

*“Nuts and Bolts”  
Petition for AIA Trial Proceedings*

Samuel A. Raque

# Presenting Your Petition: Minimum Procedural and Substantive Considerations

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- AIA trial proceedings at the Board begin with the filing of a petition that lays out the petitioner's grounds and supporting evidence for the requested proceeding. Other requests for relief must be in the form of a motion. 37 C.F.R. § 42.20(a).
- This presentation introduces the various substantive and procedural considerations that must be taken into account when filing a petition.
- Why these considerations matter
  - Ensure timely filing
  - Establish theories of unpatentability

# Minimum Procedural Compliance to Obtain a Filing Date

- A complete Petition will:
  - Comply with pertinent content provisions of the rules (e.g., 37 CFR 42.104 for IPRs);
  - Have properly been served (37 CFR 42.105);
    - Proper service address and service prior to filing of the petition. 42.105(a)
      - correspondence address of record for the subject patent; or
      - any other address known to the petitioner as likely to effect service
  - Identify real parties in interest (§ 312(a)(2)); and
  - Be accompanied by appropriate fees (37 CFR 42.15).
- 35 USC 312(a); 37 CFR 42.106

# Content Requirements of the Petition – 42.104, .204

- A substantively complete Petition will include identification of the following:
  - Grounds for standing: Petitioner must certify the patent is eligible for IPR/PGR and that Petitioner is not barred or estopped from challenging patentability
  - Identification of challenge: statement of precise relief requested
    - (1) The challenged claims;
    - (2) The specific statutory grounds under 35 U.S.C. §§ 102 or 103 on which the challenge to each claim is based and the patents or printed publications relied upon for each ground;
    - (3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;
    - (4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon; and
    - (5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.
- 37 CFR 42.104

# Common Considerations in PTAB Petitions - Pitfalls to Avoid

# Use of Expert Testimony and Other Factual Data

- Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based. See Fed. R. Evid. 705; 37 C.F.R. § 42.65.
  - Opinions expressed without disclosing the underlying facts or data may be given little or no weight. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit unsupported assertions of an expert witness).
- In addition to providing the explanation required in 37 C.F.R. § 42.65, a party relying on a test or data should provide any other information the party believes would assist the Board in understanding the significance of the test or the data.

# Timing - Certification of Grounds for Standing

- No civil action challenging validity of patent filed before Petition filing: Petitioner or RPI cannot have already filed a civil action challenging the validity of a claim of the patent. E.g., filing a declaratory judgement action seeking invalidity of the patent. 35 USC § 315(a)(1).
  - Exceptions: This bar does not apply to counterclaims of invalidity asserted against the patent. § 315(a)(3). Similarly, the declaratory judgement action can be filed before filing if the action seeks only a judgement of noninfringement (*Ariosa Diagnostics v. Isis Innovation Ltd.*, No. IPR2012-00022, at 8 (P.T.A.B. Feb. 12, 2013), Paper No. 20) or can be filed after the filing of the IPR petition if alleging invalidity.
- One-year time bar
  - Where the patent owner has served a complaint alleging infringement, the accused infringer (or RPI or privy) has one year from being served to file a petition. § 315(b).
- Why this matters
  - Pay particular attention to the statutory requirements, because a petitioner may be allowed to correct the petition but will be accorded a filing date of the corrected petition. This may be critical if the petitioner files close to the one-year bar date.

# Identification of All Interested Parties

- Who wants review of the challenged patent?
- Part of mandatory notices that each party must provide that includes identification of the real parties-in-interest, related matters, lead and back-up counsel, and the service information introduced above. 37 CFR 42.8.
- Identification of the RPI is important to assist the Board in determining whether there are conflicts of interest and if any estoppel applies.
- The pitfall: This is a highly fact-dependent question, so proper judgement is required to avoid potential time bars
  - Handled by the Board on a case-by-case basis
    - *See, e.g., Taylor v. Sturgell*, 553 U.S. at 893–895, 893 n.6 (noting that “[t]he list that follows is meant only to provide a framework [for the decision], not to establish a definitive taxonomy”).
    - Examples of situations involving RPI or privy include a party that funds and directs and controls the AIA trial proceedings (i.e., complete control and funding. CTPG, 17; *see also Cal. Physicians*, 163 Cal.App.4th at 1523-25 (discussing the role of control in the “privy” analysis, and observing that “preclusion can apply even in the absence of such control”).
- Name at least those entities that would be subject to estoppel and preclusion principles.



# Improper Usage of Claim Charts

- Petitioner “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). A common way to present this information is through a claim chart.
  - A claim chart can utilize single spacing, presumably cutting down on the page count of the petition. 42.6(a)(2)(iii). However, take care to not abuse this format by inserting language as to how the challenged claims are to be construed and how they are unpatentable under the statutory grounds raised.
  - <https://www.uspto.gov/patents/ptab/ptab-e2e-frequently-asked-questions#heading-9>

# Explicitly Set Forth any Claim Constructions

- Failure to set forth claim construction of disputed or important claim terms expressly in a claim construction section. PTAB webpage of common errors found in petitions.
- Petitioner must include a statement identifying how a claim term is to be construed and support for that construction of any such term the Petitioner requires construction thereof
  - If a parallel proceeding also has a specific or identified claim construction, be sure to identify that for the Board's consideration. CTPG, 47 (citing 37 CFR 42.100(b) for IPR).
- After the Petition is filed, Petitioner can respond to new claim construction issues raised by the Patent Owner response but can't raise new claim construction issues in reply that were not previously presented.

# Questions?

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Samuel A. Raque

[SAR@iplawgroup.com](mailto:SAR@iplawgroup.com)

615-242-2400