

# AIA Trial Roundtables



# Welcome





# Agenda

Time	Topic
1:00 PM	Welcome
1:10 PM	Presentation <ul style="list-style-type: none"><li>• Overview of trials, statistics, and lessons learned (30 minutes)</li><li>• Audience Questions/Comments (20 minutes)</li></ul>
2:00 PM	Mock Conference Call <ul style="list-style-type: none"><li>• Topics include motion to amend and motion for additional discovery (30 minutes)</li><li>• Audience Questions/Comments (20 minutes)</li></ul>
2:50 PM	BREAK (10 minutes)
3:00 PM	Panel Discussion
5:00 PM	Closing Remarks



# Roundtable Materials

- Available at:

[http://www.uspto.gov/ip/boards/bpai/ptab\\_aia\\_trial\\_roundtables\\_2014.jsp](http://www.uspto.gov/ip/boards/bpai/ptab_aia_trial_roundtables_2014.jsp)

# PTAB Presentation



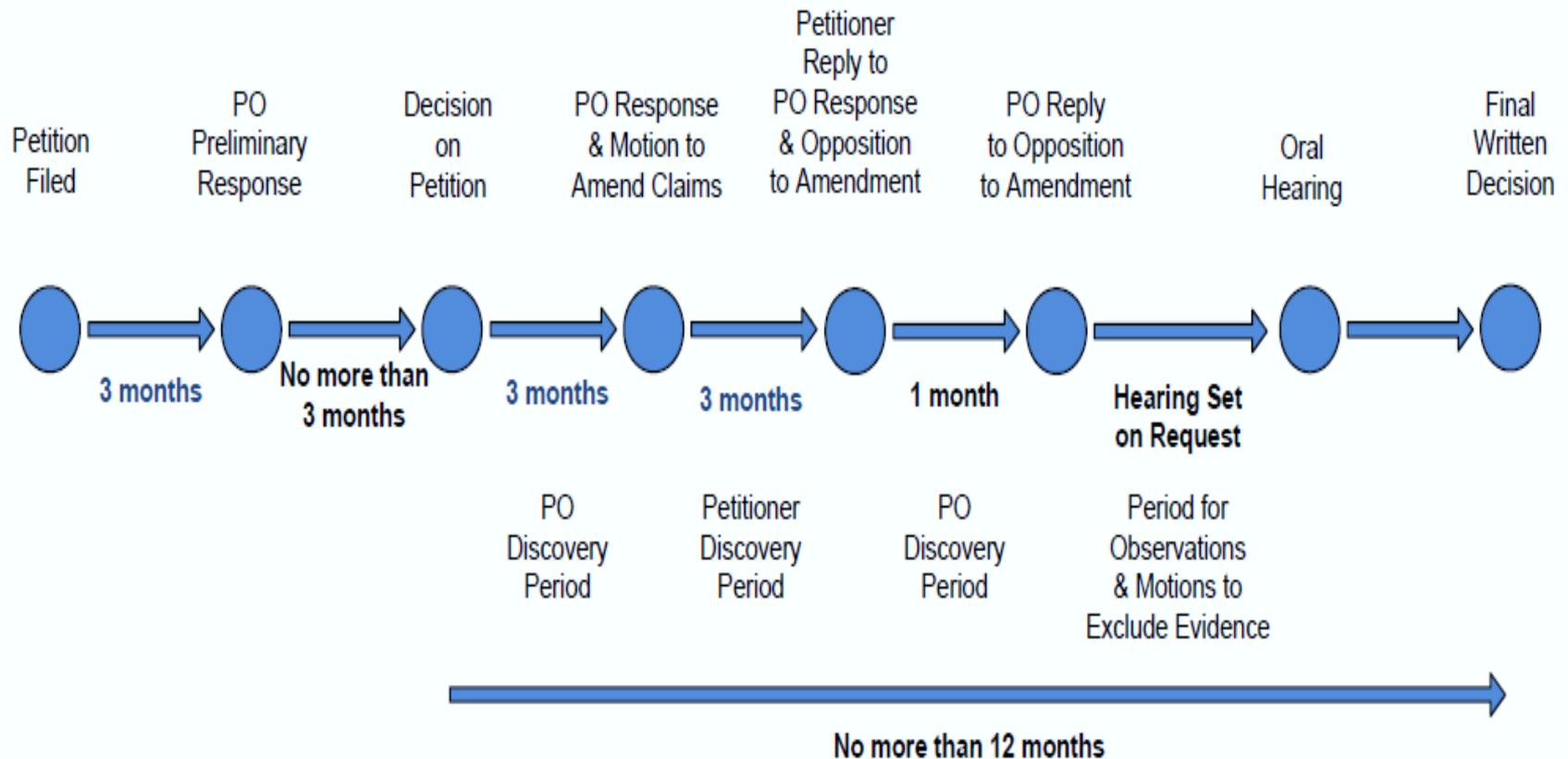


# Overview

- AIA Trials
  - Statistics
  - Lessons Learned
- Administrative Patent Judges
- PTAB Website Tour

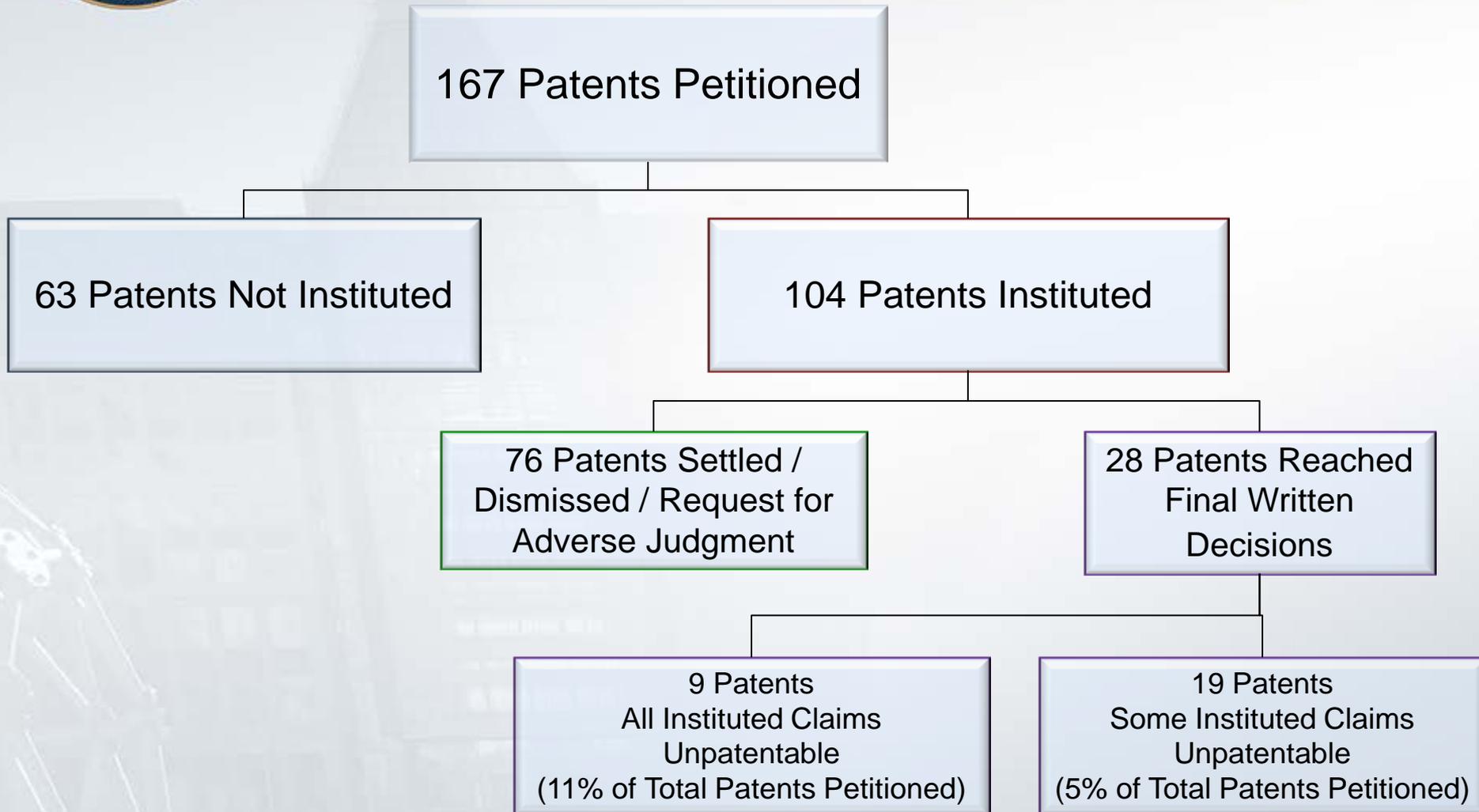


# Trial Proceeding Timeline





# *Inter Partes* Review Petitions Terminated to Date (As of 4/2/2014)





# *Inter Partes* Review Petitions Terminated to Date (As of 4/2/2014)

5,458 Claims in 167 Patents Petitioned

**2,113 Claims Challenged**  
(167 Patents)

**3,345 Claims Not Challenged**

**1,277 Claims Instituted**  
(60% of Claims Challenged)  
(104 Patents)

**836 Claims Challenged but Not Instituted**  
(40% of Claims Challenged)

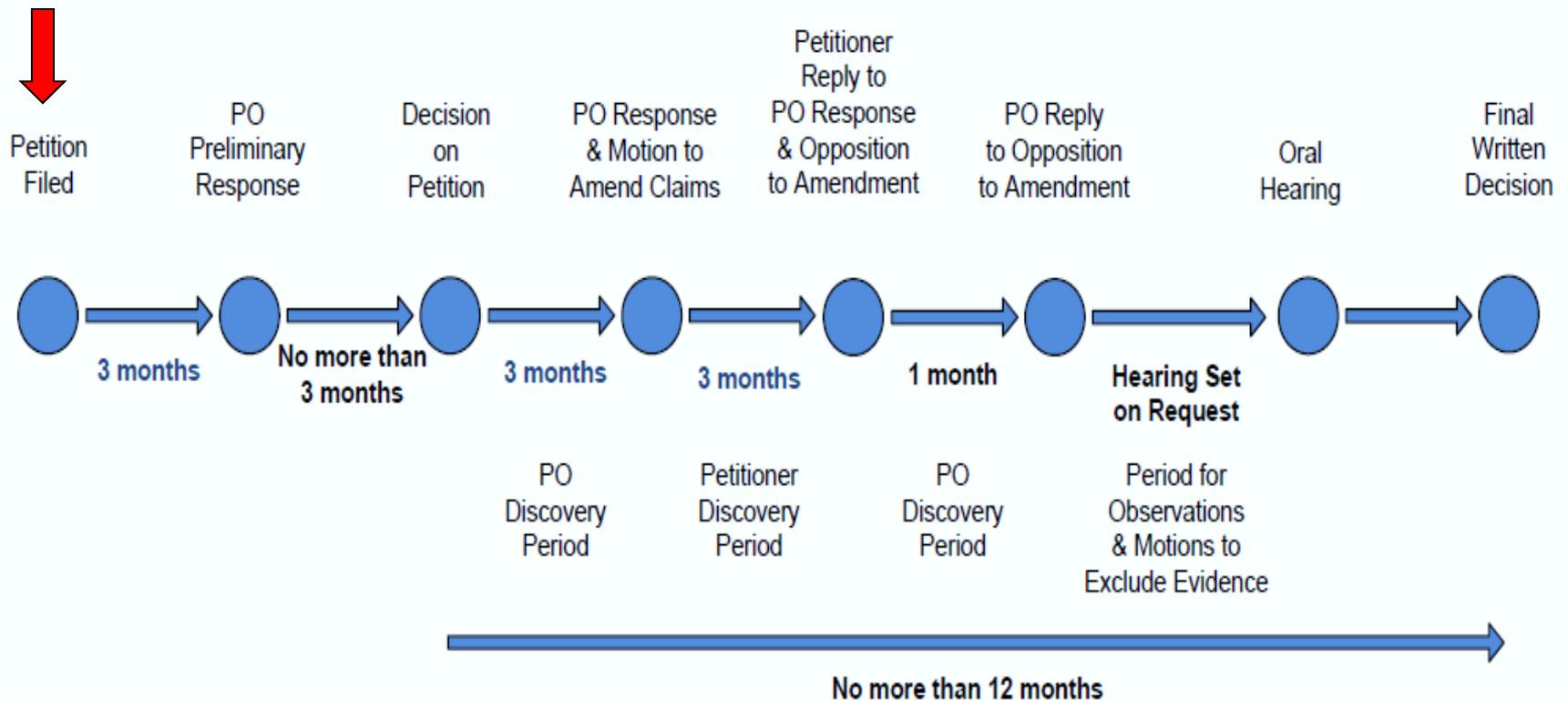
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(26% of Claims Instituted,  
15% of Claims Challenged)  
(28 Patents)

**245 Claims Cancelled or Disclaimed (Non-PTAB)**  
(19% of Claims Instituted, 12% of Claims Challenged)

**705 Claims Patentable**  
(55% of Claims Instituted, 33% of Claims Challenged)



# Petition Filing





# AIA Petitions

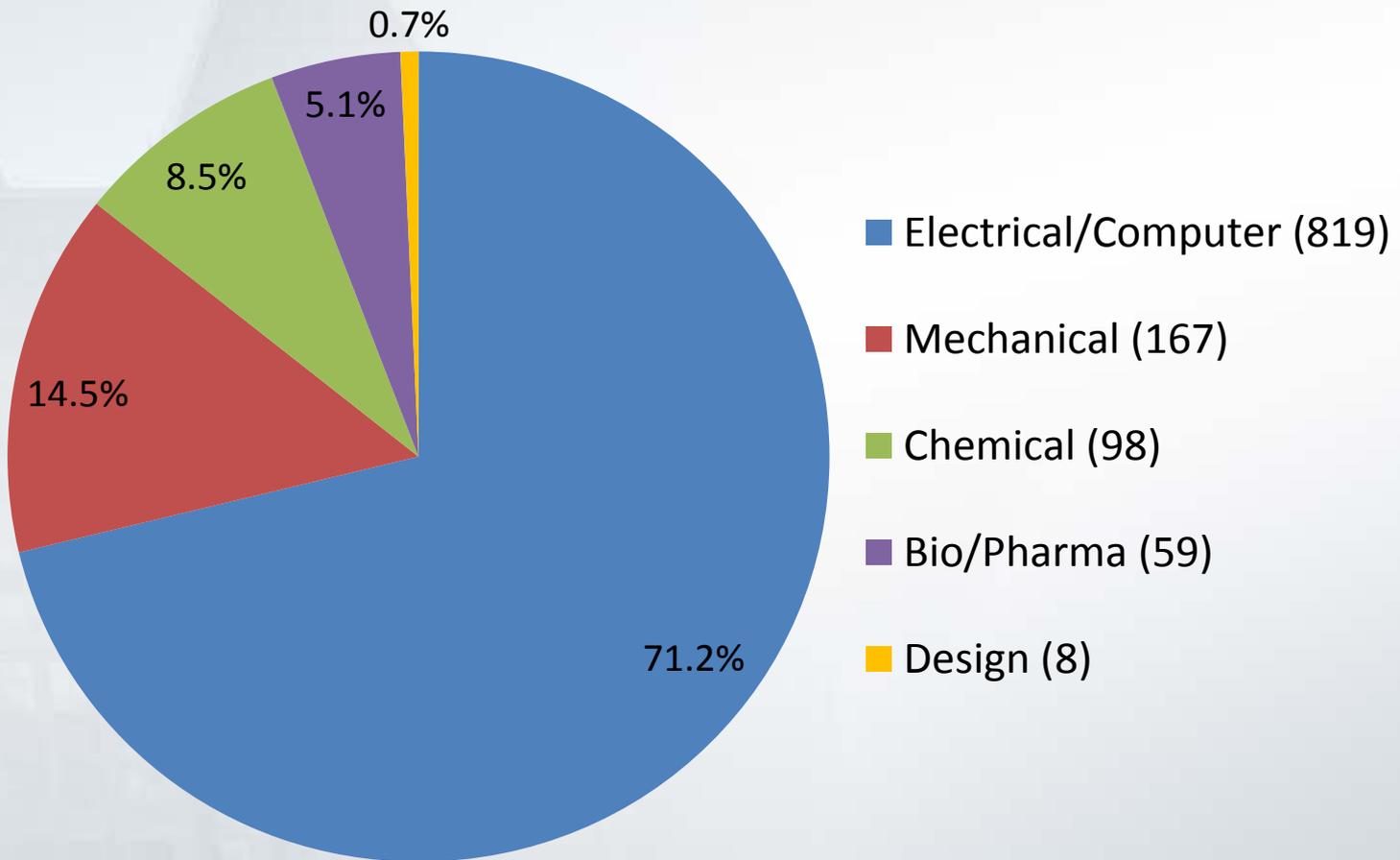
(Cumulative Number as of 4/2/2014)





# AIA Petitions

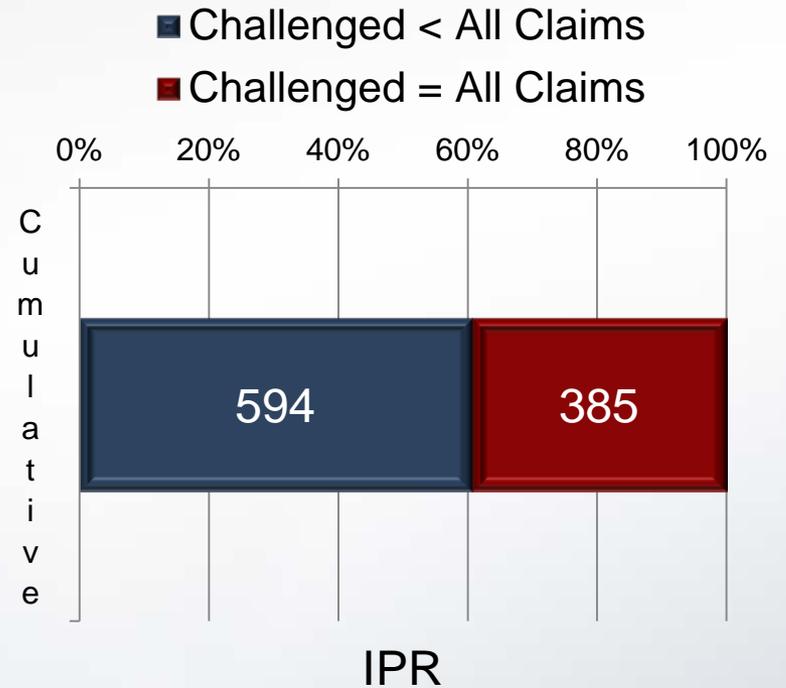
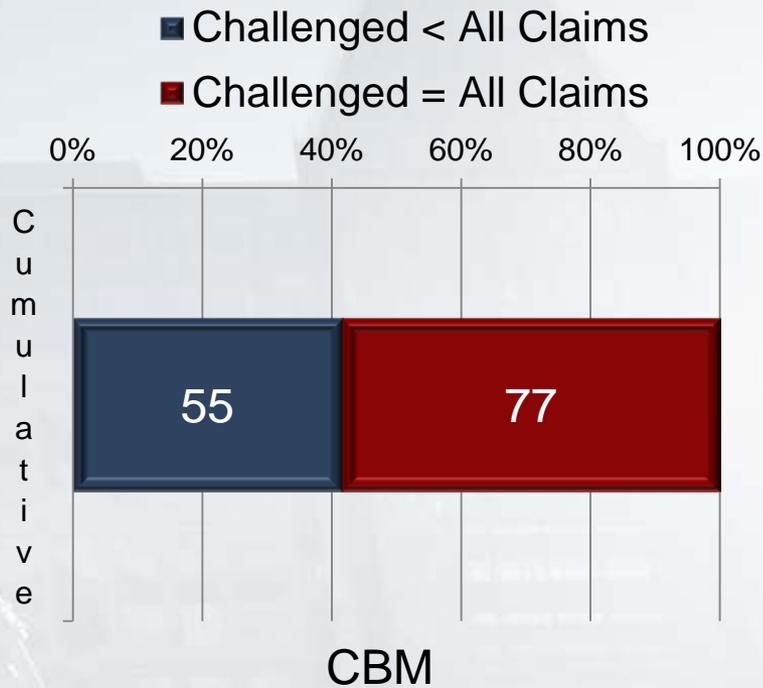
(Technology Breakdown as of 4/2/14)





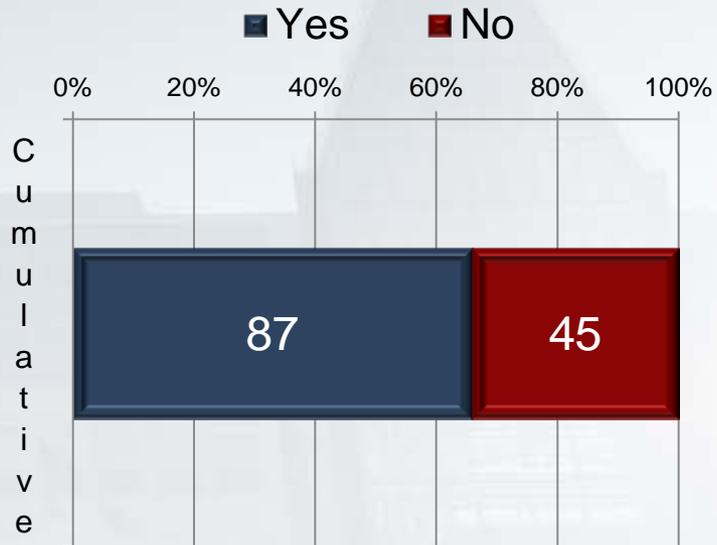
# Petition Challenges

(As of 4/2/2014)





# §101 and § 112 Grounds Raised in CBM Petitions Only (As of 4/2/2014)



101 Grounds



112 Grounds



# Lessons Learned: Petitions

- Conclusions need to be supported by:
  - Sound legal analysis; and
  - Citations to evidentiary record
- Analysis needs to appear in petition itself (no incorporation by reference from declaration)
- Better to provide detailed analysis for limited number of challenges than identify large number of challenges for which little analysis is provided
- See *Wowza Media v. Adobe*, IPR2013-00054 (Paper 12)(denying petition)



# Lessons Learned: Claim Charts

- Use standard two-column format. See FAQ D13
- Claim charts are not sufficient by themselves; they must be explained.
- Claim charts should contain pinpoint references to the supporting evidence. See FAQ D12



# Lessons Learned: Claim Construction

- Claim constructions should be supported by citations to the record that justify the proffered construction and analysis provided as to why the claim construction is the broadest reasonable construction. 37 C.F.R. § 42.104(b)(3).
- An example of a failure to provide a sufficient claim construction occurs where claim terms are open to interpretation, but party merely restates claim construction standard to be used, e.g.,
  - A claim subject to inter partes review receives the “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b)



# Lessons Learned: Experts

- Tutorials are helpful especially for complex technologies
- Expert testimony without underlying facts or data is entitled to little or no weight. 37 C.F.R. § 42.65(a). *See Monsanto Co. v. Pioneer Hi-Breed Int'l*, IPR2013-00022, Paper 43 (denying petition)
- Avoid merely “expertizing” your claim charts

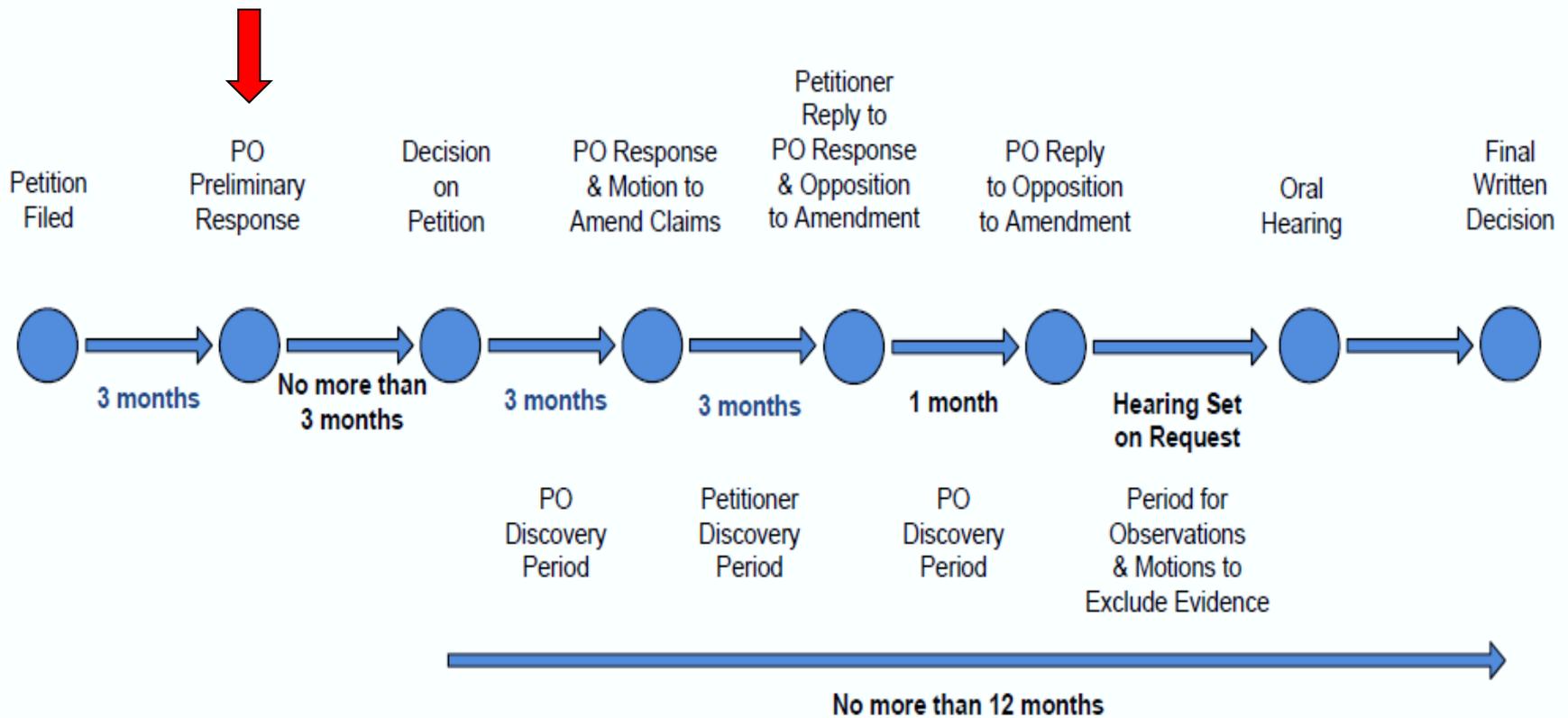


# Lessons Learned: Obviousness

- Question of obviousness is resolved based on underlying factual determinations identified in *Graham*
  - Includes addressing differences between claimed subject matter and the prior art
- Address the specific teachings of the art relied upon rather than rely upon what others have said (e.g., examiners)
  - Parties are to address whether there is a reason to combine art (*KSR*) and avoid conclusory statements
- See *Veeam Software v. Symantec*, IPR2013-00145 (Paper 12); *Heart Failure Tech. v. CardioKinetix*, IPR2013-00183 (Paper 12) (denying petition)



# Patent Owner Preliminary Response





# Patent Owner Preliminary Responses (As of 4/2/14)

	<b>Filed</b>	<b>Not Filed or Waived</b>
<b>IPR</b>	55%	45%
<b>CBM</b>	57%	43%

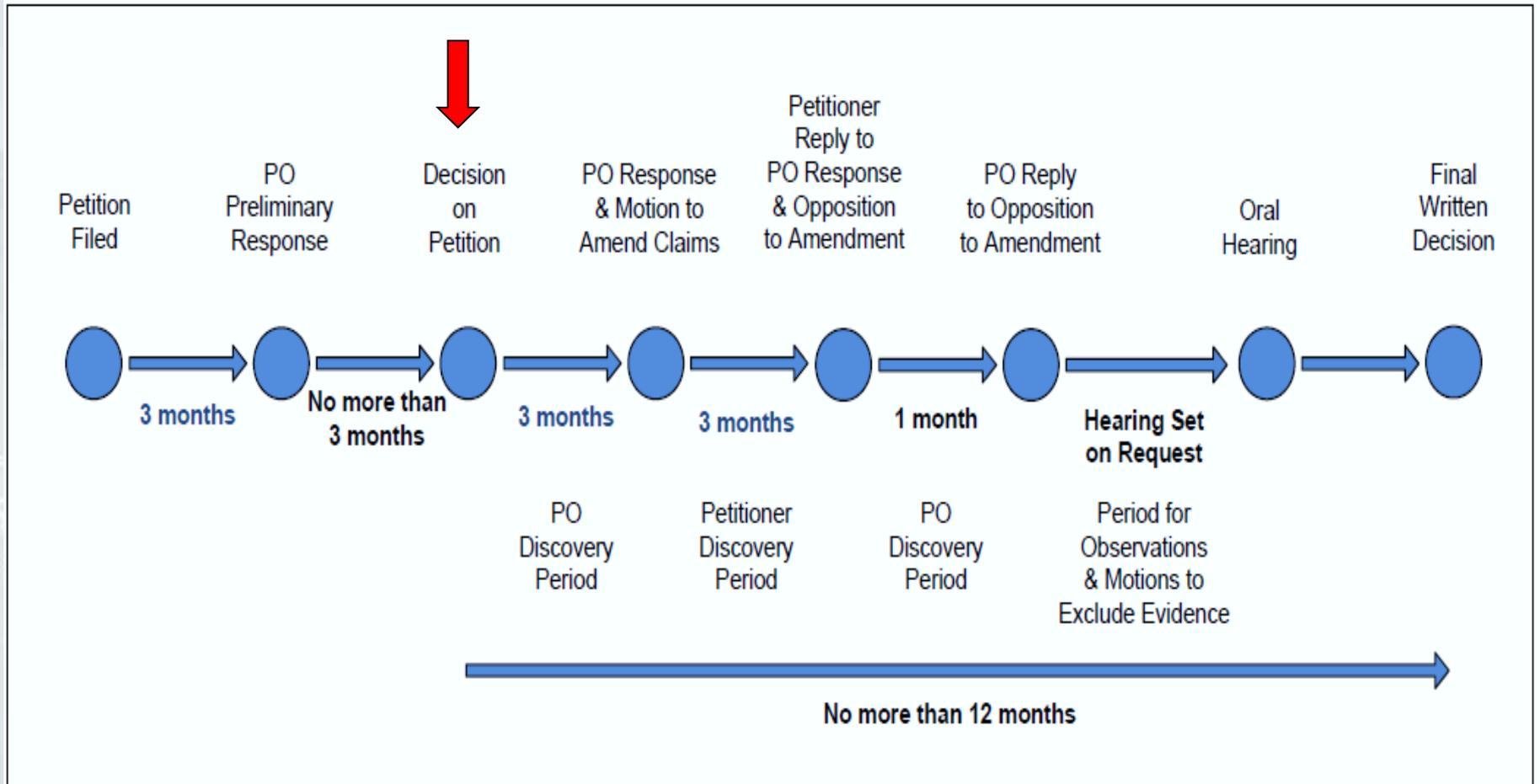


# Lessons Learned: Patent Owner Preliminary Response

- Clearly identify procedural and substantive reasons to deny petition, e.g.,
  - Statutory bar under 35 U.S.C. § 315 or § 325?
  - Failure to identify real parties-in-interest/privies?
  - Weaknesses in Petitioner's case?
    - Petitioner's claim construction is improper
    - Cited references are not, in fact, prior art
    - Cited references lack material element(s)
- Cannot present new testimonial evidence
  - BUT can cite existing testimony and reports

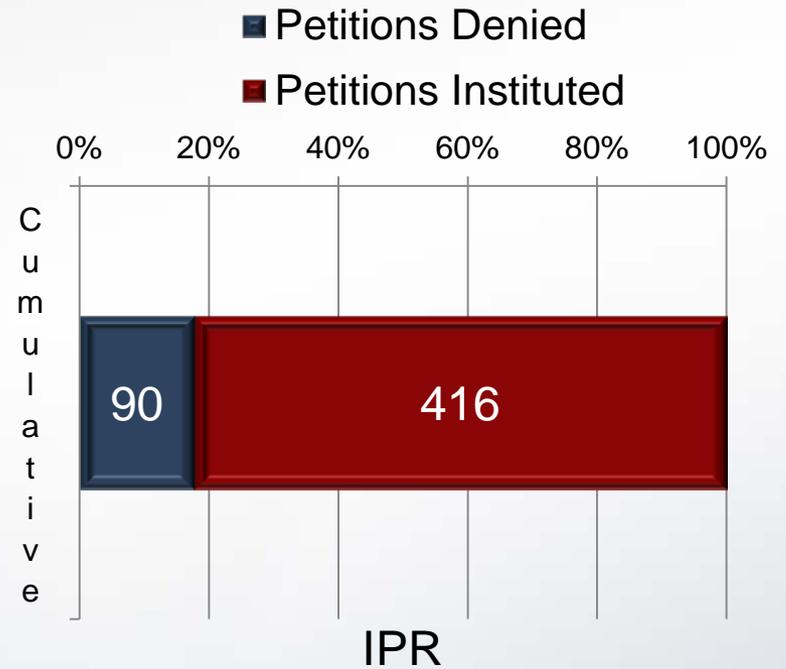
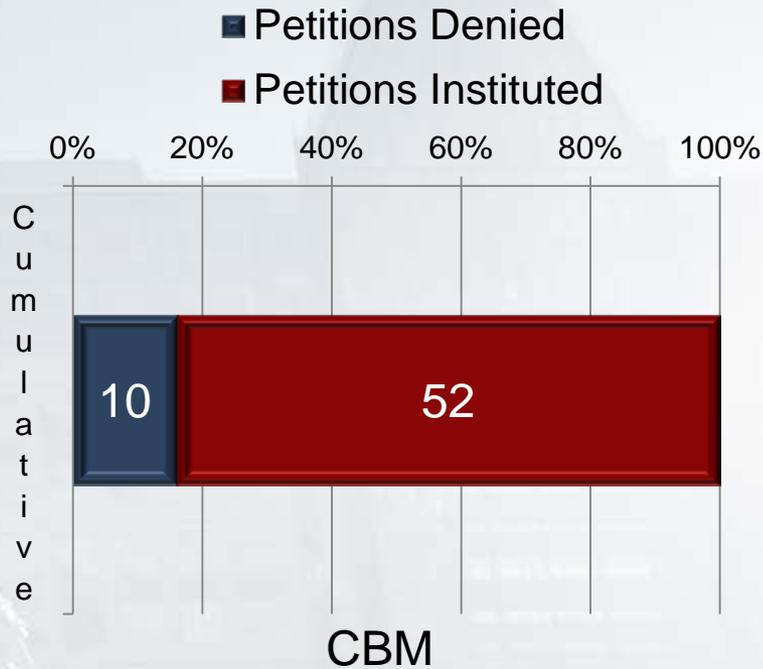


# Decision on Petition





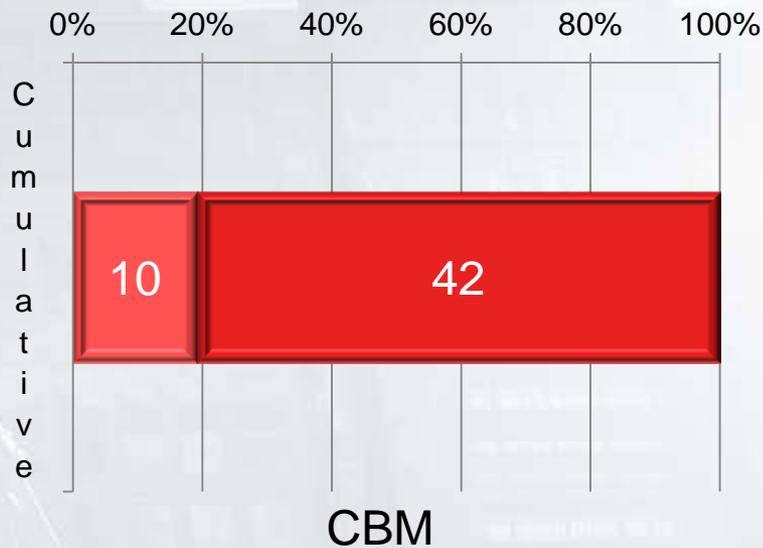
# Institutions (As of 4/2/2014)



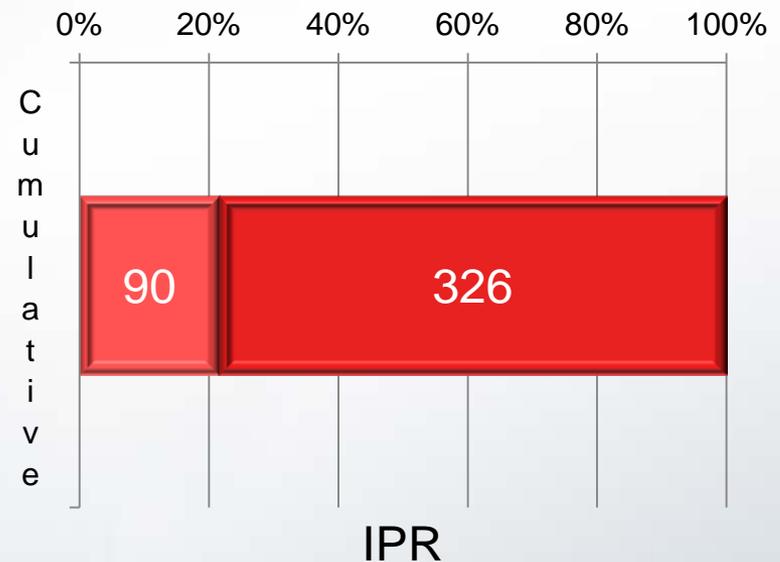


# Institutions (As of 4/2/2014)

- Instituted Claims < Challenged Claims
- Instituted Claims = Challenged Claims



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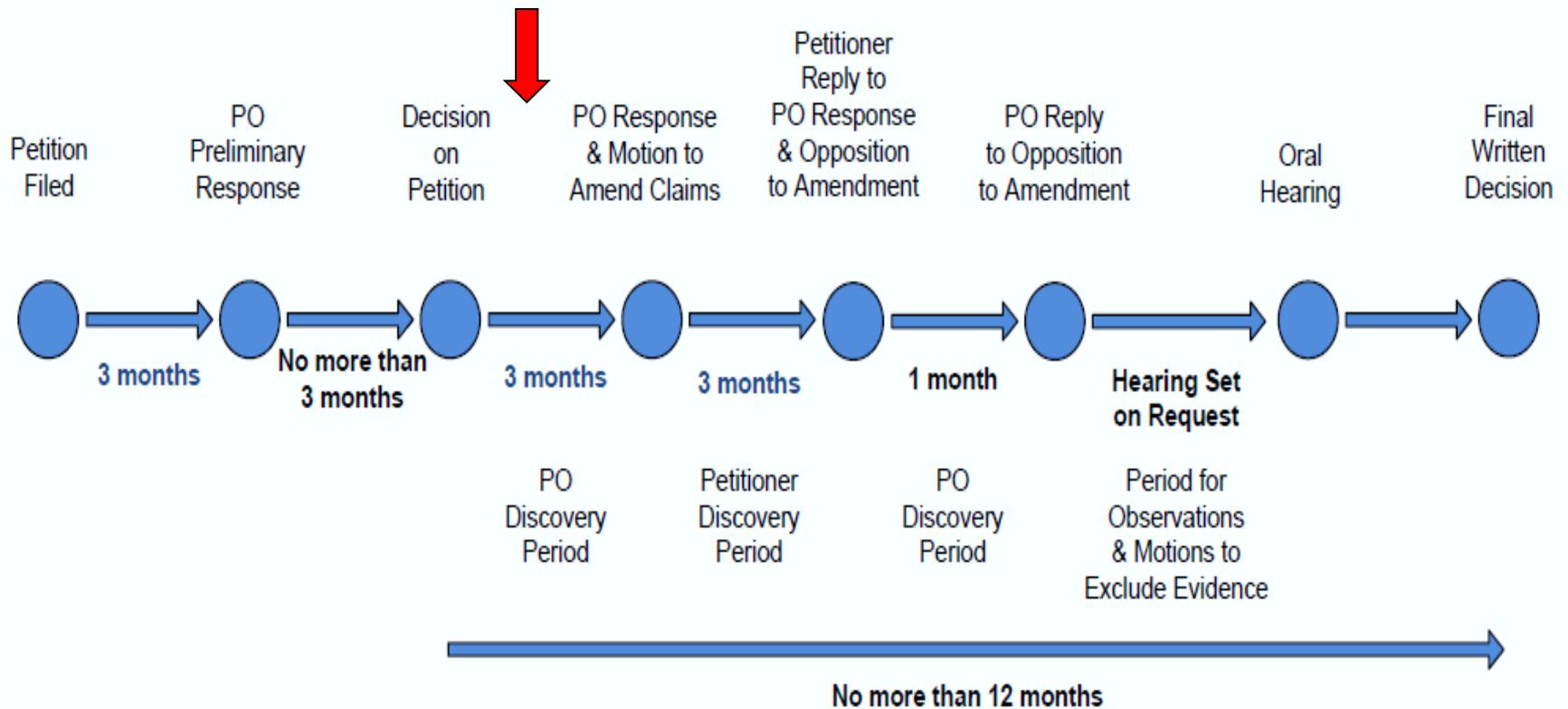
# Petition Dispositions (As of 4/2/14)

	Total No. of Decisions on Institution	Trials Instituted	Joinders	Denials	Percent Instituted
<b>IPR</b>	506	405	11+	90	80%
<b>CBM</b>	62	52	-	10	84%

+11 cases joined to 10 base trials for a total of 21 cases involved in joinder.



# Joinder





# Joinders (As of 4/2/14)

	<b>Trials Instituted</b>	<b>Joinders</b>
<b>IPR</b>	405	11+
<b>CBM</b>	52	-

+11 cases joined to 10 base trials for a total of 21 cases involved in joinder.



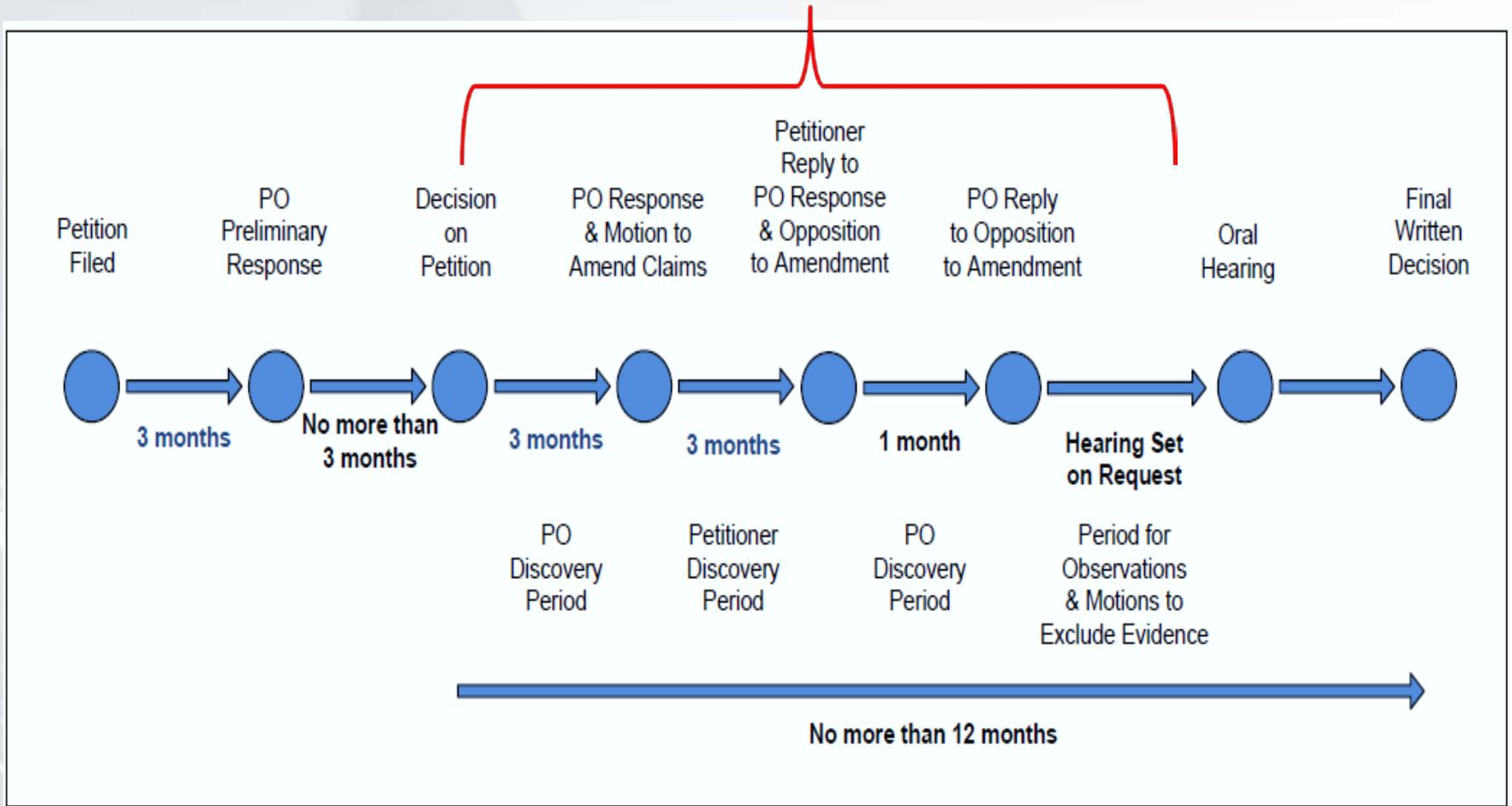
# Lessons Learned: Joinder

- Must be a like review proceeding
- Requires filing a motion and petition
- File within one month of institution
- Impact on schedule important
- *Dell v. Network-1*, IPR2013-00385 (Paper 17)(joinder granted)
- *Sony v. Network-1*, IPR2013-00386 (Paper 16)(joinder denied)



# Discovery

## Discovery Period





# Types of Discovery

- Initial disclosures (Trial Practice Guide, 77 Fed. Reg. 48756, 48761-62 (Aug. 14, 2012))
- Routine Discovery
  - Cited exhibits
  - Cross-examination of witnesses
  - Inconsistent information
- Additional Discovery



# Lessons Learned: Additional Discovery

- Five factor test used in evaluating additional discovery requests (IPR2012-00001, *Garmin v. Cuozzo* (Paper 26)):
  1. More than a possibility and mere allegation must exist that something useful might be found.
  2. Is the request merely seeking early identification of opponent's litigation position?
  3. Can party requesting discovery generate the information?
  4. Interrogatory questions must be clear.
  5. Are requests overly burdensome to answer?
- Requests for specific documents with a sufficient showing of relevance are more likely to be granted whereas requests for general classes of documents are typically denied



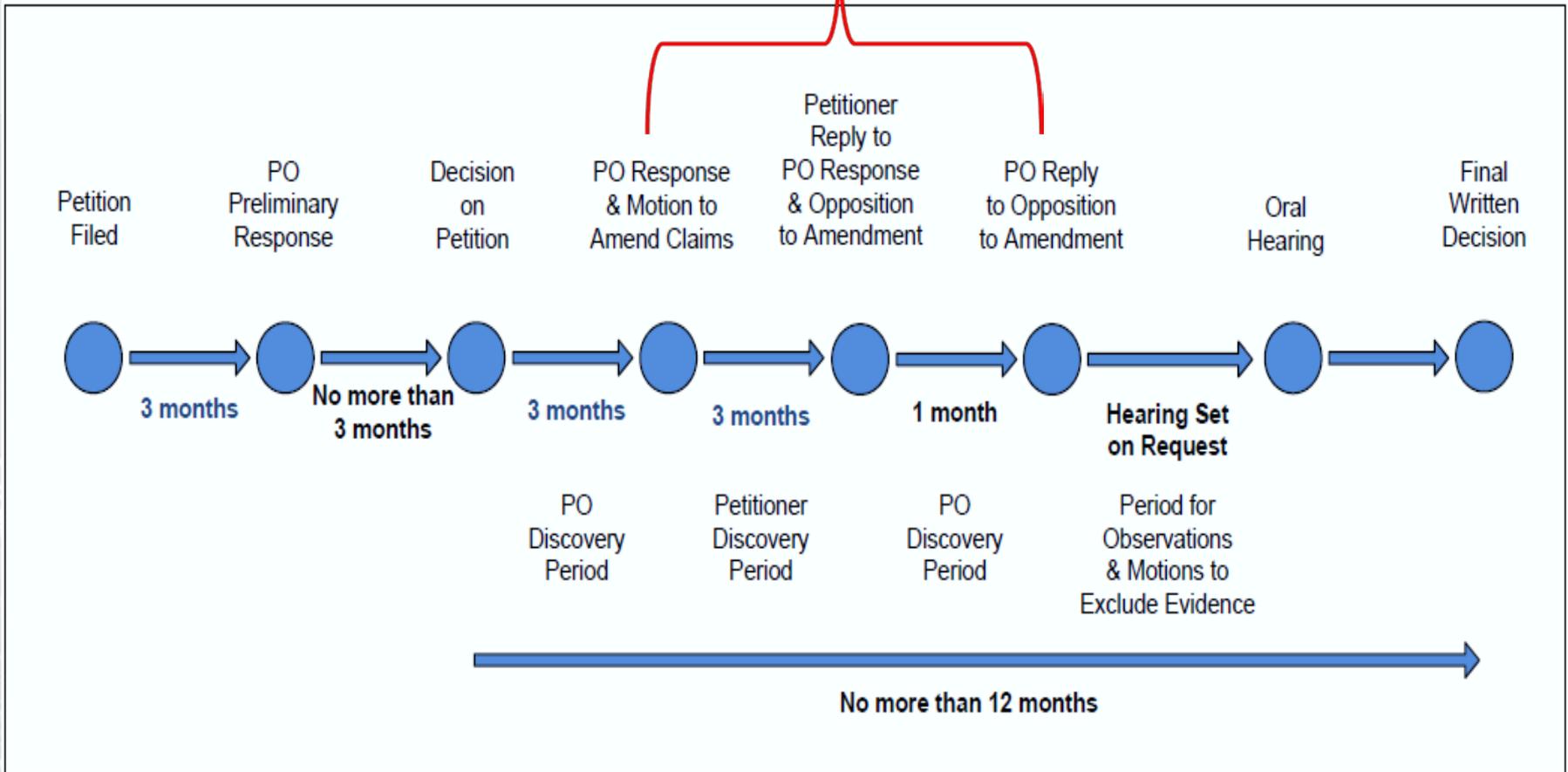
# Lessons Learned: Depositions

- Federal Rules of Evidence apply
- Objections to admissibility waived
- Follow the Testimony Guidelines (Practice Guide Appendix D)
  - No “speaking” objections or coaching
  - Instructions not to answer are limited
- Foreign language/country. *See Ariosa v. Isis*, IPR2013-00022 (Papers 55, 67)



# Motion to Amend

## Motion to Amend





# Motions to Amend

- Board conference required
- Normally one-for-one claim substitution
- Must narrow scope
- Need to show patentable distinction
- Clearly state the contingency of substitution
- *See Idle Free v. Bergstrom*, IPR2012-00027 (Paper 26)

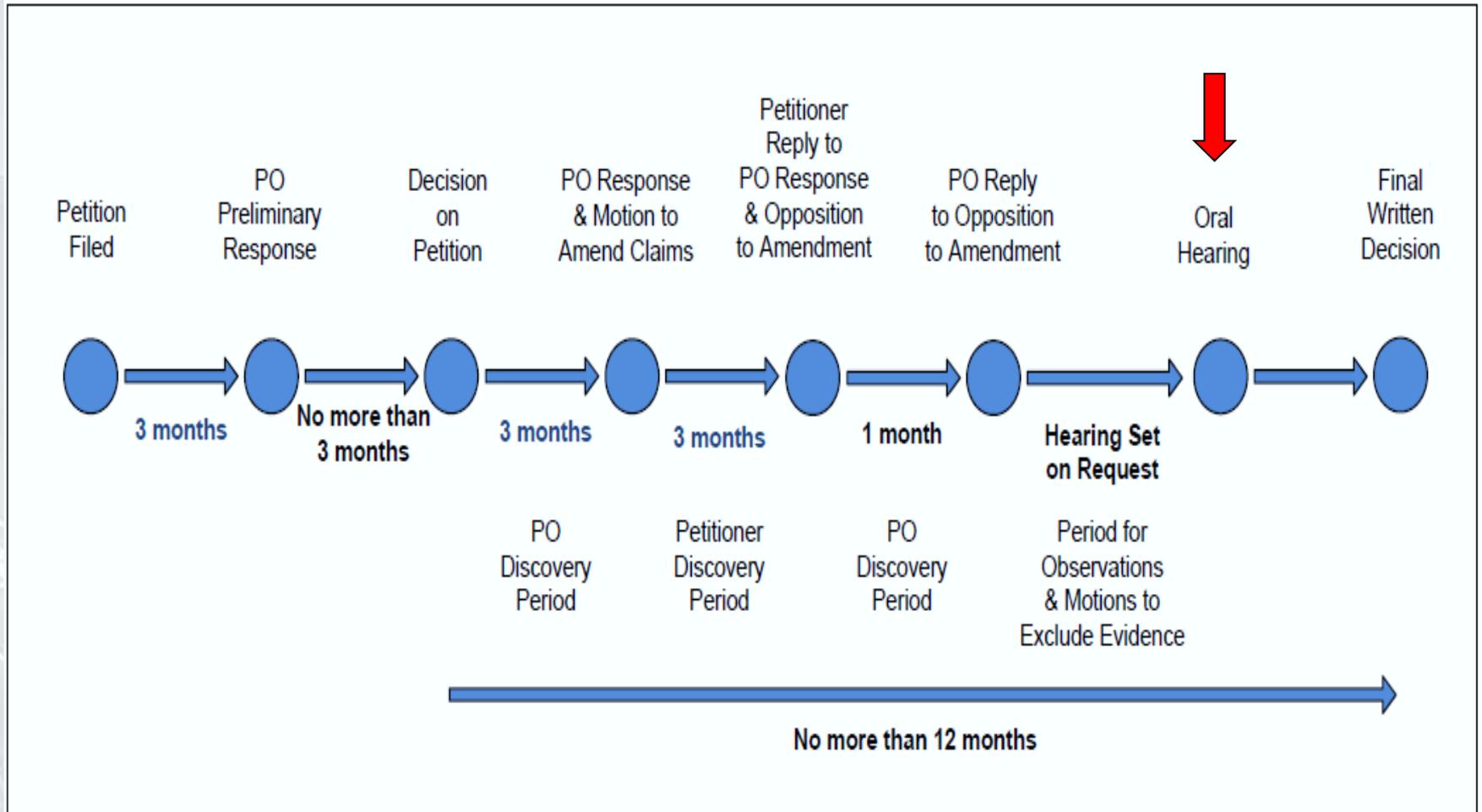


# Motions to Amend

- Unlike during examination, PTAB does not “examine” amended claims during an AIA proceeding
  - No search is conducted
  - No claim rejections made
- Burden is on the movant (i.e., the patent owner) to show the patentable distinction of the proposed amended claim



# Oral Hearing





# Lessons Learned: Oral Hearing

- Attorneys should bear in mind that:
  - Panel may have more than three judges;
  - Some panel members may participate by video; and
  - All questions from the judges are based on the written record, including arguments made in the parties' briefs and expert testimony filed in support of the parties' briefs
- Attorneys should be prepared to answer questions about the entire record, including claim construction, motion to amend, priority, secondary consideration and swearing-behind issues
  - Have sufficient familiarity with the record to answer questions effectively; and
  - Be ready to deviate from a prepared presentation to answer questions



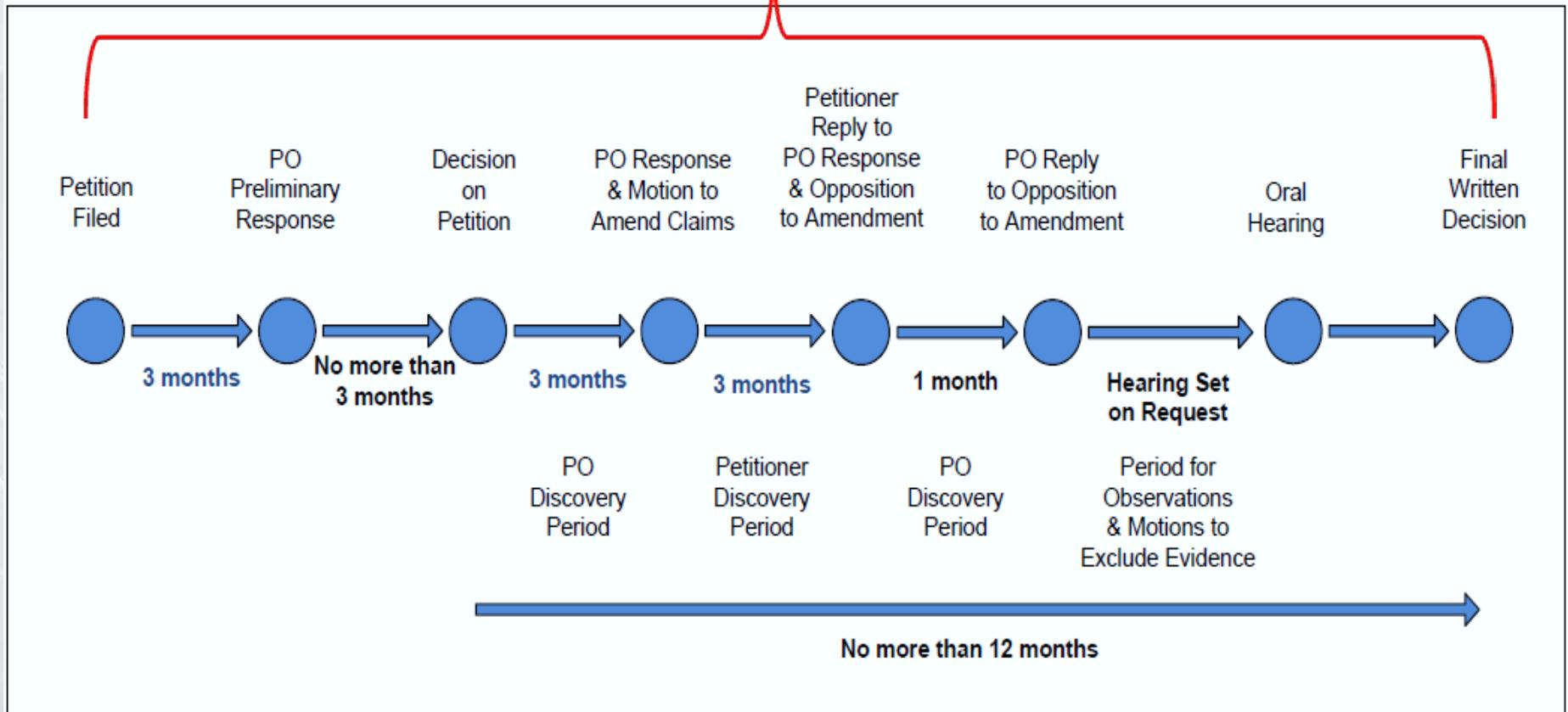
# Lessons Learned: Oral Hearing

- Attorneys should focus on the best argument and not try to cover every argument made during the course of the trial
- No new evidence or argument is permitted
- Demonstrative exhibits should serve merely as visual aids
  - Pages of the record, with appropriate highlighting (e.g., highlighted figures), are effective and could be very helpful
  - When referring to slides, identify the number of the slide rather than say “this slide” or “next slide”



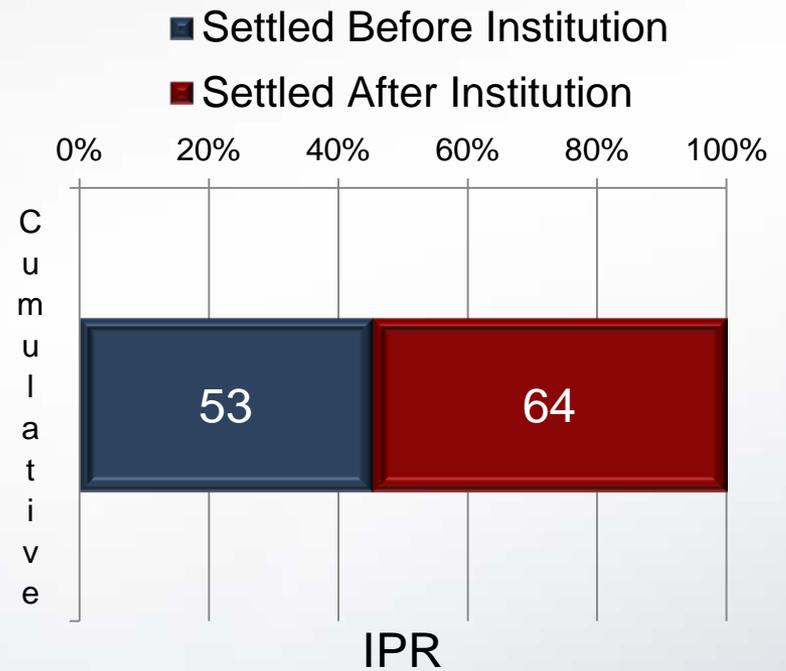
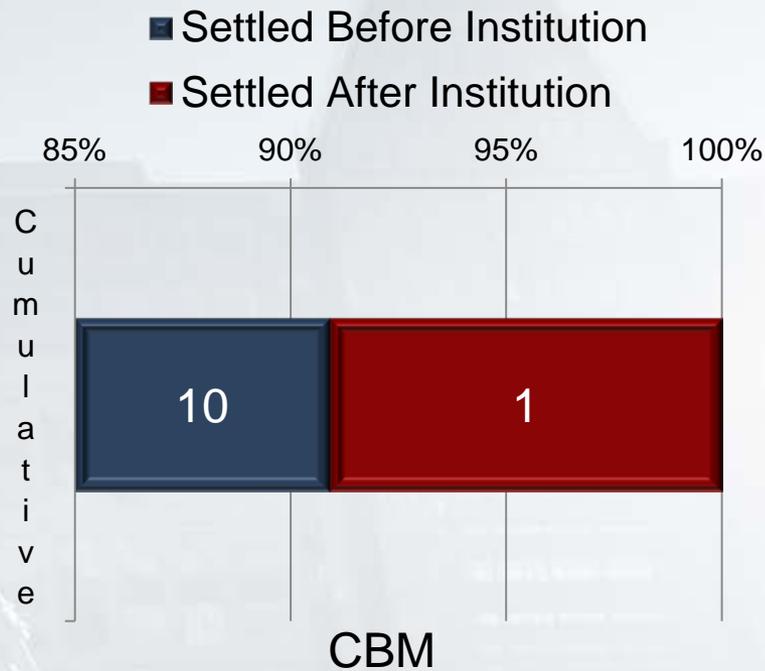
# Settlement and Termination

## Settlement and Termination





# Settlements\* (As of 4/2/2014)



\* Pool is taken from 128 cases that have settled since inception.



# Settlements and Adverse Judgments (As of 4/2/14)

	<b>Settlements</b>	<b>Adverse Judgments</b>
<b>IPR</b>	117	20
<b>CBM</b>	11	0



# Lessons Learned: Settlement

- Parties may file a joint motion to terminate a proceeding on the basis of settlement
  - Preauthorization is required; and
  - May be filed at any stage of the proceeding, even before institution
    - If the proceeding is terminated before institution, petitioner may file a request for refund of post-institution fee
- Board has discretion to proceed to final written decision, especially at an advanced stage when all briefing is complete
- Board is more likely to grant early motions to terminate

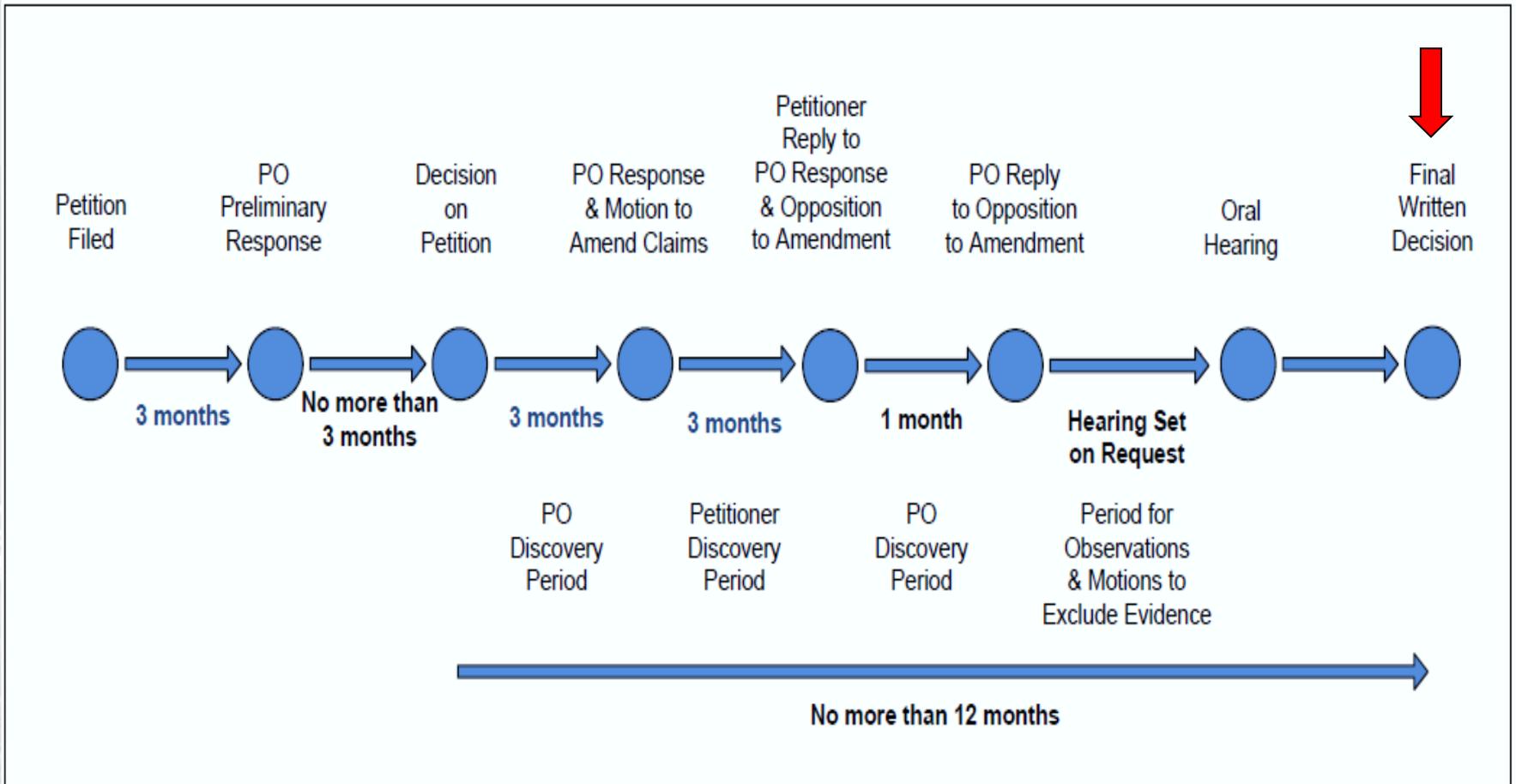


# Lessons Learned: Settlement

- When there are multiple petitioners, proceeding may be terminated with respect to one petitioner when that petitioner settles with patent owner
- Joint motion to terminate must be accompanied by a true copy of the settlement agreement; a redacted version is not permitted
- Parties may request that the settlement agreement be treated as business confidential information
  - See § 42.74(c) and FAQ G2



# Final Written Decision





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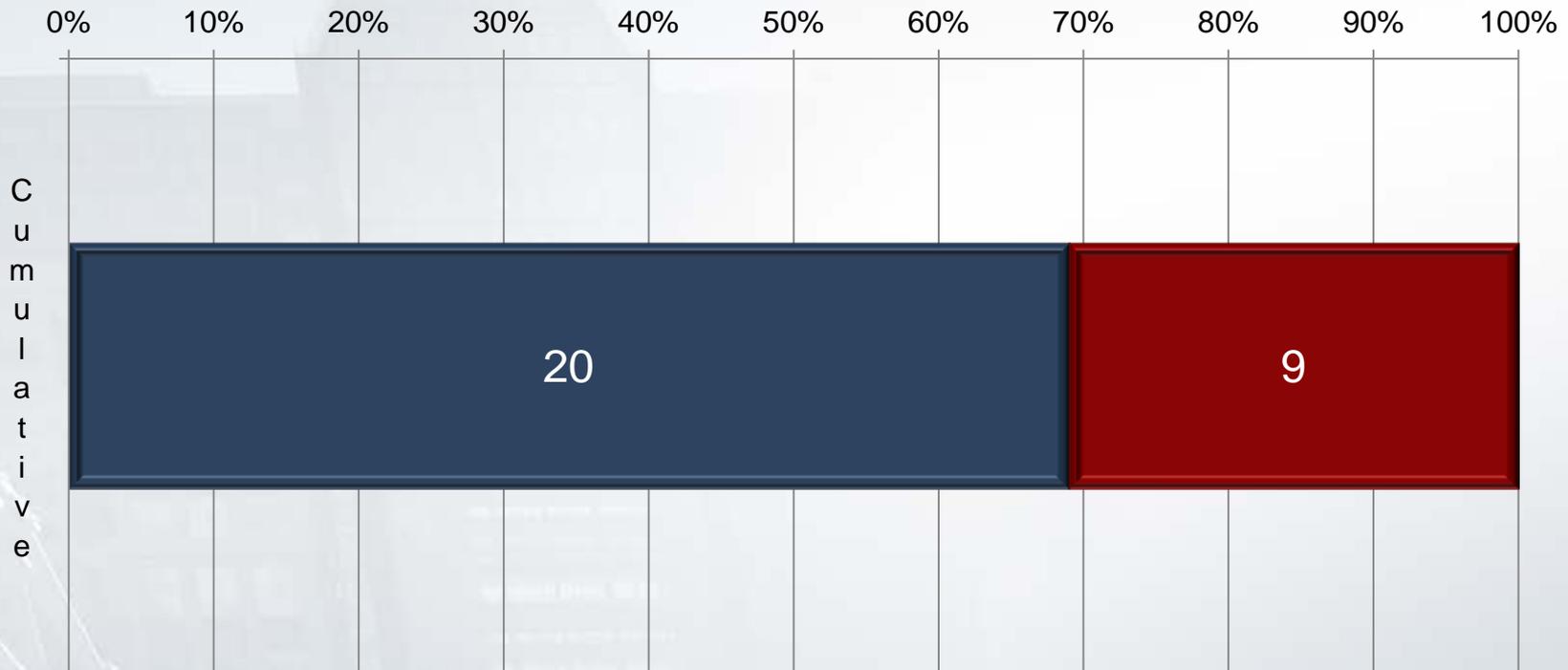
**705 Claims Patentable**  
(55% of Claims Instituted, 33% of Claims Challenged)

 **28 Patents**



# Final Written Decisions in IPRs (As of 4/2/2014)

- All Instituted Claims Unpatentable
- Some Instituted Claims Unpatentable
- None of Instituted Claims Unpatentable

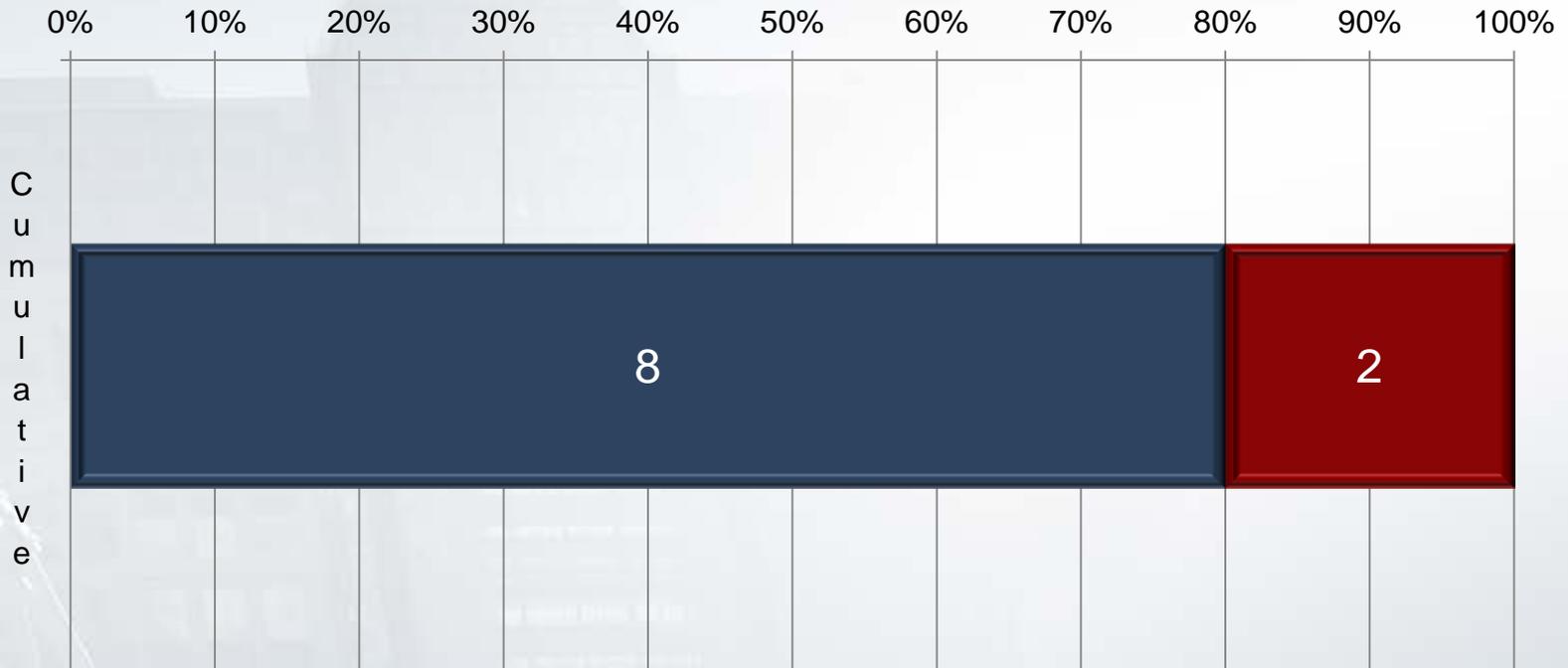


\*IPR (28 patents involved in 29 Final Written Decisions)



# Final Written Decisions in CBMs (As of 4/2/2014)

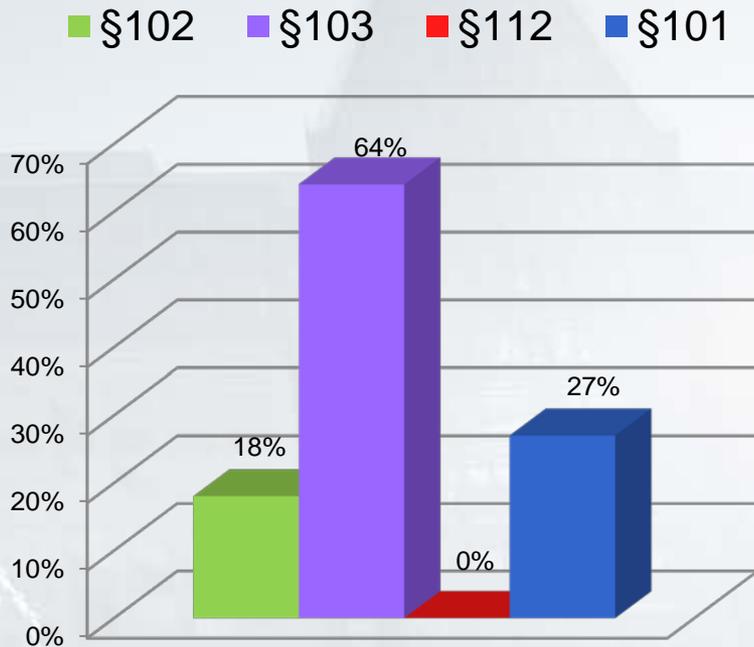
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\*CBM (10 Final Written Decisions)



# Final Written Decisions: Basis for Unpatentability (As of 4/2/2014)



CBM (10 decisions)



IPR (29 decisions)

\* Multiple bases can be reported for a single Final Written Decision



# Interesting Recent Final Decisions (Issued 4/11/14)

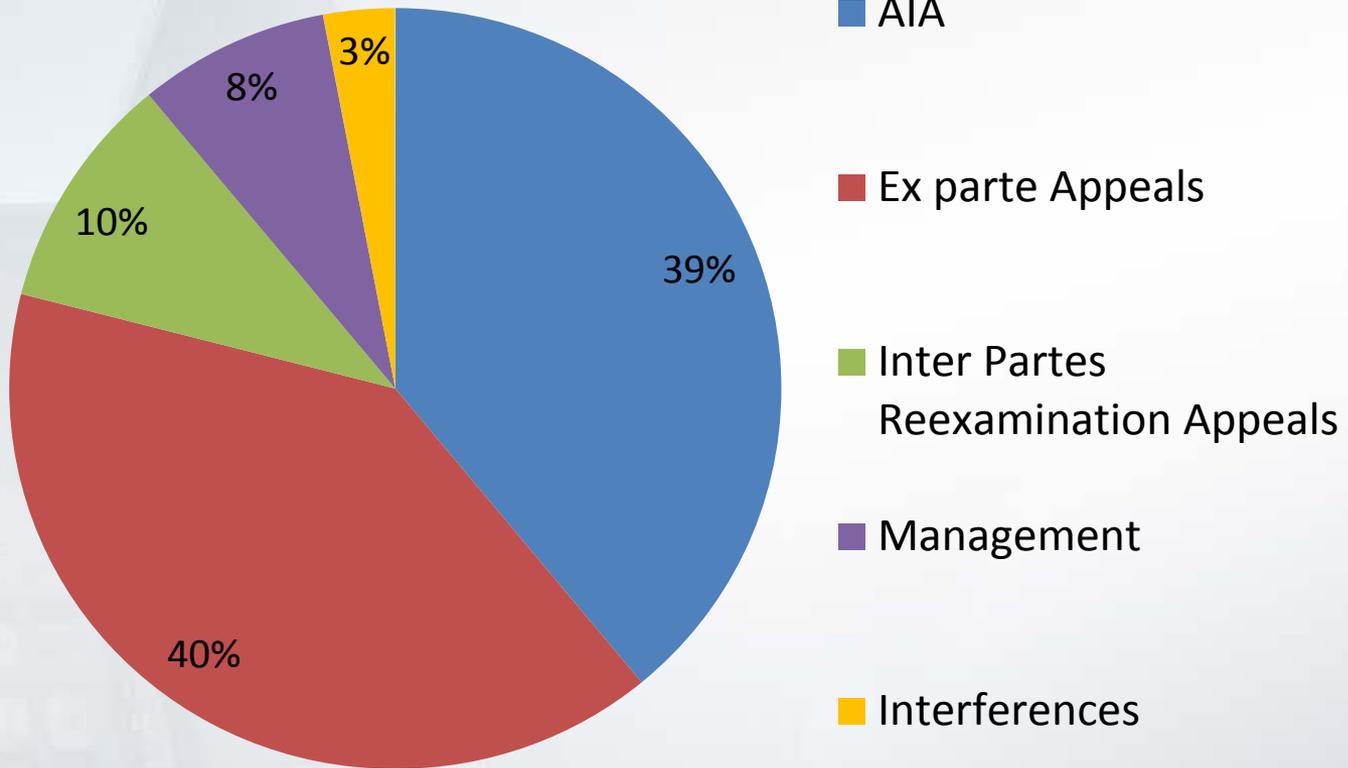
- *ABB Inc. v. Roy-G-Bi Corp.*, IPR 2013-00062 & IPR 2013-00282, Paper 84 (petitioner did not meet burden to prove any of the challenged claims unpatentable)
- *ABB Inc. v. Roy-G-Bi Corp.*, IPR 2013-00074 & IPR 2013-00286, Paper 80 (petitioner did not meet burden to prove any of the challenged claims unpatentable)



# Administrative Patent Judges



# Allocation of Judges



\* As of April 15, 2014 (183 judges)



# Board Hiring

- Goal is to add 52 judges by October
- Opportunities exist at Alexandria and at the Detroit/Denver/Dallas/Silicon Valley Satellite Offices
- Current job posting on USAJOBS
  - <https://www.usajobs.gov/GetJob/ViewDetails/364615700>)



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USPTO's next "Saturday Seminar" in Detroit for independent inventors, entrepreneurs, and small businesses is April 12. Learn about various types of intellectual property protection and the patent process, and what every small business must know about trademarks and copyright.

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Study the information dashboards

**Patent Trial and Appeal Board**  
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<b>TRIALS</b> 	<b>APPEALS</b> 	<b>DECISIONS</b> 	<b>HEARINGS</b> 
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- **Patent Trial and Appeal Board (PTAB)**
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Initiatives & Events



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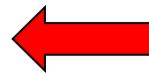


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## Representative Orders, Decisions, and Notices

### Representative Trial Hearing Orders:

- [CBM2012-00001, Order – Trial Hearing, Paper 61, Apr. 8, 2013](#)

### Representative Decisions to Institute:

- [IPR2012-00026 Decision to Institute, Paper 17, Dec. 21, 2012](#)
- [CBM2012-00001 Decision to Institute, Paper 36, Jan. 9, 2013](#)
- [IPR2012-00001 Decision to Institute, Paper 15, Jan. 9, 2013](#)
- [IPR2013-00034 Decision to Institute, Paper 22, Apr. 22, 2013](#)

### Representative Scheduling Orders:

- [IPR2012-00026 Scheduling Order, Paper 18, Dec. 21, 2012](#)
- [CBM2012-00001 Scheduling Order, Paper 37, Jan. 9, 2013](#)
- [IPR2012-00001 Scheduling Order, Paper 16, Jan. 9, 2013](#)

### Other Representative Orders and Decisions:

- [IPR2013-00639 Order Authorizing Motion for Pro Hac Vice Admission, Paper 7, Oct. 15, 2013](#)
- [IPR2012-00005, Order regarding Written Description Support for Substituted Claims, Paper 27, June 3, 2013](#)
- [IPR2012-00027, Decision on Motion to Amend Claims, Paper 26, June 11, 2013](#)
- [IPR2013-00004 Order Authorizing Motion for Joinder, Paper 15, Apr. 29, 2013](#)
- [IPR2013-00010, Decision regarding Service Under 35 U.S.C. § 315\(b\), Paper 20, Jan. 30, 2013](#)
- [IPR2013-00109, Decision granting motion for joinder, Paper 15, Feb. 25, 2013](#)
- [IPR2012-00018, Decision – Real Party in Interest, Paper 12, Jan. 24, 2013](#)
- [CBM2012-00003, Order \(Redundant Grounds\), Paper 7, Oct. 25, 2012](#)
- [CBM2012-00003, Order \(Denial of Grounds\), Paper 8, Oct. 25, 2012](#)
- [CBM2012-00001, Decision Denying Motion for Pro Hac Vice Admission, Paper 21, Nov. 6, 2012](#)
- [CBM2013-00005, Decision Granting Motion for Pro Hac Vice Admission, Paper 13, Nov. 26, 2012](#)
- [IPR2013-00033, Order to Stay Reexam, Paper 15, Nov. 6, 2012](#)
- [IPR2013-00028, Decision on Motion to Take Jurisdiction, Paper 8, Nov. 27, 2012](#)
- [CBM2012-00005 Order regarding Content of Motions List, Paper 31, Feb. 13, 2013](#)
- [IPR2012-00022 Decision regarding Standing to file Petition, Paper 20, Feb. 12, 2013](#)

### Representative Notices:

- [CBM2012-00002, Notice of Filing Date Accorded, Paper 4, Sept. 21, 2012](#)
- [IPR2013-00033, Notice of Filing Date Accorded, Paper 14, Oct. 26, 2012](#)
- [IPR2012-00004, Notice of Defective Petition, Paper 6, Sept. 21, 2012](#)
- [IPR2012-00022, Notice of Incomplete Petition, Paper 5, Sept. 27, 2012](#)

### Representative Settlement Related Orders

- [IPR2012-00004 Order regarding Settlement after Initiation, Paper 21, Feb. 4, 2013](#)
- [IPR2013-00078 Order regarding Pre-Institution Settlement, Paper 7, Feb. 8, 2013](#)
- [IPR2013-00078 Judgment Termination of Proceeding, Paper 11, Feb. 12, 2013](#)

### Exemplary Decisions and Orders including Discovery

- [IPR2013-00043 Decision on Motion for Additional Discovery, Paper 27, June 21, 2013](#)
- [CBM2013-00005 Decision on Motion for Additional Discovery, Paper 32, May 29, 2013](#)
- [CBM2012-00001, Decision on Discovery Request, Paper 24, Nov. 15, 2012](#)
- [IPR2012-00001, Decision Including Discussion of Discovery Standards, Paper 26, Mar. 5, 2013](#)
- [IPR2012-00026, Decision Denying Additional Discovery on Commercial Success, Paper 32, Mar. 8, 2013](#)
- [IPR2012-00001, Decision Motion to Seal, Paper 34, Mar. 14, 2013](#)



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# Mock Conference Call





# Motion to Amend: Fact Pattern

- IPR instituted against claims 1-5
  - Claims 1, 4, and 5 are independent
  - Claims 2 and 3 depend from claim 1
- **Before** telephone conference, Patent Owner contemplates filing a motion to amend that will:
  - Replace claim 1 with substitute claim 1;
  - Replace claim 4 with substitute claims 6-10; and
  - Cancel claim 5



# Motion to Amend: Fact Pattern

- **After** teleconference, Patent Owner intends to file a motion to amend that will:
  - Replace claim 1 with substitute claim 6;
  - Replace claim 4 with substitute claim 7; and
  - Cancel claim 5



# Lessons Learned: Motion to Amend

- Motion to amend may request cancellation or substitution of an original claim
  - Wholesale addition of new claims generally is not allowed
- A substitute claim generally should contain all of the limitations of the original claim that it replaces
- A substitute claim should add one or more features that respond to the grounds of unpatentability at issue in the trial
- Each original claim that changes in scope as a result of the amendment should be presented as a substitute claim with a unique claim number
  - Applies to claims that change in scope only by virtue of their dependence on a substitute claim too



# Motion to Amend: Lessons Learned

- AIA trial is not a patent examination
  - Board does not conduct a prior art search or enter rejections
- If a motion to amend is granted, the substitute claim is added to an issued patent without any Office search or examination
- Patent Owner “moves” to amend; no amendment of right
- As the party requesting relief, Patent Owner bears the burden of establishing the patentability of proposed substitute claims
- In general, the Board takes up a motion to amend only if the original claim is cancelled or found unpatentable, so no gloss of patentability transfers from original claim to substitute claim



# Lessons Learned: Motion to Amend

- An inventory that catalogues the individual disclosures of each prior art reference may not be helpful or the best use of the 15 pages allowed for motions
- Provide a narrative that explains what the Patent Owner knows about the state of the prior art as it relates to the feature added by amendment
  - Focus on why adding that feature to the combined elements of the original claim would not have been obvious
- Patent Owner may support that narrative with an expert declaration, citations to textbooks, or evidence of conventional practices relevant to the added feature



# Motion to Amend: Some Interesting Cases

- *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Papers 26, 66 (setting forth requirements for meeting burden of proof on a motion to amend).
- *Corning Gilbert, Inc. v. PPC Broadband, Inc.*, IPR2013-00347, Paper 20 (discussing the burden regarding the state of the prior art and level of ordinary skill in the art with respect to features added by amendment).
- *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (providing guidance on mechanics and substance of a motion to amend).
- *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 27 (motion to amend should adequately establish written description support for substitute claims based on the original disclosure of the application).



# Motion for Additional Discovery: Fact Pattern

- **Before** the telephone conference call, Patent Owner seeks pre-authorization to file a motion for additional discovery requesting 2 categories of documents:
  1. All sales and pricing documents relating to Petitioner's products that are at issue in a district court infringement action; and
  2. All documents regarding the relationship between Petitioner and two non-parties:
    - Acme = Petitioner's customer; and
    - Universal = a company recently acquired by Petitioner



# Motion for Additional Discovery: Fact Pattern

- **After** the telephone conference, the Board authorizes Patent Owner to file a motion for additional discovery directed to the following documents:
  1. A summary document that reflects sales and pricing data for the products manufactured by Petitioner that are accused of infringement in district court. Counsel for Petitioner admitted that a summary document already exists, so compiling a summary is not required; and
  2. A customer sales agreement between Acme and Petitioner, as well as an acquisition agreement between Universal and Petitioner. Counsel for Petitioner admitted that these documents exist and are easily accessible



# Lessons Learned: Motion for Additional Discovery

- The discovery permitted in an AIA trial is more limited than the discovery available in a district court
- Party seeking discovery that exceeds the scope of routine discovery must ask the Board for authorization to file a motion for additional discovery
- Motion must show that a grant of the additional discovery will serve the interests of justice (for an IPR) or is supported by good cause (for a CBM or PGR)



# Lessons Learned: Motion for Additional Discovery

- Motion must do more than target information that is likely to be useful. Motion must show that the requested documents likely exist and will be useful in making out an element of the requesting party's case
- Requests seeking "any" or "all" documents in a broad category may be viewed as speculative
- Board will consider whether the discovery request would unduly burden the producing party or can be obtained from other sources, such as the Internet
- Expect the Board to encourage reasonable compromise



# Motion for Additional Discovery: Some Interesting Cases

- *Garmin Int'l v. Cuozzo Speed Techs.*, IPR2012-00001, Paper 26 (enumerating the “Garmin factors”)
- *Corning, Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27 (granting additional discovery request for laboratory notebooks)
- *RPX Corp. v. Virnetx Inc.*, IPR2014-00171, Paper 25 (granting additional discovery regarding real-party-in-interest and privity issues after identifying a limited set of relevant documents)
- *Apple Inc. v. Achatas Ref. Publ., Inc.*, IPR2013-00080, Paper 66 (granting additional discovery of email communications exchanged directly between patent owner’s two experts)



# Thank You



# Break



# Fact Pattern: Patents

- Patent Owner is assigned two patents:
  - ‘001 Patent
    - has 100 claims; and
    - was issued in 2000
  - ‘002 Patent
    - has 5 claims;
    - was issued in 2014; and
    - and is subject to the first-inventor-to-file provisions of the America Invents Act



# Fact Pattern: District Court Litigation

- Patent Owner has sued Petitioner for infringement of certain claims in the '001 Patent in District Court
- Patent Owner is considering suing the Petitioner for infringement of certain claims in the '002 Patent in District Court too

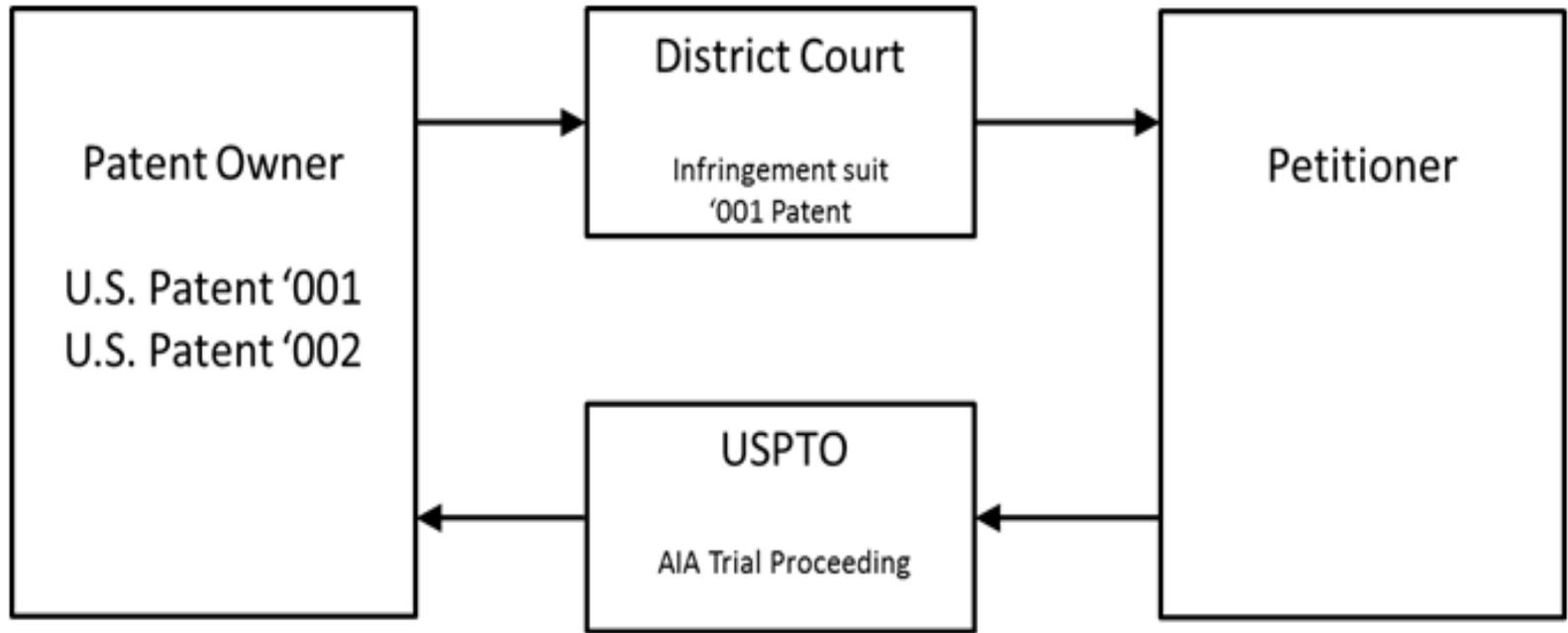


# Fact Pattern: AIA Trial

- Petitioner wants to file one or more AIA trial proceedings against the '001 Patent and the '002 Patent because it believes:
  - certain claims in the '001 Patent are anticipated and obvious as well as unpatentable under § 101 and § 112; and
  - certain claims of the '002 Patent are obvious

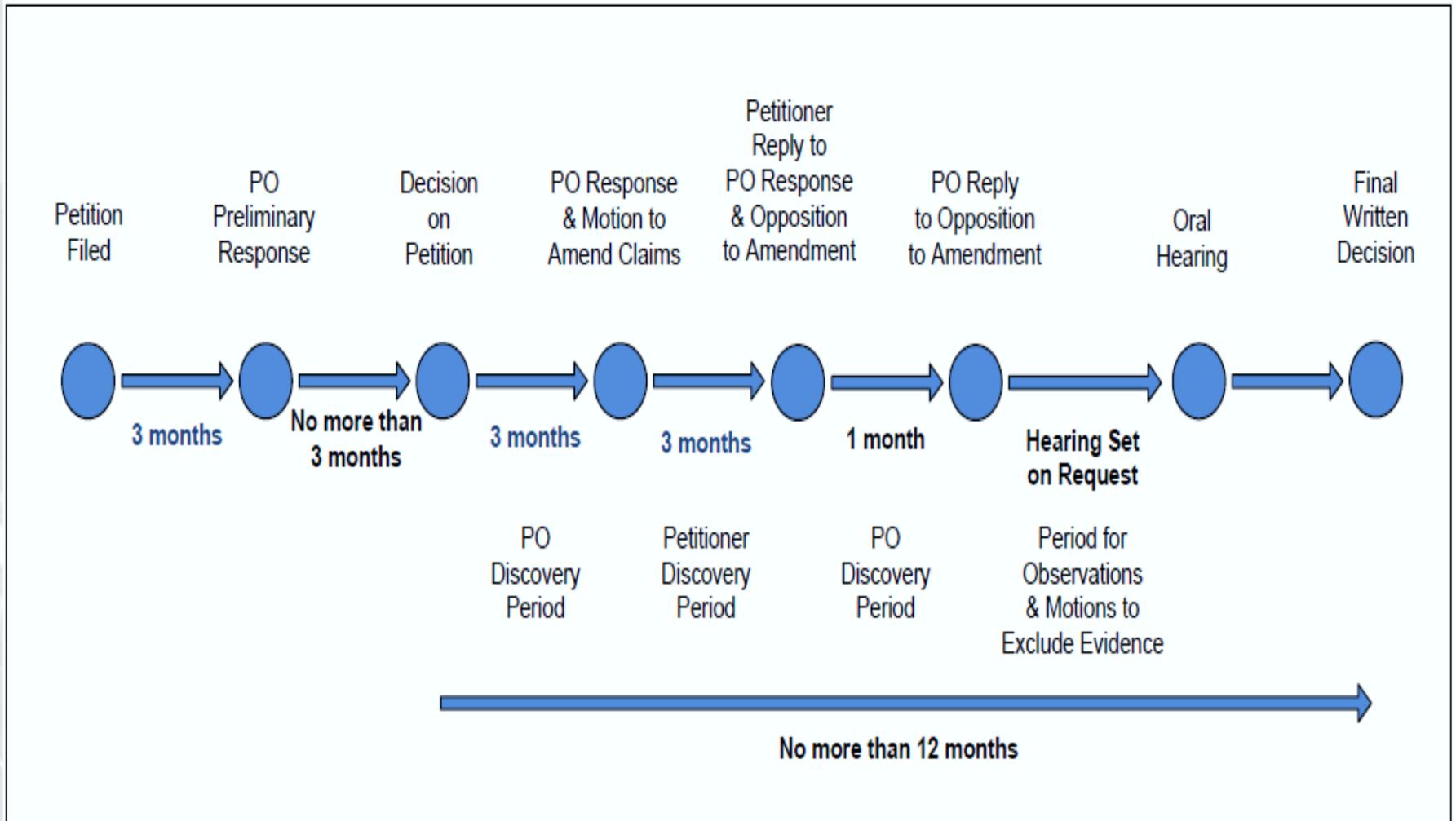


# Fact Pattern: Graphic





# Trial Proceeding Timeline





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# Closing Remarks





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