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Trial Practice Guide
July 2019 update

Michael Tierney, Vice Chief Administrative Patent Judge

Tim Fink, Vice Chief Administrative Patent Judge

August 8, 2019

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Question/comment submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov

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- Conference calls with the Board
  - Parties should meet and confer to resolve any disputes prior to making a request for a conference call.
  - Use of a court reporter on conference calls with the Board

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- Additional discovery
  - *Garmin* factors
  - Examples of when additional discovery granted or denied

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- Live testimony
  - Clarifies when live testimony will be permitted and factors considered
    - *K-40 Elecs., LLC v. Escort, Inc.*, Case IPR2013-00203 (PTAB May 21, 2014) (Paper 34) (precedential)
    - *DePuy Synthes Prods., Inc. v. MEDIDEA, L.L.C.*, Case IPR2018-00315 (PTAB Jan. 23, 2019) (Paper 29) (precedential)

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- Claim construction
  - Use of *Phillips* standard in IPR, PGR, and CBM proceedings
  - The Board will consider any prior claim construction determination in a civil action or ITC proceeding if it is timely made of record before the Board.

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- Submission of testimonial evidence with a patent owner preliminary response
  - "[A] genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute [a review]." 37 C.F.R. §§ 42.108(c), 42.208(c).
  - If a trial is instituted, a patent owner may choose not to rely on testimony submitted with the preliminary response.

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- Considerations in instituting a review
  - *Valve Corp. v. Elec. Scripting Prods., Inc.*
    - Institution denied for petition filed by co-defendant and licensor of technology of accused products, after institution denied for earlier petition filed by HTC
    - "[A]pplication of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors."
    - IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (precedential)

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– *NHK Spring Co. Ltd. v. Intri-Plex Techs., Inc.*

- Institution denied under § 325(d)
- Jury trial scheduled to begin approx. 6 months before any FWD "an additional factor that weighs in favor of denying the Petition under § 314(a)."
- IPR would involve same references and arguments presented in district court
- District court proceeding was in advanced state having already issued a claim construction ruling
- IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (precedential)

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- Parallel petitions challenging the same patent
  - One petition should be sufficient to challenge a patent in most situations.
  - At times, more than one petition may be necessary, for example, when:
    - » a large number of claims have been asserted in litigation, or
    - » there are priority disputes requiring multiple prior art references.
  - Based on Board's prior experience, it is unlikely that three or more petitions for same patent will be appropriate.

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- If a petitioner files two or more petitions challenging the same patent, then the petitioner should, in it's petition or in a separate paper (no more than 5 pages):
  - » rank the petitions in the order in which it wishes the Board to consider the merits,
  - » explain the differences between the petitions and why the differences are material, and
  - » explain why the Board should exercise its discretion to institute additional petitions.
- Patent owner can respond in its preliminary response or in a separate paper (no more than 5 pages).

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- Content of decision on whether to institute
  - Incorporation of *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
  - Board retains discretion to deny institution under 35 U.S.C. §§ 314(a) and 325(d) even when a petition includes at least one claim that meets the criteria for institution
    - *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310 (PTAB Jan. 24, 2019) (Paper 7) (informative); *Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923 (PTAB Nov. 7, 2018) (Paper 9) (informative)

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- Motions to amend
  - Burdens under *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)
  - Board determines whether substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner.
    - *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, -01130 (PTAB Feb. 25, 2019) (Paper 15) (precedential)
  - Board may consider grounds of unpatentability other than § 102 and § 103 (such as § 101 and § 112) as to proposed substitute claims.
    - *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-00948 (PTAB Jan. 18, 2019) (Paper 34) (precedential)

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- Motions for joinder
  - Board has discretion under 35 U.S.C. § 315(c) to join a petitioner to a proceeding in which it is already a party and to allow joinder of new issues into an existing proceeding.
    - *Proppant Express Invs. v. Oren Techs.*, Case IPR2018-00914 (PTAB Mar. 13, 2019) (Paper 38) (precedential)
  - In proceedings in which one or more parties are joined, Board is permitted to adjust the one-year statutory deadline for issuing a final written decision.
    - 35 U.S.C. §§ 316(a)(11), 326(a)(11)
  - If the Board adjusts the one-year deadline, it will issue an order indicating the adjustment (prior to the expiration of the one-year deadline).

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- Remands
  - Incorporates the guidelines of Standard Operating Procedure 9
  - Board has a goal to issue decisions on cases remanded from the Federal Circuit within six months of the Board's receipt of the Federal Circuit's mandate.

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- Rehearing requests
  - "Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue 'good cause' exists for admitting the new evidence. Alternatively, a party may argue 'good cause' exists in the rehearing itself."
    - *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, Case IPR2018-00816, slip op. at 4 (PTAB Jan. 8, 2019) (Paper 19) (precedential)

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- Protective order guidelines
  - A protective order is not entered by default but must be proposed by one or more parties and must be approved and entered by the Board.
  - Provides procedures for parties to request modifications to the default protective order

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Thank you


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