

Mike Rueckheim Discusses Patent Office's New Denial Process FAQ with Law360

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Winston & Strawn partner Mike Rueckheim was quoted in a Law360 article discussing the U.S. Patent and Trademark Office's recently released answers to frequently asked questions about its new patent challenge denial process for post-grant (IPR/PGR) challenges. The USPTO recently established guidance and a bifurcated briefing process in which the Director, working alongside Patent Trial and Appeal Board judges, will decide whether each petition challenging a patent warrants discretionary denial. The board will consider the merits of the petition's invalidity arguments only if it is not denied for discretionary reasons.

The [FAQs](#) address, among other things, how "the extent of reliance on expert testimony bears on discretionary to institute IPR or PGR." The office said that while the board may consider expert testimony, "extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court." It added that because PTAB judges have technical and legal expertise, the "most helpful" expert testimony is focused on aiming "to provide helpful context or to explain terms of art."

Mike observed that the FAQs caution petitioners against reliance on excessively long expert declarations that require in-depth fact-finding better suited for district court, while at the same time the office has long said that complex invalidity arguments that aren't supported by expert testimony are unlikely to succeed. The FAQs therefore require that petitioners "have to get the expert testimony just right," he said.

Another key aspect of the FAQs involves whether a petition should be denied due to petitioner maintaining prior art invalidity arguments in a related litigation while offering a stipulation to not present prior art grounds that were raised, or reasonably could have been raised, in the petition. The FAQs said the focus will be on "whether the stipulation materially reduces overlap between the proceedings." Specifically, the office said that if the petitioner relies on "corresponding system art and/or several other invalidity theories" in district court, a stipulation "may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited."

Mike observed that if the board views its reference to "corresponding system art ..." to be just a physical version of the same thing described in a publication at issue before the board, the impact could be limited. But if the board's interpretation is "broader than that ... I think litigants are going to have to really start thinking hard about which proceeding they want to present their prior art arguments," he said.

[Read the full article.](#)

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