

How Briefings Shakeup Could Shape PTAB Arguments

Media Mentions

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Bracewell's **Kit Crumbley** recently discussed with *Managing IP* the US Patent and Trademark Office's Notice of Proposed Rulemaking released on April 18.

One significant USPTO proposal involves separating discretionary denial briefings from briefings on the merits. Currently, parties must address discretionary denial issues in the same briefings that they address the merits.

Crumbley says this proposal could make things easier for petitioners because they wouldn't have to guess what kind of discretionary denial issues patent owners would argue.

"By separating this, it clears up a lot of issues," he said.

The proposed change could also improve the quality of briefings in certain cases. Crumbley says having separate briefings for discretionary denials will give parties more space to prepare their merits arguments.

"You'll be able to explain your position better. Potentially, this could result in the board being provided with more explanation of the parties' positions, which is never a bad thing."

While creating separate discretionary denial briefs could certainly be significant to practitioners, the proposed rule is significantly less sweeping than a previous 56-page Advanced Notice of Proposed Rulemaking (ANPRM) from April 2023, which contained more suggestions for how discretionary denials could play out.

Crumbley said that compared to the ANPRM, this proposal is "massively scaled back."

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“It’s much less controversial and, in many ways, just codifies existing practice. A lot of the proposals that stakeholders and members of Congress had issues with have been dropped.”