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Patent Trial & Appeal Board (PTAB) to Give Patent Owners the Last Word

The U.S. Patent and Trademark Office has issued an update to its Trial Practice Guide. The [update](#) was published in the Federal Register today, August 13, 2018. The update to the Trial Practice Guide is the first since 2012 and includes notable practice changes that favor patent owners. As of today, patent owners will be accorded a sur-reply brief at the close of trial briefing. Previously, the last brief filed was the petitioner reply, which gave the last word to petitioners. Going forward, patent owners will have the last word (previous motion for observations practice has been replaced). Further changes include providing for patent owner rebuttal argument time at the oral hearing, and increased options for managing disputes at the time of hearing via a pre-hearing conference with the Board.

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The significant practice changes, which are effective immediately, are as follows:

- **Patent owner observations on cross-examination have been replaced with a patent owner sur-reply.** While additional evidence will not be permitted, a sur-reply will now normally be authorized from the outset in the scheduling order, and will allow patent owners not only to highlight admissions made on cross-examination of a petitioner's reply declarant—as in the old observations—but also to respond to reply arguments—something that was not permitted under the old rules. Importantly, this change means that patent owners now get the last word in AIA trial briefing.
- **Patent owners may be afforded time to present a sur-rebuttal oral argument.** With this change, patent owners now also get the last word at the oral hearing.
- **The default time for all oral arguments will be one hour per side.** This practice update merely reflects the existing standard practice of the PTAB. Following this update, parties will still be able to ask for more or less time as the case demands, and consolidated cases may receive less than the default.
- **A party can request a pre-hearing conference.** The purpose of the pre-hearing conference is to allow the parties to preview—but not argue—the issues to be addressed at the hearing, seek guidance on the issues in which the Panel is most interested, and resolve procedural or evidentiary disputes. Such conferences will take place up to three business days before the oral hearing. While parties will still be required to submit their demonstrative exhibits before the conference, this new procedure will permit parties to tailor their oral arguments to address the issues that really matter to their Panel.
- **A party can request that a motion to exclude be decided before the hearing.** This change applies only to motions to exclude that are so central to a party's case that mootness is unlikely and early resolution is warranted. Such circumstances are expected to be rare but include, for example, the printed publication status of a prior art reference. In the vast majority of cases, the motion to exclude will still be considered after the oral hearing and will prove to be moot.