

The Naples Roundtable, Phoenix Issue V

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What Changes are Necessary to Constructively Better Implement the AIA?

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1. Venue and Pre-Trial Considerations

- Discuss Pre-AIA and AIA joinder issues
- Issues plaguing the court

2. Post-Grant Proceedings

- Institution issues and who determines if a trial should be instituted
- Compare BRI with Phillips – discuss whether PTAB should be consistent
- Only the petitioner can submit evidence during the petition phase
 - Patent Owner may need the same opportunity and their submission should not be viewed against their interest
- Right to appeal to the Federal Circuit but not the District Court
 - Is this what was intended by Congress?
- Different ways to Amend Claims not just within the PTAB
- Consider standing requirements for all post-grant procedures
- The Duty of Disclosure during the petition phase and the trial phase is not clear

3. Ways to encourage the submission of documents by third parties during examination