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# 2021 PTAB Bar Association Annual Conference

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## **Bootcamp: Nuts and Bolts of Proceedings Before the PTAB**

## *Disclaimer*

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# PTAB Bar Association “Boot Camp”—Agenda

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- Overview of the Patent Trial and Appeal Board (PTAB).
- Post-Grant Proceedings at the Board.
  - Overview of a post-grant proceeding with discussions re:
    - Petition;
    - Patent Owner Preliminary Response;
    - Institution of a trial;
    - Discovery;
    - Patent Owner Response/Petitioner’s Reply/Sur-Replies;
    - Motions to Amend; and
    - Oral Argument/Final Written Decision.
- *Ex Parte* Appeals Process at the Board.

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- *Ex Parte* Appeals Process at the Board.

# Statutory Authority for the Board

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- The Patent Trial and Appeal Board (PTAB) is created by 35 U.S.C. § 6(a), which provides:

“There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board.”

# Proceedings at the Board

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- Appeals from . . .
  - *Ex Parte* patent applications
  - *Ex Parte* and *Inter Partes* reexamination proceedings
  - Reissue applications
- AIA Proceedings
  - *Inter Partes* Reviews (IPR)
  - Post-Grant Reviews (PGR)
  - Covered Business Method Reviews (CBMR) (sun set 9/16/20)
  - Derivations
- Interferences

# Composition of the Board

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- Director
- Deputy Director
- Commissioners for Patents and Trademarks
- Chief Judge
- Deputy Chief Judge
- Vice Chief Judges
- Lead Judges
- Judges
  - The judges shall be “persons of competent legal knowledge and scientific ability who are appointed by the Secretary in consultation with the Director.” 35 U.S.C. § 6(a).
- Patent Attorneys, Paralegals, Administrators, and Support Staff, etc.

# Action by the Board

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- 35 U.S.C. § 6(c) requires final decision by minimum of 3-member panels:

“Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.”



# Board Guidance and Authority

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- **Precedential opinions** create consistent authority to be followed in future Board decisions and with the examining core.
- **Informative decisions** have persuasive value and illustrate procedural and other norms.

# Precedential Opinion Panel (“POP”)

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- Created September 2018
- POP typically comprises the Director, the Commissioner for Patents, and the Chief Judge of the PTAB.
- The POP serves two primary functions:
  - rehear matters in pending trials and appeals, major policy or procedural issues, or other issues of importance; and
  - assist the Director in determining whether a decision previously issued by the PTAB should be designated as precedential or informative.

# Standard of Review by the Federal Circuit

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- The Board's decisions must be reviewed under the Administrative Procedure Act (APA).
- Board's fact findings are given deference while legal conclusions are reviewed without deference.
  - “Substantial evidence” standard for fact findings by the Board.
  - “***De novo***” standard for reviewing questions of law.

# QUESTIONS?

# PTAB Bar Association “Boot Camp”—Agenda

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# Post-Grant Options: *Inter Partes* Review (IPR)

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- Eligible Patents:
  - All non-AIA patents.
  - After nine months of grant or after termination of a Post-Grant Review (PGR), if PGR has been initiated for AIA patents.
- Eligible Petitioners:
  - Any individual or entity who is not the Patent Owner, unless:
    - The Petitioner or Petitioner's real party-in-interest filed a civil action challenging the validity of a claim of the patent;
    - The Petition is filed more than one year after the Petitioner, Petitioner's real party-in-interest, or Petitioner's privy was served with a complaint alleging infringement of the patent; or
    - The Petitioner, the Petitioner's real party-in-interest, or Petitioner's privy is estopped from challenging the claims on the grounds in the Petition.
- Eligible Grounds:
  - 35 U.S.C. §§ 102 and 103 based on patents and printed publications.

# *Inter Partes* Review (IPR)

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- **Claim Construction Standard:** *Phillips* - petitions filed on or after Nov. 13, 2018; BRI - non-expired patents for petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - Reasonable likelihood that Petitioner would prevail on at least one challenged claim.
- **Estoppel:**
  - PTO/District Court/ITC: “any ground that the Petitioner raised or reasonably could have raised”
- **Key Authority:**
  - 35 U.S.C. §§ 102, 103, 311-319;
  - 42 C.F.R. §§ 42.1-42.80, 42.100-42.123;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73); and
  - Trial Practice Guide Update (Nov. 2019).

# Post-Grant Options: Post-Grant Review (PGR)

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- **Eligible Patents:**
  - AIA patents no later than nine months from the date of grant.
- **Eligible Petitioners:**
  - Any individual or entity who is not the Patent Owner, unless:
    - The Petitioner or Petitioner's real party-in-interest filed a civil action challenging the validity of a claim of the patent; or
    - The Petitioner, the Petitioner's real party-in-interest, or Petitioner's privy is estopped from challenging the claims on the grounds in the Petition and grounds that reasonably could have been raised.
- **Eligible Grounds:**
  - All available grounds under 35 U.S.C. § 282(b)(2) or (3).



# Post-Grant Review (PGR)

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- **Claim Construction Standard:** *Phillips* - petitions filed on or after Nov. 13, 2018; BRI - non-expired patents for petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - More likely than not that at least one challenged claim is unpatentable.
- **Estoppel:**
  - PTO: “any ground that the Petitioner raised or reasonably could have raised.”
  - District Courts/ITC: “any ground that the Petitioner raised or reasonably could have raised.”
- **Key Authority:**
  - 35 U.S.C. §§ 101-112, 282, 321-329;
  - 42 C.F.R. §§ 42.1-42.80, 42.200-42.224;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73); and
  - Trial Practice Guide Update (Nov. 2019).

# Post-Grant Options: Covered Business Method (CBMR)

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- Eligible Patents:
  - Non-AIA “financial services” patents and AIA “financial services” patents nine months after grant; excluding “technological inventions.”
- Eligible Petitioners:
  - Any individual or entity who is not the Patent Owner **and** who itself, its real party-in-interest, or its privy, has been sued or charged with infringement of the challenged patent, unless:
    - The Petitioner or Petitioner’s real party-in-interest filed a civil action challenging the validity of a claim of the patent; or
    - The Petitioner, the Petitioner’s real party-in-interest, or Petitioner’s privy is estopped from challenging the claims on the grounds in the Petition and grounds that reasonably could have been raised.
- Eligible Grounds:
  - All available grounds under 35 U.S.C. § 282(b)(2) or (3), except as modified by section 18(a)(1)(C) of the AIA.
  - Sunsetting on Sept. 16, 2020 (last day to file petition (AIA § 18(a)(3))

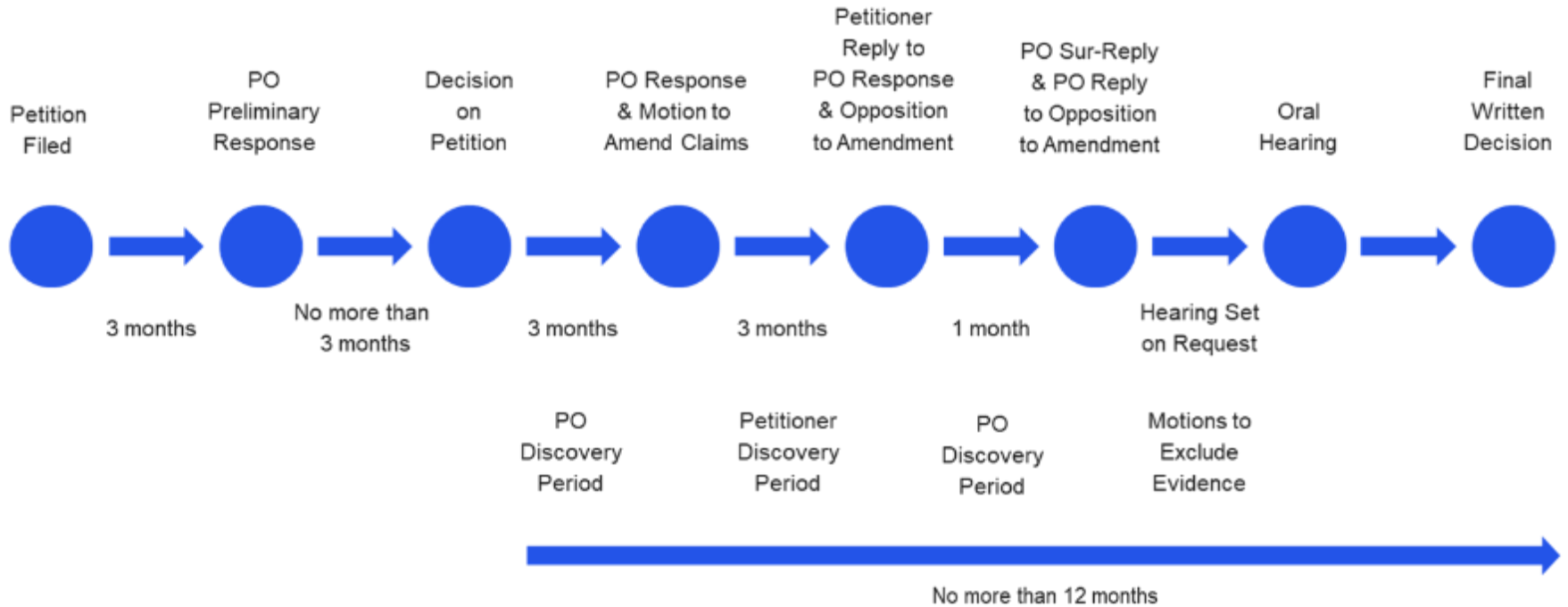
- **Claim Construction Standard:** *Phillips* - petitions filed on or after Nov. 13, 2018; BRI - non-expired patents for petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - More likely than not that at least one challenged claim is unpatentable.
- **Estoppel:**
  - PTO: “any ground that the Petitioner raised or reasonably could have raised.”
  - District Courts/ITC: “**any ground that the Petitioner raised.**”
- **Key Authority:**
  - Pub. Law. 112-29, 125 Stat, 329-31, § 18 (AIA);
  - 35 U.S.C. §§ 321-329;
  - 42 C.F.R. §§ 42.1-42.80, 42.203, 42.205-42.224, 42.300-42.305;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73);
  - Trial Practice Guide Update (August 2018); and
  - 2019 Revised Patent Subject Matter Eligibility Guidance.

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# Overview of PTAB Proceedings



# “Petition” Phase



- Also referred to as the “preliminary proceeding” phase.
- Begins with the filing of a Petition and ends with an Institution Decision.

# “Trial” Phase



- Begins with Institution Decision, ends with Final Written Decision.
- Statutorily required to be completed within one year of institution.
  - Except that the time may be extended up to six months for good cause or adjusted in the case of joinder.

# Petition



- Most important document filed by the Petitioner.
- Must carry threshold burden that Petitioner will prevail with respect to at least one challenged claim.
  - IPR: Reasonable likelihood of success.
  - PGR/CBMR: More likely than not.



# Petition “Must Haves”

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- Every Petition must identify Petitioner, real-parties-in-interest, counsel, etc.
  - CBMR requires additional analysis regarding why patent subject to CBMR review and showing that Petitioner has been charged with infringement.
- Must include a statement of the precise relief requested.
- Must include a full statement of the reasons for the relief requested (i.e., detailed explanation of why the claims are invalid).
  - IPR/PGR/CBMR – prior art (i.e., patents/printed publication) analysis (§§ 102/103).
  - PGR/CBMR – analysis of additional grounds (§§ 101, 112).
- Must set forth any claim constructions needed to interpret the claims.

# Petition “Must Haves”

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- The Petition must be in size 14, font TNR, and double spaced; although there are some exceptions. See Rule 42.6(a)(2)(iii).
  - Claim charts, however, can be single spaced.
- Petitions have strict word limits (not page limits):
  - IPR: 14,000 words; PGR/CBMR: 18,700 words.
- No incorporation of arguments by reference to other documents.
  - E.g., may be unable to meet threshold burdens with arguments only incorporated by reference from expert declaration, or by incorporating papers from another proceeding.
- For non-substantive issues, PTAB may authorize filing corrected Petitions to fix minor informalities.
  - But only one chance to submit a winning Petition.

# Real Party-in-Interest/Privy

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- The Board considers RPI/privy issues when, e.g., a missing RPI or a privy would result in a § 315(b) bar.
  - *Sharkninja Operating LLC, et al. v. iRobot Corporation*, IPR2020-00734, Paper No. 11 (PTAB Oct. 06, 2020) (precedential)
- The Federal Circuit has clarified the parties' respective burdens regarding an RPI or privy issue:
  - IPR petitioner bears burden of persuading the Board that petition is not time-barred under § 315(b);
  - Board should accept the petitioner's initial identification of RPIs unless and until disputed by the patent owner; and
  - Patent owner must produce "some evidence" that a particular third party should have been named an RPI and was not. *Worlds Inc. v. Bungie, Inc.*, 930 F.3d 1237 (Fed. Cir. Sep. 7, 2018).

# Real Party-in-Interest/Privy

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- Who is an RPI?
  - RPI is “the party that desires review of the patent,” which may be the petitioner itself or “the party or parties at whose behest the petition has been filed.” Consolidated Trial Practice Guide (Nov. 2019).
  - “Determining whether a nonparty is a ‘real party in interest’ demands a **flexible approach** that takes into account both the equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018).
  - Nonparty to IPR can be RPI even without express or implied agreement with the petitioner to file a petition. *Id.*

# Real Party-in-Interest/Privy

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- Who is a privy?
  - Privy is an inquiry into whether the parties have a “substantive legal relationship.” *Taylor vs. Sturgell*, 553 U.S. 880 (2008).
  - Trial Practice Guide and Board analyze the following *Taylor* factors:
    1. The existence of an agreement that the non-party be bound by a determination of issues in an action between the parties.
    2. The existence of a pre-existing substantive legal relationship between the non-party and a party.
    3. Representation in an action by someone with the same interests as the non-party.
    4. The assumption of control over an action by the non-party.
    5. Re-litigation of issues through a proxy.
    6. The existence of a special statutory scheme.

# Claim Construction

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- Petitions filed on or after November 13, 2018: the previous “broadest reasonable interpretation” standard replaced with federal court claim construction standard used to construe a claim in a civil action under 35 U.S.C. § 282(b).
  - This is the same claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.
- When construing a claim term in an IPR (or PGR and CBMR), PTAB will consider any prior claim construction determination made in a civil action, or a proceeding before the International Trade Commission (ITC), if timely made of record.

# Section 112 Issues

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- Section 112 issues cannot be raised in an IPR. *Samsung Elecs. Am., Inc. v. Prisia Eng'g Corp.*, 948 F.3d 1342, 1350-53 (Fed. Cir. Feb. 4, 2020).
- Pre-SAS, Board occasionally refused to institute review of certain claims indefinite under § 112; challenges to those claims not part of the Board's final written decisions. Post-SAS, IPR can no longer proceed claim-by-claim.
- § 112 issues can arise in IPR when determining the earliest effective filing date assigned to the challenged patent claims, in the context of which prior art applies (and whether PGR is available for particular patent).
- § 112 issues can be leveraged to convert a pre-AIA patent to an AIA patent, which can have certain advantages.

# Selecting Prior Art

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- The petitioner has the burden of demonstrating that a reference qualifies as prior art.
- The burden of persuasion always remains with the petitioner to prove “unpatentability by a preponderance of evidence” under 35 U.S.C. § 316(e).
- In evaluating prior art, petitioner should consider scope of any later estoppel under 35 USC §§ 315(e), 325(e).



# Prior Art Eligibility: Printed Publication

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- If relying on an article or publication, Petitioners are required to establish references as printed publications.
- “Public accessibility” is the *touchstone* in determining whether a reference constitutes a “printed publication.” *HULU, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 10 (PTAB Dec. 20, 2019) (Precedential).
- Reference is publicly accessible if “satisfactory showing” is made that “document has been disseminated or otherwise made available to the extent that **persons interested** and ordinarily skilled in the subject matter or art, **exercising reasonable diligence, can locate** it.” *Id.* at 10-11.

# Prior Art Eligibility: Printed Publication

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- Factors to be considered in determining whether information is “publicly accessible” and therefore, qualifies as a printed publication are set forth in *Jazz Pharm.*, 895 F.3d at 1358-59:
  - (i) the length of time the material was displayed;
  - (ii) the expertise of the target audience;
  - (iii) the existence (or lack thereof) of reasonable expectations that the material would remain confidential or not be copied;
  - (iv) the simplicity or ease with which the material could have been copied;
  - (v) the size and nature of the meeting; and
  - (vi) whether the material is addressed to or of interest to persons of ordinary skill.

# Prior Art Eligibility: Printed Publication

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- Strategies for qualifying a reference as a printed publication:
  - Provide evidence when filing a petition establishing a reference as a printed publication. For example:
    - Declarations from people with personal knowledge regarding the publication.
    - Evidence as to indexing at a library.
    - Evidence as to release in a well-known journal.
  - Consider showing multiple instances of public dissemination.
- See USPTO, Best Practices for Proving a Document is a Printed Publication, Dec. 7, 2017.  
([https://www.uspto.gov/sites/default/files/documents/proving\\_a\\_document\\_is\\_a\\_printed\\_publication\\_12\\_7\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/proving_a_document_is_a_printed_publication_12_7_2017.pdf))

# Patent Owner Preliminary Response (POPR)



- The choice to file a POPR is discretionary
- Any POPR is due within three months of a Notice of Filing Date Accorded - Not Petition filing date.
- Patent Owners may submit new testimonial evidence with Preliminary Response.
- For purposes of Institution Decision, Board will resolve any disputed material fact in favor of Petitioner (potential rule change).

# Patent Owner Preliminary Response (POPR)

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- Opportunity to make arguments against institution, such as:
  - Statutory Bars (e.g., outside one year window (IPR), RPI issues, and estoppel).
  - Board should use discretion to deny (e.g., arguments already considered by Office, redundant grounds, etc.).
  - Incomplete Petition.
    - Failure to meet Petition content requirements (e.g., claim constructions).
- Failure to meet institution thresholds; lack of rational underpinning.
- Consider making arguments that the prior art lacks a material element of the claims, teaches away, or doesn't actually qualify as prior art.

# Institution Decision



- Within three months of the POPR, PTAB will issue an Institution Decision
- Accompanied by a Scheduling Order for the “trial phase.”
- Starts the one-year clock to issue a Final Written Decision.

# Scheduling Order

DUE DATE APPENDIX	
<b>DUE DATE 1</b>	
Patent owner's response to the petition	<b>3 months</b>
Patent owner's motion to amend the patent	
<b>DUE DATE 2</b>	
Petitioner's reply to patent owner response to petition	<b>3 months</b>
Petitioner's opposition to motion to amend	
<b>DUE DATE 3</b>	
Patent Owner's sur-reply to reply	<b>1 month</b>
Patent Owner's reply to opposition to motion to amend	
<b>DUE DATE 4</b>	
Petitioner's sur-reply to reply to opposition to motion to amend	<b>1 month</b>
Motion to exclude evidence	
<b>DUE DATE TO FILE REQUESTS FOR ORAL ARGUMENT</b>	<b>Same as Due Date 4 (but parties may not stipulate an extension)</b>
<b>DUE DATE 5</b>	
Opposition to motion to exclude	<b>1 week</b>
<b>DUE DATE 6</b>	
Reply to opposition to motion to exclude	<b>1 week</b>
Request for prehearing conference	
<b>DUE DATE 7</b>	
Oral argument	<b>2 weeks</b>

# Institution Decision “Takeaways”

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- Board will institute as to **all claims or none**, *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018), and as to **all grounds or none**. *AC Techs. S.A. v. Amazon.com*, 912 F.3d 1358 (Fed. Cir. 2019).
- IPR Institution Decisions are “final and non-appealable”
  - Director’s decision whether to institute is final (§ 314(d))
  - Also precludes judicial review “where the grounds for attacking the decision to institute . . . consist of questions . . . closely tied to the application and interpretation of statutes related to the . . . decision to initiate” an IPR. *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367 (2020)
    - E.g., time-bar determinations, findings re estoppel. *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1367 (Fed. Cir. 2018). *Cf. Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1049-51 (Fed. Cir. 2017).
  - But request for reconsideration is an option



# Board Considerations in Instituting a Review

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- Board considers various non-exclusive factors in determining whether to institute trial.
  - See 35 USC §§ 314(a), 324(a), 325(d).
- Sections §§ 314(a) & 324(a) give Director discretion to deny a petition.
  - In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential).
  - *General Plastic* enumerated non-exclusive factors that the Board will consider in exercising discretion on instituting IPR.
    - *General Plastic* factor analysis especially relevant as to “follow-on” petitions.

## Board Considerations in Instituting a Review (§§ 314(a) and 324(a))

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- *General Plastic* non-exclusive factors include:
  1. Whether same petitioner previously filed petition directed to same claims of same patent;
  2. Whether, when first petition filed, petitioner knew, or should have known, of prior art asserted in second petition;
  3. Whether, when second petition filed, petitioner already received POPR to first petition or Board's decision on whether to institute review on first petition;
  4. Length of time between time petitioner learned of the prior art asserted in the second petition and filing of second petition;
  5. Whether petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to same claims of same patent;
  6. The finite resources of the Board; and
  7. The requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

## Considerations in Instituting a Review - § 325(d)

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- “The Director may take into account whether, and reject the petition or request because, the **same or substantially the same prior art or arguments** previously were presented to the Office.” 35 U.S.C. § 325(d).
- Board has considered certain non-exclusive factors when evaluating whether to deny institution on the basis of 35 U.S.C. § 325(d). *Becton Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative).

## Considerations in Instituting a Review - 35 U.S.C. § 325(d)

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- *Advanced Bionics* two-part test:
  1. Whether the same or substantially the same art or argument were previously presented to the Office; and
  2. Whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

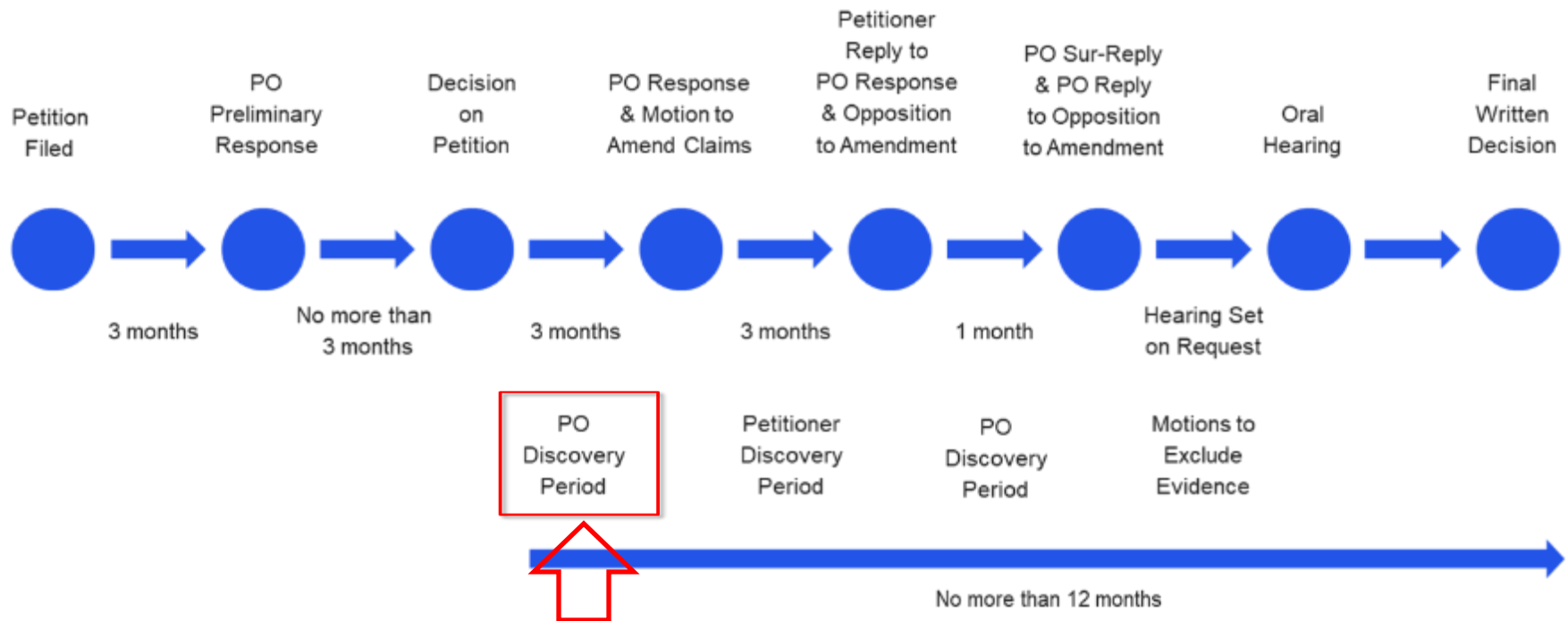
*Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential)

# Joinder

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- The Board has the discretion to join multiple petitions under 35 U.S.C. § 315(c).
- A request for joinder must be filed within one month after the institution date of a petition for which joinder is requested. 37 CFR § 42.122(b).
- **No “same-party” joinder.** A time-barred petitioner may not join its own previously-instituted IPR and raise new claims or new issues. See *Facebook, Inc. v. Windy City Innovations, Inc.*, \_\_\_ F.3d \_\_\_, 2020 WL 5267975, at \*12 (Fed. Cir. Sept. 4, 2020) (overruling *Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2018-00914, Paper No. 38 (Mar. 13, 2019) (precedential)).

# Patent Owner Discovery Period



- Institution Decision begins Patent Owner Discovery Period.
  - Typically includes cross-examination of Petitioner’s expert.
- Discovery is limited to three types:
  - Routine, Mandatory, and Additional Discovery.

# Routine Discovery

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- Three general categories:
  - A party must serve any exhibit cited in a paper or in testimony, unless it has already been served or the parties agree otherwise.
  - A party must serve relevant information that is *inconsistent* with a position advanced by the party concurrent with the filing of the documents that include the inconsistency.
  - A party may cross-examine the other party's declarants.

# Testimony

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- Direct testimony entered by paper (declaration)
- Depositions (for cross-exam)
  - Up to seven hours
  - Trial testimony, not discovery deposition
    - Seek admissions
    - Emphasize inconsistencies
  - Up to four hours for redirect, two hours for re-cross



# Testimony

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- Depositions (for cross-exam) (cont'd)
  - Limited objections
    - No speaking objections - only non-argumentative, non-suggestive (form, hearsay, relevance, foundation)
    - Not “vague,” “take your time,” “look at the document,” “I don’t understand”
    - If asked to do so, objecting party must explain objection
  - May not talk to your witness until after cross complete (think trial – witness still on stand; breaks for convenience only)
    - *Focal Therapeutics, Inc. v. Senorax, Inc.*, IPR2014-00116, Paper 19 (PTAB July 21, 2014).
    - May talk to witness between cross and re-cross

## "Mandatory" Initial Disclosures

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- Parties may agree to mandatory discovery that requires initial disclosures, but this rarely happens.
- There are two options available for initial disclosures:
  - Option 1 is modeled after Rule 26(a)(1)(A) of the Federal Rules of Civil Procedure.
  - Option 2 is more extensive and generally requires the petitioner to:
    - Identify persons and information relating to the basis of any alleged obviousness, secondary considerations, and, if a challenge is based on alleged prior nonpublished public disclosure, information relating to it.

# Additional Discovery

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- Additional discovery is discovery that goes beyond routine discovery (or mandatory discovery, if applicable).
  - For example, the production of documents not referred to in the Petition or Preliminary Response may be additional discovery.
- Parties may agree to additional discovery between themselves, and when they do not agree, a party may seek authorization to move for additional discovery.
- Opposed requests for additional discovery require a joint conference call with the Board to discuss the request.

# Additional Discovery

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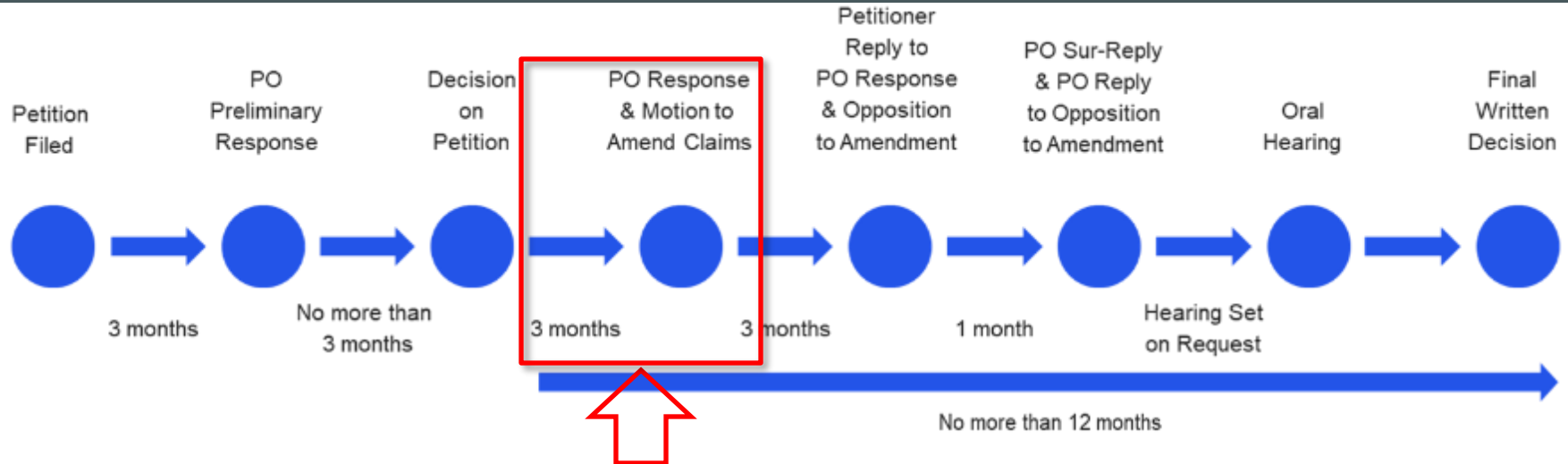
- A party seeking additional discovery must show that the additional discovery is “in the interests of justice” (for IPRs) or for “good cause” (for PGRs).
- These two standards are closely related but, on balance, the interests-of-justice standard is slightly higher than the good-cause standard.
- And, additional discovery in PGR proceedings is limited to evidence directly related to factual assertions advanced by either party.

# Additional Discovery

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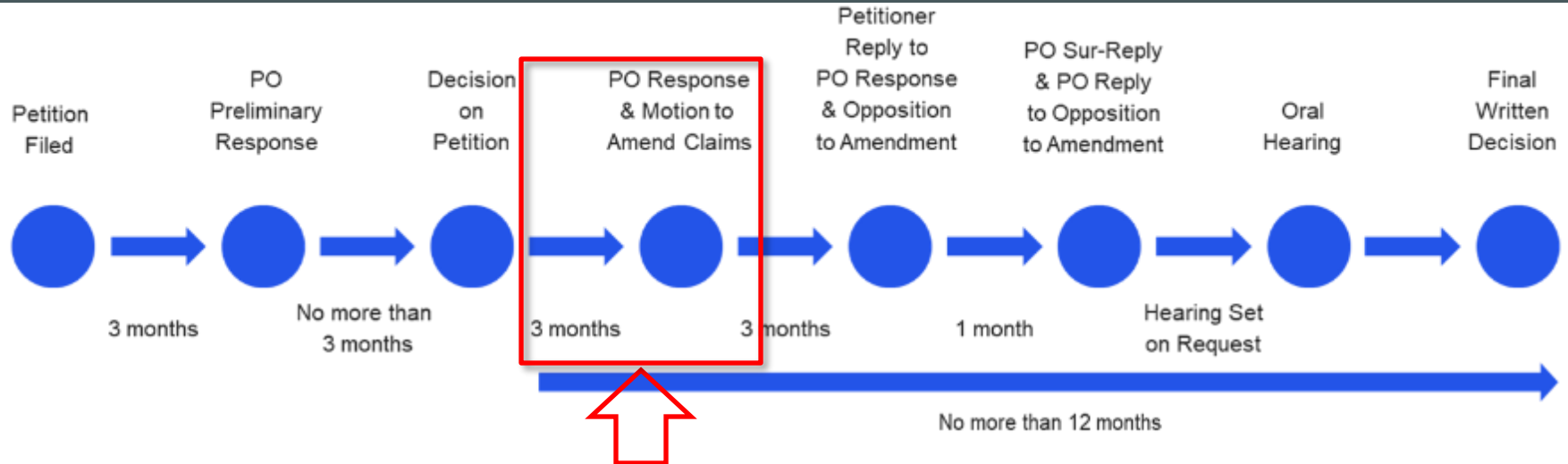
- *Garmin* Factors:
  - more than a possibility and mere allegation that something useful will be discovered;
  - requests that do not seek other party's litigation positions and the underlying basis for those positions;
  - no ability to generate equivalent information by other means;
  - easily understandable instructions; and
  - requests that are not overly burdensome to answer.

# Patent Owner Response (POR)



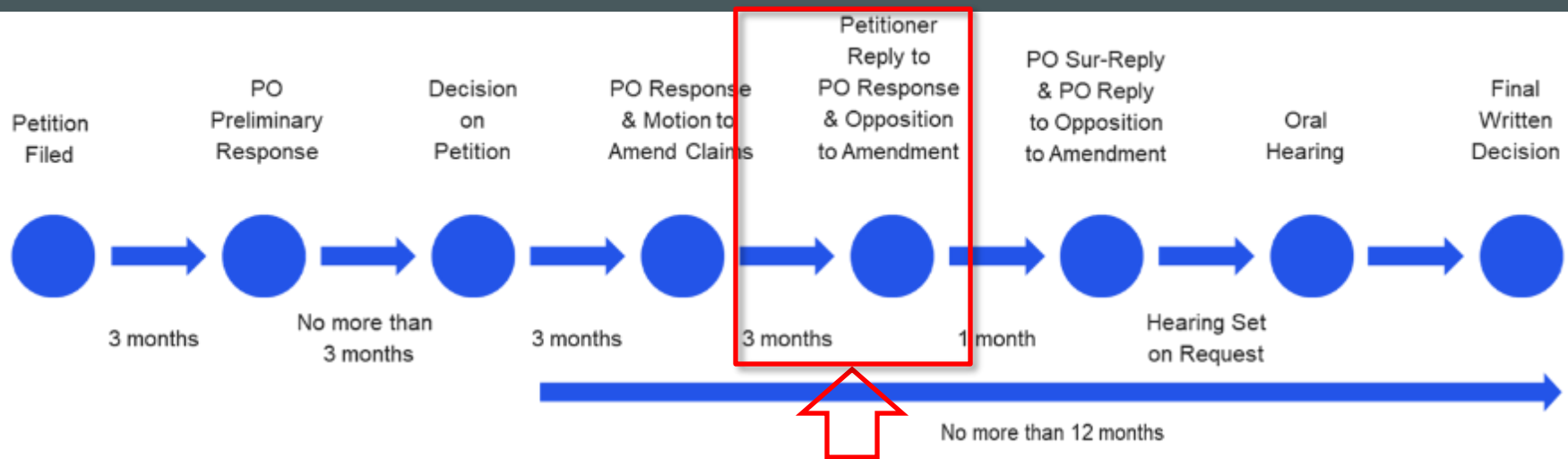
- Patent Owner must file a Response typically due within 2-3 months.
  - Due date set by Scheduling Order.
- Patent Owner is permitted to fully address the merits of the challenger's Petition on the instituted grounds and present evidence.

# Patent Owner Response (POR)



- Arguments not raised in the Response are deemed waived, even if previously raised in the Preliminary Response.
- **Arguments** made in the Preliminary Response **cannot be incorporated by reference** in the Response. 37 C.F.R. § 42.6(a)(3).

# Petitioner Reply to Patent Owner Response



- Petitioner may submit new evidence/expert declaration (but this triggers a new Patent Owner Discovery period).
- Scope limited to responding to Patent Owner Response.
  - Reply may explain petition arguments in responding to Patent Owner Response and ID, but no new arguments are permitted.



# Patent Owner Sur-Reply to Petitioner Reply



- Patent Owner Sur-Replies to a Petitioner's Reply to Patent Owner Response will normally be authorized by the scheduling order entered at institution. Trial Practice Guide Update (August 2018).
  - Sur-reply practice replaces previous practice of filing motions for observations on cross-examination testimony.
  - No new evidence permitted other than deposition transcripts of the cross-examination of any reply declarant

# Objective Indicia of Non-Obviousness

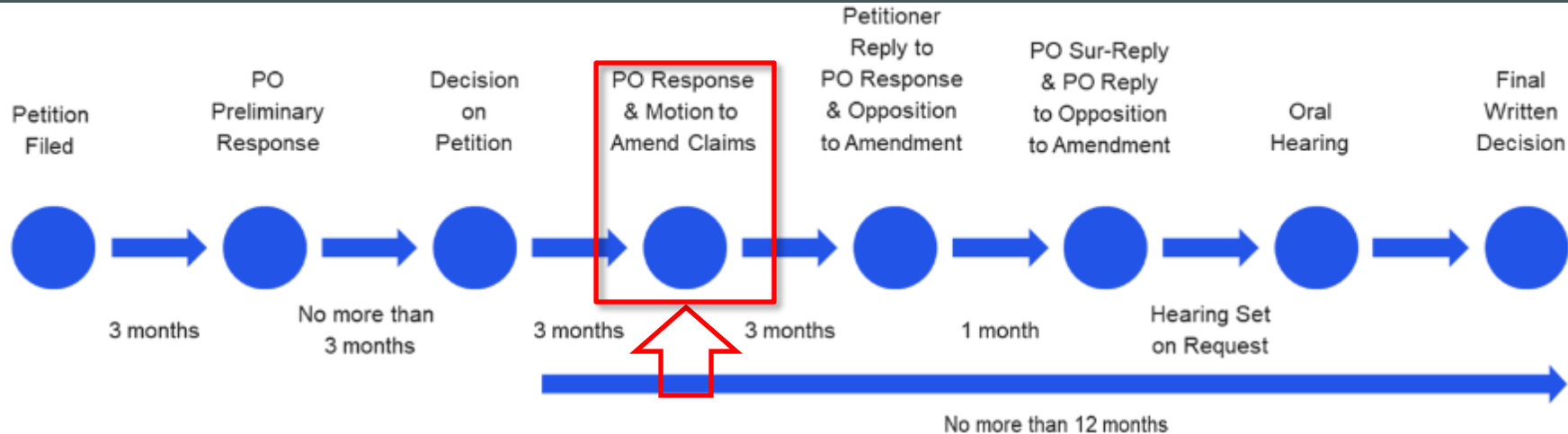
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## Voting keys:

- A) Would serve document requests on Petitioner
- B) Would move for entry of a protective order and include the Petitioner's documents as exhibits
- C) Would try to get Petitioner to agree to additional discovery and, if no agreement, seek Board authorization to move for additional discovery

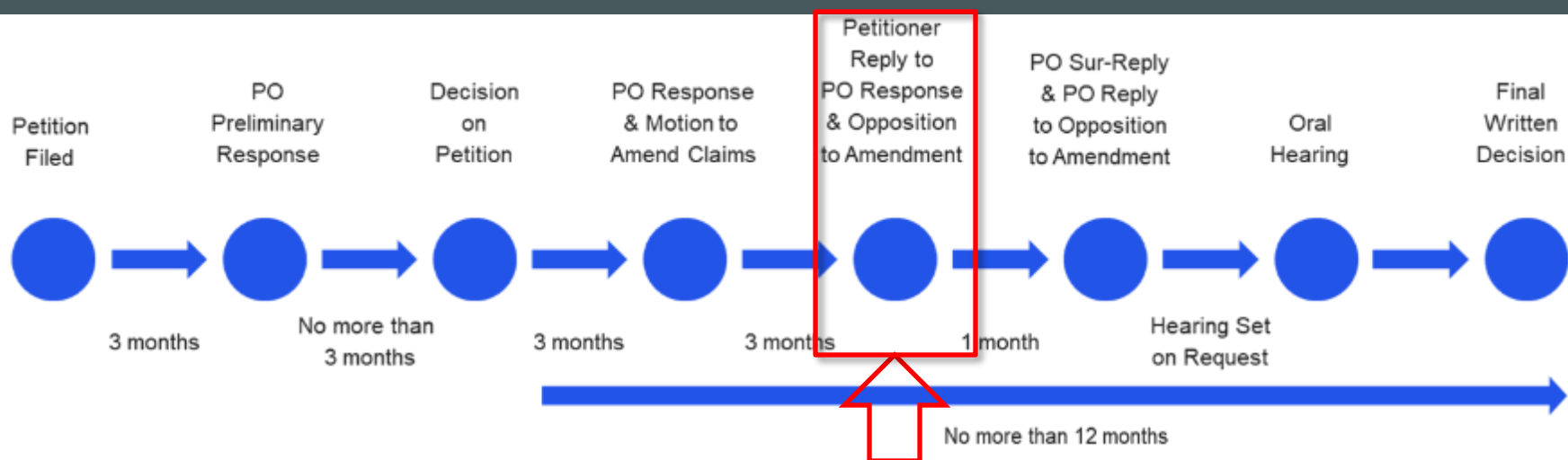
You represent a patent owner in an instituted IPR. In co-pending litigation, your litigation team has received documents (subject to a protective order) regarding Petitioner's copying of the patented product. Do you (A) serve document requests on Petitioner, (B) submit the evidence with the POR (subject to a protective order), or (C) seek agreed, additional discovery and, if unsuccessful, seek Board authorization to move for additional discovery?

# Motion to Amend Claims – Status Quo



- Motion to Amend Claims currently due with the Patent Owner Response.
  - A single Motion to Amend may be filed as of right, additional motions require a showing of “good cause.”
  - The same *Phillips* claim construction standard will be used for proposed substitute claims in a motion to amend.
- *Lectrosonics*

# Petitioner Opposition to Motion to Amend



- Petitioner may argue reasons the claim amendments do not distinguish over all known prior art.
- Petitioner may submit new evidence/expert declaration (triggers a new Patent Owner Discovery period).

# Patent Owner Reply ISO Motion to Amend



- Patent Owner may submit a new evidence/expert declaration (triggers a new Petitioner discovery period).
- Scope limited to responding to Petitioner Opposition.

# Pet. Sur-Reply to PO Reply ISO Motion to Amend



- Petitioner Sur-Replies to a Patent Owner's Motion to Amend will normally be authorized by the scheduling order entered at institution. Trial Practice Guide Update (August 2018).
- Scope limited to responding to Patent Owner Reply.

# Motion to Amend (MTA) Pilot Program

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- AIA trials instituted on/after March 15, 2019, patent owner may opt in to MTA Pilot Program.
- Program provides patent owner with two new options:
  - the “patent owner may choose to receive preliminary guidance from the Board on its MTA,” [non-binding] and
  - (2) if the guidance is unfavorable, patent owner may then choose
    - to file a revised MTA after receiving petitioner’s opposition to the original MTA and/or after receiving the Board’s preliminary guidance (if requested)
    - OR file a reply to the preliminary guidance
    - Or do nothing

# Motions to Exclude/Strike



- The parties may move to exclude evidence and strike arguments/evidence from the record.
- The Board may rule on motions to exclude/strike on pre-hearing conference, at oral hearing, and/or in FWD.
  - Motions to exclude generally decided after oral hearing.
  - Motions to strike rarely granted.



# Motions to Exclude

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- Objections to Evidence: To preserve challenges to admissibility of evidence, objections must be filed within five business days of service of evidence to which the objection is directed, or ten days after institution of trial. 37 C.F.R. § 42.64(b)(1). Objections to admissibility of deposition evidence must be made during the deposition. 37 C.F.R. § 42.64(a).
  - Objection due dates do not appear in scheduling order.
- Supplemental Evidence: Responds to evidentiary objections. 37 C.F.R. § 42.64(b)(2).
  - Serve within 10 business days of objection to evidence

# Motions to Exclude

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- Motions to Exclude: Objections preserved only by moving to exclude the evidence. 37 C.F.R. § 42.64(c).
  - Due dates for moving to exclude evidence, opposition, and reply usually set in the Scheduling Order.

# Supplemental Information vs. Supplemental Evidence

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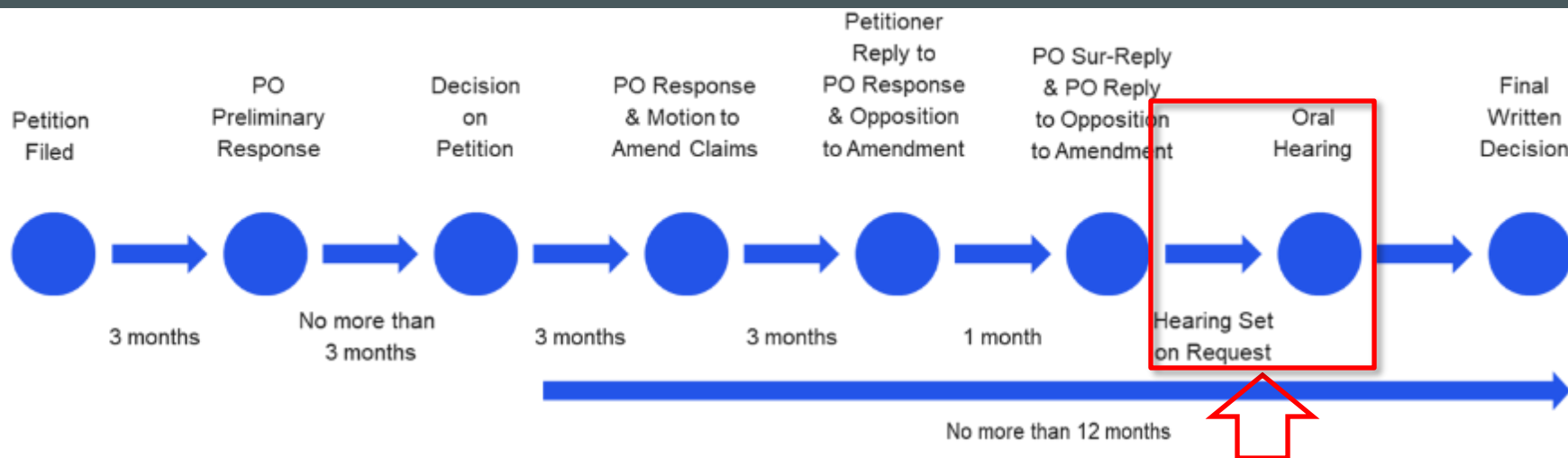
- Supplemental Information (37 C.F.R. § 42.123(a), (b)) :
  - Evidence to support an argument on the merits (e.g., evidence to support printed publication status of a prior art)
- Supplemental Evidence (37 C.F.R. § 42.64 (b)) :
  - Evidence offered to support admissibility of previously submitted evidence
  - Can only be submitted in response to an objection to evidence
  - 10 business days to supplement evidence after service of an objection to evidence

# Motions to Strike

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- Motions to Strike: If a party believes that a paper filed by opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike.
  - Alternatively, a party may request authorization for further merits briefing to address the merits of any newly-raised arguments or evidence.
    - Standard sur-reply practice has largely obviated this need.
  - Striking a party's brief (whether partially or entirely) is exceptional remedy.
  - Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission. PTAB Trial Practice Guide, 81 (Nov. 2019).

# Oral Hearing



- The parties may request oral argument.
- Live testimony may be permitted when requested and approved by the Board.
- The parties may file demonstrative exhibits.
  - Demonstrative must only include material from the record.

# Oral Hearing

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- Board expects to ordinarily provide for an hour of argument per side for a single proceeding, but a party may request more or less time depending on the circumstances of the case.
- Board encourages the parties to confer before filing a request for oral hearing and, if possible, jointly agree regarding appropriate argument time needed for each side.

# Oral Hearing

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- A pre-hearing conference call may be held at either party's request.
- The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties.
- Board may also permit patent owners the opportunity to present a brief sur-rebuttal during the hearing, if requested.

# Final Written Decision



- Required within one year of institution (subject to possible extension for good cause and joinder).
- Decides all instituted grounds.
  - If the claims are deemed unpatentable, the Board will order them “cancelled” (as opposed to invalid).
- Issuing the Final Written Decision creates estoppel for issues raised (or reasonably could have been raised for IPRs and PGRs) during the “proceeding.”



# Post-Final Written Decision

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- Director Review
  - Interim process implemented post-*Arthrex*.
- Rehearing
  - Due 30 days from the Final Written Decision.
  - Can only request panel rehearing or Director review
- Appeal
  - Parties may appeal the PTAB's Final Written Decision to the United States Court of Appeals for the Federal Circuit.
  - Notice of Appeal is due within 63 days unless tolled by a timely-filed Request for Rehearing

# Remand

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- Standard Operating Procedure 9 governs cases remanded from the Federal Circuit.
- Board goal: issue decisions within 6 months after the Federal Circuit's mandate.
- Board has set default procedures for trials & *ex parte* appeals regarding whether further briefing, evidence, or oral hearings are warranted in individual case, and whether prosecution will be reopened. See Standard Operating Procedure 9, Appendix 2.

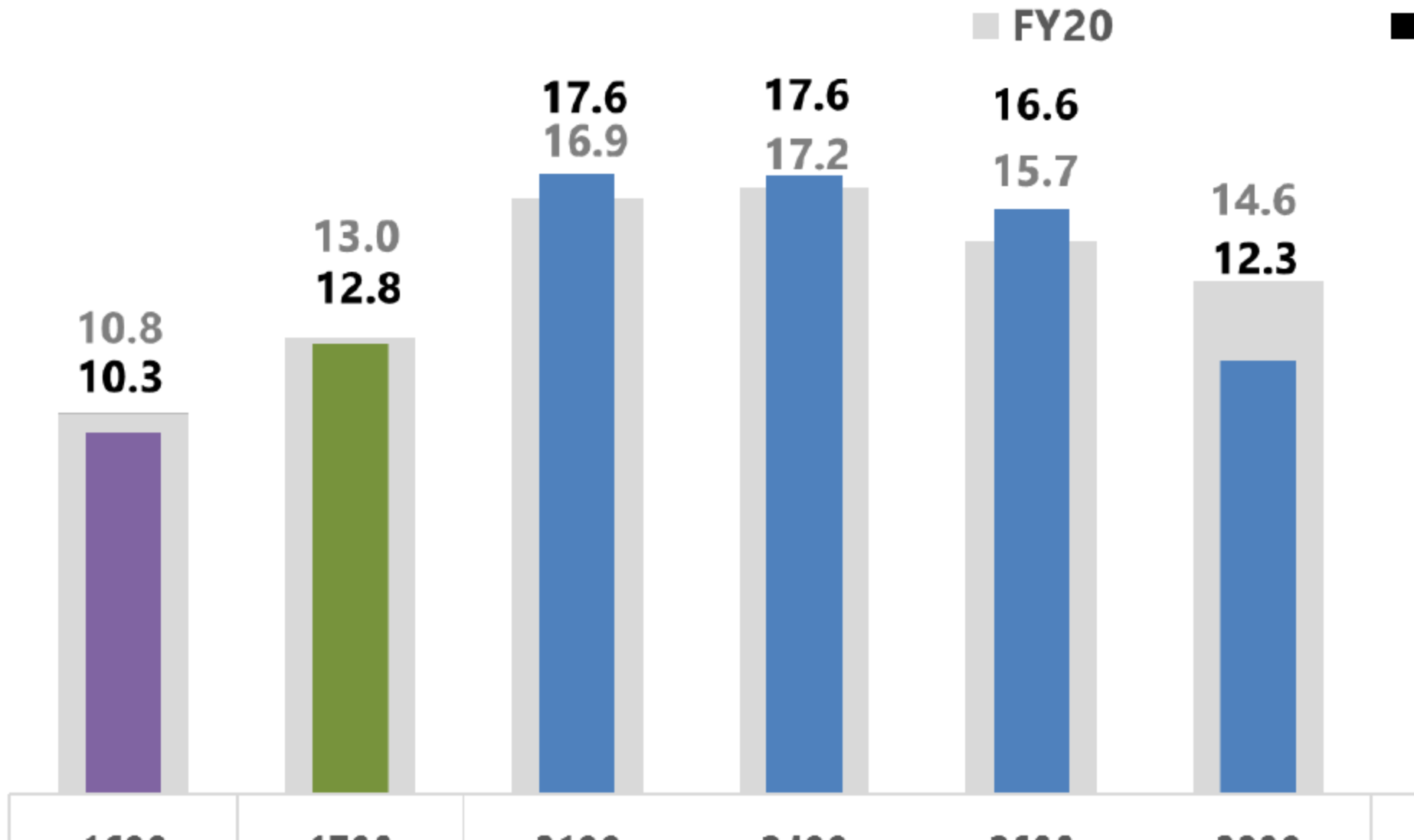
# PTAB Bar Association “Boot Camp”—Agenda

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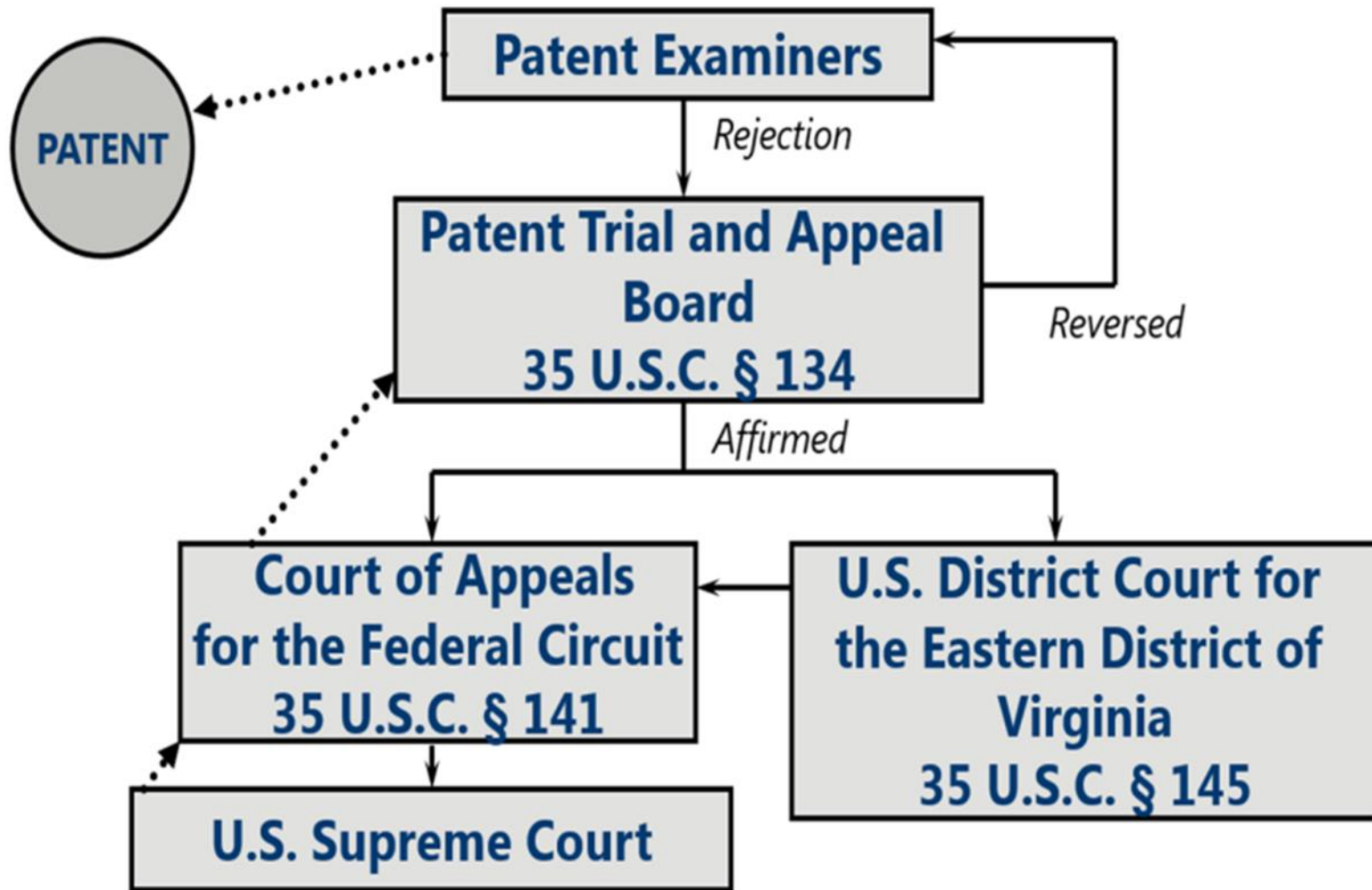
- Overview of the Patent Trial and Appeal Board (PTAB).
- Post-Grant Proceedings at the Board.
  - Overview of a post-grant proceeding with roundtable discussions re:
    - Petition;
    - Patent Owner Preliminary Response;
    - Institution of a trial;
    - Discovery;
    - Patent Owner Response/Petitioner’s Reply/Sur-Replies;
    - Motions to Amend; and
    - Oral Argument/Final Written Decision.
- *Ex Parte Appeals Process at the Board.*

# Pendency of decided appeals

(May 2020 – Jul. 2020 compared to May 2021 – Jul. 2021)



# The Board in the Appeals Process



# The Appeals Process

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- *Ex Parte* Appeals are from the Examiner’s “adverse” decision rejecting the claims in a patent application, reissue application, or a reexam proceeding.
- The Board is a judicial body reviewing issues identified by Appellant.
  - The Board does not “allow” claims.
- Decisions are based on the arguments in the Appeal Briefs and the preponderance of the evidence relied upon by the Appellant and the Examiner in the record. See *Ex parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential).
- Appellant may request an Oral Hearing.

# The Appeals Process

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- The Board has authority delegated by the Director to enter new grounds of rejection.
  - Use of this authority is discretionary.
- The MPEP advises Examiners not to draw any inference from a Board decision that does not exercise this discretion.

# Basic View of the Process

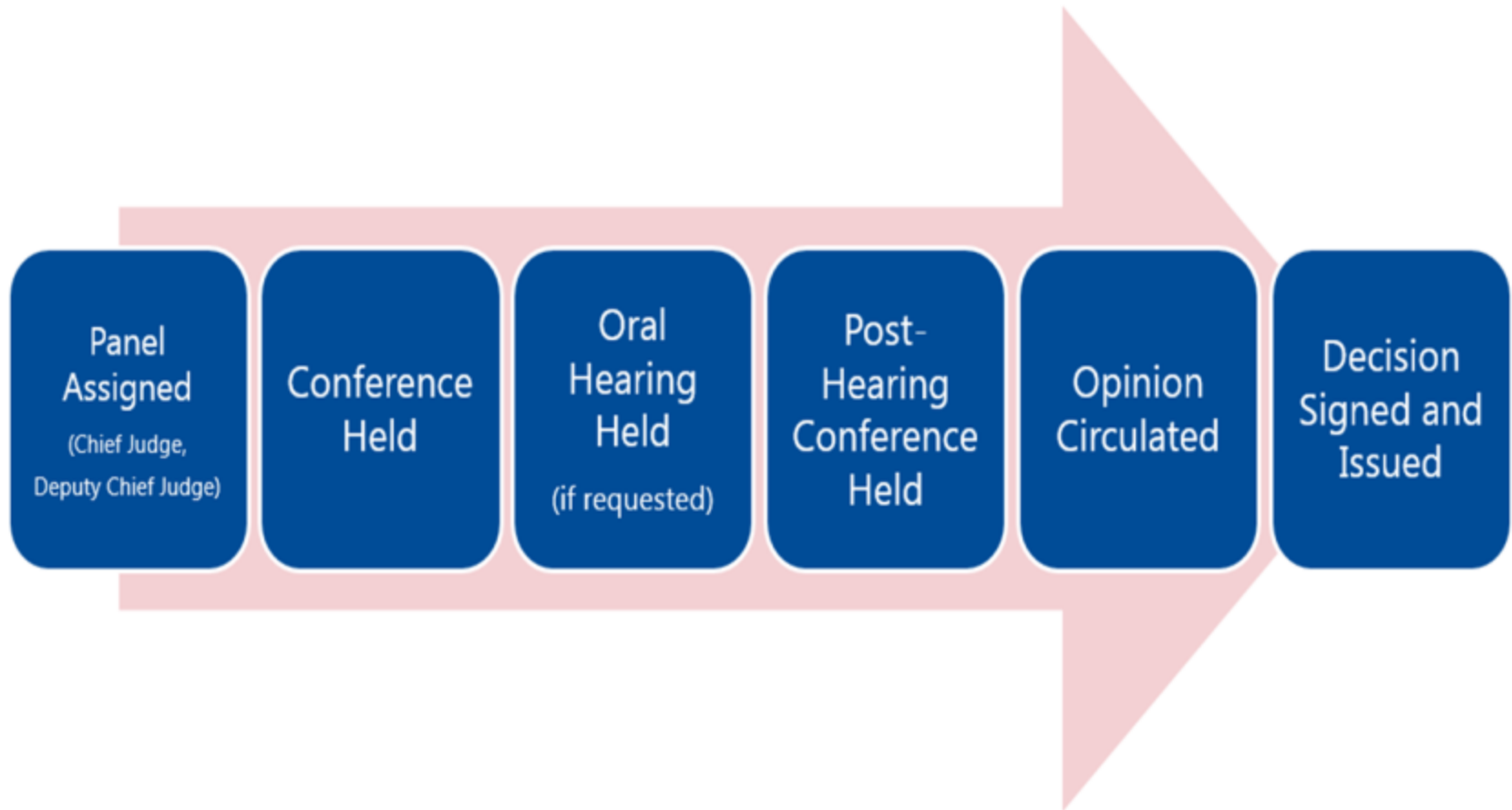
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- Getting to be heard at the Board.
  - Twice Rejected (or “Final” Rejection)
  - Notice of Appeal
    - Pre-Appeal Brief Review Request Program
  - Filing of an Appeal Brief
    - Appeal Conference
  - Filing of an Examiner’s Answer
  - Filing of a Reply Brief
  - Payment of the Appeal Brief Forwarding Fee
  - Oral Argument Request
  - Oral Hearing (if requested)



# The Appeal Process at the Board

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# Actions After Adverse Decision

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- Request for Continued Examination (RCE); or
- Request for Rehearing; or
- Appeal to United States Court of Appeals for the Federal Circuit, and then to United States Supreme Court; or
- Civil Action in the United States District Court for the Eastern District of Virginia.

# PTAB Practice and Procedure Resources

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- PTAB Website:
  - <http://www.uspto.gov/ip/boards/bpai/index.jsp>
- PTAB Rules and Trial Practice Guide:
  - [http://www.uspto.gov/ip/boards/bpai/board\\_trial\\_rules\\_and\\_practice\\_guide.jsp](http://www.uspto.gov/ip/boards/bpai/board_trial_rules_and_practice_guide.jsp)
- Consolidated Trial Practice Guide (November 2019)
  - <https://www.uspto.gov/TrialPracticeGuideConsolidated>
- Precedential & Informative Decisions:
  - <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>
- Fees:
  - <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>

# QUESTIONS?