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Pre-Institution Overhaul: Unpacking the PTAB's New Briefing Procedures

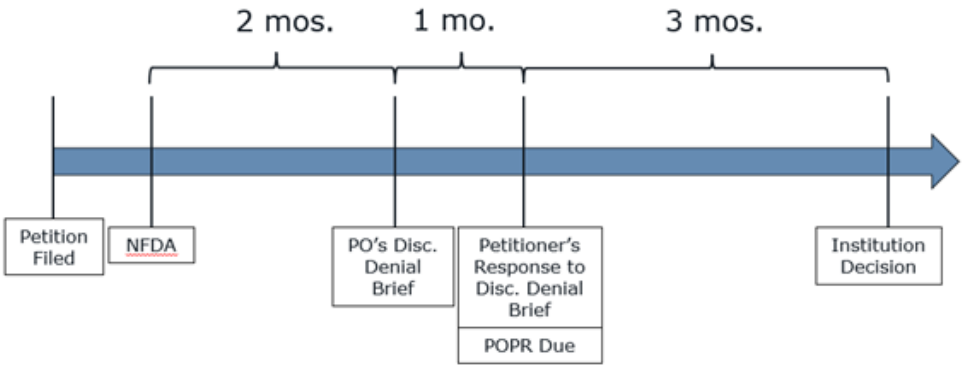
by Justin L. Krieger

Hot on the heels of rescinding former Director Vidal's June 2022 memo providing guidance on discretionary denials, Acting Director of the USPTO, Coke Morgan Stewart, issued a memo yesterday outlining new "Interim Processes for PTAB Workload Management." The memo provides a new mechanism for addressing discretionary and substantive issues before institution. The new procedure aims to improve PTAB efficiency, improve discretionary denial consistency, and maintain the current PTAB workload. The policy is in effect immediately for any cases in which a patent owner preliminary response (POPR) deadline has not yet passed.

The memo provides a new bifurcated approach in addressing whether to institute trial in an IPR or PGR between: (i) discretionary considerations, and (ii) merits and other non-discretionary statutory considerations. Under the new procedure, the Director will consult with three PTAB judges to determine if discretionary denial of institution is warranted. If it is, the Director will issue a decision denying institution. If it is not, the Director will refer the case to a new panel of PTAB judges who will address whether institution is appropriate based on substantive and non-discretionary issues.

The parties also will be permitted to file separate briefing on the discretionary denial and substantive issues. Under the new procedure, within two months of receiving a Notice of Filing Date Accorded (NFDA), a patent owner may file a brief explaining why discretionary denial is warranted, and the petitioner may then file an opposition brief one month thereafter. The briefs will be limited to 14,000 words each. Further briefing may be permitted with a showing of good cause. The merits briefing schedule will proceed in parallel with the new discretionary denial briefing under the traditional schedule outlined in 37 C.F.R. § 42.107(b), i.e., a POPR addressing the merits and non-discretionary considerations will be due within three months of the NFDA.

The memo also reiterates that the Board will address all discretionary denial issues as outlined in the 2019 Trial Practice Guide and according to existing Board precedent, e.g., *Fintiv* (co-pending litigation), *General Plastic* (follow-on petitions), and *Advanced Bionics* (same/similar prior art as previously considered). The below timeline summarizes the new pre-institution procedure.



Takeaway: The impact of the Board's new pre-institution procedure remains to be determined. At a minimum, the procedure should: (i) increase the consistency of discretionary denials, and (ii) effectively increase the number of pages the parties can use for briefing substantive issues since discretionary denial issues will be addressed separately.