

PTAB LAYS INITIAL GROUNDWORK FOR POST-REMAND PROCEEDINGS

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Patent Office Litigation Alert

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In a key development regarding Inter Partes Review (IPR) procedure, on September 1, 2015, the Patent Trial and Appeal Board (the "Board") issued an order that lays the groundwork for how the Board may address cases on remand from the Federal Circuit.

The Federal Circuit on June 16, 2015, issued an opinion reversing the Board's claim construction for three terms at issue in two IPR proceedings (IPR2012-00026 and IPR2013-00109). *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292 (Fed. Cir. 2015). Consequently, the Federal Circuit also vacated the Board's unpatentability determination for certain of the claims at issue and remanded both cases to the Board for proceedings consistent with the Federal Circuit's opinion. These cases have been closely watched because they represent the first reversal by the Federal Circuit in an AIA post-grant proceeding and, more importantly, the procedures for remand are not specifically outlined. The Federal Circuit's mandate issued on August 25, 2015, and it appears that the parties unsuccessfully tried to negotiate a post-remand procedure before contacting the Board. As a result, the petitioner contacted the Board to resolve the dispute between the parties. The petitioner proposed that each party file a new brief, limited to 15 pages, to address the impact of the Federal Circuit's opinion on the patentability determination. The patent owner proposed that additional briefing was not needed and would delay the proceeding. Notably, the Board remarked that the parties agreed "that the Board would have to reconsider the evidence on remand in light of the Federal Circuit's rulings on claim construction and would not be in a position to decide the case for either party without further analysis."

The Board ultimately sided with the petitioner's proposal and ordered additional briefing by each party, limited to 15 pages, with both briefs being due at the same time. The Board further ordered that the briefs should address the effect of the Federal Circuit's opinion on the patentability of the affected claims. Finally, the Board ordered that "no new prior art references or other evidence shall be presented by either party beyond that considered in the Board's Final Written Decision."

It is possible that a different Board may propose a different procedure on remand, but this decision at least is informative of how the Board may treat further remanded cases. The provision for simultaneous briefing is interesting in that the Board is giving each party one opportunity to set forth its best case rather than a traditional adversarial briefing format.

Please click on the following for the [Federal Circuit Opinion](#) and the [Board Decision](#).

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