

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:
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Agenda

- General rules for motions
- Types of motions
- Audience Q&A

General rules for motions

General rules - 37 C.F.R. § 42.20-25

- Need to meet and confer before contacting the Patent Trial and Appeal Board (Board). See Consolidated Trial Practice Guide (“CTPG”) p. 37
- Prior Board authorization required for motion. § 42.20(b), CTPG p. 37
- Exceptions for **required** authorization:
 - I. Impractical, such as:
 - Motions to seal
 - Motion filed with petition, e.g., waive word count or page limits
 - II. Automatically authorized, such as:
 - Request for rehearing
 - Patent Owner (PO) sur-reply per CTPG, p. 74 – replaced observations on cross examination
 - Motion to exclude evidence (set forth in Scheduling Order)



Which motions require authorization?

Motion	Prior Authorization Required	37 C.F.R. §	Consolidated Trial Practice Guide page
To submit supplemental information	Yes	42.123; 42.223	75-76
For joinder	No if timely	42.122; 42.222	76-78
To seal	No	42.14; 42.54-55	19
To exclude evidence	No (Due Dates 5 and 6)	42.64	37, 75, 78-80
To compel	Yes	42.52	29

Which motions require authorization?

Motion	Prior Authorization Required	37 C.F.R. §	Consolidated Trial Practice Guide page
To expunge confidential information	Yes	42.56	20-22, 92, 100
Motion filed with petition, e.g., waive word count or page limits	No	42.20	37-38
For additional discovery	Yes	42.51	4, 6-7, 22-34, 92, 100
To terminate	Yes	42.72	4, 86
For pro hac vice	Yes – in Notice of Filing Date Accorded	42.10	11

Burden of proof - 37 C.F.R. §§ 42.20-21

- Burden of proof to establish entitlement to requested relief is on moving party.
- Notice of basis for relief
 - Board may require party to file and set times
 - Must state relief requested and basis for entitlement
 - Must provide sufficient detail to put Board and opponents on notice of precise relief requested
 - Party limited to filing motions consistent with notice

Content of motions - 37 C.F.R. §§ 42.22-23

- Motion contents (separate paper)
 - Statement of precise relief requested
 - Full statement of reasons for request; detailed explanation of significance of evidence, material facts, law; showings required by rules
- **Oppositions and Replies**
 - Comply with requirements for motion
 - Identify any disputed material facts, else admitted
 - Replies directed only to corresponding opposition

Page limits of motions - 37 C.F.R. § 42.24

- Motions (excluding Motion to Amend (MTA)) - 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 oppositions (excluding MTA) - 5 pages. § 42.24 (c)(2)
- 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

Time for filing motions – 37 C.F.R. § 42.25

- Pro hac vice – typically authorized in notice of filing date accorded
 - No sooner than 21 days after service of petition; (i.e., time for PO mandatory notices)
 - Oppose w/in 1 week; no reply to opposition, unless Board authorizes
- Content and procedural requirements, *See IPR2013-00639, Paper No. 7, Oct. 15, 2013 Set in scheduling order*
 - PO motion to amend (Due Date 1), Petitioner (Pet.) opposition (Due Date 2) and PO reply or revised motion to amend (Due Date 3)
 - PO sur-reply (Due Date 3)
 - Motion to exclude evidence (Due Date 5), opposition to motion to exclude (Due Date 6) and reply (Due Date 7)

Time for filing motions – 37 C.F.R. § 42.25 (cont.)

- Set during conference or in response to email
- Conference with the Board seeking authorization; can decide procedural matters during call or shortly thereafter without additional briefing
- Board can deny relief not promptly sought. § 42.25(b)
- Opposition default = 1 month, § 42.25(a)(1) – typically set much shorter (as set by the Board)

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De-designation of decisions



- PTAB now allows parties to request de-designation of precedential or informative decisions via a revised online form
- Visit the PTAB decision nomination webpage and select option to request a de-designation (under “Type of nomination” drop-down menu)
- Requests may be submitted anonymously
- www.uspto.gov/patents/ptab/ptab-decision-nomination



Types of motion

Motion to submit supplemental information - 37 C.F.R. §§ 42.123, 42.223 IPR2013-00139, Paper 27; IPR2013-00106, Papers 24, 36

- **Criteria (authorization to file is required)**
 - Within 1 month of instituting trial, or
 - If more than 1 month must show: (1) why the information could not reasonably have been obtained earlier; and (2) consideration of the information would be in the interests-of-justice.
 - Relevance to a claim on which trial instituted (not the grounds)
- **Burden of proof on party filing motion to establish entitlement to relief**
- **Not automatic, even if criteria met; Board considers efficient administration and completing a trial on time**



Motion to submit supplemental information - 37 C.F.R. §§ 42.123, 42.223 IPR2013-00139, Paper 27; IPR2013-00106, Papers 24, 36

- Motion to submit should not include the evidence itself – evidence submitted only if motion is granted after filing and opposition.
- Address why information reasonably could not have been submitted sooner
 - Avoiding cost of petitioner expert until after grounds instituted, not good reason
 - Late submission could raise due process concern

Motion to submit supplemental information - 37 C.F.R. §§ 123, 223 IPR2013-00139, Paper 27; IPR2013-00106, Papers 24, 36

- “Supplemental Information” is different from “supplemental evidence” in connection with 37 C.F.R. § 42.64(b)(2).
- **Supplemental 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 motion is both authorized and granted.
- *Handi Quilter, Inc. and Tacony Corp. v. Bernina International AG*, IPR2013-00364, slip op. at 2-3 (PTAB June 12, 2014) (Paper 30).



Motion for joinder - 37 C.F.R. §§ 42.122, 42.222

- Not later than 1 month after institution date
 - Me-too joinder to an existing petition
- Board considers impact on schedule/efficiency
 - Can Board avoid major changes to scheduling order?
- Factors to be addressed in motion
 - Reason why joinder is appropriate
 - State how the impact of joinder on schedule and costs of proceeding would be minimized

Motion to seal – 37 C.F.R. §§ 42.14, 42.54

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

Motion to seal – 37 C.F.R. §§ 42.14, 42.54

- Production of same information in the parallel litigation as confidential alone is not good cause
- Personal information is more likely confidential – consider redactions, e.g., residential address
- Motion to expunge confidential information after denial of petition or final judgment. 37 C.F.R. § 42.56
- Remember to also file a public version of the paper being filed under seal; do not redact more than necessary

Protective order

- A protective order is not entered by default, but must be proposed by one or more parties and approved and entered by the Board
- A protective order should be filed before or with a motion to seal
- A default protective order can be found in Appendix B of the CTPG. Parties can vary the default protective order
- If the protective order is not granted, the party submitting the confidential info will have the opportunity to have the submitted info expunged from the record
- Board has authority to enforce terms of protective order, including by providing remedies for breach and sanctions

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Status of Director Review webpage



- To provide a better user experience, we have updated our Status of Director Review requests webpage
- Director Review decisions are organized by subject matter
- More convenient access to recent actions and cases
- www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests

Motion to exclude – 37 C.F.R. § 42.64

- 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 within 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 within 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

Motion to exclude – 37 C.F.R. § 42.64

- Contents of motion to exclude (is not a motion to strike)
 - 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
 - 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 – 37 C.F.R. § 42.64

- Motion to exclude is NOT a substantive sur-reply
- Motion to exclude is NOT a vehicle challenging sufficiency of evidence to prove material fact
- Motion to exclude is NOT a vehicle for arguing whether a reply or supporting evidence is of appropriate scope.
(*Conopco, Inc. v. Proctor and Gamble Co.*, IPR2013-00505, slip op. at 29 (PTAB Feb. 10, 2015) (Paper 69))

Motions to compel testimony and production – 37 C.F.R. § 42.52

- Authorization to file required
- Compelling discovery is case specific
 - Encourage parties to work it out
 - Consider time/efficiency
 - Avoid fishing expedition – must be tailored discovery
- Content of Motion
 - Identify witness by name and title, and/or general nature of document or thing sought
 - Describe relevance of testimony, document, or thing
 - Address *Garmin* factors (IPR2012-00001, Paper 26) concerning whether additional discovery is in interest of justice
 - Requests should be responsibly tailored and sensible
 - Genuine need for the information in this proceeding

Motion to limit deposition testimony

- During deposition, counsel seeks to limit witness testimony by refusing to allow witness to answer questions. *See* 37 C.F.R. § 42.53(d)(5)(ii) (“For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.”)
- “Counsel may instruct a witness not to answer *only* when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or *to present a motion to terminate or limit the testimony.*” CTPG 129 (emphasis added)
- Options are “either (1) object on the record and proceed with the examination, subject to the objection, or (2) contact the Board immediately (not the day after) to present a motion to terminate or limit the testimony.” IPR2013-00358, Paper 37 (limiting cross-examination questions to experience and education stated generally in declaration.)

Motion to petition for certificate of correction

- Patent Owner realizes there is an error in patent, e.g., incorrect inventorship, typographical or clerical mistake in claim language
- Process to move for a certificate of correction requires Patent Owner to (1) seek authorization from the Board to file a motion, 37 C.F.R. § 42.20(b); (2) if authorization is granted, file a motion with the Board, asking the Board to cede its exclusive jurisdiction so that the patentee can seek a certificate of correction from the Director, 37 C.F.R. § 1.323; MPEP § 1485; and (3) if the motion is granted, petition the Director for a certificate of correction under 35 U.S.C. § 255. *See, e.g., Plastic Dev. Grp., LLC v. Maxchief Investments, Ltd.*, IPR2017-00846, slip op. at 2 (PTAB Nov. 13, 2017) (Paper 16)."
- Board must articulate "if [Patent Owner] had demonstrated a 'sufficient basis' that the mistake 'may' be correctable. *See Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019)."

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

- Request for adverse judgment
 - Disclaimer, claim cancellation, concession of unpatentability, abandonment of contest
- Settlement
 - Joint request. 35 U.S.C. §§ 317(a), §327(a)
 - All agreements/understandings must be in writing and filed with Board
 - May be business confidential – request to keep separate
 - Board not a party to the settlement
- Termination
 - Of a party – Board may proceed to final written decision (even if no petitioner remains)
 - Of the proceeding – Board enters judgment; terminates proceeding

***Pro hac vice* motion – 37 C.F.R. § 42.10**

- Attorney not registered to practice at USPTO
- May not be lead counsel; can be back-up counsel
- May not withdraw without Board's authorization
- Motion must show that:
 - Counsel is an experienced litigating attorney
 - Counsel has an established familiarity with the subject matter at issue in proceeding
- 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

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