



# THINK FORWARD

## Who Gets the Last Word?

Typically the party with the burden of proof has the final opportunity to argue in an IPR. In most situations, this means the Petitioner, as the party bearing the ultimate burden of proving unpatentability, is afforded the last word. This is true during the initial briefings where the Petitioner argues last with their Petitioner's reply to Patent Owner's response. This is also true later during the oral hearings where the Petitioner is allowed to reserve time for rebuttal.

One instance during the IPR where the Patent Owner argues last is with a motion to amend, where the Patent Owner is given the opportunity to argue last because it carries the burden of proving patentability of the amended claims.

In more limiting circumstances, the Board has allowed a Patent Owner to argue last with respect to a specific issue raised by the Patent Owner by way of a sur-reply. For example, the Board has allowed Patent Owners to file sur-replies to address questions regarding the dating of prior art references.

In IPR2014-01198 (*HTC America v. NFC Technology*), the Patent Owner argued that it antedated a prior art reference. (IPR2014-01198, Paper 45 p. 10). As expected, the Petitioner responded to the antedating arguments in its Reply. (*Id.* Paper 42 pp. 7-10). Under these circumstances, the Board allowed the Patent Owner to file a sur-reply to specifically address arguments on antedating because the Patent Owner had the burden of showing reduction to practice. (*Id.*, Paper 45 pp. 3-5).

More recently, in IPR2015-01227 the Patent Owner challenged whether a prior art reference was entitled to a provisional application filing date as prior art under 102(e) (IPR2015-01227, Paper 38 pp. 44-53). The Patent Owner also argued that its patented invention antedated the prior art filing date. (*Id.* Paper 38 pp. 53-60). The Board, however, did not initially recognize the Patent Owner's burden to prove reduction to practice for antedating a prior art reference, and denied the Patent Owner's request to file a sur-reply following the Petitioner's Reply. Following Oral Arguments, the Board acknowledged it was improper to deny the Patent Owner's request to file a sur-reply on this issue of antedating the prior art reference<sup>[1]</sup>. (*Id.*, Paper 61 pp. 2-3). Therefore, the Board allowed the Patent Owner to file their sur-reply, after Oral Arguments, on these issues related to antedating the prior art reference.

## Contact Us

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<sup>[1]</sup> Based in part on the Federal Circuit's decision in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Circ. 2015) that was decided during the IPR proceedings. The Federal Circuit in *Dynamic Drinkware* held a "reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with [35 U.S.C.] § 112, ¶ 1" (800 F.3d at 1381).

