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# *Discovery at the PTAB*

PTAB Bar Association Young Lawyers & Agents Committee  
Nuts & Bolts Series

Maria A. Stubbings  
Counsel, Perkins Coie LLP

- Not governed by the Federal Rules of Civil Procedure
- Governed by:
  - 37 C.F.R. § 42.51
  - The PTAB Trial Practice Guide
- More limited discovery than district court proceedings
- Helps keep PTAB proceedings streamlined

# Two Types of Discovery

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- Routine Discovery
- Additional Discovery

# Routine Discovery (37 C.F.R. § 42.51(b)(1))

**(b) Limited discovery.** A party is not entitled to discovery except as provided in paragraph (a) of this section, or as otherwise authorized in this subpart.

**(1) Routine discovery.** Except as the Board may otherwise order:

**(i)** Unless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.

**(ii)** Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.

**(iii)** Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency. This requirement does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product. This requirement extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.

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# Deposition Strategy

	<b>District Court</b>	<b>IPR</b>
Scope	Broader scope	Limited to declaration
Objections	Depends on jurisdiction	Limited objections
What's in the record?	Designate selected testimony to be played or read at trial	Entire transcript
Discussions with witness	Can't discuss substance during breaks until deposition is over	Can't discuss substance during cross, but once cross is over, can discuss substance of testimony between cross and redirect

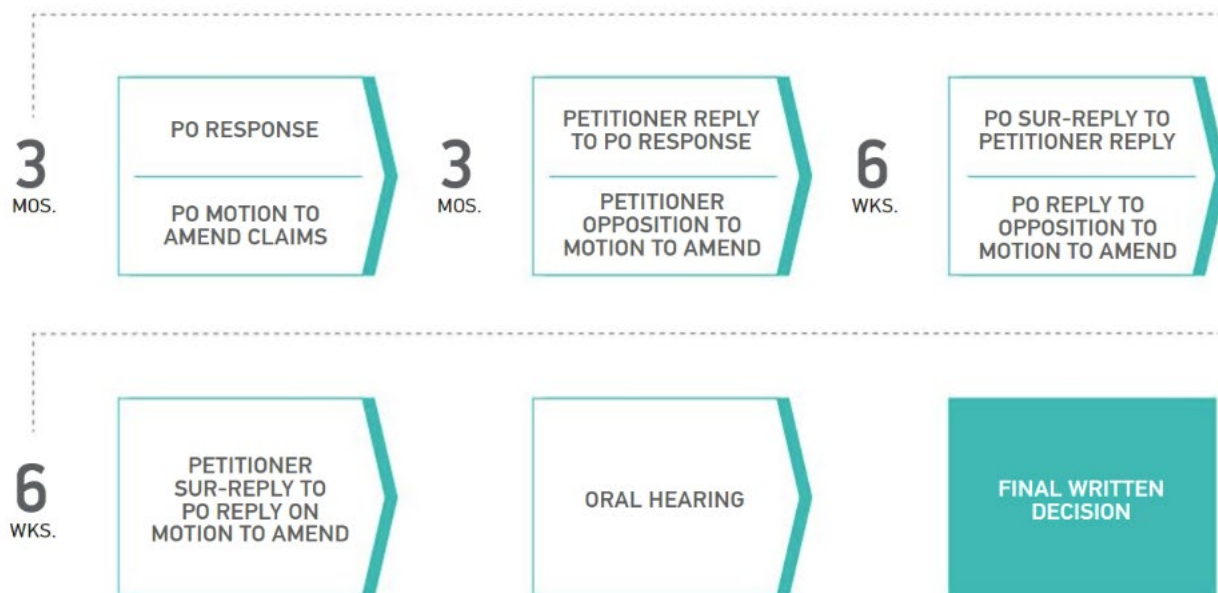
# IPR Timeline

## Petition Phase



## Trial Phase

*Generally no more than 12 months*



[Perkins Coie IPR >> IRL Guide](#)

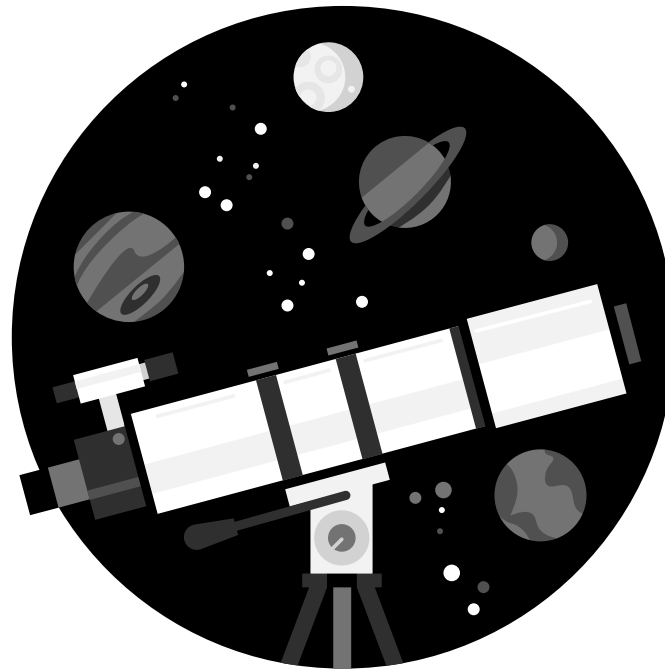
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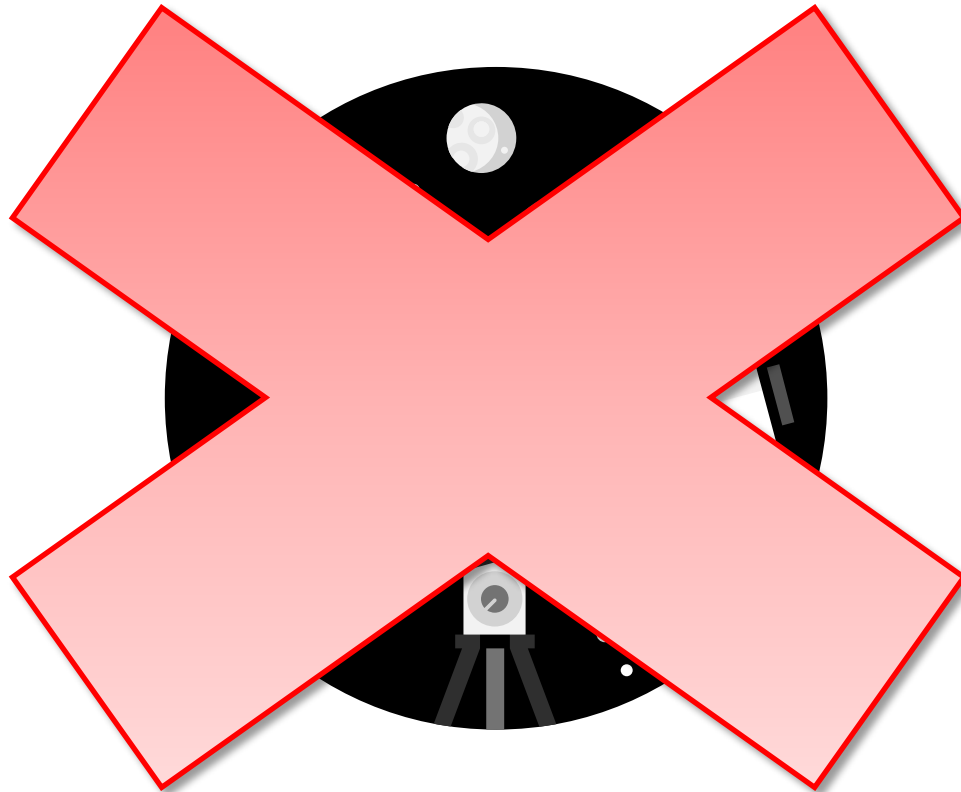
**Trial Phase**  
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What if you want more discovery?



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# Additional Discovery (37 C.F.R. § 42.51(b)(2))

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...

## **(2) Additional discovery.**

**(i)** The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice, except in post-grant reviews where additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding (*see* § 42.224). The Board may specify conditions for such additional discovery.

**(ii)** When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during authorized compelled testimony under § 42.52.

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# Interests of Justice: *Garmin* Factors

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1. More Than A Possibility And Mere Allegation
2. Litigation Positions And Underlying Basis
3. Ability To Generate Equivalent Information By Other Means
4. Easily Understandable Instructions
5. Requests Not Overly Burdensome To Answer

*Garmin Int'l, Inc. v. Cuozzo Speed Tech. L.L.C.*, IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013).

# Additional Discovery

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- Possible additional discovery:
  - Who is a real party-in-interest (RPI)?
  - Secondary considerations evidence

# Motions to Exclude

- At the end of the proceeding, a party may file a motion to exclude evidence it believes inadmissible
- Admissibility governed by the Federal Rules of Evidence



# Final Thoughts

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- More limited discovery than district court proceedings
- Helps keep PTAB proceedings streamlined
- Key differences in how deposition testimony is used in IPRs vs. in district court
- Parties seeking additional discovery must meet a high standard



# Additional PTAB Materials

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- The PTO has more information about PTAB Trials:  
<https://www.uspto.gov/patents/ptab/trials>
- PTAB Trial Practice Guide available at  
<https://www.uspto.gov/patents/ptab/resources>
- My firm, Perkins Coie, has post-grant materials available at  
<https://www.perkinscoie.com/en/post-grant-resources.html>

Questions? Reach out to me at:

- [Mstubbings@perkinscoie.com](mailto:Mstubbings@perkinscoie.com)
- <https://www.linkedin.com/in/maria-stubbings-18b5b42b/>