

# Naples Program Phoenix Issue V

What Changes are Necessary to  
Constructively Better Implement  
the AIA?

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# Panelists

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# 1. Venue and Pre-Trial Consolidation

- ▶ Pre-AIA: Rule 20 governed infringement suits involving multiple defendants
- ▶ AIA: Section 299 modified the standard for joinder
- ▶ Does pre-trial consolidation circumvent Congress' purpose and violate the spirit of Section 299?
- ▶ If not consolidate then what should Courts do as a practical matter for handling the large number of separate cases?

## 2a. Post-Grant Proceedings

- ▶ Section 6 of the AIA allowed PTAB review of granted patents with the right of appeal to the Federal Circuit
- ▶ Is this working as Congress anticipated?

## 2b. Post-Grant Proceedings Considerations

- ▶ Should the Director's proper delegate (as authorized by 35 USC 3(b)(3)), but not the PTAB, decide petitions seeking IPR/PGR institution?
- ▶ Should patent claims be construed in IPR/PGR proceedings as they are in the courts?
  - Should the PTAB apply the same burdens and presumptions as in the courts?
  - Issue is before the Supreme Court now

## 2c. Post-Grant Proceedings Considerations

- ▶ Should patent owners have the right to submit declarations or other evidence in their preliminary response?
  - Should the PTAB weigh both parties evidence equally prior to deciding?

## 2d. Post-Grant Proceedings Considerations

- ▶ Should all parties have the right to appeal to a district court under 35 USC 146?
  - If the matter is already in a district court, should this be the only district court used?
  - Should the prevailing party be awarded reasonable attorneys fees and costs incurred in connection with such an appeal?

## 2e. Post-Grant Proceedings Considerations

- ▶ Should patent owners who seek to amend their claims have an off-ramp that would allow reexamination or reissue and then return to the IPR/PGR proceeding?
- ▶ Should we consider a standing requirement for IPR's similar to what is required for CBM's?

## 2f. Post-Grant Proceedings Considerations

- ▶ Do we need to clarify the duty of disclosure applicable to petitioners and patent owners?

### 3. Pre-Issuance Submissions by Third Parties

- ▶ Section 8 allows third parties to submit prior art in the record of a patent application
- ▶ The goal was to make certain that the best prior art was before the Examiner
- ▶ Since patent quality is a major concern, what can be done to encourage third party submissions before issuance of the patent?