

The Evolution of PTAB Practice Strategies in Light of Recent Developments

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Teresa Stanek Rea, Crowell & Moring LLP (Moderator)
Vanessa P. Bailey, Intel Corporation
Hon. Thomas L. Giannetti, Patent Trial and Appeal Board
Hon. Grace Obermann, Patent Trial and Appeal Board
David L. McCombs, Haynes and Boone LLP

Discussion Topics

- Board “Administrative” Responses to Recent Developments
- Petition Strategies
- Prior Art – Can You Prove It Was Published?
- Patent Owner Preliminary Response
- Claim Construction
- Evidence and Discovery
- Wrap-Up: “A New Day at the PTAB”

Board “Administrative” Responses to Recent Developments

- How has the Board responded to challenges presented by recent developments, concerning the following?
 - Policy making, consistency among panels, and dissenting opinion
 - Education of stakeholders
- What additional administrative challenges lie ahead?

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Petition Strategies

- **Multiple grounds**
 - Post-*SAS Institute*, what should petitioners do differently? What strategies are likely to be negatively received by the Board?
- **Multiple proceedings**
 - Have discretionary denials increased or decreased?
 - Under what circumstances are multiple petitions likely to be discretionarily denied?
 - When should I do a joint filing, seek joinder, or go it alone?
 - Should a petition pre-emptively address facts related to the discretionary denial factors?

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Petition Strategies

- **Real party in interest**
 - How are panels and parties adapting to the Court's recent views concerning the RPI question?
- **Petition Drafting**
 - What are common pitfalls to avoid in crafting the petition?

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Prior Art: Can You Prove It Was Published?

- **For certain types of documents, establishing “printed publication” status can be tricky.**
 - What are the most common pitfalls faced by petitioners? Is the Board becoming more, or less, lenient at the Institution stage?
 - What are the most frequent deficiencies associated with documents obtained using Internet Archive's Wayback Machine?
 - What should patent owners do to maximize the chances a reference will be disqualified as prior art?

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