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## ARTICLES

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# INSIGHTS FROM A RECENT PANEL ON NAVIGATING AIA TRIALS

On July 14, 2014, the Bar Association of the District of Columbia presented "Navigating AIA Trials at the USPTO," a panel discussion on the Leahy-Smith America Invents Act (AIA) trials, which took place at the D.C. office of Venable LLP. The diverse panel included Patent Trial and Appeal Board (PTAB) Judge Brian Murphy, Procter & Gamble in-house counsel Mark Charles, Ashe P.C. founder Oliver Ashe, who has over 20 years of experience at the PTAB and its predecessor the BPAI, and Venable partner Adam Hess, a patent litigator with experience in both AIA trials and interferences.[1] Carly Levin from Venable moderated the discussion.

Starting things off, Judge Murphy discussed the timeframes and procedures relating to *Inter Partes* Review (IPR) proceedings. He noted that the USPTO is not likely to slacken the strict deadlines in place for AIA trials, and indicated that the PTAB is bolstering the ranks of its judges to accommodate the significant number of actions filed to date. According to Judge Murphy, the PTAB is aiming to employ a total of 230 judges by the end of September, with approximately 70-80 of those judges dedicated to AIA trials.

Judge Murphy also expressed his view that the expert declaration was the most important part of a petitioner's case, and advised declarants to take a "deep dive" on key points regarding invalidity of the challenged claims. He advised declarants against making conclusory statements, and to avoid making arguments in the claim charts (where they are prohibited). For respondents, Judge Murphy advised that the PTAB judges generally appreciate and find the preliminary response helpful. He suggested identifying differences in the parties' claim constructions as one area on which to focus in the preliminary response.

The next panelist, Oliver Ashe, continued with a technical discussion of PTAB procedures and tactics. He noted an increase in preliminary responses filed by respondents, indicating that respondents recognize the preliminary response as their single best shot to stop the proceeding. He encouraged the filing of preliminary responses on "knock out" issues, *e.g.*, where the petitioner's references are not prior art, where the petitioner misses an element of the claims, or where the petitioner is not a real party in interest. He noted that filing a preliminary response on weaker issues, however, may simply give your opponent a "six-month head start" on rebutting your arguments. Additionally, he suggested that many petitioners may be leaving significant money on the table (in the USPTO's pockets) by not filing a request for refund of the USPTO post-initiation fees in cases where the petition is denied.

Next, Adam Hess shared insights on the respective benefits of AIA trials and district court litigation. He suggested that the PTAB may be a better venue for obviousness cases and highly technical cases, because of the PTAB's expertise in both patent law and technology. On the other hand, he suggested that a jury trial may be better for simpler cases, or in cases where the story or a sense of equity will be important. Additionally, he noted that other invalidity defenses and types of prior art (*e.g.*, on-sale and public use bars) are available in district court.

Finally, Mark Charles offered an in-house perspective on AIA trials. He advised that clients review their own portfolio and products for vulnerabilities before instituting an AIA trial, cautioning that in many cases it is impossible to "unring the bell." Furthermore, he urged clients to consider the amount of resources – both internal and external– involved in filing an IPR or similar proceeding. He suggested companies may be able to find alternatives to AIA proceedings that may likewise obtain their business goals.

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[1] The views and opinions of the panelists and moderator were their own, and do not necessarily reflect the views or opinions of their respective employers.


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