

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Boardside Chat: AIA Motions Practice

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Agenda

- Rules and guidance
- Common motions



Rules and guidance

- a. General considerations
- b. Requesting authorization
- c. Burden of proof
- d. Content
- e. Page limits
- f. Timing

General considerations

- Rules 37 C.F.R. § 42.20–25
- Trial Practice Guide (www.uspto.gov/TrialPracticeGuideConsolidated)
- In addition to the merits, the Board may consider the following when deciding whether to authorize a motion or to grant the relief requested in an authorized motion:
 - Burden on parties
 - Efficient, effective resolution of issues
 - Documenting for due process and Administrative Procedure Act
 - Statutory deadlines
 - Effect on schedule

Requesting authorization

- Authorization obtained via conference call with panel
- Common procedure – requesting email:
 - Should copy all parties
 - Should indicate generally the relief requested or subject matter of the call
 - Should not include substantive argument or attachments (e.g., draft motions)
 - Should include multiple times when all parties are available
 - Should state any opposition and address the meet & confer requirement

Burden of proof for motions

- Burden of proof to establish entitlement to requested relief is on moving party: § 42.20(c)

Content of motions

- **Motion contents (filed as separate paper): § 42.22**
 - Statement of precise relief requested
 - Full statement of reasons for request, including detailed explanation of significance of evidence, material facts, and law
 - All showings required by rules
- **Oppositions and replies: § 42.23**
 - Comply with requirements for motions
 - Identify any disputed material facts (avoids unintentional admission)
 - Replies directed only to corresponding opposition

Page limits for motions

- Page limits
 - Motions - 15 pages: § 42.24(a)(1)(v)
 - Unless waiver granted in advance: 42.24(a)(2)
 - Oppositions - same number of pages as corresponding motion: § 42.24(b)(3)
 - Replies to motions - 5 pages: § 42.24(c)(2)
- Limits INCLUDE any statement of material facts to be admitted or denied: § 42.24(a)(1)
- Limits EXCLUDE table of contents, certificate of service, appendix of exhibits: § 42.24(a)(1)
- Board may set other page constraints, e.g., fewer pages set when granting authorization to file

Timing for filing motions

- Set in Scheduling Order
 - Patent owner motion to amend (and opposition/reply)
 - Revised motion to amend (if filed)
 - Motion(s) to exclude evidence (and opposition/reply)
- Opposition default – 1 month: § 42.25(a)(1)
 - Typically set much shorter
- Board can deny relief not promptly sought: § 42.25(b)

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LEAP

- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the Board
- To qualify, a patent agent or attorney must have:
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB, *and*
 - Seven or fewer years of experience as a licensed attorney or agent



Common motions

- a. Pro hac vice
- b. To submit supplemental information
- c. To join proceedings
- d. To seal
- e. To exclude
- f. For additional discovery
- g. To terminate

Pro hac vice motion: 37 C.F.R. § 42.10

- Authorized in Notice of Filing Date
 - No sooner than 21 days after service of petition (i.e., time for patent owner mandatory notices)
 - Oppose w/in 1 week; no reply to opposition, unless Board authorizes
 - Content requirements, *see* IPR2013-00639, Paper No. 7, Oct. 15, 2013
- Needed when attorney not registered to practice at USPTO
- Eligible only as back-up counsel
- May not withdraw without Board authorization



Pro hac vice motion: 37 C.F.R. § 42.10

- Motion must show that:
 - Counsel has sufficient legal and technical qualifications
 - Counsel has an established familiarity with the subject matter at issue in proceeding
 - Party intends to be represented by attorney
- Motion must be accompanied by affidavit of counsel seeking *pro hac vice* admission
 - Required affidavit contents (8 items),
see IPR2013-00639, Paper 7, Oct. 15, 2013

Supplemental information versus supplemental evidence

- “Supplemental information” is different than “supplemental evidence” in connection with 37 C.F.R. § 42.64(b)(2). Only supplemental information requires an authorized motion. 37 C.F.R. § 42.123.
- “[S]upplemental evidence—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental information, on the other hand, is evidence a party intends to support an argument on the merits. Such evidence may only be filed if a § 123 motion is both authorized and granted.” *Handi Quilter, Inc. v. Bernina Int’l AG*, IPR2013-00364, Paper 30 at 2-3 (PTAB June 12, 2014)
- *See, e.g.*, CBM2013-00033, Paper 29 (distinguishing admissibility vs sufficiency)

Motion to submit supplemental information: 37 C.F.R. §§ 42.123, 223

- Criteria (authorization to file is required)
 - Within 1 month of instituting trial
 - Relevance to a claim on which trial instituted (not the grounds)
 - If more than 1 month, must show: (1) why the information could not reasonably have been obtained earlier; and (2) why in the interests of justice

Motion to submit supplemental information: 37 C.F.R. §§ 42.123, 223

- Not automatic, even if criteria met; Board considers efficient administration and completing IPR on time
- Motion to submit should not include the exhibit itself – exhibit submitted only if motion is granted

Motion for joinder: 37 C.F.R. §§ 42.122, 222

- No later than 1 month after institution date
- Request for authorization to file motion is not required
- Board considers impact on schedule/efficiency
 - Can Board avoid major changes to scheduling order?

Motion for joinder: 37 C.F.R. §§ 42.122, 222

- Motion for joinder should:
 - Provide reasons why joinder is appropriate
 - Explain what impact (if any) joinder would have on schedule and costs of existing proceeding
 - Address how briefing and/or discovery can be simplified
 - Consolidated filings; limit separate filings to joined party's points of disagreement with consolidated filing (page limit)
 - Consolidated depositions – no extension of allotted time unless requested and authorized first

Motion to seal: 37 C.F.R. §§ 42.14, 54

- Confidential information only – public policy to make all information available
- Standard = good cause
- Motion must include:
 - Proposed protective order (if one has not already been entered) – Board’s default protective order is NOT automatically entered (entry must be requested) – show differences from Board’s default order
 - Certification that moving party attempted/conferred in good faith with opposing party on scope of order
 - Explanation of why info is confidential

Motion to seal: 37 C.F.R. §§ 42.14, 54

- Production of same information in district court as confidential alone is not good cause, but provides context
- Information likely not confidential if previously available publicly (particularly if still available)
- Irrelevant personal information more likely confidential – consider redactions, e.g., account number on a check
- Move to expunge confidential information after final judgment, if appropriate: 37 C.F.R. § 42.56

Motion to exclude

- Federal Rules of Evidence generally apply to proceedings: § 42.62
- Objections prior to institution typically are premature
 - Addressed during trial (e.g., lack of authentication)
- **Objections required**
 - Objections to be filed w/in 10 business days of institution of trial to evidence submitted during preliminary phase: § 42.64(b)(1)
 - During trial – file objection within 5 business days of service: § 42.64(b)(1)
 - Respond by serving supplemental evidence w/10 business days of objection: § 42.64(b)(2)
 - Objections themselves are not motions to exclude
 - Motion to exclude required to preserve objection: § 42.64(c) – due date in Scheduling Order
 - Identify grounds with sufficient particularity to allow correction with supplemental evidence, e.g., authentication by testimony
- **If party objects after supplementation, party moves to exclude**

Motion to exclude

- Contents of motion to exclude
 - Identify each objection in the record and where evidence sought to be excluded was relied upon
 - Explain each objection (may be exhibits to motion) - explain why info/evidence is not admissible
- Motion to exclude is NOT a substantive sur-reply
- Motion to exclude is NOT a vehicle to challenge sufficiency of evidence to prove a fact
- Motion to exclude is NOT a vehicle to argue whether a reply or supporting evidence is of appropriate scope: *Conopco, Inc. v. Procter & Gamble Co.*, IPR2013-00505, Paper 69 at 29 (PTAB Feb. 10, 2015)

Motions for additional discovery: 37 C.F.R. § 42.51

- Authorization to file required
- Consideration is case specific
- Parties may agree to additional discovery between themselves

Motions for additional discovery: 37 C.F.R. § 42.51

- Content of motion
 - Address *Garmin* factors concerning whether additional discovery is in interests of justice, see IPR2012-00001, Paper 26 for IPR
 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
 - See also, *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005, Paper 32 for CBM and PGR (good cause)

Motion to terminate: 37 C.F.R. §§ 42.72–42.74

- Termination: § 42.72
 - Of a party – Board may proceed to final written decision (even if no petitioner remains)
 - Of the proceeding – Board enters judgment; terminates proceeding
- A party may request adverse judgment: § 42.73(b)
 - Disclaimer of patent, claim cancellation, concession of unpatentability, and abandonment of contest may be construed as such a request
- Settlement: § 42.74
 - Parties can settle any issue via joint request: 35 U.S.C. § 317(a), § 327(a)
 - All agreements/understandings in writing & filed with Board; no side agreements (panel may require parties to represent that no side agreements exist in the motion): 35 U.S.C. § 317(b), § 327(b)
 - May be treated as business confidential – request to keep separate
 - Board not a party to the settlement

Motion to terminate: 35 U.S.C. § 315(e)(1)

- Section 315(e)(1) provides:

(e) Estoppel. —

(1) Proceedings before the office.—The petitioner in an inter partes review of a claim . . . that results in a final written decision . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 315(e)(1); *see* 37 C.F.R. § 42.73(d).

- Termination

– Of a second proceeding – Board enters judgment in a first proceeding and terminates a second proceeding (no joinder) having a ground that *reasonably* could have been raised in first proceeding.

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Fast-Track Appeals Pilot Program

- One-year pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Last month's Boardside Chat (February 18, 2021) provides additional information, including statistics:
 - Available at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/appeals/learn-about-recent-developments-ex-parte-appeals>



Next Boardside Chat

- April 22, 2021, at 12-1 pm ET
- Remote Hearings
 - PTAB procedure for video and telephonic hearings
 - Recommendations for practitioners
 - Applicable to AIA proceedings and ex parte appeals



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Appendix

Common motions

| Motion | Authorization Req'd | 37 CFR § | Consolidated Trial Practice Guide page |
|--|--------------------------------|-----------------|--|
| Pro Hac Vice | Yes – in Notice of Filing Date | 42.10 | 11 |
| Motion Filed with Petition, e.g. waive page limits | No | 42.20 | 37-38 |
| To Seal | No | 42.14; 42.54-55 | 19 |
| For Joinder | Yes | 42.122; 42.222 | 76 |
| For Additional Discovery | Yes | 42.51 | 4, 6-7, 22-34, 92, 100 |
| To Exclude Evidence | No (Due Dates 5 & 6) | 42.64 | 37, 75, 78-80 |
| Request For Rehearing | No | 42.71(d) | 90 |

More common motions

| Motion | Authorization Req'd. | 37 CFR § | Trial Practice Guide-Fed. Reg. |
|---------------------------|-------------------------|----------------|--------------------------------|
| To File Supplemental Info | Yes | 42.123; 42.223 | 75-76 |
| PO Sur-reply | No (Due Dates 4 & 5) | | 7-8, 73-74 |
| To Expunge | Yes | 42.56 | 20-22, 92, 100 |
| To Terminate | Yes | 42.72; 42.73 | 4, 53, 86 |
| To Strike | Yes | | 80 |

