



[3510-16-P]

DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2019-0039]

Office Patent Trial Practice Guide, November 2019 Edition

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (“Office”) is issuing a consolidated Office Patent Trial Practice Guide (“Practice Guide”) to incorporate prior updates to the original August 2012 Practice Guide. The Office publishes the Practice Guide to provide practitioners with guidance on typical procedures and timeframes for taking action in post-grant trials implemented following the Leahy-Smith America Invents Act (“AIA”), as well as to bring greater procedural consistency among panels of the Patent Trial and Appeal Board (“Board”).

FOR FURTHER INFORMATION CONTACT: Michael Tierney and William Fink, Vice Chief Administrative Patent Judges, by telephone at (571) 272–9797.

SUPPLEMENTARY INFORMATION: The Office is issuing a consolidated Practice Guide to incorporate prior updates to the original August 2012 Practice Guide. The Office previously issued updates to the original 2012 Practice Guide in August 2018 and July 2019. The consolidated Practice Guide includes no substantive changes from the prior updates or current Board practices. The topic of such revisions and updates include:

- institution of trial after *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018);
- use of sur-replies in lieu of observations;
- how parties may contact the Board to request an initial conference call;
- use of word counts;
- updates to the sample scheduling order for derivation proceedings; and
- updates to the default protective order.

The November 2019 edition of the Practice Guide may be viewed or downloaded from the USPTO website at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. The earlier Practice Guide update from July 2019 is available at <https://www.uspto.gov/TrialPracticeGuide3> and the Practice Guide update from August 2018 is available at <https://go.usa.gov/xU7GP>. The full version of the original August 2012 Practice Guide continues to be available for reference on the USPTO website at <https://go.usa.gov/xU7GK>.

Comments regarding the Practice Guide can be sent to PTABAIATrialSuggestions@uspto.gov.

Dated: November 14, 2019.

Andrei Iancu,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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