

## Andrew Lowes and Clint Wilkins in Law360: PTAB Not Straitjacketed in Institutional Decisions

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January 6, 2016 J. Andrew Lowes, Clint Wilkins

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**PRACTICES** Patent Office Trials, Intellectual Property Litigation, Technology Transactions, Patent Litigation, AI and Technology, Medical Device and Technology

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In three recent decisions, the Federal Circuit confirmed that the Patent Trial and Appeal Board has considerable latitude to institute an inter partes review or a covered business method review based on an independent reading of prior art in view of the facts provided in a petition, and is not limited to the explicit invalidity grounds raised in the petition. The three decisions continue to demonstrate a flexible approach to finding patent claims obvious, provided the facts are stated sufficiently in the petition to support the finding. As a result, board decisions to institute an IPR or CBM are immune from appeal, and the procedural framework for PTAB trials allows for such latitude without violating due process.

First, in *Belden Inc. v. Berk-Teck LLC*, the Federal Circuit reminded practitioners of the procedural framework established by the America Invents Act for IPRs.[1] The procedure: (1) begins with a petition from a party challenging patent validity, followed by (2) a preliminary response from the patent owner (PO) and (3) then a decision whether to institute. If an IPR is instituted, the procedure further includes: (4) a post-institution response from PO followed by (5) a reply from the petitioner. The petition, response(s), and reply may each be submitted with a supporting expert declaration, which serves as direct testimony. A party has the right to cross-examine an affiant who has submitted testimony, and both parties have a right to an oral hearing.

Furthermore, “in the event that cross-examination occurs after a party has filed its last substantive paper on an issue, ... the Board may authorize the filing of observations on that cross-examination, though the observations are to be brief and nonargumentative.”[2] Finally, surreplies are allowed with board permission, and a party has the right to move to exclude evidence.[3] Observations, surreplies and motions to exclude give a PO options to respond to petitioner replies and build a record to rely on at the oral hearing.

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