



AMERICA INVENTS ACT

IMPLEMENTATION

The Board of Patent Appeals and Interferences

New Board Proceedings

The Trial Phase

- The Board has determined to institute – what next?
 - Scheduling Order concurrent with a decision to institute the trial. Conference call with Judge about one month from institution. (See Practice Guide). The Order would set due dates taking into account the complexity of the proceeding.
 - IPR/PGR/CBM trial will be completed within one year from institution, except the time may be extended up to six months for good cause.



Discovery

- Testimony and document production is permitted
 - AIA authorizes the Office to set standards and procedures for the taking of discovery.
 - The proposed rules allow for two types of discovery: routine discovery and additional discovery.



Discovery

- **Routine discovery** – reduces costs to parties by making basic information readily available at the outset of the proceeding. Routine discovery may assist the parties to assess the merits of their respective positions, to avoid harassment in the proceeding, or to reach settlement.
- **Routine discovery includes:**
 - documents cited,
 - cross-examination for submitted testimony, and
 - information inconsistent with positions advanced during the proceeding.



Discovery

- Additional discovery – a party must request any discovery beyond routine discovery.
- A party seeking additional discovery in IPR and derivation must demonstrate that the additional discovery is in the interests of justice.
- A party seeking additional discovery in PGR and CBM will be subject to the lower good cause standard.
- Live testimony – the Board may authorize, where critical, to assess credibility. For example, a Judge may attend a deposition in appropriate instances.



Estoppel

- **Petitioner Estoppels After Final Written Decision**
 - A petitioner in an IPR/PGR/CBM may not request or maintain a proceeding before the Office with respect to any claim on any ground raised or reasonably could have been raised.
 - A petitioner in an IPR/PGR/CBM may not assert in district court or the ITC that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised.



Estoppel

- **Patent Owner Estoppel**

- A patent owner whose claim is cancelled is precluded from taking action inconsistent with the adverse judgment including obtaining in any patent a claim to substantially the same invention.

- **Derivation Specific Estoppel**

- In a derivation, a losing party who could have moved for relief, but did not so move, may not take action inconsistent with that party's failure to move. Where a party receives a split judgment (wins on one claimed invention, loses on another), estoppel does not attach to the subject matter for which a favorable judgment was obtained.





AMERICA INVENTS ACT

IMPLEMENTATION

THANK YOU!