

**TRIAL PRACTICE GUIDE UPDATE**

**(July 2019)**

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## **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 also was 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. An update to the Practice Guide was published on August 13, 2018, and is available at <https://go.usa.gov/xU7GP>. *See* 83 Fed. Reg. 39,989 (Aug. 13, 2018). Sections of the Practice Guide changed or added in this second update are set forth below.

## **I. General Procedures**

### **A. Jurisdiction and Management of the Record**

#### **2. Prohibition on *Ex Parte* Communications**

All substantive communications with the Board regarding a proceeding must include all parties

to the proceeding, except as otherwise authorized. 37 C.F.R. § 42.5(d). The prohibition on *ex parte* communications does not extend to: (1) ministerial communications with support staff (for instance, to arrange a conference call); (2) conference calls or hearings in which opposing counsel declines to participate; (3) informing the Board in one proceeding of the existence or status of a related Board proceeding; or (4) reference to a pending case in support of a general proposition (for instance, citing a published opinion from a pending case or referring to a pending case to illustrate a systemic problem).

#### Arranging a conference call with the Board

The Board encourages the use of conference calls to raise and resolve issues in an expedited manner. Prior to making a request for a conference call, the parties should meet and confer to resolve any disputes. If attempts to resolve the dispute fail, a party may request a conference call with the Board. The Board envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, *i.e.*, in a matter of days. When arranging a conference call, parties should be prepared to discuss with a Trial Section paralegal why the call is needed and what materials may be needed during the call, *e.g.*, a particular exhibit. When contacting the Board to arrange a conference call, a party to a proceeding should notify the Board if it intends to provide a court reporter for the call. If a court reporter is present for the conference call, the party that retained the court reporter should notify the panel at the beginning of the call that a reporter is on the line, and shall file the transcript of the call as an exhibit to the proceeding within one week of receiving the transcript.

### Refusal to participate

The Board has the discretion to permit a hearing or conference call to take place even if a party refuses to participate. In such cases, the Board may order as a condition for the call additional safeguards, such as the recording of the communication and the entry of the recording into the record.

## **E. Public Availability and Confidentiality**

### **4. Protective orders**

A party may file a motion to seal where the motion contains a proposed protective order, such as the default protective order in Appendix B. 37 C.F.R. § 42.54. A protective order is not entered by default but must be proposed by one or more parties and must be approved and entered by the Board. Specifically, protective orders may be issued for good cause by the Board to protect a party from disclosing confidential information. 37 C.F.R. § 42.54. Guidelines on proposing a protective order in a motion to seal, including a Default Protective Order, are provided in Appendix B. The document or thing will be protected on receipt of the motion and remain so, pending the outcome of the decision on motion. If a motion for a protective order is not granted, the party submitting the confidential information will have the opportunity to have the submitted information expunged from the record. Otherwise, the submitted information may be publicly disclosed.

## **F. Discovery**

### **2. Additional discovery**

A request for additional discovery must be in the form of a motion, although the parties may agree to such discovery among themselves. 37 C.F.R. § 42.51(b)(2). Parties to an AIA trial can generally seek the same types of discovery available under the Federal Rules of Civil Procedure. The standard for granting such requests varies with the proceeding.

By way of background, an “interests of justice” standard applies in IPR and derivation proceedings (37 C.F.R. § 42.51(b)(2)), whereas the slightly more liberal “good cause” standard applies in PGR and CBM proceedings (37 C.F.R. § 42.224). The more liberal “good cause” standard applies to PGR and CBM proceedings because the scope of these proceedings may be broader than IPRs. They include all of the grounds of IPRs, as well as 35 U.S.C. §§ 101 and 112 (with the exception of failure to disclose the best mode). Also, because a petition for a PGR must be filed no later than nine months after the date of the grant of a patent or of the issuance of a reissue patent (35 U.S.C. § 321(c)), information regarding the patentability of claims subject to PGR review may be more readily available than information regarding the patentability of claims subject to other forms of review that could take place many years after the challenged patent issued, and therefore discovery in a PGR is likely to be obtained from the patent owner in a less burdensome manner. The discussion below centers on additional discovery under the “interests of justice” standard.

In determining when a request for additional discovery will be granted in IPRs under the in the “interests of justice” standard, the Board will be guided primarily by the factors set forth in the Board’s precedential decision in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential). Similar factors for consideration of such requests under the “good cause” standard are set forth in *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005 (PTAB May 29, 2013) (Paper 32) (precedential). Parties in PGR and CBM proceedings should also refer to that decision for guidance.

In *Garmin*, the Board set forth a set of five factors considered to be important in authorizing and deciding a motion for additional discovery:

“1. More Than A Possibility And Mere Allegation—The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence” or reasoning “tending to show beyond speculation that in fact something useful will be uncovered.” *Garmin*, Case IPR2012-00001, slip op. at 6. *See, e.g., Kashiv Pharma LLC v. Purdue Pharma L.P.*, Case IPR2018-00625 (PTAB July 31, 2018) (Paper 20) (granting patent owners’ motion for additional discovery where patent owners identified several pieces of “threshold” evidence that tended to show that the two requested depositions would shed light on the question of whether an



additional party should have been named as a real party-in-interest); *Mylan Pharmaceuticals Inc. v. Allergan Inc.*, Case IPR2016-01127 (PTAB May 31, 2017) (Paper 28) (granting additional discovery of data underlying figures relied on by the patent owner in order for the petitioner to fully develop its rebuttal to patent owner’s evidence of unexpected results). Additionally, “‘useful’ . . . does not mean merely ‘relevant’ and/or ‘admissible,’” but rather “means favorable in substantive value to a contention of the party moving for discovery.” *Garmin*, Case IPR2012-00001, slip op. at 7. *See, e.g., Corning Inc. v. DSM IP Assets B.V.*, Case IPR2013-00043 (PTAB June 21, 2013) (Paper 27) (finding that laboratory notebooks were per se useful because they contained protocols and procedures used to synthesize and test oligomers and coatings that were relied on by the petitioner’s expert to demonstrate unpatentability of the challenged claims).

“2. Litigation Positions And Underlying Basis—Asking for the other party’s litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.” *Garmin*, Case IPR2012-00001, slip op. at 6. Therefore, a party will receive this information in due course. Thus, contention interrogatories would typically not be permitted. *See, e.g., St. Jude Med., LLC v. Snyders Heart Valve LLC*, Case IPR2018-00105 (PTAB Oct. 18, 2018) (Paper 37) (denying petitioner’s request of expert reports and deposition transcripts from a parallel litigation because petitioner stated that such discovery was sought to probe patent owner’s IPR positions).

“3. Ability To Generate Equivalent Information By Other Means”—Production by another of “[i]nformation a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice. . . .” *Garmin*, Case IPR2012-00001, slip op. at 6. *See, e.g., Dynamic Air Inc. v. M-I Drilling Fluids UK Ltd.*, Case IPR2016-00260 (PTAB Nov. 30, 2016) (Paper 39) (denying petitioner’s request for additional documents and deposition partly because petitioner did not show that it could not obtain information about the state of the art and properties of drill cuttings by other means). “In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.” *Garmin*, Case IPR2012-00001, slip op. at 6.

“4. Easily Understandable Instructions”—The requests “should be easily understandable.” *Garmin*, Case IPR2012-00001, slip op. at 6.

“5. Requests Not Overly Burdensome To Answer—The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests should be sensible and reasonably tailored according to a genuine need” for the discovery. *Garmin*, Case IPR2012-00001, slip op. at 7.

A party seeking authorization to file a motion for additional discovery should be prepared to address the *Garmin* factors and any other pertinent factors during a conference call with the Board to discuss the motion.

Two areas where additional discovery has been sought frequently are identifying real parties-in-interest and secondary evidence of non-obviousness. Narrowly focused requests for additional discovery on these issues may, if appropriate, be permitted. *See, e.g., Ventex Co. v. Columbia Sportswear N. Am., Inc.*, Case IPR2017-00651 (PTAB Dec. 19, 2017) (Paper 40) (granting additional “focused and narrow” discovery regarding production of “relevant testimony concerning secondary consideration of non-obviousness”); *but see Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 36) (denying additional discovery relating to copying where patent owner failed to adequately explain how the allegedly copied feature was embodied in the claims for which trial was instituted and finding that the request appeared “not focused, overly broad, and unduly burdensome”); *see, e.g., Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, Case IPR2014-00488 (PTAB Nov. 5, 2014) (Paper 25) (granting additional discovery of information pertaining to real party-in-interest that was narrowly tailored to communications “regarding the preparation or filing of the Medtronic IPRs”); *but see Unified Patents v. Vilox Techs.*, Case IPR2018-00044 (PTAB Feb. 6, 2019) (Paper 64) (denying request for post-oral argument real party-in-interest discovery where patent owner acknowledged that the discovery would not have any impact on the merits of the final decision and did not assert that any time bar applied).

## 5. Live testimony

Cross-examination may be ordered to take place in the presence of an administrative patent judge, which may occur at the deposition or oral argument. Occasionally, the Board will permit live testimony where the Board considers the demeanor of a witness critical to assessing credibility. Examples of where such testimony may be permitted before the Board include where derivation is an issue or where misconduct is alleged to have occurred during the proceeding. In another instance, such testimony was allowed where the witness was an inventor who provided declaration testimony to antedate the references relied on by the petitioner to challenge patentability. *See K-40 Elecs., LLC v. Escort, Inc.*, Case IPR2013-00203 (PTAB May 21, 2014) (Paper 34) (precedential). In contrast, the testimony of an inventor at an oral hearing was considered new evidence, and was not permitted, when a declaration from the inventor had not been previously provided. *See DePuy Synthes Prods., Inc. v. MEDIDEA, L.L.C.*, Case IPR2018-00315 (PTAB Jan. 23, 2019) (Paper 29) (precedential).

Live testimony will be necessary only in limited circumstances and requests for live testimony will be approached by the Board on a case-by-case basis. Factors that may be considered by the Board in determining whether to permit live testimony are set forth in the Board's precedential decision in *K-40 Electronics*, Case IPR2013-00203, slip op. at 3. Such factors may include the importance of the witness's testimony to the case, i.e., whether it may be case-dispositive. *Id.* Another factor favoring live testimony is if the witness is a fact witness. *Id.* In contrast, the

credibility of experts often turns less on demeanor and more on the plausibility of their theories. *See Andreu v. Sec'y of HHS*, 569 F.3d 1367, 1379 (Fed. Cir. 2009). *See* Appendix D of the August 2012 Trial Practice Guide for guidance on testimony and Section II.M. of the August 13, 2018 Trial Practice Guide update for additional information on live testimony at an oral hearing.

## **II. Petitions and Motions Practice**

### **B. Petition**

#### **6. Claim Construction**

If a petitioner believes that a claim term requires an express construction, the petitioner must include a statement identifying a proposed construction of the particular term and where the intrinsic and/or extrinsic evidence supports that meaning. On the other hand, a petitioner may include a statement that the claim terms require no express construction. The patent owner may then respond to these positions and/or propose additional terms for construction, with corresponding statements identifying a proposed construction of any particular term or terms and where the intrinsic and/or extrinsic evidence supports those meanings. The petitioner may respond to any such new claim construction issues raised by the patent owner, but cannot raise new claim construction issues that were not previously raised in its petition. If the Board raises a claim construction issue on its own, both parties will be afforded an opportunity to respond before a final written decision is issued. *See, e.g., Hamilton Beach Brands, Inc. v. f'real Foods, LLC*, 908 F.3d 1328, 1339 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. ComplementSoft, LLC.*, 825 F.3d 1341, 1351 (Fed. Cir. 2016), *reversed on other grounds, SAS Inst., Inc. v. Iancu*, 138 S. Ct.

1348, 1351 (2018)) (finding that the Board did not violate the Administrative Procedure Act when it adopted its own claim construction in the final written decision because the parties had notice of the contested claim construction and an opportunity to be heard).

Where claim language may be construed according to 35 U.S.C. § 112(f), a petitioner must provide a construction that includes both the claimed function and the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function. 37 C.F.R. § 42.104(b)(3). A party may choose to elaborate why § 112(f) should or should not apply to the limitation at issue. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015). A petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).

The Office has revised the claim construction standard used in IPR, PGR, and CBM proceedings, and now applies the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). *See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (Final Rule) (applying to all IPR, PGR and CBM petitions filed on or after November 13, 2018). This is the same claim construction standard used by Article III federal courts and the ITC, which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) and its progeny. The amended rules (37 C.F.R. §§ 42.100(b), 42.200(b), and 42.300(b)) reflect that in an AIA proceeding, the Board will apply the same standard used in

federal courts to construe patent claims. The Board will construe patent claims and proposed substitute claims based on the record of the IPR, PGR, or CBM proceeding, taking into account the claim language itself, specification, and prosecution history pertaining to the patent, as well as relevant extrinsic evidence, all as in prevailing jurisprudence of Article III courts. The Board will also take into account the prosecution history that occurred previously in proceedings at the Office prior to the IPR, PGR, or CBM proceeding at issue, including in another AIA proceeding, or before an examiner during examination, reissue, and reexamination.

The Board will determine the claim construction based on the record of the proceeding at issue. Thus, as in a district court proceeding, the parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy of any such evidence to the arguments they advance. Each party bears the burden of providing sufficient support for any construction advanced by that party.

The claim construction rule also provides that “[a]ny prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the . . . proceeding will be considered.” 37 C.F.R. §§ 42.100(b), 42.200(b), 42.300(b). Under this provision, the Board will consider any prior claim construction determination in a civil action or ITC proceeding if a federal court or the ITC has previously construed a term of the involved claim using the same standard, and the claim construction determination has been timely made of record in the IPR, PGR, or CBM

proceeding. The Board will give such other claim construction determinations appropriate weight. Non-exclusive factors considered by the Board when determining appropriate weight may include, for example, the similarities between the record in the district court or the ITC and the record before the Board. It may also be relevant whether the prior claim construction is final or interlocutory. These factors will continue to be relevant under the district court claim construction standard, which is articulated in *Phillips*. The Board may also consider whether the terms construed by the district court or ITC are necessary to deciding the issues before it. This is not an exclusive list of considerations, and the facts and circumstances of each case will be analyzed as appropriate.

Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available. Preferably, the prior claim construction determination should be submitted with the petition, preliminary response, or response, along with explanations. Submission of a prior claim construction determination is mandatory under 37 C.F.R. § 42.51(b), if it is “relevant information that is inconsistent with a position advanced by the party during the proceeding.” In such cases, the determination should be submitted “concurrent with the filing of the documents or things that contains the inconsistency.” *Id.* After a trial is instituted, the Board’s rules on supplemental information govern the timing and procedures for submitting claim construction decisions. 37 C.F.R. §§ 42.123, 42.223. Under those rules, a party must first request authorization from the Board to file a motion to submit supplemental information. If it is more than one month after the date the



trial is instituted, the motion must show why the supplemental information reasonably could not have been obtained earlier. Normally, the Board will permit such information to be filed, as long as the final oral hearing has not taken place. The Board may permit a later filing where it is not close to the one-year deadline for completing the trial. Again, parties should submit a prior claim construction as soon as the decision is available.

The Board, in its claim construction determinations, will consider statements regarding claim construction made by patent owners and by a petitioner filed in other proceedings, if the statements are timely made of record. *Cf. Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360–61 (Fed. Cir. 2017) (extending the prosecution disclaimer doctrine to include patent owner’s statements made in a preliminary response that was submitted in a prior AIA proceeding). To the extent that a party wants such information to be considered by the Board, that party should point out specifically the statements and explain how those statements support or contradict a party’s proposed claim construction in the proceeding at issue. Each party bears the burden of providing sufficient support for any construction advanced by that party. Furthermore, the Board may take into consideration statements made by a patent owner or petitioner about claim scope, such as those submitted under 35 U.S.C. § 301(a), for example.

The petitioner and patent owner have opportunities, during the preliminary stage, to submit their proposed claim constructions (in a petition and preliminary response, respectively) and any supporting evidence, including both intrinsic and extrinsic evidence. Upon consideration of the

parties' proposed claim constructions and supporting evidence, the Board will provide an initial claim construction determination in the institution decision, to the extent that such construction is required to resolve the disputes raised by the parties. If a trial is instituted, the parties also will have opportunities to cross-examine any opposing declarants, and to submit additional arguments and evidence, addressing the Board's initial claim construction determination and the opposing party's arguments and evidence before oral hearing. The Board also will consider the entirety of the trial record, including the claim language itself, the specification, prosecution history pertaining to the patent, extrinsic evidence as necessary, and any prior claim construction determinations from the federal courts and ITC that have timely been made of record, before entering a final written decision that sets forth the final claim construction determination. All parties will have a full and fair opportunity to present arguments and evidence prior to any final determination.

### **C. Patent Owner Preliminary Response**

For IPR, PGR, and CBM proceedings, a patent owner may file a preliminary response within three months after the Notice of Filing Date Accorded to Petition. 37 C.F.R. §§ 42.107(b), 42.207(b). The preliminary response may present arguments and supporting evidence (including testimonial evidence) to demonstrate that no review should be instituted. 37 C.F.R. §§ 42.107(a), 42.207(a). For example, a patent owner preliminary response may include one or more of the following arguments:

- (1) The petitioner is statutorily barred from pursuing a review;

- (2) The references asserted to establish that the claims are unpatentable are not in fact printed publications;
- (3) The prior art lacks a material limitation in a challenged claim;
- (4) The prior art does not teach or suggest a combination that the petitioner is advocating;
- (5) The petitioner's claim interpretation for the challenged claims is unreasonable;
- (6) If a PGR or CBM petition raises 35 U.S.C. § 101 grounds, a brief explanation as to how the challenged claims are directed to a patent-eligible invention; or
- (7) Reasons why the Director should exercise his or her discretion and deny institution under 35 U.S.C. § 314 and/or § 325(b).

Testimonial evidence is permitted to be submitted with a preliminary response. “[B]ut, a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute [a review].” 37 C.F.R. §§ 42.108(c), 42.208(c). This allows the petitioner to have an opportunity to cross-examine the declarant during the trial. No negative inference will be drawn if a patent owner decides not to present testimonial evidence with a preliminary response.

Not every factual contradiction rises to the level of a genuine issue of material fact at the preliminary stage of a proceeding. As the Federal Circuit has recognized, “[t]he mere existence in the record of dueling expert testimony does not necessarily raise a genuine issue of material fact.” *Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed.

Cir. 2016) (citing *KTEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1374–76 (Fed. Cir. 2012) (affirming grant of summary judgment that design patent was not analogous art, despite contrary opinion in expert report); *Minkin v. Gibbons, P.C.*, 680 F.3d 1341, 1351–52 (Fed. Cir. 2012) (indicating that summary judgment of invalidity may be available notwithstanding expert report supporting validity)).

The weight to be given testimonial evidence submitted with the preliminary response in reaching the final written decision will be decided on a case-by-case basis. In general, a party has the opportunity to cross-examine a witness providing declaration testimony submitted by another party, after institution, unless the Board orders otherwise. 37 C.F.R. § 42.51(b)(1)(ii). If a trial is instituted, a patent owner may choose not to rely on testimony submitted with the preliminary response. In that case, the patent owner should advise the Board of its decision, which can be done by affirmatively withdrawing the testimony in the patent owner response. If a patent owner withdraws a declaration submitted with its preliminary response, that declarant will usually not be subject to deposition on the withdrawn declaration. If, on the other hand, the patent owner does not withdraw a declaration submitted with its preliminary response, that declaration may be relied upon during the trial, and the declarant would usually be subject to discovery and deposition in the ordinary course of the trial.

Submission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence. A petitioner may seek leave to file a reply to the

preliminary response in accordance with 37 C.F.R. §§ 42.23 and § 42.24(c). 37 C.F.R. §§ 42.108(c), 42.208(c). Any such request must make a showing of good cause. The decision concerning whether the petitioner will be afforded a reply and the appropriate scope of such a reply rests with the panel deciding the proceeding to take into account the specific facts of the particular case. However, the Board does not expect that such a reply will be granted in many cases due to the short time period the Board has to reach a decision on institution.

Where a patent owner seeks to expedite the proceeding, the patent owner may file an election to waive the patent owner preliminary response. 37 C.F.R. §§ 42.107(b), 42.207(b). No adverse inference will be taken by such an election. Moreover, a patent owner may file a statutory disclaimer of one or more challenged claims to streamline the proceedings. Where no challenged claims remain, the Board would terminate the proceeding. Where one or more challenged claims remain, the Board's decision on institution would be based solely on the remaining claims. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1315 (Fed. Cir. 2016); *Sony Computer Entm't Am. Inc. v. Dudas*, 2006 WL 1472462 (E.D. Va. May 22, 2006).

Once a trial is instituted, the Board may decline to consider arguments set forth in a preliminary response unless they are raised in the patent owner response. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (explaining that a patent owner waives an issue presented in its preliminary response if it fails to renew the issue in its response after trial is instituted).

## 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;<sup>1</sup>
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.

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<sup>1</sup> Since *General Plastic*, the Board has held that the application of the first *Generic Plastic* factor is not limited to instances where multiple petitions are filed by the same petitioner. See *Valve Corp. v. Elec. Scripting Prods., Inc.*, Case IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (precedential) (denying institution when a party filed follow-on petitions for *inter partes* review after the denial of an *inter partes* review request of the same claims filed by the party's co-defendant). When different petitioners challenge the same patent, the Board considers the relationship, if any, between those petitioners when weighing the *General Plastic* factors. *Id.*



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.<sup>2</sup> 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

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<sup>2</sup> For example, in *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, Case IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (precedential), the Board denied institution under § 325(d). The Board also found that the advanced state of a parallel district court proceeding was an additional factor weighing in favor of denying institution under § 314(a). *Id.* at 19–20. Specifically, the Board noted the district court proceeding involved the same prior art and arguments, had already construed claim terms, and was set for trial six months before the Board would complete its own proceeding. *Id.*

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.

#### Parallel Petitions Challenging the Same Patent

Based on the Board's prior experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b). In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. In such cases two petitions by a petitioner may be needed, although this should be rare. Further, based on prior experience, the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions,<sup>3</sup> identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a). The Board encourages the petitioner to use a table to aid in identifying the similarities and differences between petitions.<sup>4</sup>

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<sup>3</sup> A separate paper filed with the petitions is limited to providing this explanation and shall be no more than 5 pages where the same paper is filed with each petition.

<sup>4</sup> Prior to the issuance of this guide, a panel requested from the petitioner and patent owner an additional paper after the patent owner preliminary response to address these issues. *See Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, Case IPR2019-00224, -00225, -00226, -00227, -00228, -00229 (PTAB April 3, 2019) (Paper 10). Panels may continue to authorize such papers for petitions submitted before the publication of this guide. After the publication of this guide, it will be expected that petitioners will justify multiple petitions in the first instance in their petitions or in a separate paper with the petitions, and patent owners will respond in their preliminary responses or in a separate paper with their preliminary responses.

If the petitioner provides this information, the patent owner could, in its preliminary responses or in a separate paper filed with the preliminary responses,<sup>5</sup> respond to the petitioner and explain why the Board should not exercise its discretion to institute more than one petition (if it institutes at all). Among other issues, the patent owner should explain whether the differences identified by the petitioner are directed to an issue that is not material or not in dispute. If stating that issues are not material or in dispute, the patent owner should clearly proffer any necessary stipulations. For example, the patent owner may seek to avoid additional petitions by proffering a stipulation that certain claim limitations are not disputed or that certain references qualify as prior art. The Board will consider the parties' submissions in determining whether to exercise its discretion to institute *inter partes* review under 35 U.S.C. § 314(a).

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

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<sup>5</sup> A separate paper filed with the preliminary responses is limited to providing this explanation and shall be no more than 5 pages where the same paper is filed with each preliminary response.

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.

### **3. Content of Decision on Whether to Institute**

In instituting a trial, the Board will either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution. The Board will not institute on fewer than all claims or all challenges in a petition. *See SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–62 (Fed. Cir. 2018); and *Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018). The Board generally will provide analysis of the strengths and weaknesses of all challenges in the petition in order to provide guidance to the parties for the upcoming trial. The Board retains the discretion to deny institution of the petition as a whole under 35 U.S.C. §§ 314(a) and 325(d) under

appropriate circumstances, even when the petition includes at least one claim subject to a challenge that otherwise meets the criteria for institution. *See Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310 (PTAB Jan. 24, 2019) (Paper 7) (informative); *Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923 (PTAB Nov. 7, 2018) (Paper 9) (informative). If a panel determines that a petition meets the standards for institution in relation to fewer than all the challenges presented, or where deficiencies in the petition (such as a failure to provide a construction under 35 U.S.C. § 112(f)) affect only a portion of the challenges presented, the panel will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied. *See* 37 C.F.R. §§ 316(b), 326(b).

Where no trial is instituted, a decision to that effect will be provided. The Board expects that the decision will contain a short statement as to why the standards were not met, although this may not be necessary in all cases. A party dissatisfied with a decision whether or not to institute may file a request for rehearing before the Board, but the Board's determination on whether to institute a trial is final and nonappealable. 35 U.S.C. §§ 135(a) and 314(d), as amended; 35 U.S.C. § 324(e); 37 C.F.R. § 42.71(c).

## **G. Motions to Amend**

### **1. IPR, PGR, and CBM Amendments**

Patent owners in IPR, PGR, and CBM proceedings may file motions to amend the claims subject



to certain conditions. 37 C.F.R. §§ 42.20, 42.121, 42.221.

### Motion to Amend

Although patent owners may file a first motion to amend and need not obtain prior Board authorization, the patent owner is still required to confer with the Board before filing the motion. 37 C.F.R. §§ 42.121(a), 42.221(a). During a conference call or by email communication, the panel will provide procedural guidance to the patent owner and petitioner regarding the motion. Patent owners are encouraged to contact the Board to arrange a conference call as early as possible after deciding to file a motion to amend, to allow time for any discussion or guidance provided during the conference call to be incorporated into the motion.

### Motion to Amend Practice

The motion to amend practice is currently under review by the Office. On March 15, 2019, the Office issued a notice of a pilot program for motion to amend practice and procedures that provides the patent owner with additional options regarding the motion to amend process. These options include (1) requesting preliminary guidance from the Board in its first motion to amend, and (2) filing a revised motion to amend. *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019). Further information on current motion to amend practice may be found at the following website: <https://www.uspto.gov/patents-application-process/patenttrialandappealboard>.

### Due Date

A motion to amend must be filed no later than the time period for filing a patent owner response, unless a different due date is provided in a Board order. 37 C.F.R. §§ 42.121(a), 42.221(a).

### Evidentiary Standards

On October 4, 2017, the U.S. Court of Appeals for the Federal Circuit issued an en banc decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017). In the decision containing five separate opinions, the court addressed the burden of persuasion that the Board applies when considering the patentability of substitute claims presented in a motion to amend filed under 35 U.S.C. § 316(d) in an IPR. The lead opinion concludes with the following.

The only legal conclusions that support and define the judgment of the court are: (1) the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference; and (2) in the absence of anything that might be entitled deference, the PTO may not place that burden on the patentee.

*Aqua Prods.*, 872 F.3d at 1327.

In accordance with *Aqua Products*, a patent owner does not bear the burden of persuasion to demonstrate the patentability of substitute claims presented in a motion to amend. Rather, the burden of persuasion ordinarily will lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence. The Board itself also may justify any finding of unpatentability by reference to evidence of record in the proceeding, for example, when a petitioner ceases to participate. Ultimately, the Board determines whether substitute

claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, -01130, slip op. at 3-4 (PTAB Feb. 25, 2019) (Paper 15) (precedential) (providing additional information and guidance regarding motions to amend, such as statutory and regulatory requirements as set forth in 35 U.S.C. § 316(d) and 37 C.F.R. §§ 42.121 and 42.221). Thus, for example, if the entirety of the evidence of record before the Board is in equipoise as to the unpatentability of one or more substitute claims, the Board will grant the motion to amend with respect to such claims, and the Office will issue a certificate incorporating those claims into the patent at issue.

#### Contents of Motion to Amend

Any motion to amend must comply with the content requirements of 37 C.F.R. §§ 42.121(b) or 42.221(b). 37 C.F.R. §§ 42.121(b) and 42.221(b) require that any motion to amend include a claim listing, show the changes being sought clearly, and describe how the original disclosure of the patent and any relied upon prior application supports each claim that is added or amended. The claim listing may be contained in an appendix to the motion. 37 C.F.R. §§ 42.121(b), 42.221(b). A patent owner may not enlarge the scope of the claims of the patent or add new matter. 35 U.S.C. §§ 316(d)(3), 326(d)(3). Where a motion seeks to replace an original patent claim with a new claim, the new claim should be identified as a proposed substitute claim, specifying the original claim for which the new claim is a proposed substitute, with all changes relative to the original claim clearly identified and discussed. Any motion to amend must also

set forth the support in the original disclosure of the patent as well as any application for which benefit of the filing date of the earlier filed disclosure is sought. 37 C.F.R. §§ 42.121(b), 42.221(b).

A patent owner should identify specifically the feature(s) added to each substitute claim and any proposed constructions for new claim terms. Although not required, patent owners may offer arguments regarding patentability of any proposed substitute claim and may support their arguments regarding patentability with testimony from a technical expert. For example, such testimony may be helpful to show what would have been known to a person of ordinary skill in the art and explain the significance of features added in a proposed substitute claim.

#### Claim Construction

In relation to any AIA petition filed on or after November 13, 2018, the Board will interpret claims at issue in the proceeding, including substitute claims proposed in a motion to amend, using the same standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b); Final Rule, 83 Fed. Reg. 51,340 (Oct. 11, 2018).

When filing a motion to amend, a patent owner may seek to demonstrate that the scope of the amended claim is substantially identical to that of the original patent claim, as the original patent claim would have been interpreted by a district court. In such cases, a patent owner may request that the Board determine that the amended claim and original patent claim are substantially

identical within the meaning of 35 U.S.C. § 252. *See Google Inc. v. ContentGuard Holdings, Inc.*, Case CBM2015-00040, slip op. at 69–72 (PTAB June 21, 2016) (Paper 34) (determining that a substitute claim proposed by the patent owner was “substantially identical” to the original claim).

## **2. Amendments in Derivation Proceedings**

The filing of a motion to amend claims by a petitioner or respondent in a derivation proceeding will be authorized upon a showing of good cause. 37 C.F.R. § 42.20. An example of good cause is where the amendment materially advances settlement between the parties or seeks to cancel claims. The Board expects, however, that a request to cancel all of a party’s disputed claims will be treated as a request for adverse judgment. 37 C.F.R. § 42.73(b).

## **3. General Practice Tips on Amendments**

Motions to amend claims are expected to be filed by the due dates set for filing a patent owner response. To reduce the number of issues in dispute, however, motions to cancel claims will generally be permitted even late in the proceeding, as will motions to amend to correct simple and obvious typographical errors.

Amendments should clearly state where the specification and any drawings support all the limitations in the proposed substitute claims. If the Board is unable to determine how the specification and drawings support the proposed substitute claims, the motion to amend may be

denied.

Motions to amend must respond to a ground of unpatentability involved in the trial. 37 C.F.R. § 42.121(a)(2)(i). The rule does not require, however, that every word added to or removed from a claim in a motion to amend be solely for the purpose of overcoming an instituted ground.

Additional modifications that address potential 35 U.S.C. § 101 or § 112 issues, for example, are not precluded by rule or statute. *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, -01130, slip op. at 5–6 (PTAB Feb. 25, 2019) (Paper 15) (precedential).

Motions to amend should clearly state the patentably distinct features for proposed substitute claims. This will aid the Board in determining whether the amendment enlarges the claims and if the amendment is responsive to the grounds of unpatentability involved in the trial.

“Under 37 C.F.R. § 42.11, all parties have a duty of candor, which includes a patent owner’s duty to disclose to the Board information of which the patent owner is aware that is material to the patentability of substitute claims, if such information is not already of record in the case.” *Id.* at 9–10.

The number of substitute claims must be “reasonable.” There is a presumption that only one substitute claim would be needed to replace each challenged claim. 37 C.F.R. §§ 42.121(a), 42.221(a). This presumption may be rebutted by a demonstration of need.

## **H. Opposition to a Motion to Amend**

A petitioner will be afforded an opportunity to fully respond to a patent owner's motion to amend. The time for filing an opposition generally will be set in a Scheduling Order.

No authorization is needed to file an opposition to a motion to amend. Petitioners may respond to new issues arising from proposed substitute claims and may include evidence responsive to the amendment. 35 U.S.C. §§ 316(a), 326(a). This includes the submission of new expert declarations or additional prior art that are directed to the proposed substitute claims.

The grounds of unpatentability that can be raised in response to proposed substitute amended claims presented in a motion to amend are not limited by 35 U.S.C. § 311(b). In contrast to § 311(b), the statutory provision providing a right to a motion to amend, 35 U.S.C. § 316(d), does not prevent the Board from considering unpatentability under sections other than § 102 and § 103 with respect to substitute claims. *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-00948, slip op. at 5 (PTAB Jan. 18, 2019) (Paper 34) (precedential). Thus, petitioner may raise, and the Board may consider, other grounds of unpatentability, including § 101 and § 112, as to proposed substitute claims.

## **I. Reply to Patent Owner Response and Reply to Petitioner Opposition to a Motion to Amend**

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. A party also may submit rebuttal evidence in support of its reply. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015).

A reply may only respond to arguments raised in the corresponding opposition. 37 C.F.R. § 42.23. “Respond,” in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the position taken in the original petition or motion to amend, or the decision on institution. While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence may not be considered. The Board is not required to attempt to sort proper from improper portions of the reply. Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing. *See Intelligent Bio-Sys., 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).

## **J. Other Motions**

There are many types of motions that may be filed in a proceeding in addition to motions to



amend. Examples of additional motions include motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, etc.

Where a party believes it has a basis to request relief on a ground not identified in the rules, the party should contact the Board and arrange for a conference call with the Board and opposing party to discuss the requested relief with the judge handling the proceeding.

When filing the motion, the party must comply with the appropriate requirements. For example, a motion to submit supplemental information must meet the requirements of 37 C.F.R. §§ 42.123 or 42.223 that: (1) a request for the authorization to file a motion to submit supplemental information be made within one month of the date the trial is instituted; and (2) the supplemental information must be relevant to a claim for which the trial has been instituted. Further, a party seeking to submit supplemental information more than one month after the date the trial is instituted must request authorization to file a motion to submit the information. Such a motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice. 37 C.F.R. §§ 42.123(b) or 42.223(b).

#### Motions for Joinder

A party may seek to join a first proceeding by filing a motion for joinder within one month of the

date that a trial is instituted as to the first proceeding. 37 C.F.R. §§ 42.122, 42.222. A party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion. The purpose of the conference call is for the panel to timely manage the proceedings.

Factors that the Board may consider in deciding a motion for joinder include why joinder is appropriate, whether a new ground of unpatentability is raised in the second petition, how the cost and schedule of the first proceeding will be impacted if joinder is granted, and whether granting joinder will add to the complexity of briefing and/or discovery. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004 (PTAB Apr. 24, 2013), slip op. at 4 (Paper 15).

The Board has discretion under 35 U.S.C. § 315(c) to join a petitioner to a proceeding in which it is already a party and to allow joinder of new issues into an existing proceeding. *Proppant Express Invs. v. Oren Techs.*, Case IPR2018-00914, slip op. at 3–4 (PTAB Mar. 13, 2019) (Paper 38) (precedential). Furthermore, the existence of a time bar under 35 U.S.C. § 315(b) is one of several factors that may be considered when exercising discretion under 35 U.S.C. § 315(c). *Proppant*, Case IPR2018-00914, slip op. at 4. Thus, when an otherwise time-barred petitioner requests same party and/or issue joinder, the Board may exercise its discretion to permit joinder, but will do so only where fairness requires it and to avoid undue prejudice to a party. *Id.* at 19. The Board expects to exercise its discretion to permit such joinder only in extremely limited circumstances. *Id.* Circumstances leading to this narrow exercise of discretion to permit such

joinder may include, for example, certain actions taken by a patent owner in a co-pending litigation such as certain late additions of newly asserted claims. *Id.* The Board does not generally expect fairness and prejudice concerns to be implicated by, for example, the mistakes or omissions of a petitioner. *Id.* The conduct of the parties and attempts to game the system may also be considered. *Id.* In this way, the Board can carefully balance the interest in preventing harassment against fairness and prejudice concerns on a case-by-case basis, based on the facts then before it. *Id.*

Other factors may also be important when considering whether to grant joinder to an otherwise time-barred petitioner requesting same party and/or issue joinder. For example, the stage and schedule of an existing *inter partes* review might make joinder to that proceeding inappropriate. *Id.* Also, consideration of the non-exclusive factors set out in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i), may support the exercise of the Board’s discretion to deny institution under 35 U.S.C. § 314(a). *Proppant*, Case IPR2018-00914, slip op. at 19. Events in other proceedings related to the patent at issue may also weigh on the Board’s discretion in a given case. *Id.*

In proceedings in which one or more parties are joined, the Board is permitted to adjust the one-year statutory deadline for issuing a final written decision. *See* 35 U.S.C. §§ 316(a)(11), 326(a)(11) (“[T]he final determination in [an *inter partes* or post-grant] review [shall] be issued

not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director . . . may adjust the time periods in this paragraph in the case of joinder”); *see also* 37 C.F.R. §§ 42.100(c), 42.200(c), 42.300(c) (An IPR, PGR, or CBM “proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be . . . adjusted by the Board in the case of joinder.”).

Notwithstanding joinder, the Board will endeavor to issue a final written decision within one year from the date a trial is instituted. In cases where the joined party adds additional claims, grounds, evidence, or arguments that complicate the proceeding, however, it is more likely that the Board will adjust the deadline for issuing a final written decision. If possible, such adjustments will not exceed an additional six months. In the case of joinder, if the Board determines that it will adjust the deadline for issuing a final written decision, the Board will specify the new deadline in an order issued prior to the expiration of the one-year statutory time period in the case to which the current petitioner is joined. *See, e.g., Apple, Inc. v. Evolved Wireless LLC*, Case IPR2016-00758 (PTAB Oct. 12, 2017) (Paper 44).

#### **O. Final Decision**

For IPR, PGR, and CBM proceedings, the Board will enter a final written decision not more than one year from the date a trial is instituted, except that the time may be extended up to six months for good cause. This timeline may also be adjusted in case of joinder (see above). The Board

expects that a final written decision will address the issues necessary for resolving the proceeding.

In the case of derivation proceedings, although not required by statute, the Board expects to provide a final decision not more than one year from the institution of the proceeding. The Board will provide a final decision as to whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner's application and filed the earlier application claiming such invention without authorization.

### Remands

The Board has established a goal to issue decisions on cases remanded from the Court of Appeals for the Federal Circuit for further proceedings within six months of the Board's receipt of the Federal Circuit's mandate. The procedure and pace of a remand following a Federal Circuit decision will vary depending on the type of case, the legal and factual issues involved, the specific instructions from the Federal Circuit, the recommendations of the parties, and any other particularities of the case. For additional information on remands, see the Board's Standard Operating Procedure 9. PAT. TRIAL & APP. BD., USPTO, STANDARD OPERATING PROCEDURE 9: PROCEDURE FOR DECISIONS REMANDED FROM THE FEDERAL CIRCUIT FOR FURTHER PROCEEDINGS.

To facilitate the Board's timely issuance of decisions on remand, parties in remanded trial cases

are to contact the Board within ten business days after the mandate issues to arrange a conference call with the panel. Before the conference call, the parties shall meet and confer in a reasonable and good faith attempt to propose a procedure on remand. Parties are encouraged to seek agreement, if possible, on remand procedures including, but not limited to: (1) whether additional briefing is necessary; (2) subject matter limitations on briefing; (3) length of briefing; (4) whether the parties should file briefs concurrently or sequentially; (5) if briefs are filed sequentially, which party should open the briefing; (6) whether a second brief from either party should be permitted; (7) the briefing schedule; (8) whether either party should be permitted to supplement the evidentiary record; (9) limitations, if any, on the type of additional evidence that will be submitted; (10) the schedule for submitting additional evidence, if any; and (11) any other relevant procedural issues. Conference calls with the Board should take place within the first month after the mandate issues.

The Board will consider the parties' proposals and decide the procedures to be followed. For example, the Board will decide whether to permit additional briefing and additional evidence (testimonial and documentary) or hold additional hearings following a remand, taking into account, among other considerations, the scope of the remand, as determined from the reasoning and instructions provided by the Federal Circuit, and 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), 326(b).

In deciding whether to permit additional briefing and the introduction of additional evidence, the Board may take into account whether the parties already have had an adequate opportunity to address the issues raised by the remand with the briefing and evidence already of record.

Additional briefing, when permitted, will normally be limited to the specific issues raised by the remand. *See Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2012-00026 (PTAB Sept. 1, 2015) (Paper 77); *see also Dell Inc., v. Acceleron, LLC*, Case IPR2013-00440 (PTAB May 26, 2016) (Paper 46). Moreover, unless the Federal Circuit's opinion directs the Board to reopen the evidentiary record, a party seeking to re-open the evidentiary record will be expected to demonstrate why the evidence already before the Board is inadequate and to show good cause why additional evidence is necessary. The Board may also consider whether any authorized additional briefing would be sufficient without the submission of additional evidence, as well as how much additional time would be necessary to develop a new evidentiary record. In most cases, an additional oral hearing will not be authorized, as the existing record and previous oral argument normally will be sufficient. However, in those situations where new evidence is permitted, the Board may authorize additional oral argument.

Although no statutory time limit exists for completion of a re-opened proceeding following remand, the Board recognizes that delays caused by re-opening the record after remand may be inconsistent with the Board's stated goal of issuing a remand decision within six months from the mandate. Accordingly, the Board also will consider the time and expense that permitting additional briefing and new evidence will add to the proceeding, consistent with the expression

of Board policy in 37 C.F.R. § 42.1(b): “This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”

Absent good cause, proceedings on remand generally will not be stayed once the Federal Circuit has issued its mandate, even when a party has petitioned the Supreme Court for a writ of certiorari. A party may contact the Board to request authorization to file a motion for a stay of proceedings on remand. The Board will consider such requests on a case-by-case basis. The Board may require briefing on a motion to stay the remand proceedings, or, for convenience, the issue may be discussed and decided in a conference call. In deciding whether to stay remanded proceedings, the Board may consider, among other things, whether the Supreme Court’s judgment would impact the Board’s decision on remand. *See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC*, Case IPR2013-00226 (PTAB Feb. 8, 2017) (Paper 57) (denying request to stay because the issue on remand was separable from, and not influenced by, the question presented in the certiorari petition). The Board’s decision not to stay remanded proceedings does not affect the right of a party to petition the Supreme Court for a writ of certiorari.

#### **P. Rehearing Requests**

A party dissatisfied with a decision of the Board may file a request for rehearing. 37 C.F.R. § 42.71. The burden of showing that a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and where each matter was previously addressed in a



motion, an opposition, or a reply. “Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue ‘good cause’ exists for admitting the new evidence. Alternatively, a party may argue ‘good cause’ exists in the rehearing itself.” *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, Case IPR2018-00816, slip op. at 4 (PTAB Jan. 8, 2019) (Paper 19) (precedential). Absent a showing of “good cause” prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted. *Id.*

The opposing party should not file a response to a request for rehearing absent a request from the Board. The Board envisions that, absent a need for additional briefing by an opponent, requests for rehearing will be decided approximately one month after receipt of the request.

## **APPENDIX B: Protective Order Guidelines (based on the trial rules).**

(a) Purpose. This document provides guidance on the procedures for filing of motions to seal and the entry of protective orders in proceedings before the Board. A protective order is not entered by default but must be proposed by one or more parties and must be approved and entered by the Board. The protective order governs the protection of confidential information contained in documents, discovery, or testimony adduced, exchanged, or filed with the Board. The parties are encouraged to agree on the entry of a stipulated protective order. Absent such agreement, the default protective order may be entered by the Board.

(b) Timing; lifting or modification of the Protective Order. The terms of a 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 either on the motion of a party for good cause shown or *sua sponte* by the Board.

(c) Protective Order to Govern Treatment of Confidential Information. The terms of a protective order govern the treatment of the confidential portions of documents, testimony, and other information designated as confidential, as well as the filing of confidential documents or discussion of confidential information in any papers filed with the Board. The Board shall have the authority to enforce the terms of the Protective Order, to provide remedies for its breach, and to impose sanctions on a party and a party's representatives for any violations of its terms.

(d) Contents. The Protective Order shall include the following terms:

(1) Designation of Confidential Information. The producing party shall have the obligation to clearly mark as “PROTECTIVE ORDER MATERIAL” any documents or information considered to be confidential under the Protective Order.

(2) Persons Entitled to Access to Confidential Information. A party receiving confidential information shall strictly restrict access to that information to the following individuals who first have signed and filed an Acknowledgement as provided herein:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Other Employees of a Party. Employees (*e.g.*, corporate officers), consultants, or other persons performing work for a party, other than in-house counsel and in-house counsel’s support staff, who sign the Acknowledgement, shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that

person. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

(F) The Office. Employees and representatives of the U.S. Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and staff, other Office support personnel, court reporters, and other persons acting on behalf of the Office.

(G) Support Personnel. Administrative assistants, clerical staff, court reporters, and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding. Such support personnel shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(3) Protection of Confidential Information. Persons receiving confidential information shall take reasonable care to maintain the confidentiality of that information, including:

(A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential

information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed to conduct the proceeding and maintaining a record of the locations of such copies, which similarly must be kept secure.

(4) Treatment of Confidential Information. Persons receiving confidential information shall use the following procedures to maintain confidentiality of documents and other information—

(A) Documents and Information Filed With the Board.

(i) A party may file documents or information with the Board under seal, together with a non-confidential description of the nature of the confidential information that is under seal and the reasons why the information is confidential, or if the information has been designated as confidential by the opposing party, that party shall set forth the reasons why the information redacted is confidential and should not be made available to the public. The submission shall be treated as confidential and remain under seal, unless upon motion of a party or response of the designating party and after a hearing on the issue, or *sua sponte*, the Board determines that the documents or information do not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its

submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential, or if the information has been designated as confidential by the opposing party, that party shall set forth the reasons why the information redacted is confidential and should not be made publicly available. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal, unless upon motion of a party or response of the designating party and after a hearing on the issue, or *sua sponte*, the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Information designated as confidential that is disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as “PROTECTIVE ORDER MATERIAL” and shall be produced in a manner that maintains its confidentiality.

(5) Confidential Testimony. Any person providing testimony in a proceeding may, on the record during the testimony, preliminarily designate the entirety of the person’s testimony and all transcriptions thereof as confidential, pending further review. Within ten days of the receipt of the transcript of the testimony, that person, or that person’s representative, shall advise the opposing party of those portions of the testimony to which a claim of confidentiality is to be maintained, and the reasons in support of that claim. Such portions shall be treated as

confidential and maintained under seal in any filings to the Board unless, upon motion of a party and after a hearing on the issue, or *sua sponte*, the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(6) Other Restrictions Imposed By the Board. In addition to the foregoing, the Board may, in its discretion, include other terms and conditions in a Protective Order it enters in any proceeding.

(7) Requirement of Acknowledgement. Any person receiving confidential information during a proceeding before the Board shall, prior to receipt of any confidential information, first sign an Acknowledgement, under penalty of perjury, stating the following:

- (A) The person has read the Protective Order and understands its terms;
- (B) The person agrees to be bound by the Protective Order and will abide by its terms;
- (C) The person will use the confidential information only in connection with that proceeding and for no other purpose;
- (D) The person shall only extend access to the confidential information to support personnel, such as administrative assistants, clerical staff, paralegals, and the like, who are reasonably necessary to assist him or her in the proceeding. The person shall inform such support personnel of the terms and requirements of the Protective Order prior to disclosure of any confidential information to such support personnel and shall be personally responsible for their compliance with the terms of the Protective Order; and

(E) The person agrees to submit to the jurisdiction of the Office for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

(e) Filing of Proposed Protective Order. The party filing a Motion to Seal shall include with its supporting papers a copy of a proposed Protective Order and shall certify that the party accepts and agrees to the terms of the Protective Order. Prior to the receipt of confidential information, any other party to the proceeding also shall certify that the party accepts and agrees to the terms of the proposed Protective Order. The proposed Protective Order shall remain in effect until superseded by a Protective Order entered by the Board. If the parties agree to accept the terms of the Default Protective Order, they are not required to provide a copy but must certify that they accept and agree to its terms.

(f) Duty To Retain Acknowledgements. Each party to the proceeding shall maintain a signed Acknowledgement from each person acting on its behalf who obtains access to confidential information after signing an Acknowledgement, as set forth herein, and shall produce such Acknowledgements to the Office upon request.

(g) Motion to Seal. A party may file an opposition to the motion that may include a request that the terms of the proposed Protective Order be modified including limiting the persons who are entitled to access under the Order. Any such opposition shall state with particularity the grounds for modifying the proposed Protective Order. The party seeking the modification shall have the



burden of proving that such modifications are necessary. While the motion is pending, no disclosure of confidential information shall be made to the persons for whom disclosure is opposed, but the filing of the motion shall not preclude disclosure of the confidential information to persons for whom disclosure is not opposed and shall not toll the time for taking any action in the proceeding.

(h) Other Proceedings. Counsel for a party who receives confidential information in a proceeding will not be restricted by the Board from representing that party in any other proceeding or matter before the Office. Confidential information received in a proceeding, however, may not be used in any other Office proceeding in which the providing party is not also a party.

(i) Disposal of Confidential Information. Within one month after final termination of a proceeding, including any appeals, or within one month after the time for appeal has expired, each party shall assemble all copies of all confidential information it has received, including confidential information provided to its representatives and experts, and shall destroy the confidential information and provide a certification of destruction to the party who produced the confidential information.

(j) Modifications to the Default Protective Order. The parties may propose modifications to the Default Protective Order. The Board will consider changes agreed to by the parties, and

generally will accept such proposed changes if they are consistent with the integrity and efficient administration of the proceedings. For example, the parties may agree to modify the Default Protective Order to provide additional tiers or categories of confidential information, such as “Attorneys’ Eyes Only.” The Board will presumptively accept agreed-to changes that provide additional categories of confidentiality as long as they are reasonable and adequately define what types of materials are to be included in the additional categories. The Board will not accept overly inclusive definitions that encourage the parties to categorize all or most of their discovery materials as “Attorneys’ Eyes Only.”

When a proceeding before the Board involves the same parties and subject matter as a parallel district court proceeding, parties may propose that a protective order entered by the district court be adopted by the Board. The Board may enter such a proposed protective order especially if certain provisions commonly found in district court protective orders that are unnecessary or inappropriate in proceedings before the Board are removed before submitting the proposed protective order to the Board. For example, provisions protecting computer source code may be unnecessary because proceedings before the Board rarely, if ever, require analysis of computer source code. Likewise, prosecution bars are rarely appropriate in proceedings before the Board because the disadvantage caused by a prosecution bar to patent owners wishing to make use of amendment or reissue processes in most cases outweighs the risk that confidential technical information about existing or future commercial products will be revealed during a proceeding. Finally, all terms of district court protective orders that conflict with Board procedures for filing

or otherwise handling confidential information should be removed before the proposed order is submitted to the Board.

#### DEFAULT PROTECTIVE ORDER

The following Default Protective Order will govern the filing and treatment of confidential information in the proceeding:

##### **Default Protective Order**

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked “PROTECTIVE ORDER MATERIAL.”
  
2. Access to confidential information is limited to the following individuals who have executed the acknowledgment appended to this order:
  - (A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.
  - (B) Party Representatives. Representatives of record for a party in the proceeding.
  - (C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.
  - (D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

3. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than in-house counsel and in-house counsel's support staff, who sign the Acknowledgement shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

4. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

(A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

5. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

(A) Documents and Information Filed With the Board.

(i) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may

challenge the confidentiality of the information by opposing the Motion to Seal. The submission shall be treated as confidential and remain under seal, unless the Board determines that the documents or information do not to qualify for confidential treatment. The information shall remain under seal unless the Board determines that some or all of the information does not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as “PROTECTIVE ORDER MATERIAL” and shall be produced in a manner

that maintains its confidentiality.

6. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information must return, or certify the destruction of, all copies of the confidential information to the producing party.

(k) Standard Acknowledgement of Protective Order. The following form may be used to acknowledge a protective order and gain access to information covered by the protective order:

[CAPTION]

**Standard Acknowledgment for Access to Protective Order Material**

I \_\_\_\_\_, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the

United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

[Signature]