

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board (PTAB) Boardside Chat: Interim processes relating to institution in ALA proceedings

Janet Gongola, Chief Communications Officer (Acting)

Michelle Ankenbrand, Senior Legal Advisor (Acting)

Kalyan Deshpande, Vice Chief Administrative Patent Judge

April 17, 2025



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Question/comment submission

To send in questions or comments during the webinar, please email:

- PTABBoardsideChat@uspto.gov

Agenda

1. New interim processes for PTAB workload management overview (“Interim processes”)
2. Interim processes operations and filing director discretionary denial briefing
3. Q&A

Interim processes for PTAB workload management

Interim processes

- Acting Director Stewart issued interim processes memorandum on March 26, 2025.
 - www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf
- The USPTO is planning to begin notice and comment rulemaking after some experience with the interim processes.

Interim processes (cont'd)

- Decisions on whether to institute an ALA trial will be bifurcated between:
 - discretionary considerations and
 - merits and other non-discretionary considerations

Interim processes (cont'd)

- The Director (in consultation with at least three senior PTAB judges) will determine whether discretionary denial of institution is appropriate.
- If not appropriate, a Board panel will address the merits and other non-discretionary considerations and determine whether to institute.

Interim processes (cont'd)

- Processes go into effect in cases where the deadline to file a patent owner preliminary response (POPR) had not yet passed—i.e., it does not apply in cases where a patent owner filed a POPR (or date for filing one has passed)—as of March 26, 2025.
- Processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings.

Interim processes (cont'd)

- To facilitate, the USPTO will permit both parties to file a separate briefing on requests for discretionary denial of institution.
 - A patent owner may file a discretionary denial brief after the PTAB issues a Notice of Filing Date Accorded (or a Notice of Defective Petition) and the PTAB accepts patent owner's Mandatory Notice.
 - A petitioner may file an opposition brief in P-TACTS after the patent owner files its discretionary denial brief.



Interim processes (cont'd)

- Consistent with existing precedent and guidance, parties are permitted to address all relevant discretionary considerations, including:
 - Whether PTAB or another forum has already adjudicated validity or patentability of the challenged claims;
 - Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
 - The strength of the unpatentability challenge;
 - The extent of the petition's reliance on expert testimony;
 - Settled expectations of parties, such as the length of time the claims have been in force;
 - Compelling economic, public health, or national security interests; and
 - Any other considerations bearing on the Director's discretion.

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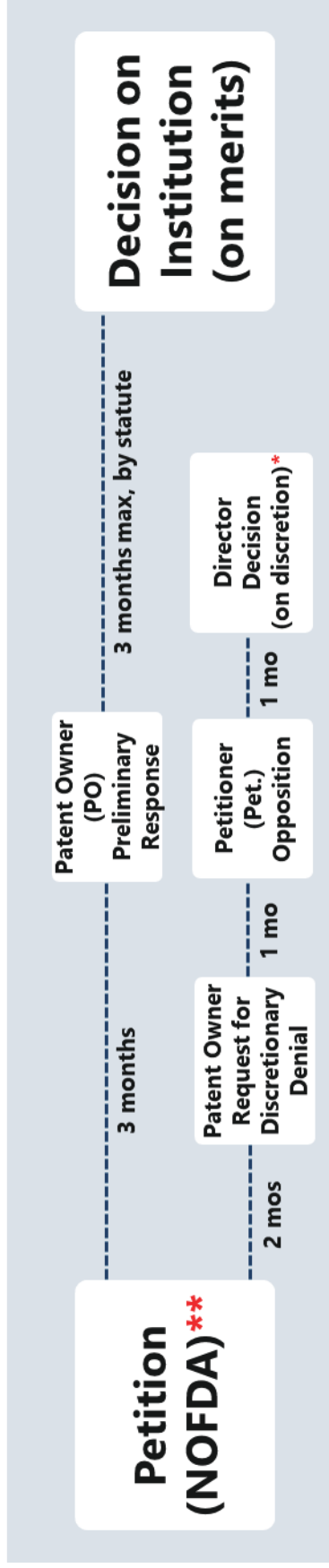


Interim Processes Operations

Timeline: ALA proceedings

Interim processes (March 26, 2025 memorandum)

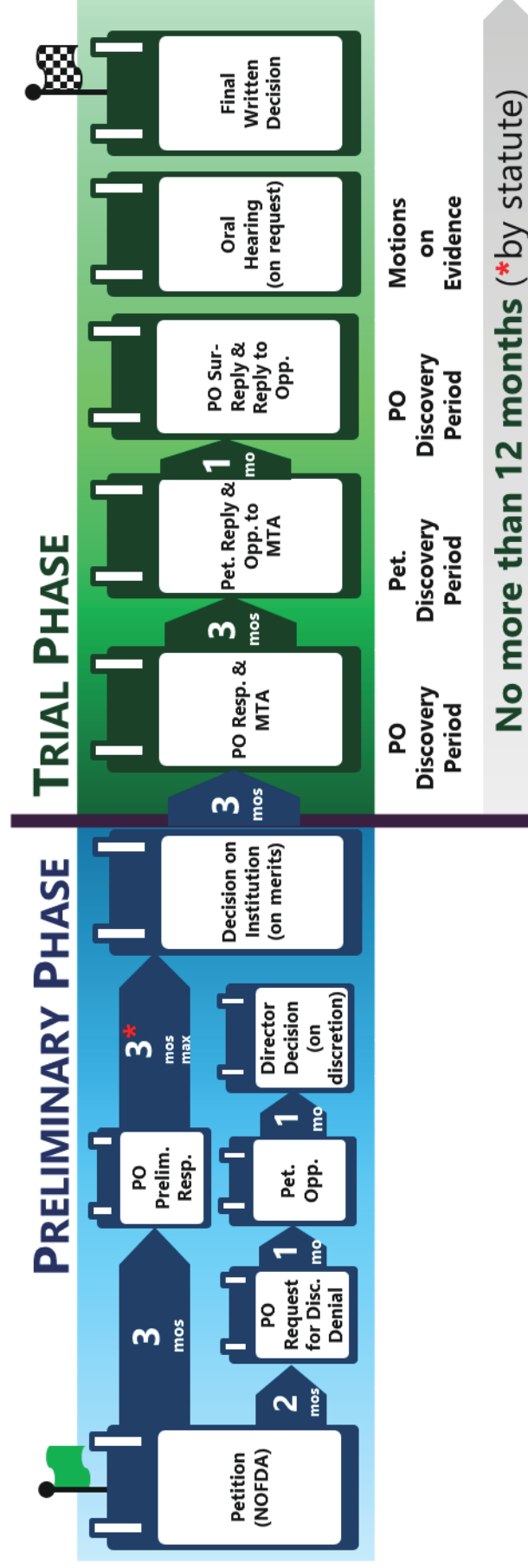
Preliminary Phase



** Notice of filing date accorded

* If the Director does not exercise discretion to deny institution, a Board panel determines whether to institute based on merits

Timeline: AIA proceedings Interim processes (March 26, 2025 memorandum)



Interim processes

- The bifurcated process is available in cases in which the patent owner files a preliminary response, or the deadline for the patent owner to file a preliminary response occurs, after March 26, 2025.
- In cases where the time for filing a discretionary denial brief has not yet elapsed but will elapse in 1 month or less after March 26, 2025, the Board has or will issue a notice extending the deadline.
 - The patent owner's brief will be due no later than 1 month of the date of the notice.
 - The petitioner's brief will be due no later than 1 month after the patent owner files its brief.

Interim processes (cont'd)

- In cases where the time for filing a discretionary denial brief has elapsed, but the deadline for filing a patent owner preliminary response had not yet passed as of March 26, 2025.
 - As the March 26 memorandum states, the patent owner's brief will be due within one month of the date of the memorandum.
 - The petitioner's brief will be due no later than one month after the patent owner files its brief.



Filing discretionary considerations briefs in P-TACTS

- On April 11, the PTAB introduced two new paper types in P-TACTS:
 - PO Discretionary Denial Brief
 - PET Opposition to Discretionary Denial Brief
- For timely consideration, parties should use these new paper types to file discretionary considerations briefs.
- If you filed a discretionary considerations brief before April 14, please email Director_Discretionary_Decision@USPTO.gov:
 - The email should identify the IPR or PGR number and the date the brief was filed
 - The email should copy counsel for all parties



Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a patent owner discretionary denial brief:
 - Log into P-TACTS.
 - Go to My Docket and select the AIA Review case number to open Case Viewer.
 - Select the “+Add Document” button and File Other Document modal from the menu option.
 - Select “PO Discretionary Denial Brief” from the list of paper types.
 - Enter information into all required fields marked by a red asterisk beginning with paper type.
 - Select “PO Discretionary Denial Brief”; and
 - Click on “Add to List” and then “Submit.”



Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a petitioner opposition to a discretionary denial brief:
 - Log into P-TACTS.
 - Go to My Docket and select the AIA Review case number to open Case Viewer.
 - Select the “+Add Document” button and File Other Document modal from the menu option.
 - Select “PET Opposition to Discretionary Denial Brief” from the list of paper types.
 - Enter information into all required fields marked by a red asterisk beginning with paper type.
 - Select “PET Opposition to Discretionary Denial Brief”; and
 - Click on “Add to List” and then “Submit.”



Questions

Questions

For any questions, please email:

Director_Discretionary_Decision@uspto.gov or

call 571-272-7822.



