

The Sedona Conference
Commentary on Parallel USPTO Proceedings Chapter
“Stage One” (October 2017 Edition)
“Stage Two” (July 2017 public comment version)

The WG10 Chapter on Parallel USPTO Proceedings provides Principles and Best Practice recommendations for navigating the issues that have arisen from the establishment of the new post-grant proceedings for patent invalidity determinations at the U.S. Patent and Trademark Office by the Leahy-Smith America Invents Act in 2011. It is not at all uncommon for a USPTO Patent Trial and Appeal Board (PTAB) proceeding to run concurrently with a district court litigation or a U.S. International Trade Commission (USITC) section 337 unfair trade practice proceeding involving the same patent(s), and as such there is the risk of conflicting outcomes between such parallel proceedings. A number of issues have also arisen largely from the different standards that the various forums use when construing the claims and also the different scope of discovery that each forum permits to occur. As a consequence, a number of courts have struggled with deciding various issues, e.g., of stay and subsequent estoppels.

“Stage One” of this Chapter’s proposals were developed primarily from the perspective of district court litigation, both for practitioners and the district courts. The October 2016 Edition of the Chapter has now been fully updated to incorporate all of the comments received in response to the October 2014 public comment version.

“Stage Two” of this WG10 project expands its scope and develop recommendations directed toward improving proceedings before the PTAB and the collaborative resolution of patent disputes through both the federal courts and the PTAB working in concert, as opposed to in conflict. A new drafting team was formed in early 2015 to address issues such as: real party-in-interest and privy; presenting evidence and protecting confidentiality in PTAB Proceedings; termination after settlement; and the efficient handling of multiple parallel USPTO proceedings. The new sections were published for public comment in July 2017.

Also, as the PTAB has been developing its procedures, a number of issues have been in flux. For example, how will the PTAB decide what claims it will actually consider in the proceeding and what scope of discovery it will permit? As time and experience progress, there may well be changes to a number of aspects of the proceedings. Such changes will necessitate the WG10 drafting team to revisit this Chapter on a regular basis.

The Principles that guided the development of many of the Best Practice recommendations of this Chapter focus on the harmonization of parallel proceedings between the PTAB, ITC, and district courts and the opportunity to present evidence before the PTAB. The Principles are:

Principle No. 1 – The PTAB, ITC, and district courts should take steps to



harmonize parallel proceedings and exercise their discretion, when possible, to reduce abusive litigation and foster just, speedy, and inexpensive determinations.

Principle No. 2 – Parties to PTAB proceedings should be afforded a fair opportunity to present appropriate evidence and argument both before and after institution.

The full text of *The Sedona Conference Commentary on Parallel USPTO Proceedings*, Stage 1 (October 2017 Edition) and Stage 2 (July 2017 public comment version), is available free for individual download from The Sedona Conference website at

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