

PTAB Remand Guidance To Create Smoother, Clearer Process

By **Ryan Davis**

Law360, New York (December 1, 2017, 1:30 PM EST) -- New guidelines from the Patent Trial and Appeal Board about how it will handle remands from the Federal Circuit, which include the involvement of top board judges in each case, will help streamline the remand process and make it more predictable, attorneys say.

The Federal Circuit has remanded a few dozen America Invents Act review cases to the board after finding fault with its conclusions or reasoning. Until recently, parties had no way of knowing what to expect when a case returned to the board, but that changed with guidance issued last month.

The board's new standard operating procedure sets a goal of issuing decisions in remanded cases within six months and states that the PTAB's chief judge and vice chief judge will consult with the panel in each remanded case to identify issues that will need to be resolved.

Attorneys say the guidelines, particularly having the board's top officials play a role in each remand, is a welcome change that will improve the proceedings.

"The bottom line is that this standard operating procedure will likely streamline the remand process and hopefully make it more consistent," said Andrew Williams of McDonnell Boehnen Hulbert & Berghoff LLP.

Resolving remands in six months is a "reasonable goal," he said, and having the chief judge involved in each case will ensure that the board handles remands in a uniform fashion. Otherwise, there's a chance that various panels could be coming up with their own remand procedures and "reinventing the wheel each time," he said.

"I feel better knowing that they are trying to discuss these kinds of issues beforehand," he said.

The board now has hundreds of judges, and it's important for them to all be on the same page, said Naveen Modi of Paul Hastings LLP. The guidance shows the PTAB wants to make sure whatever fault the Federal Circuit found in the board's initial ruling isn't made again in other cases, and having top judges involved with help, he said.

"My sense is that the chief judge has been working hard to make sure there's uniformity within the board, and this is another step toward that," he said. "It's great that the PTAB is looking at things in this

way and that there are so many eyes on these cases on remand."

Initial AIA review proceedings have strict timelines set by the statute, but the AIA contains no regulations regarding remands. As a result, parties previously had to do their own research about what panels had done in prior cases where the Federal Circuit sent a case back to the board.

"This is very helpful. Prior to this, you had to dig into the cases yourself to get any kind of clue about what the board was doing on remand," said Jon Wright of Sterne Kessler Goldstein & Fox PLLC.

In some instances, cases on remand languished for months, with neither the parties nor the board taking any action to get the ball rolling, attorneys say. That is likely to be a thing of the past under the new guidelines, which say that parties should contact the board within 10 days of the date the Federal Circuit's mandate issues to arrange a teleconference with the panel.

In addition, the board said the parties should meet and confer before that happens to discuss issues like whether additional briefing and evidence is necessary on remand, what form it should take, and other procedural issues.

"It's a clear signal to the parties that they need to start thinking about this a little before the mandate issues," Wright said. "They're looking for the parties to be proactive."

The guidance is not binding and doesn't carry legal weight, meaning that panels can decide to go their own way and reject requests from parties even when both sides agree. But it gives a sense of how remands will proceed in most cases.

The document lays out several common remand scenarios and what the board will likely do in each one. For instance, if the Federal Circuit finds that the board used an incorrect claim construction, the board will likely allow additional briefing unless the construction adopted on appeal has been fully briefed, but will likely not allow additional evidence.

However, if the Federal Circuit finds that the board's initial decision violated a party's due process rights, the board said it will likely allow additional evidence, as well as additional briefing for the party whose rights were violated and possibly new oral arguments.

"This does provide some really good insight into how the board will handle cases on remand," Wright said.

The information about what opportunities a party may get to make its case on remand could influence decisions about which arguments to make on appeal, Williams said.

Parties that want to have the best chance of introducing new briefing and evidence might gravitate toward alleging a due process violation, he noted. In contrast, arguing the board failed to explain its reasoning may be the least effective strategy, since the guidance says the board is unlikely to allow new material on remand.

"You'll likely have the same panel and they're probably going to come to the same decision and just explain their decision better," he said. "You're unlikely to get additional evidence, so it may be a Pyrrhic victory. You may win at the Federal Circuit, but it seems unlikely you'll get a different ultimate outcome."

The guidance said that in most cases, the board will not allow additional evidence on remand. So parties who think that is important to their case should make an effort to nudge the Federal Circuit to say in its decision that new evidence is warranted, Wright said.

"If you want to get additional evidence, you need to get the Federal Circuit to say you're entitled to it," he said.

Much of the guidance is a formalization of how the board has been handling remands up to this point, Williams said. He noted that even before the document established a goal of completing remands in six months, that has been the ballpark estimate he's given clients who have asked how long it would take.

"This is not really altering what the board has been doing as much as putting it down on paper to let others see what's going on," he said.

The guidance indicates the board is aiming to ensure there is an efficient process when the Federal Circuit sends cases back for further proceedings, Modi said.

"It shows that the PTAB really want the cases to move along on remand," he said.

--Editing by Rebecca Flanagan and Emily Kokoll.