Practice before the Patent Trial and Appeals Board
Part Two

Practicing Law Institute
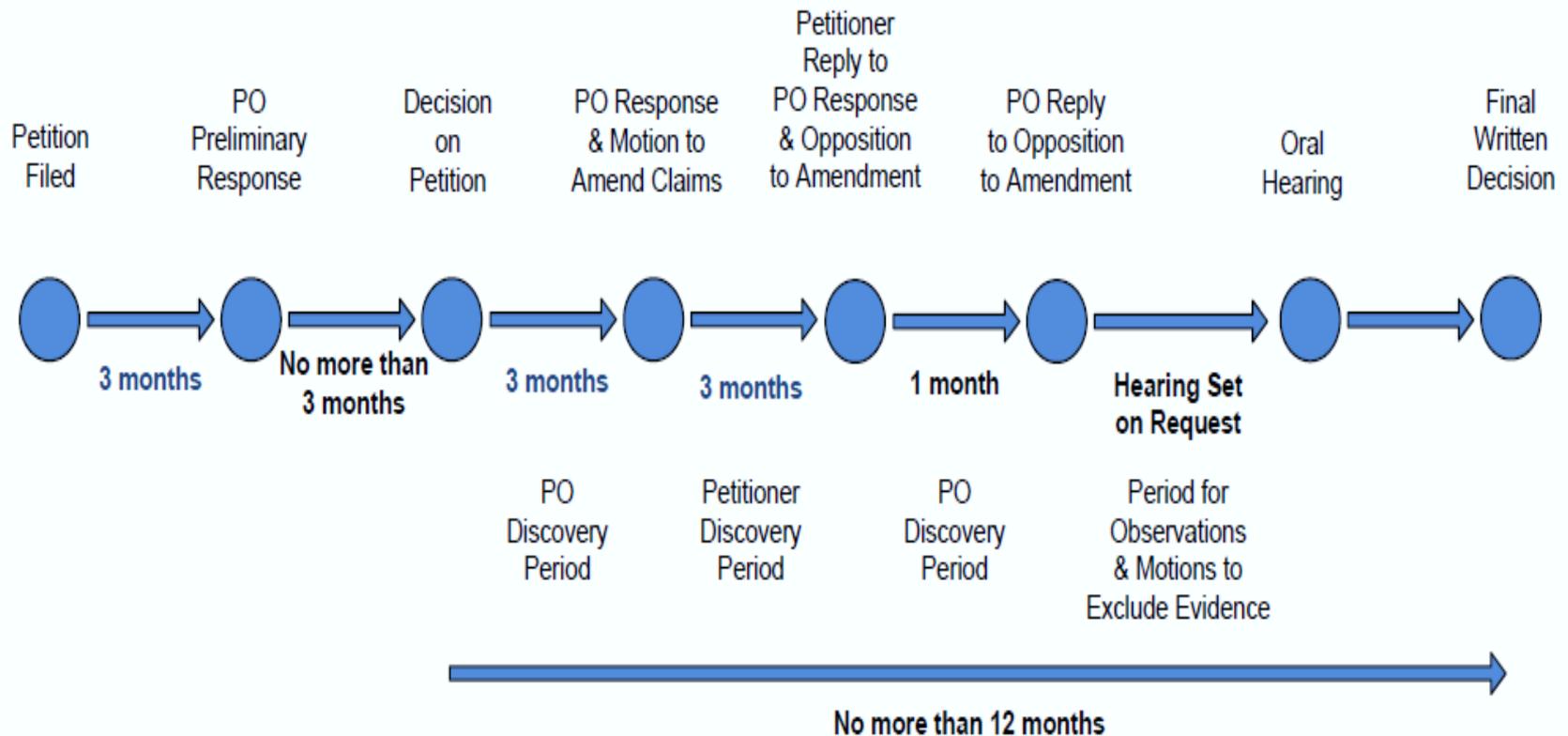### October 3, 2012

Michael P. Tierney

Lead Administrative Patent Judge

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Trial Proceedings

PO = Patent Owner

Scheduling Order

- The Board will enter a Scheduling Order concurrent with the decision to institute a trial

- The Scheduling Order will set due dates for the trial taking into account the complexity of the proceeding but ensuring that the trial is completed within one year of institution

Initial Conference Call

- An initial conference call will be conducted within about one month from the date of institution of the trial to discuss:

  - the Scheduling Order and

  - any motions that the parties anticipate filing during the trial

- A list of proposed motions should be filed no later than two business days prior to the conference call

Umbrella Rules: Discovery

- AIA authorizes the Office to set standards and procedures for the taking of discovery

- Discovery rules allow parties to agree to discovery between themselves

- Final rules provide for:

  ➢mandatory initial disclosures;

  ➢routine discovery; and

  ➢additional discovery

Protective Orders

- The parties are encouraged to agree on the entry of a stipulated protective order

    – Absent such agreement, the default standing protective order will be automatically entered

- The protective order take effect upon the filing of a Motion to Seal by a party and remain in place until lifted or modified by the Board

- The Board has the authority to enforce the terms of the Protective Order, to provide remedies for its breach, and to impose sanctions

Depositions

- Taking testimony - § 42.53

- Testimony guidelines - Practice Guide, Appendix D

- Compelling testimony and production - § 42.52(a)

  – A party seeking to compel testimony or production of documents or things must file a motion for authorization

- Coaching and objections

Thank You

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