

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Patent Trial and Appeal Board Inventor Hour: Episode 12

Janet Gongola, Vice Chief Administrative Patent Judge

Tawen Chang, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

Lynne Browne, Administrative Patent Judge

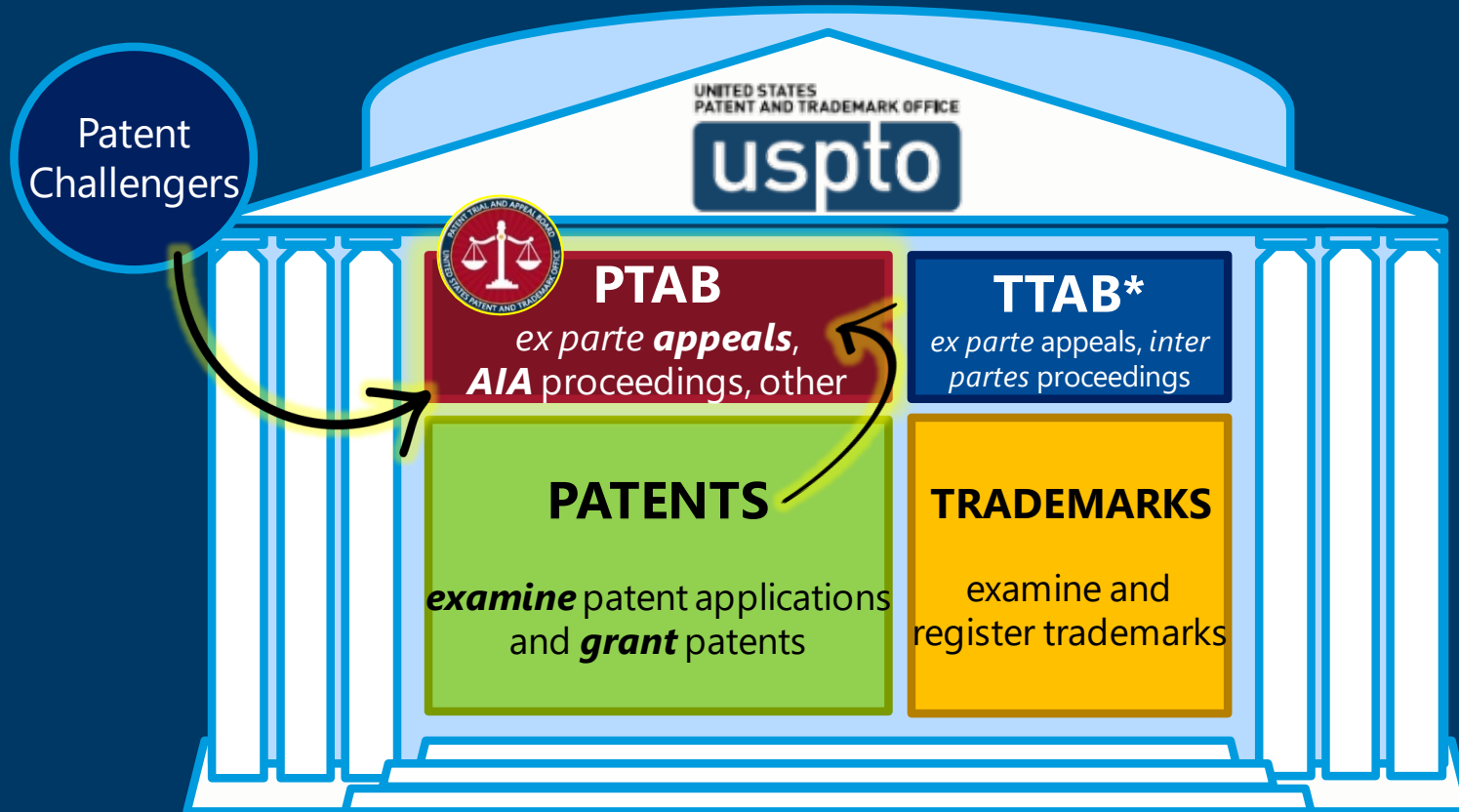
Carmine Denisco, Inventor, United Inventors Association

September 22, 2022



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# What is the Patent Trial and Appeal Board?



# Today's agenda

1

**Meet an  
inventor**

2

**Appeal byte:  
Arguments**

3

**Trial byte:  
Discovery**

4

**Q&A**

# Question/comment submission

To send in questions or comments about the presentation, please email:

- [PTABInventorHour@uspto.gov](mailto:PTABInventorHour@uspto.gov)

Lynne Browne, Administrative Patent Judge



**Meet an inventor:**

**Carmine Denisco, United Inventors Association**



**Carmine Denisco**



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# Journeys of Innovation



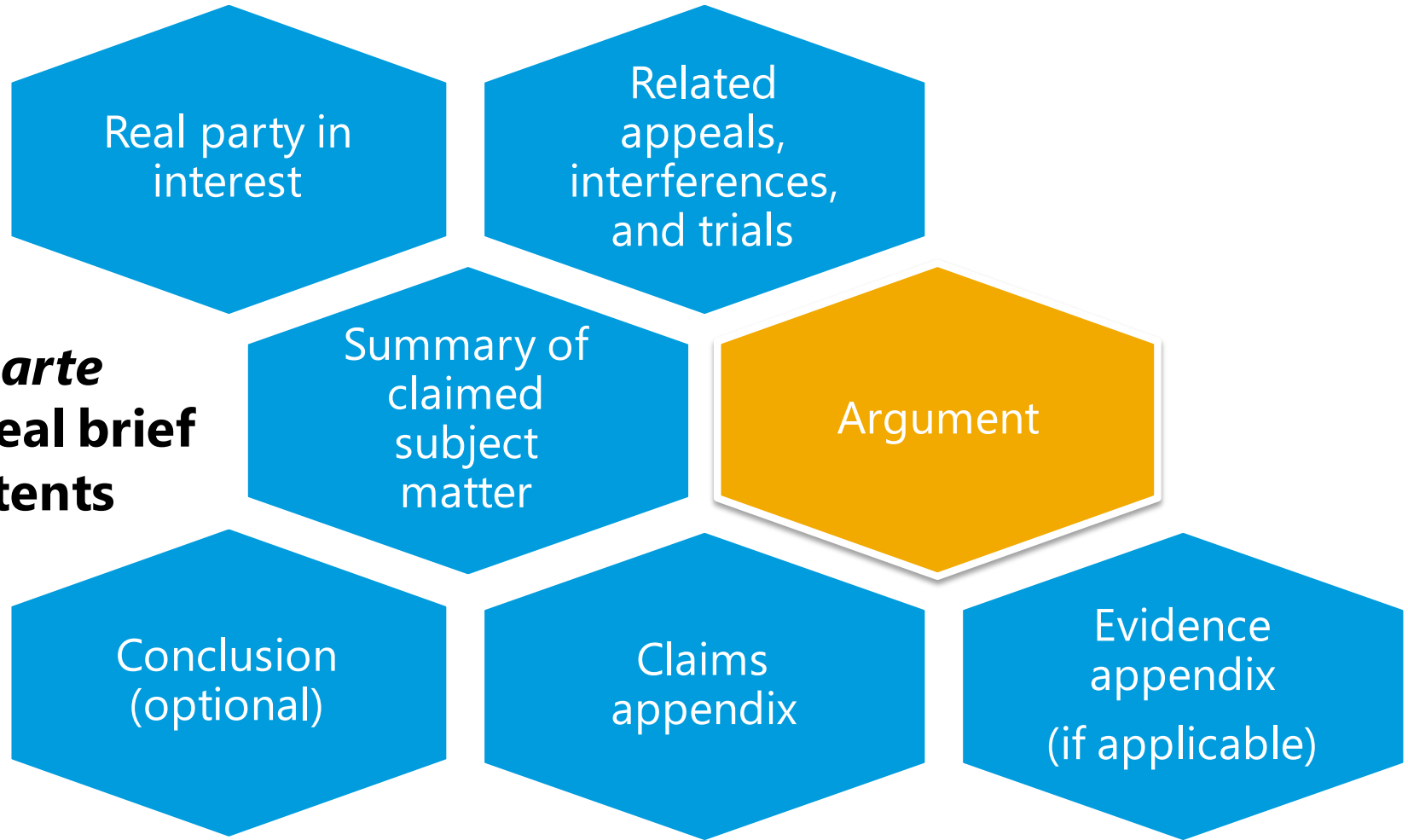
- Relatable stories that chronicle the journeys of inventors and entrepreneurs
  - E.g., Jim Henson, Martine Rothblatt, Shawn Springs, Temple Grandin
- Meet USPTO featured innovators
  - Learn how they got their start, challenges they faced, and what it took to bring their ideas to fruition
  - Learn about the importance of creating and protecting intellectual property
- A new story each month:  
<https://www.uspto.gov/learning-and-resources/journeys-innovation>

Tawen Chang, Administrative Patent Judge



# **Appeal byte:** **Crafting the argument section**

***Ex parte*  
appeal brief  
contents**



# Agenda



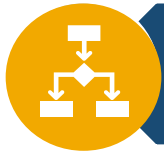
Preliminary steps



Strategic considerations



Effective arguments



Organization tips

# Preliminary steps

Review the record

Decide rejections  
& claims to  
address

Identify strongest  
arguments

# Strategic considerations

- Clarity and conciseness ↑ chances of prevailing
- Weaker arguments may dilute impact of strongest arguments
- Cost

- Summary affirmance of rejections not substantively contested
- Waiver of arguments not timely made

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# Strategic considerations:

## Deciding which rejections and claims to address

### REJECTIONS

- Applied to many/important claims?
- Similar arguments for multiple rejections?
- Can be obviated (without losing desired coverage)?

### CLAIMS

- Independent claims?
- Separately applicable arguments (e.g., unexpected results)?
- Commercial importance?

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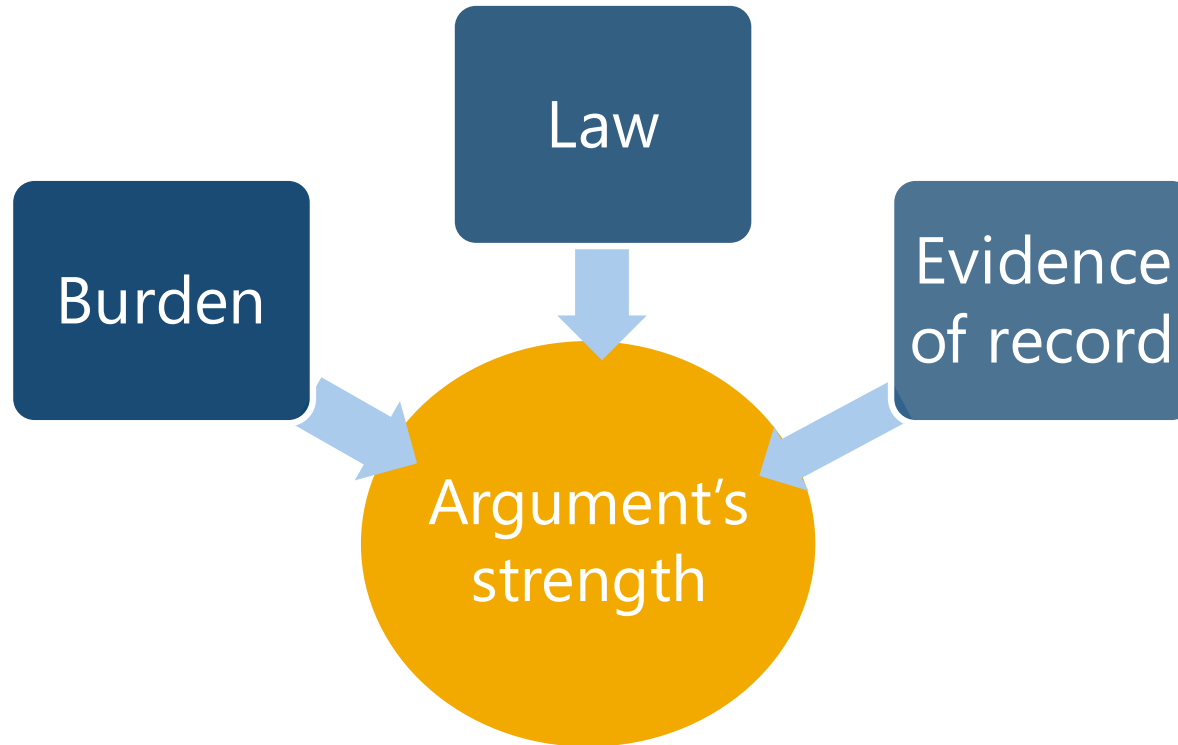
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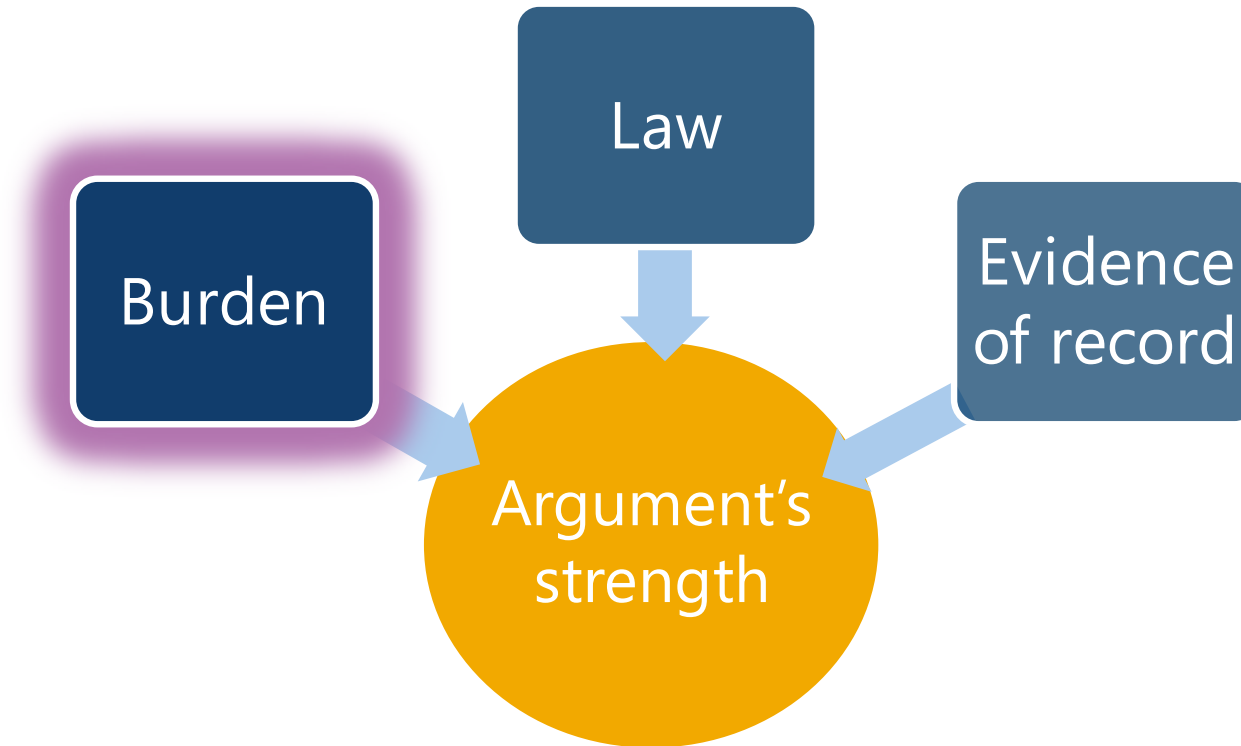
### CLAIMS

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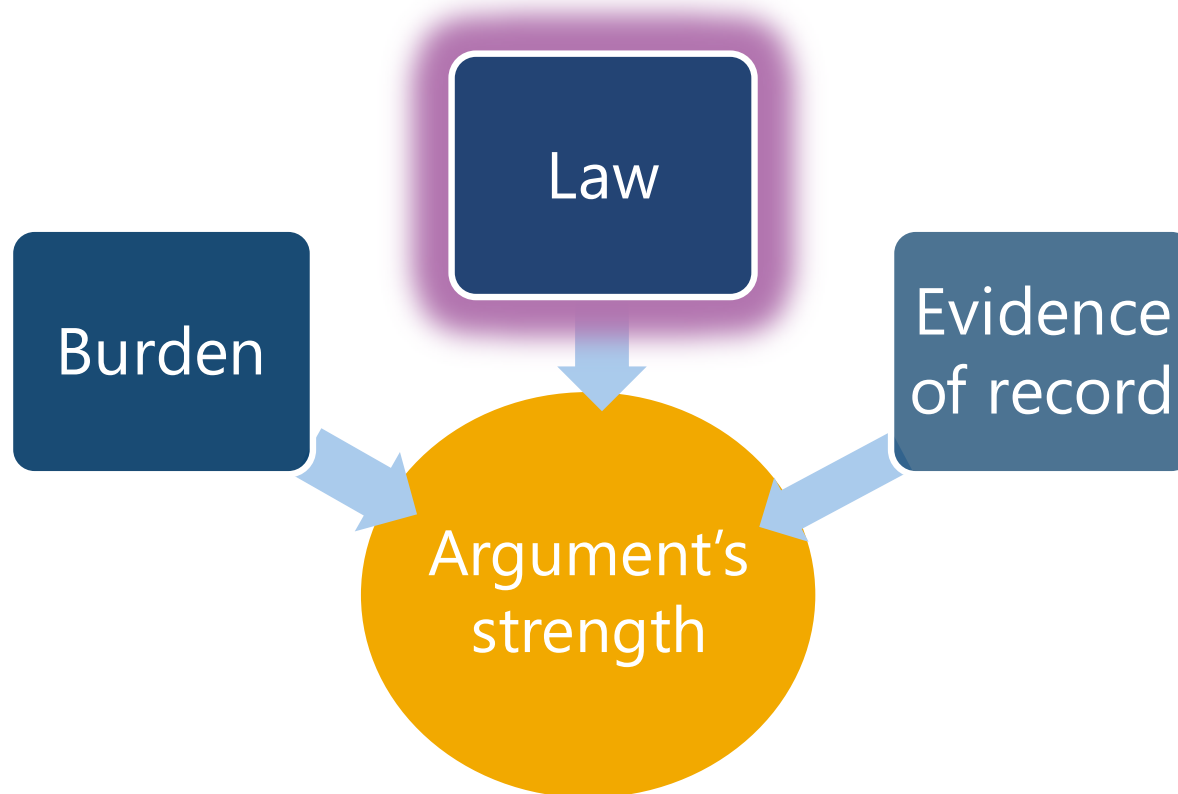
# Strategic considerations: Identify strongest arguments



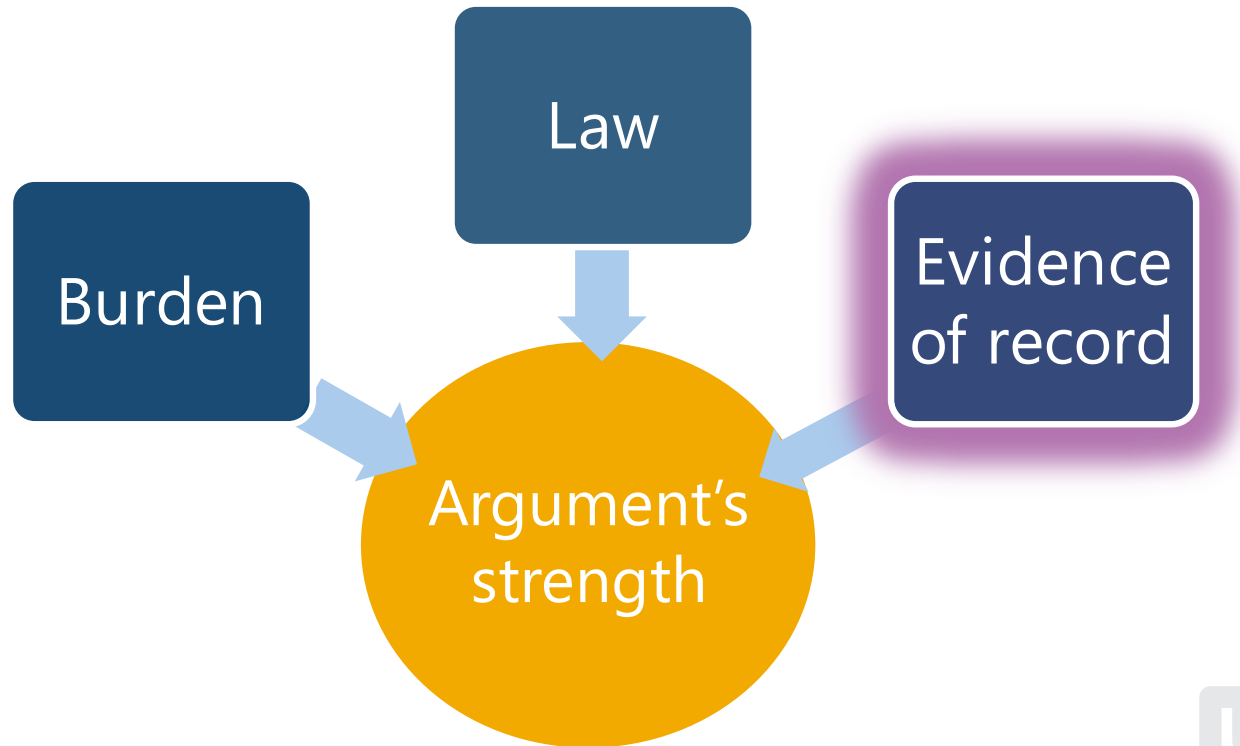
# Strategic considerations: Identify strongest arguments



# Strategic considerations: Identify strongest arguments



# Strategic considerations: Identify strongest arguments



# Effective arguments

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Do

Focus on the claimed invention

\* broadest reasonable interpretation in view of the Specification

---

Explain the arguments (i.e., because....)

---

Cite to evidence in the record (e.g., prior art references, data in the Specification, declarations)

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# Effective arguments

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## Don't

Include issues not appealable to the Board

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Make arguments not relevant under the legal standard for a particular rejection

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Rely on attorney arguments or conclusory statements for issues of fact

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# Organization tips

## REJECTIONS

- Separate heading
- Identify claim numbers, statutory basis, references (if any)

## CLAIMS

- Group claims where possible
- Separate heading or subheading for claims you wish to be considered separately

# Question/comment submission

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# USPTO YouTube Channel



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  - USPTO's Invention-Con
  - Tips for registering a trademark
  - Science of Innovation series for kids and teachers
  - Careers at USPTO
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- <https://www.youtube.com/user/USPTOvideo/>



Eric C. Jeschke, Administrative Patent Judge



# **Trial byte:**

## **Discovery in AIA proceedings**

# The *what?* and *why?* of discovery

- What?

- The method by which parties request documents and information from the opposing side to build their case
  - Answers to specific questions (interrogatories)
  - Documents
  - Witness testimony (e.g., experts)

- Why?

- Allows full development of the facts to promote settlement and prevent trial by “ambush”
- Opposing side will have information that may help your arguments that you cannot get elsewhere

# Consolidated Trial Practice Guide

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Home > About Us > News & Updates > Consolidated Trial Practice Guide, November 2019

## Consolidated Trial Practice Guide, November 2019

November 20, 2019

In November 2019, the United States Patent and Trademark Office published a second edition of the America Invents Act (AIA) Trial Practice Guide (Practice Guide) to incorporate the Practice Guide updates released in August 2018 and July 2019 into the original August 2012 Practice Guide. The second edition consolidates all updates of the Practice Guide into a single document. This second edition also includes additional revisions for greater consistency across all sections of the newly consolidated guide.

### Updated guidance included in the November 2019 edition

- Institution of trial after *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
- Use of sur-replies in lieu of observations
- How parties may contact the Board to request an initial conference call
- Use of word counts
- Updates to the sample scheduling order for derivation proceedings
- Updates to the default protective order

### Trial Practice Guide resources and updates

- [Consolidated Trial Practice Guide November 2019](https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019)
- [Trial Practice Guide July 2019 update](#)
- [Trial Practice Guide August 2018 update](#)
- [Trial Practice Guide August 2012](#)

<https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>

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# Consolidated Trial Practice Guide



Patent Trial and Appeal Board  
Consolidated Trial Practice Guide  
November 2019

**I.F.1** – Routine Discovery

**I.F.2** – Additional Discovery

**I.F.3** – Compelled Testimony

**I.F.4** – Mandatory Initial Disclosures

**I.F.5** – Live Testimony

**I.F.6** – Times and Locations for  
Witness Cross-Examination

**I.F.7** – E-Discovery

Appendix C – Model Order Regarding E-Discovery

Appendix D – Testimony Guidelines





# Most common discovery in AIA trials

- Mandatory initial disclosures
- Routine discovery
  - Cited exhibits
  - Cross-examination of witnesses
  - Inconsistent information
- Additional discovery
- Cross-examination of witnesses

# Mandatory initial disclosures

## 37 C.F.R. § 42.51(a)

- The parties may agree to provide certain information up front
  - Parties may also agree to provide more extensive information
- If no agreement is reached, the parties may file a motion requesting the Board to compel such information.
- The parties may automatically take discovery of the information identified in the initial disclosures once trial is instituted.



# Routine discovery

## 37 C.F.R. § 42.51(b)(1)

- Board authorization isn't required
- Presenting party bears burden and expense of producing witnesses
- Discoverable information includes:
  - exhibits cited in paper or testimony
  - cross-examination for submitted testimony, and
  - information inconsistent with the positions advanced during the proceeding

# Additional discovery

- 37 C.F.R. § 42.51(b)(2), the parties may seek “additional discovery”
  - Requires Board authorization unless mutually agreed upon by the parties
- Separate standards apply for parties seeking additional discovery in inter parties reviews (IPR) vs. post grant review (PGR)
  - Motions will only be granted in an IPR if the requesting party establishes that it is “in the interest of justice” (§ 42.51(b)(2)(i))
  - Motions may be granted in PGRs if the requesting party demonstrates “good cause” (§ 42.224)
  - The good cause standard is **slightly more liberal** than the interests of justice standard

# Additional discovery

- **Five factors under “interests of justice”**
  - 1) Whether the request is **more than a hunch**
    - Mere allegations and the possibility of finding something are not enough
  - 2) Whether the request aims to reveal the opposing party’s **litigation position**
    - This information, e.g. invalidity contentions, will be provided per the scheduling order and not under the guise of “discovery”
  - 3) Whether the requesting party can obtain the information using **other (reasonable) means**

# Additional discovery

- **Five factors under “interests of justice” cont’d**
  - 4) Whether the request is easy to **understand**
  - 5) Whether the request is overly **burdensome**
    - E.g., will the request impose a financial burden, burden on human resources, or burden on meeting the time schedule
- Requests for **specific documents** with a sufficient showing of relevance are more likely to be granted, whereas requests for general classes of documents are typically denied

# Document production

- Documents/ information should be produced in the United States. § 42.51(c)
- Cited exhibits must be served with any papers or testimony cited in the exhibits. § 42.51(b)(1)(i)
- Parties must identify in advance documents relied upon for direct deposition testimony. § 42.53(d)(3)

# Discovery disputes

- In our Scheduling Orders, we encourage parties to resolve disputes relating to discovery on their own.
- The parties must attempt to resolve such any disputes before contacting the Board.
- If the parties are unable to resolve their dispute, a party may request a conference call with the Board.



# Depositions

- Uncompelled direct testimony at the Board is almost always presented by affidavit or declaration
- Other testimony is typically through oral examination with video
- § 42.53 relates to Taking Testimony
- Guidelines for obtaining oral testimony are provided in Appendix D of the Trial Practice Guide, including:
  - How to conduct examination and cross-examination outside presence of the Board
  - Examples of proper and improper objections
  - Guidance on how to preserve privilege and counsel-witness communication

# Question/comment submission

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Questions?

# Future programs

## Inventor Hour, Episode 13

Thursday, Oct. 27, at noon ET



