicting testimonial evidence (85 Fed. Reg. 79120, December 9, 2020).

Practitioner response.

Joseph Matal, former USPTO Acting Director and Acting Solicitor, and current partner in the Washington, D.C., office of Haynes Boone, told *IP Law Daily* that he does not expect this final rule to have a significant effect, provided that the change is applied in a way that is consistent with the statute.

"The petitioner is not required to meet a preponderance standard at institution—only to show that there is a reasonable likelihood of unpatentability," Matal said. "If the petition presents a prima facie case that the invention is obvious, and competing declarations manage to create a genuine fact dispute, then almost by definition there is a reasonable likelihood of unpatentability."

Addressing the "trial within a trial" concern raised by some practitioners, Matal said he hopes that this change "does not lead to discovery and a need to decide evidentiary disputes at the institution phase—that is what trials under section 316 are for."

To read the full article, click [here](#).