

TRIAL PRACTICE GUIDE UPDATE

(August 2018)

Introduction..... 2

I. General Procedures..... 2

 G. Expert Testimony 2

II. Petitions and Motions Practice 5

 A. General Motions Practice Information..... 5

 3. Word Count and Page Limits..... 5

 D. Institution of Trial 8

 2. Considerations in Instituting a Review 8

 35 U.S.C. §§ 314(a), 324(a)..... 8

 35 U.S.C. § 325(d) 11

 I. Reply to Patent Owner Response and Reply for a Motion to Amend; Sur-Replies 14

 K. Challenging Admissibility; Motions to Exclude; Motions to Strike..... 16

 M. Oral Hearing 19

APPENDIX A: Sample Scheduling Order for *Inter partes* Review, Post-Grant Review, and Covered Business Method Patents Review (based on the trial rules). 24

 A. GENERAL INSTRUCTIONS 24

 B. DUE DATES..... 27

Introduction

The Office published the Office Patent Trial Practice Guide (“Practice Guide”) in August 2012, concurrent with the promulgation of the AIA Trial Rules. *See* 77 Fed. Reg. 48,756 (Aug. 14, 2012). The Practice Guide was intended to apprise the public of standard practices before the Board during AIA trial proceedings, including *inter partes* reviews, post-grant reviews, covered business method reviews, and derivation proceedings. The Practice Guide was also intended to encourage consistency of procedures among panels of the Board.

The Office is committed to updating the Practice Guide to take into account stakeholder feedback, lessons learned during the years since the first AIA trial, and the natural evolution of the Board’s practices. In order to expedite these updates and provide guidance to the public as quickly as possible, the Office has chosen to issue updates to the Practice Guide on a section-by-section, rolling basis, rather than a single, omnibus update addressing all aspects of the current Practice Guide. Sections of the Practice Guide changed or added in this update are set forth below.

I. General Procedures

G. Expert Testimony

Expert testimony may be submitted with the petition, preliminary response, and at other appropriate stages in a proceeding as ordered or allowed by the panel overseeing the trial.

Expert opinion testimony is generally permitted where the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue. Fed. R. Evid. 702(a).

An expert witness must be qualified as an expert by knowledge, skill, experience, training, or education to testify in the form of an opinion. Fed. R. Evid. 702. There is, however, no requirement of a perfect match between the expert's experience and the relevant field. *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010). A person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702, but rather must be "qualified in the pertinent art." *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363–64 (Fed. Cir. 2008). For example, the absence of an advanced degree in a particular field may not preclude an expert from providing testimony that is helpful to the Board, so long as the expert's experience provides sufficient qualification in the pertinent art.

Expert testimony is presented in the form of an affidavit or declaration. See 37 C.F.R. § 42.53(a). Expert testimony may have many uses. For example, it may be used to explain the relevant technology to the panel. It may also be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims. Expert testimony may also be offered on the issue of whether there would have been a reason to combine the teachings of references in a certain way, or if there may have been a reasonable expectation of success in doing so. If evidence of objective indicia of nonobviousness has been entered into the record, an expert may also provide testimony as to how this evidence should be weighed against evidence of unpatentability, or may explain the nature and import of such objective evidence.

The Board has broad discretion to assign weight to be accorded expert testimony. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010). However, the testimony must be based on sufficient facts and data. Fed. R. Evid. 702(b). “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). Furthermore, the testimony must be the product of reliable principles and methods. Fed. R. Evid. 702(c). Moreover, an expert must reliably apply the principles and methods to the facts of the case. Fed. R. Evid. 702(d).

The rules governing the conduct of AIA trial proceedings were designed to promote fairness and efficiency. For instance, 37 C.F.R. § 42.24(a) sets word limits for petitions, motions, and replies, and § 42.6(a)(3) prohibits incorporating arguments by reference from one document into another. Thus, parties that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board. *See Cisco Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative).

Expert testimony may be presented to establish the scope and content of the prior art for determining obviousness and anticipation. Such testimony may be helpful in evaluating, for example, the “prior art as viewed with the knowledge of one of skill in the art at the time of invention.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002). Expert testimony, however, cannot take the place of a disclosure in a prior art reference, when that disclosure is required as part of the unpatentability analysis. For example, because “[a] claim is anticipated only if each and every element as set forth in the claim is found, either

expressly or inherently described, in a single prior art reference,” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987), a petitioner asserting anticipation cannot rely on its expert to supply disclosure of a claim element that is not expressly or inherently present in the reference. Similarly, in an obviousness analysis, conclusory assertions from a third party about general knowledge in the art cannot, without supporting evidence of record, supply a limitation that is not evidently and indisputably within the common knowledge of those skilled in the art. *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014).

Furthermore, because an *inter partes* review may only be requested “on the basis of prior art consisting of patents or printed publications,” 35 U.S.C. § 311(b), expert testimony cannot take the place of disclosure from patents or printed publications. In other words, expert testimony may explain “patents and printed publications,” but is not a substitute for disclosure in a prior art reference itself.

II. Petitions and Motions Practice

A. General Motions Practice Information

3. Word Count and Page Limits

A word count limit applies to petitions, patent owner preliminary responses, patent owner responses, and petitioner replies to patent owner responses, and any sur-replies filed in AIA trial proceedings. For all other briefing, a page limit applies. 37 C.F.R. § 42.24. The rules set a limit of 14,000 words for petitions requesting IPR and derivation proceedings, and a limit of 18,700 words for petitions requesting PGR and CBM proceedings. § 42.24(a). Motions, other than motions to amend, are limited to 15 pages. *Id.* Motions to amend are limited to 25 pages. *Id.* Patent owner preliminary responses and patent owner responses to a petition are subject to the

same word limits as the corresponding petition. Oppositions to other motions, including motions to amend, are subject to the same page limits as the corresponding motion. 37 C.F.R. § 42.24(b). Replies to patent owner responses to petitions are limited to 5,600 words, replies to oppositions to motions to amend are limited to 12 pages, and replies to all other oppositions are limited to 5 pages. § 42.24(c). Sur-replies, if authorized, are subject to the same word or page limits as the reply, unless the Board orders otherwise.

37 C.F.R. § 42.24(d) requires that any paper whose length is specified by type-volume limits must include a certification stating the number of words in the paper. In making such a certification, a party may rely on the word count of the word-processing system used to prepare the paper. Page and word count limits do not include table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service, or appendix of exhibits or claim listing; but this exemption from word count limits does not apply to grounds for standing. *See* 37 C.F.R. § 42.24(a)(1); 81 FR 24702–03 (April 27, 2016). A party is not required to submit a statement of material facts in its briefing. § 42.22. Further, double spacing is not required for claim charts. § 42.6(a)(2)(iii).

Federal courts routinely use word count limits to manage motions practice, as “[e]ffective writing is concise writing.” *Spaziano v. Singletary*, 36 F.3d 1028, 1031 n.2 (11th Cir. 1994). Federal courts have found that word count limits ease the burden on both the parties and the courts, and patent cases are no exception. *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014) (explaining that allowing a party to incorporate by reference, resulting in exceeding court’s allowable word count would be fundamentally unfair).

Although parties are given wide latitude in how they present their cases, the Board's experience is that the presentation of an overwhelming number of issues tends to detract from the argument being presented, and can otherwise cause meritorious issues to be missed or discounted. Thus, parties should avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record. Another factor to keep in mind is that judges of the Board are familiar with the general legal principles involved in issues which come before the Board. Accordingly, unless there is a dispute over the applicable law, extended discussions of general patent law principles may not be necessary.

The Office provides the following practical guidance regarding compliance with the word count limits. With a word count limit, parties may include concise arguments in claim charts if they choose. Moreover, when certifying word count, a party need not go beyond the routine word count supplied by their word processing program. Parties should not abuse the process.

Excessive words in figures, drawings, or images, deleting spacing between words, or using excessive acronyms or abbreviations for word phrases, in order to circumvent the rules on word count, may lead to a party's brief not being considered. *See, e.g., Pi-Net Int'l, Inc. v. JPMorgan Chase & Co.*, 600 F. App'x 774 (Fed. Cir. 2015). Except in cases of obvious abuse, the Board will generally accept a party's certification of compliance with word count limits. If a party feels that it would suffer undue prejudice from an opposing party's alleged word count limit violation or abuse, that party should raise the issue with the Board promptly after discovering the issue.

The Board expects the parties to take reasonable steps to remedy any such issues before

approaching the Board. If an opposing party raises a word count limit violation or abuse, the Board will consider such a violation or abuse on a case-by-case basis.

D. Institution of Trial

2. Considerations in Instituting a Review

The Board institutes the trial on behalf of the Director. 37 C.F.R. § 42.4(a). In deciding whether to institute the trial, the Board considers at a minimum whether or not a party has satisfied the relevant statutory institution standard. The Board will also take into account whether various considerations, including those discussed below, warrant the exercise of the Director’s discretion to decline to institute review. *See, e.g.*, 35 U.S.C. §§ 314(a), 324(a). Among other things, the Board will also take into account whether the same or substantially the same prior art or arguments were previously presented to the Office. *See, e.g.*, 35 U.S.C. § 325(d).

35 U.S.C. §§ 314(a), 324(a)

Sections 314(a) and 324(a) provide the Director with discretion to deny a petition. *See* 35 U.S.C. § 314(a) (stating “[t]he Director may not authorize an *inter partes* review to be instituted unless . . .”); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). Under 35 U.S.C. § 316(a)(2), the Director shall prescribe regulations “setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a).” Once instituted, “[petitioner] is entitled to a final written decision addressing all of the claims it has challenged.” *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018).

The Director’s discretion is informed by 35 U.S.C. §§ 316(b) and 326(b), which require the Director to “consider the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” The AIA was “designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. Rep. No. 112–98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69 (Post grant reviews were meant to be “quick and cost effective alternatives to litigation”); *see also* S. Rep. No. 110–259, at 20 (2008). In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board recognized these goals of the AIA, but also “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential).

Accordingly, to aid the Board’s assessment of “the potential impacts on both the efficiency of the *inter partes* review process and the fundamental fairness of the process for all parties,” *General Plastic* enumerated a number of non-exclusive factors that the Board will consider in exercising discretion on instituting *inter partes* review, especially as to “follow-on” petitions challenging the same patent as challenged previously in an IPR, PGR, or CBM proceeding. *Id.* at 18. The *General Plastic* non-exclusive factors include the following:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id. at 15–16.

The *General Plastic* factors, alone or in combination, are not dispositive, but part of a balanced assessment of all relevant circumstances in the case, including the merits. *Id.* at 15 (“There is no *per se* rule precluding the filing of follow-on petitions.”). The *General Plastic* factors are also not exclusive and are not intended to represent all situations where it may be appropriate to deny a petition. *Id.* at 16. There may be other reasons besides the “follow-on” petition context where the “effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,” 35 U.S.C. § 316(b), favors denying a petition even though some claims meet the threshold standards for institution under 35 U.S.C. §§ 314(a), 324(a). This includes, for example, events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC. *See NetApp, Inc. v. Realtime Data LLC*, Case IPR2017-01195, slip op. at 12–13 (PTAB Oct. 12, 2017) (Paper 9)

(denying institution under § 314(a) of a follow-on petition filed by a different petitioner where, due to petitioner's delay, the Board likely would not have been able to rule on patentability until after the district court trial date). Accordingly, parties may wish to address in their submissions whether any other such reasons exist in their case that may give rise to additional factors that may bear on the Board's discretionary decision to institute or not institute, and whether and how such factors should be considered along with the *General Plastic* factors.

35 U.S.C. § 325(d)

35 U.S.C. § 325(d) provides that, in determining whether to order a reexamination or institute an IPR, PGR, or CBM proceeding, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office. Thus, in exercising its discretion whether to institute trial, the Board considers whether the same or substantially the same prior art or arguments were presented previously. *See, e.g., Cultec, Inc. v. StormTech LLC*, Case IPR2017-00777 (PTAB Aug. 22, 2017) (Paper 7) (informative) (denying institution under 35 U.S.C. § 325(d) where the Office previously evaluated two asserted references during examination and additional relied-upon references were cumulative of prior art considered during examination); *Hospira, Inc. v. Genentech, Inc.*, Case IPR2017-00739 (PTAB July 27, 2017) (Paper 16) (informative) (denying institution under 35 U.S.C. § 325(d) where the Office previously considered and evaluated during examination the same arguments regarding a patent owner's priority claim).

Whether to deny institution of trial on the basis of 35 U.S.C. § 325(d) is a fact-dependent decision, in which the Board balances the petitioner's desire to be heard against the interest of

the patent owner in avoiding duplicative challenges to its patent. The Board also takes into account the “efficient administration of the Office,” *see* 35 U.S.C. § 316(b), which may be affected by consideration of trial petitions that raise the same or substantially the same prior art or arguments presented previously to the Office during examination, a reexamination proceeding, a reissue proceeding, or in an earlier-filed petition requesting an IPR, PGR, or CBM review.

In evaluating whether to deny institution on the basis of 35 U.S.C. § 325(d), the Board has considered certain non-exclusive factors. *See Becton Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative). The *Becton Dickinson* non-exclusive factors include:

1. the similarities and material differences between the asserted art and the prior art involved during examination;
2. the cumulative nature of the asserted art and the prior art evaluated during examination;
3. the extent to which the asserted art was evaluated during examination;
4. the extent of the overlap between the arguments made during examination and the manner in which a petitioner relies on the prior art or a patent owner distinguishes the prior art;
5. whether a petitioner has pointed out sufficiently how the Office erred in evaluating the asserted prior art; and
6. the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Id.

Although the Board has considered the above-listed factors in the context of a trial petition that raises art that is the same or substantially the same as art presented previously during examination, parties to a IPR, PGR, or CBM proceeding may wish to analyze similar factors in the context of a trial petition involving art that is the same or substantially the same as art presented previously during a prior reexamination proceeding, a reissue proceeding, or an earlier-filed petition requesting an IPR, PGR, or CBM review. In deciding whether to deny institution under 35 U.S.C. § 325(d), the Board may also consider materially changed circumstances or facts and evidence of which the Office was not aware during its previous consideration of the asserted art or arguments. *Kayak Software Corp. v. Int’l Bus. Machs. Corp.*, Case CBM2016-00075, slip op. at 10–12 (PTAB Dec. 15, 2016) (Paper 16) (informative). The above-listed factors are not exclusive—the parties may wish to address additional factors they consider relevant to the Board’s exercise of discretion to deny institution under 35 U.S.C. § 325(d).

The above-listed factors are considered by the Board when determining whether to institute a trial. When determining whether to order ex parte reexamination, however, the Office may not necessarily consider these factors. An ex parte reexamination proceeding is not a trial proceeding, and the considerations with respect to issues involving 35 U.S.C. 325(d) may differ due to the different nature of an ex parte reexamination proceeding.

I. Reply to Patent Owner Response and Reply for a Motion to Amend; Sur-Replies

A petitioner may file a reply to a patent owner response, and a patent owner may file a reply to an opposition to a motion to amend. 37 C.F.R. § 42.23. Additionally, in response to issues arising from the Supreme Court's decision in *SAS* (138 S. Ct. at 1358), the Board will permit the petitioner, in its reply brief, to address issues discussed in the institution decision. The Patent Owner will similarly be allowed to address the institution decision in its sur-reply, if necessary to respond to petitioner's reply. Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability. But a petitioner may submit directly responsive rebuttal evidence in support of its reply. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015). If a party submits a new expert declaration with its reply, the opposing party may cross-examine the expert, move to exclude the declaration, and comment on the declaration and cross-examination in any sur-reply. *Id.* at 1081–82.

Sur-replies to motions are not generally permitted, but may be authorized on a case-by-case basis. Sur-replies to principal briefs (i.e., to a reply to a patent owner response or to a reply to an opposition to a motion to amend) normally will be authorized by the scheduling order entered at institution. The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. As noted above, a sur-reply may address the institution decision if necessary to respond to the petitioner's reply. This sur-reply practice essentially replaces the previous practice of filing observations on cross-examination testimony.

Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23, except as noted above. To the extent that a reply or sur-reply “responds” to the institution decision as discussed above, “respond,” in the context of § 42.23(b), does not mean embark in a new direction with a new approach as compared to positions taken in a prior filing. While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered. The Board is not required to sort proper from improper portions of the reply or sur-reply.

Examples of new issues are new theories or arguments necessary to make out petitioner’s case-in-chief for the unpatentability of an original or proposed substitute claim, such as a newly raised rationale to combine the prior art references that was not expressed in the petition. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) (holding that the Board did not err in refusing the reply brief as improper under 37 C.F.R. § 42.23(b) because Petitioner relied on an entirely new rationale to explain why one of skill in the art would have combined the references at issue). It is also improper to present in reply new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to “gap-fill” by teaching a claim element that was not present in the prior art presented with the petition. *See Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365–69 (Fed. Cir. 2016) (proper for Board to rely on prior art references submitted with petitioner’s reply to establish the state of the art at the time of the invention in response to patent owner arguments).

K. Challenging Admissibility; Motions to Exclude; Motions to Strike

A party wishing to challenge the admissibility of evidence must file any objections within five business days of service of evidence to which the objection is directed, or ten days after institution of trial. 37 C.F.R. §§ 42.64(a), 42.64(b)(1). Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude. *See* § 42.64(b)(2).

Motions to Exclude. Objections may be preserved only by filing a motion to exclude the evidence. 37 C.F.R. § 42.64(c). The due dates for filing a motion to exclude evidence, an opposition, and a reply for a motion to exclude are usually set in the Scheduling Order.

A motion to exclude evidence should:

- (a) Identify where in the record the objection originally was made;
- (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
- (c) Address objections to exhibits in numerical order; and
- (d) Explain the basis and grounds for each objection.

A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact. A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents. Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.

Generally, the Board waits until after the oral hearing, when it reviews the record in its entirety, to decide the merits of any motions to exclude. In the Board's experience, consideration of the objected-to evidence is often unnecessary to resolve the patentability of the challenged claims, and the motion to exclude is moot. Nevertheless, in certain circumstances, the evidence may be so central to the parties' dispute that mootness is unlikely and early resolution of the motion to exclude may be warranted. In such cases, a party may request a pre-hearing conference with the panel to seek early resolution of a motion to exclude on a limited number of objections. The Board will preferably rule on such a motion during the pre-hearing conference (or after the pre-hearing conference but before the oral hearing), but may also defer ruling until the oral hearing or thereafter.

Motions to Strike. If a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike. Alternatively, a party may request authorization for further merits briefing, such as a sur-reply, to address the merits of any newly-raised arguments or evidence.

A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety, whereas further briefing may be more appropriate when the party wishes to address the proper weight the Board should give to the arguments or evidence. In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such,

striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely. In some cases, however, whether an issue is new or evidence is belatedly presented may be beyond dispute, or the prejudice to a party of waiting until the close of the evidence to determine whether new issues or belatedly presented evidence has been presented may be so great, that the facts may merit considering a motion to strike. For example, where a reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate. When authorized, the Board expects that it will decide a motion to strike as soon as practicable, and preferably before oral hearing, so that the parties need not devote time during the hearing to addressing improper arguments.

Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission. The Board will consider such requests on a case-by-case basis.

M. Oral Hearing

Each party to a proceeding will be afforded an opportunity to present their case before at least three members of the Board. The time for requesting an oral hearing is normally set in the Scheduling Order but may be modified on a case-by-case basis. A request for oral hearing should include the amount of time a party considers sufficient to present its argument to the Board. The Board expects to ordinarily provide for an hour of argument per side for a single proceeding, but a party may request more or less time depending on the circumstances of the case. The Board encourages the parties to confer before filing a request for oral hearing and, if possible, jointly agree regarding the appropriate argument time needed for each side.

A pre-hearing conference call will be held at either party's request and will generally occur no later than three business days prior to the oral hearing. Prior to making such a request, the parties should meet and confer and, when possible, send a joint request to the Board with an agreed upon set of limited issues for discussion. A request for a pre-hearing conference may be made by email and shall include a list of issues to be discussed during the call, including, e.g., identification of a limited number of objections for early resolution as discussed above. The time for making the request will be set in the Scheduling Order, but generally will be required to be sent to the Board no later than the due date set for a reply to an opposition to motion to exclude evidence.

The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties. The parties may also discuss

with the Board any pending motions to strike, request an early decision on the admissibility of a limited number of exhibits subject to a motion to exclude, and discuss any unresolved issues with demonstrative exhibits. The Board will preferably rule on pending motions and limited numbers of objections and disputed exhibits during the pre-hearing conference (or after the pre-hearing conference but before the oral hearing), but may also defer ruling until the oral hearing or thereafter.

At the oral hearing, a petitioner generally will argue first, followed by the patent owner, after which a rebuttal may be given by the petitioner. Absent special circumstances, a petitioner will not be permitted to reserve for rebuttal more than half the total time allotted for argument. The Board may also permit patent owners the opportunity to present a brief sur-rebuttal if requested. In hearings involving multiple parties or multiple patents, the Board will work with the parties to come up with a format for the hearing that gives the parties a fair opportunity to present their case while preserving the efficiency of the proceedings.

Although most hearings in AIA trials are held at USPTO headquarters in Alexandria, Virginia, some hearings are held in USPTO regional offices. The Scheduling Order will generally indicate if a panel is available to hold a final hearing in locations other than Alexandria and will provide guidance to the parties on expressing a location preference. If the necessary resources are available, the request will be given due consideration. The Board may not always be able to honor the parties' preference of hearing location, however, due to the availability of hearing room resources and panel needs.

Special equipment or needs. Hearing rooms are equipped with projectors for PowerPoint presentations. However, a party should advise the Board as soon as possible before an oral argument of any special needs. Examples of such needs include additional space for a wheelchair, an easel for posters, or an overhead projector (“Elmo”). Parties should not make assumptions about the equipment the Board may have on hand. Such requests should be directed in the first instance to a Board Trial Division paralegal at (571) 272-9797.

Demonstrative exhibits. The Board has found that elaborate demonstrative exhibits are more likely to impede than help an oral argument. The most effective demonstrative exhibits tend to be a few presentation slides and a handout or binder containing the demonstrative exhibits. The pages of each exhibit should be numbered and counsel should identify the exhibit numbers during course of oral argument, particularly if the panel includes members participating remotely.

Demonstrative exhibits used at the final hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide of a demonstrative exhibit may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer.

Demonstrative exhibits cannot be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely argument . . . raised for the first time during oral argument”). Demonstrative exhibits, marked as noted above, should be filed in the record in accordance with the orders of the panel.

The order setting oral argument will set forth the panel's preferred procedure for handling objections to demonstratives, if any. The parties are encouraged to resolve objections by exchanging proposed demonstrative exhibits and conferring prior to submitting the exhibits to the Board. Objections to demonstratives should be carefully considered and framed as the Board has not found that such objections are helpful in many cases.

Live testimony. The Board receives relatively few requests for presenting live testimony. When requested by a party, and where the panel believes live testimony will be helpful in making a determination, the Office will permit live testimony at the oral hearing. The Board will consider such requests on a case-by-case basis, but does not expect to permit live testimony in every case where there is conflicting testimony.

The format for presenting live testimony is left to the discretion of the panel. Live testimony is normally evidence that becomes part of the record. The Board may direct questions to any witness who testifies in person at the hearing.

In general, a request for live testimony is more likely to be granted where the Board determines that the demeanor of a witness is critical to evaluating that witness's credibility. A party requesting live testimony should be prepared to explain why and how this consideration applies. An example of a situation where this may apply is where an inventor is attempting to antedate a reference by establishing a prior reduction to practice. *See K-40 Electronics, LLC v. Escort, Inc.*, IPR2013-00203 (PTAB May 21, 2014) (Paper 34). Other factors may include the importance of

the issue that is the subject of the testimony. The Board is more likely to grant oral testimony critical to issues that are case-dispositive. *Id.* at 2.

No new evidence and arguments. During an oral hearing, a party may rely upon appropriate demonstrative exhibits as well as evidence that has been previously submitted in the proceeding, but may only present arguments relied upon in the papers previously submitted. Except in cases where the Board permits live testimony, no new evidence may be presented at the oral argument. Live testimony may not exceed the scope of the underlying declaration and may not address new theories or arguments not previously presented by a party.

APPENDIX A: Sample Scheduling Order for *Inter partes* Review, Post-Grant Review, and Covered Business Method Patents Review (based on the trial rules).

A. GENERAL INSTRUCTIONS

1. Initial Conference Call

The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (“Practice Guide”) (guidance in preparing for the initial conference call). A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

2. Protective Order

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. The Board encourages the parties to adopt the Board’s default protective order if they conclude that a protective order is necessary. *See* Practice Guide, App’x B (Default Protective Order). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

The Board has a strong interest in the public availability of trial proceedings. Redactions to documents filed in this proceeding should be limited to the minimum amount necessary to protect confidential information, and the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information

subject to a protective order may become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Practice Guide 48,761.

3. Discovery Disputes

The Board encourages parties to resolve disputes relating to discovery on their own. To the extent that a dispute arises between the parties relating to discovery, the parties must meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board.

4. Testimony

The parties are reminded that the Testimony Guidelines appended to the Trial Practice Guide, Appendix D, apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

5. Cross-Examination

Except as the parties might otherwise agree, for each due date:

Cross-examination ordinarily takes place after any supplemental evidence is due.

37 C.F.R. § 42.53(d)(2).

Cross-examination ordinarily ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

6. Oral Argument

Requests for oral argument must comply with 37 C.F.R. § 42.70(a). To permit the Board sufficient time to schedule the oral argument, the parties may not stipulate to an extension of the request for oral argument beyond the date set forth in the Due Date Appendix.

Unless the Board notifies the parties otherwise, oral argument, if requested, will be held at [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office].

The parties may request that the oral argument instead be held at [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office], or [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office]. The parties should meet and confer, and jointly propose the parties' preference at the initial conference call, if requested. Alternatively, the parties may jointly file a paper stating their preference for the hearing location within one month of this order. Note that the Board may not be able to honor the parties' preference of hearing location due to, among other things, the availability of hearing room resources and the needs of the panel. The Board will consider the location request and notify the parties accordingly if a request for change in location is granted.

Seating in the Board's hearing rooms may be limited, and will be available on a first-come, first-served basis. If either party anticipates that more than five (5) individuals will attend the argument on its behalf, the party should notify the Board as soon as possible, and no later

than the request for oral argument. Parties should note that the earlier a request for accommodation is made, the more likely the Board will be able to accommodate additional individuals.

B. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. The parties may stipulate different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate an extension of DUE DATES 6 and 7, or to the requests for oral hearing.

In stipulating different times, the parties should consider the effect of the stipulation on times to object to evidence (37 U.S.C. § 42.64(b)(1)), to supplement evidence (§ 42.64(b)(2)), to conduct cross-examination (§ 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony.

1. DUE DATE 1

Patent Owner may file—

- a. A response to the petition (37 U.S.C. § 42.120). If Patent Owner elects not to file a response, Patent Owner must arrange a conference call with the parties and the Board. Patent Owner is cautioned that any arguments for patentability not raised in the response may be deemed waived.
- b. A motion to amend the patent (37 U.S.C. § 42.121). Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. 37 U.S.C. § 42.121(a). To satisfy this requirement,

Patent Owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1. The parties are directed to the Board's Guidance on Motions to Amend in view of *Aqua Products* (https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf), and *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018-00082 (PTAB April 25, 2018) (Paper 13) (providing information and guidance on motions to amend).

2. DUE DATE 2

Petitioner may file a reply to the Patent Owner's response.

Petitioner may file an opposition to the motion to amend.

3. DUE DATE 3

Patent Owner may file a sur-reply to Petitioner's reply.

Patent Owner may file a reply to the opposition to the motion to amend.

4. DUE DATE 4

Petitioner may file a sur-reply to Patent Owner's reply to the opposition to the motion to amend.

Either party may file a motion to exclude evidence (37 U.S.C. § 42.64(c)).

5. DUE DATE 5

Either party may file an opposition to a motion to exclude evidence.

6. DUE DATE 6

Either party may file a reply to an opposition to a motion to exclude evidence.

Either party may request that the Board hold a pre-hearing conference.

7. DUE DATE 7

The oral argument (if requested by either party) shall be held on this date.

Approximately one month prior to the argument, the Board will issue an order setting the start time of the hearing and the procedures that will govern the parties' arguments.

DUE DATE APPENDIX

DUE DATE 1	
Patent owner's response to the petition	3 months
Patent owner's motion to amend the patent	

DUE DATE 2	
Petitioner's reply to patent owner response to petition	3 months
Petitioner's opposition to motion to amend	

DUE DATE 3	
Patent Owner's sur-reply to reply	1 month
Patent Owner's reply to opposition to motion to amend	

DUE DATE 4	
Petitioner's sur-reply to reply to opposition to motion to amend	1 month
Motion to exclude evidence	

DUE DATE TO FILE REQUESTS FOR ORAL ARGUMENT	Same as Due Date 4 (but parties may not stipulate an extension)
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DUE DATE 5	
Opposition to motion to exclude	1 week

DUE DATE 6	
Reply to opposition to motion to exclude	1 week
Request for prehearing conference	

DUE DATE 7

2 weeks

Oral argument
