Oral Argument

• **Oral Argument** - each party will be afforded an opportunity to present their case before at least three members of the Board
  
  – *No new evidence and arguments are permitted*

• **Live testimony** - parties may file a motion for live testimony in appropriate situations
Umbrella Rules: Final Decision and Request for Rehearing

• Board will issue a final written decision that addresses the patentability of any claim challenged and any new claim added

• Request for rehearing must be filed within:
  – 14 days of the entry of a non-final decision or a decision to institute a trial or
  – 30 days of the entry of a final decision or a decision not to institute a trial

• Party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit
Petitioner Estoppels After Final Written Decision

- A petitioner in an IPR/PGR/CBM may not request or maintain a proceeding before the USPTO with respect to any claim on any ground raised or reasonably could have been raised before the USPTO, 35 U.S.C. 315(e)(1), 325(e)(1); § 42.73(d)(1)

- A petitioner in an IPR/PGR/CBM may not assert in district court or the ITC that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised in the trial before the USPTO, 35 U.S.C. 315(e)(2), 325(e)(2); §18(a)(1)(D) of AIA
Umbrella Rules: Patent Owner Estoppel

Patent Owner Estoppel (§ 42.73(d)(3))

• A patent owner is precluded from taking action inconsistent with the adverse judgment including obtaining in any patent:
  – A claim that is patentably indistinct from a finally refused or canceled claim
  – An amendment of a specification or drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description
Appeal

• A party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit, 35 U.S.C. 319, 329

• A party dissatisfied with a final decision in a derivation may appeal to the Federal Circuit, 35 U.S.C. 141(d), or have remedy by a civil action, 35 U.S.C. 146; § 90.2

• The determination by the Director whether to institute an IPR, PGR, or CBM shall be final and nonappealable, 35 U.S.C. 314(d) and 324(e)
Thank You