UNITED STATES PATENT AND TRADEMARK OFFICE

Guidance on the impact of SAS on AIA trial proceedings

On April 24, 2018, the U.S. Supreme Court issued SAS Institute Inc. v. Iancu, 2018 WL 1914661.

As required by the decision, the PTAB will institute as to all claims or none. If the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.

For pending trials in which a panel has instituted trial on all of the challenges raised in the petition, the panel will continue with the proceeding in the normal course. By contrast, for pending trials in which a panel has instituted trial only on some of the challenges raised in the petition (as opposed to all challenges raised in the petition), the panel may issue an order supplementing the institution decision to institute on all challenges raised in the petition.

Additionally, for pending trials in which a panel enters an order supplementing the institution decision pursuant to this notice, the panel may take further action to manage the trial proceeding, including, for example, permitting additional time, briefing, discovery, and/or oral argument, depending on various circumstances and the stage of the proceeding. For example, if the panel has instituted a trial and the case is near the end of the time allotted for filing the Patent Owner Response, the panel may extend the due date for the Patent Owner Response to enable the patent owner to address any additional challenges added to the proceeding. Additionally, cases near the end of the 12-month statutory deadline may be extended, on a case-by-case basis, if required to afford all parties a full and fair opportunity to be heard. In such cases, the panel may adjust other procedural dates as necessary.

Upon receipt of an order supplementing the institution decision, the petitioner and patent owner shall meet and confer to discuss the need for additional briefing and/or any other adjustments to the schedule. While the Board may act *sua sponte* in some cases, additional briefing and schedule adjustments might not be ordered if not requested by the parties. Additionally, the parties may agree to affirmatively waive additional briefing or schedule changes. After meeting and conferring, the parties then shall contact the Board to discuss any requested additional briefing and/or schedule changes. It is expected that the parties will work cooperatively amongst themselves to resolve disputes and propose reasonable modifications to the schedule. Any remaining disputes shall be raised in a conference call with the Board. For details, the parties are commended to the order supplementing the institution decision entered in their particular case, and shall follow the instructions provided by the Board in such order.

The final written decision will address, to the extent claims are still pending at the time of decision, all patent claims challenged by the petitioner and all new claims added through the amendment process.

If parties have any questions about the impacts of the SAS decision, the parties may contact the panel (if case-specific) or submit questions in writing to the Board's **Trials@uspto.gov (mailto:Trials@uspto.gov)** email box (if general).

The PTAB hosted a "**Chat with the Chief (https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/oil-states-and-sas-decisions-supreme-court)**" webinar on April 30, 2018 to discuss the SAS decision, its impacts on AIA trial proceedings, and answer questions.

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