Patent Trial and Appeal Board
Boardside Chat:
AIA Motions Practice

Erica Franklin, Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
March 18, 2021
Question/comment submission

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

• Rules and guidance
• Common motions

*The presentation today will not cover motions to amend.
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.
Question/comment submission

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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:
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

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

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<tr>
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<tbody>
<tr>
<td>To File Supplemental Info</td>
<td>Yes</td>
<td>42.123; 42.223</td>
<td>75-76</td>
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<tr>
<td>PO Sur-reply</td>
<td>No (Due Dates 4 &amp; 5)</td>
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<tr>
<td>To Expunge</td>
<td>Yes</td>
<td>42.56</td>
<td>20-22, 92, 100</td>
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<tr>
<td>To Terminate</td>
<td>Yes</td>
<td>42.72; 42.73</td>
<td>4, 53, 86</td>
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<tr>
<td>To Strike</td>
<td>Yes</td>
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