



# THINK FORWARD

## PTAB Provides Guidance On The Impact Of SAS On AIA Trial Proceedings

By [Sen \(Alex\) Wang](#), [James Cleland](#), [Peter Lee](#)

April 27, 2018

On April 26, 2018, in response to the U.S. Supreme Court's decision *SAS Institute Inc. v. Iancu*, 2018 WL 1914661 (U.S. Apr. 24, 2018), the Patent Trial and Appeal Board ("PTAB") provided guidance as to the impact of the SAS decision on AIA trial proceedings. See [Guidance On The Impact Of SAS On AIA Trial Proceedings](#) ("Guidance"). Starting now, the PTAB will proceed as follows for cases in the various stages:

1. Petition filed, but no institution decision yet.
  - The PTAB will issue an all-or-nothing determination instituting all claims or none.
  - When a trial is instituted, the PTAB will institute on "all challenges raised in the petition." The phrase "all challenges raised in the petition" means that the institution decision will include all challenged claims and all petitioned grounds.
2. Trial already instituted on all challenges raised in the petition.
  - The PTAB will continue with the proceeding in the normal course.
3. Trial instituted on only some (but not all) of the challenges raised in the petition.
  - The PTAB *may* issue an order supplementing the institution decision to institute on all challenges raised in the petition.
  - If the PTAB issues an order supplementing the institution decision, the panel may take further action to manage the trial proceeding, including, for example, permitting additional time (e.g., granting extension to the parties, extending (on a case-by-case basis) the 12-month statutory deadline), briefing, discovery, and/or oral argument, depending on various circumstances and the stage of the proceeding.
  - Once an order supplementing the institution decision is issued, the Petitioner and Patent Owner are required to meet and confer to discuss the need for additional briefing and/or any other adjustments to the schedule. The parties are encouraged to work cooperatively amongst themselves to resolve disputes. Although a *sua sponte* order is possible in some cases, the PTAB warned that additional briefing and schedule adjustments might not be ordered if not requested by the parties. Of course, the parties have the option to agree to affirmatively waive additional briefing or schedule changes.

#### 4. Scope of final written decisions.

- The final written decision will address, to the extent claims are still pending at the time of decision, all patent claims challenged by the petitioner and all new claims added through the supplementation process.

The Guidance is not limited to IPRs but is applicable to all AIA trial proceedings, including post-grant review and covered business method review proceedings. The Guidance also signaled the possibility of future guidance in view of the PTAB's continued assessment of the impact of the SAS decision. In addition, on Monday, April 30, 2018, the PTAB will host a "[Chat with the Chief](#)" webinar (noon to 1 p.m. ET) featuring Chief PTAB Judge David Ruschke to discuss the SAS decision and its impacts on AIA trial proceedings, and to answer questions.

#### **Take-Aways**

The PTAB's Guidance provides much needed answers, but also leaves open questions. One answer that stands out is the guidance that the PTAB will address not only all challenged claims going forward, but all petitioned grounds, which in turn may have a resulting impact on the scope of estoppel. This practice may lead to longer institution decisions, however, in view of the number of petitions filed and the amount of grounds presented in those petitions every year, it is also possible for the PTAB to cut its own workload by issuing shorter institution decisions as soon as it finds at least one challenged claim that warrants institution. This practice may also reduce or eliminate the PTAB's use of redundancy to exclude petitioned grounds from the institution decision and/or final written decision.

In terms of open questions, the Guidance's language, stating the PTAB "*may issue* an order supplementing the institution decision" in those instances where trial has only been instituted on some, but not all, of the challenges raised in the petition, leaves unclear when the PTAB will issue supplemental orders and when it will not. And while it is clear that the parties are directed to discuss additional briefing and schedule adjustments, and notify the PTAB, when the PTAB does issue a supplemental order, it is unclear whether the parties can petition the PTAB to trigger a supplemental order. Petitioners or respondents who wish to have additional claims or petitioned grounds addressed should consider communicating with their panel to determine the best way to approach supplementation.

We expect the PTAB's Guidance to evolve and the PTAB's preferred practices to become clearer in the next several months as these changes are carried out.

For more information about the SAS decision, please refer to Brinks' IP Alert [Supreme Court Signals Full Steam Ahead for Challenging Patents in AIA Proceedings in Back-to-Back Oil States and SAS Institute Decisions](#).

#### **Contact Us**

If you have any questions or wish to discuss how these decisions impact your business, please contact one of our [Brinks Attorneys](#).