

***PTAB Bootcamp:  
Nuts and Bolts of Proceedings  
Before the PTAB***

**Administrative Judge Panel:  
Ken Barrett, Linda Horner,  
Christopher Paulraj, and William Saindon**

**Moderators:  
Dave Higer, Mita Chatterjee, and David Reese**

# PTAB Bar Association “Boot Camp”—Agenda

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- Overview of the Patent Trial and Appeal Board (PTAB).
- *Ex Parte* Appeals Process at the Board.
- Post-Grant Proceedings at the Board.
  - Overview of a post-grant proceeding with roundtable discussions re:
    - Petition;
    - Patent Owner Preliminary Response;
    - Institution of a trial;
    - Discovery;
    - Patent Owner Response/Petitioner’s Reply/Sur-Replies;
    - Motions to Amend; and
    - Oral Argument/Final Written Decision.

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# Statutory Authority for the Board

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- The Patent Trial and Appeal Board (PTAB) is created by 35 U.S.C. § 6(a), which provides:

“There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board.”

# Proceedings at the Board

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- Appeals
  - *Ex Parte* patent applications
  - *Ex Parte* and *Inter Partes* reexamination proceedings
  - Reissue applications
- AIA Proceedings
  - *Inter Partes* Reviews (IPR)
  - Post-Grant Reviews (PGR)
  - Covered Business Method Reviews (CBMR)
  - Derivations
- Interferences

# Composition of the Board

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- Director
- Deputy Director
- Commissioners for Patents and Trademarks
- Chief Judge
- Deputy Chief Judge
- Vice Chief Judges
- Lead Judges
- Judges
  - The judges shall be “persons of competent legal knowledge and scientific ability who are appointed by the Secretary in consultation with the Director.” 35 U.S.C. § 6(a).
- Patent Attorneys, Paralegals, Administrators, and Support Staff, etc.

# Action by the Board

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- 35 U.S.C. § 6(c) requires final decision by minimum of 3-member panels:

“Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.”

# Board Guidance and Authority

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- **Precedential opinions** create consistent authority to be followed in future Board decisions and with the examining core.
- **Informative decisions** have persuasive value and illustrate procedural and other norms.



# Precedential Opinion Panel (“POP”)

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- POP typically comprises the Director, the Commissioner for Patents, and the Chief Judge of the PTAB.
- The POP serves two primary functions:
  - it may be convened to rehear matters in pending trials and appeals, major policy or procedural issues, or other issues of importance; and
  - it may assist the Director in determining whether a decision previously issued by the PTAB should be designated as precedential or informative.

# Standard of Review by the Federal Circuit

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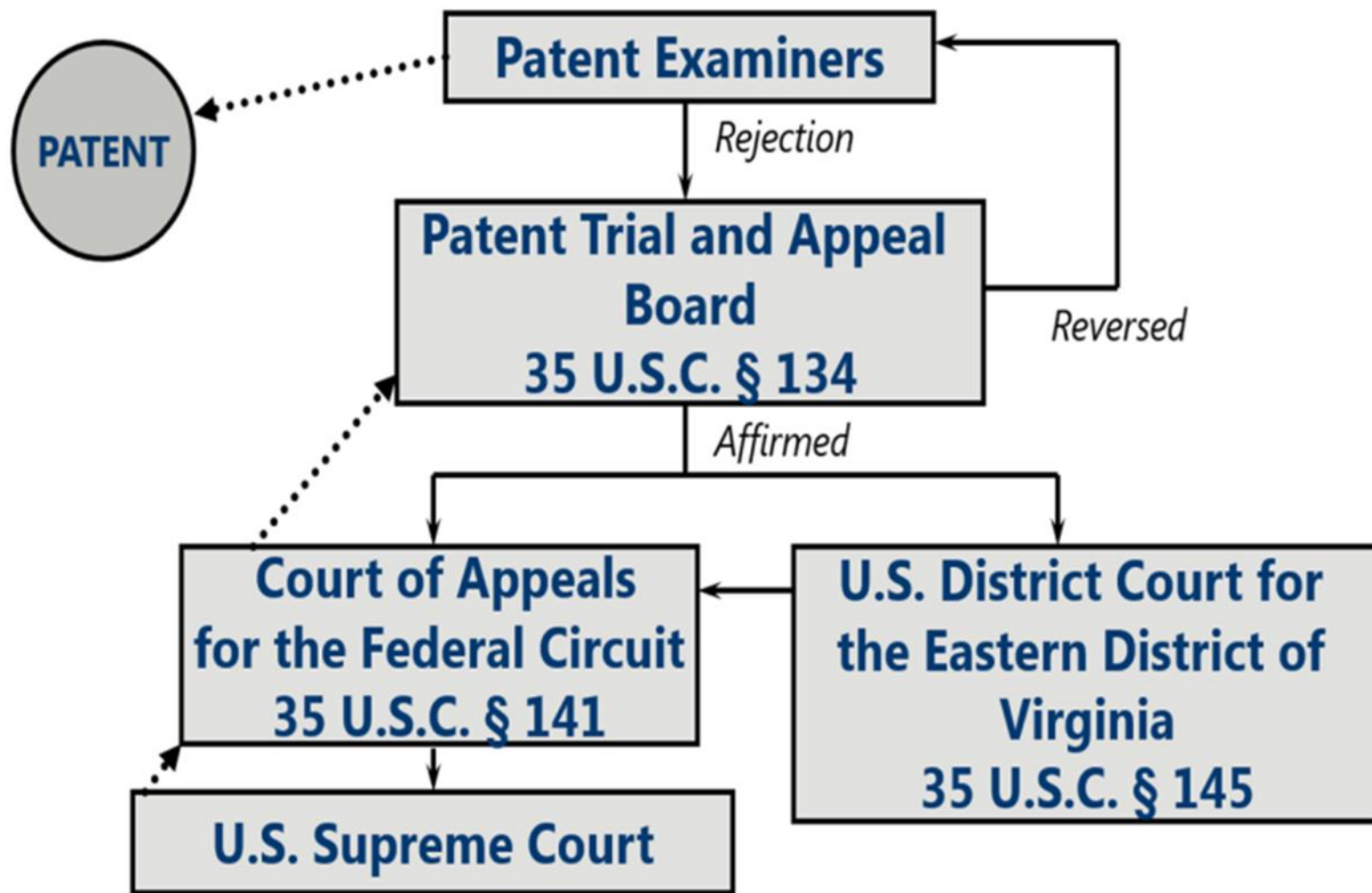
- The Board's decisions must be reviewed under the Administrative Procedures Act (APA).
- Board's fact findings are given deference while legal conclusions are reviewed without deference.
  - “Substantial evidence” standard for fact findings by the Board.
  - “***De novo***” standard for reviewing questions of law.

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# The Board in the Appeals Process



# The Appeals Process

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- *Ex Parte* Appeals are from the Examiner's "adverse" decision rejecting the claims in a patent application, reissue application, or a reexam proceeding.
- The Board is a judicial body reviewing issues identified by Appellant.
  - The Board does not "allow" claims.
- Decisions are made based on the arguments in the Appeal Briefs and the preponderance of the evidence relied upon by the Appellant and the Examiner in the record. See *Ex parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential).
- Appellant may request an Oral Hearing.

# The Appeals Process

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- The Board has authority delegated by the Director to enter new grounds of rejection.
  - Use of this authority is discretionary.
- The MPEP advises Examiners not to draw any inference from a Board decision that does not exercise this discretion.

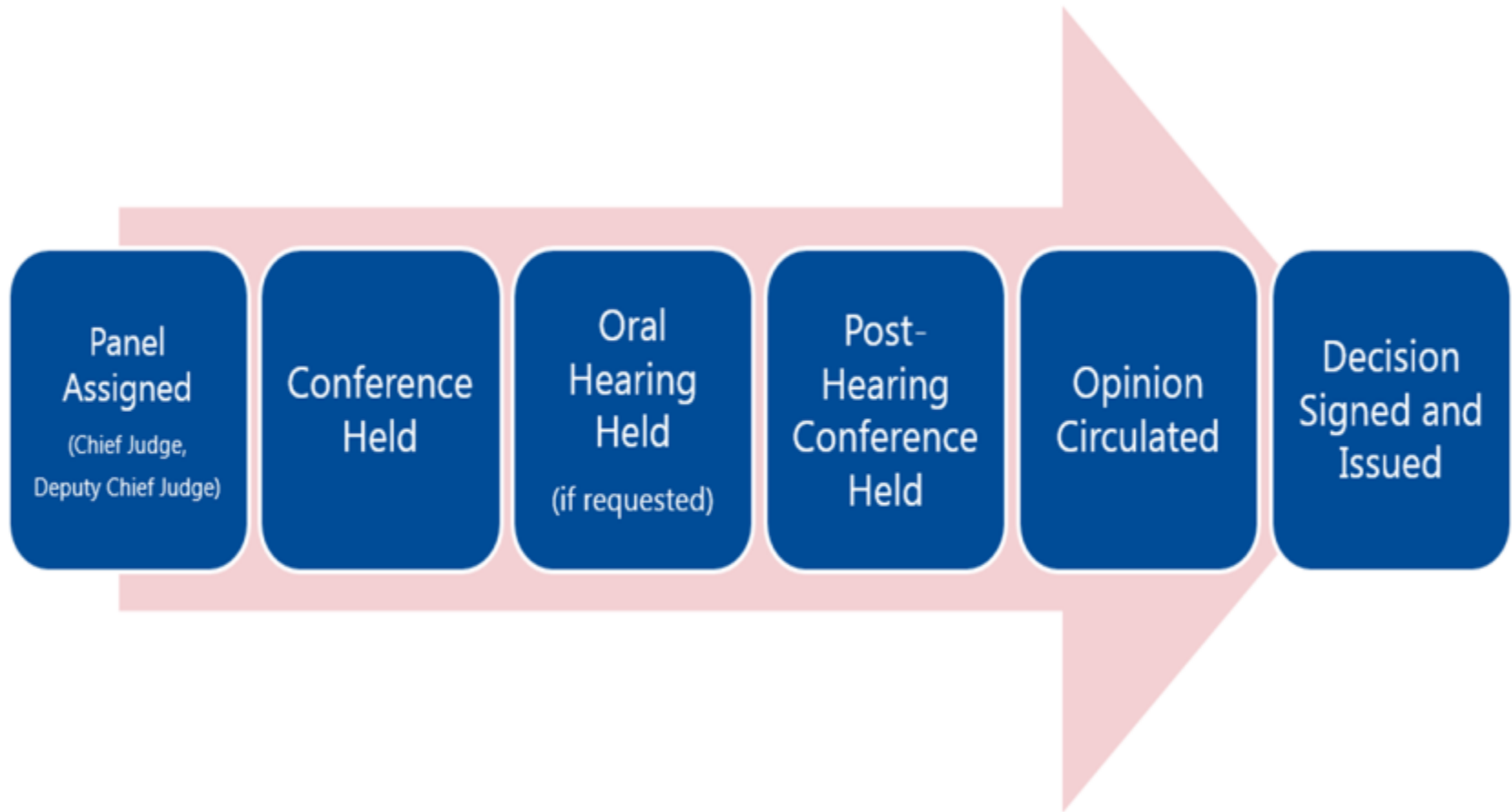
# Basic View of the Process

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- Getting to be heard at the Board.
  - Twice Rejected (or “Final” Rejection)
  - Notice of Appeal
    - Pre-Appeal Brief Review Request
  - Filing of an Appeal Brief
    - Appeal Conference
  - Filing of an Examiner’s Answer
  - Filing of a Reply Brief
  - Payment of the Appeal Brief Forwarding Fee
  - Oral Argument Request
  - Oral Hearing (if requested)

# The Appeal Process at the Board

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# Actions After Adverse Decision

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- Request for Continued Examination (RCE); or
- Request for Rehearing; or
- Appeal to United States Court of Appeals for the Federal Circuit, and then to United States Supreme Court; or
- Civil Action in the United States District Court for the Eastern District of Virginia.

# Best Practices – Appeal Briefs

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- Discussion with Judges related to:
  - Effective Appeal Briefs.
    - Present only the strongest arguments.
    - Strategically group claims to highlight the strongest arguments in the case.
    - Develop the facts of your case to show how the law applies to achieve the result being sought.
    - Understand the burden of proof.
    - Define key claim terms.
    - Support arguments with evidence.
    - Understand the difference between appealable and petitionable issues.
    - Use Summary of Claimed Subject Matter to support your appeal.

# Best Practices – Reply Briefs

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- Discussion with Judges related to:
  - Effective Reply Briefs.
    - Use to respond to points raised in the Examiner's Answer.
    - Do not reiterate arguments presented in Appeal Brief.
    - Do not raise new arguments in a Reply Brief that are not responsive to arguments made in the Examiner's Answer.
    - Do not separately argue claims for the first time in a Reply Brief.

# Best Practices – Rehearing

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- Discussion with Judges related to:
  - Effective Rehearing Requests.
    - File Requests for Rehearing only when appropriate.
    - Do not simply re-argue the points raised in the Briefs.
    - Identify particular points of error by the Board.
    - Strategically limit arguments to only one or two assertions of error, and refer to the specific portions of the Board’s opinion where the errors can be found.
- Other best practices.

## Roundtable Discussion – *Ex Parte* Appeals

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- Roundtable discussion regarding:
  - Deciding when and what to appeal.
  - Strategies for oral argument.

# QUESTIONS?

# PTAB Bar Association “Boot Camp”—Agenda

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- Overview of the Patent Trial and Appeal Board (PTAB).
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- **Post-Grant Proceedings at the Board.**
  - Overview of a post-grant proceeding with roundtable discussions re:
    - Petition;
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    - Discovery;
    - Patent Owner Response/Petitioner’s Reply/Sur-Replies;
    - Motions to Amend; and
    - Oral Argument/Final Written Decision.

# Post-Grant Options: *Inter Partes* Review (IPR)

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- Eligible Patents:
  - All non-AIA patents.
  - After nine months of grant or after termination of a Post-Grant Review (PGR), if PGR has been initiated for AIA patents.
- Eligible Petitioners:
  - Any individual or entity who is not the Patent Owner, unless:
    - The Petitioner or Petitioner's real party-in-interest filed a civil action challenging the validity of a claim of the patent;
    - The Petition is filed more than one year after the Petitioner, Petitioner's real party-in-interest, or Petitioner's privy was served with a complaint alleging infringement of the patent; or
    - The Petitioner, the Petitioner's real party-in-interest, or Petitioner's privy is estopped from challenging the claims on the grounds in the Petition.
- Eligible Grounds:
  - 35 U.S.C. §§ 102 and 103 based on patents and printed publications.



# *Inter Partes* Review (IPR)

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- **Claim Construction Standard:** *Phillips* for petitions filed on or after Nov. 13, 2018; BRI for non-expired petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - Reasonable likelihood that Petitioner would prevail on at least one challenged claim.
- **Estoppel:**
  - PTO: “any ground that the Petitioner raised or reasonably could have raised.”
  - District Courts/ITC: “any ground that the Petitioner raised or reasonably could have raised.”
- **Key Authority to Know:**
  - 35 U.S.C. §§ 102, 103, 311-319;
  - 42 C.F.R. §§ 42.1-42.80, 42.100-42.123;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73); and
  - Trial Practice Guide Update (August 2018).

# Post-Grant Options: Post-Grant Review (PGR)

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- **Eligible Patents:**
  - AIA patents no later than nine months from the date of grant.
- **Eligible Petitioners:**
  - Any individual or entity who is not the Patent Owner, unless:
    - The Petitioner or Petitioner's real party-in-interest filed a civil action challenging the validity of a claim of the patent; or
    - The Petitioner, the Petitioner's real party-in-interest, or Petitioner's privy is estopped from challenging the claims on the grounds in the Petition.
- **Eligible Grounds:**
  - All available grounds under 35 U.S.C. § 282(b)(2) or (3).

# Post-Grant Review (PGR)

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- **Claim Construction Standard:** *Phillips* for petitions filed on or after Nov. 13, 2018; BRI for non-expired petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - More likely than not that at least one challenged claim is unpatentable.
- **Estoppel:**
  - PTO: “any ground that the Petitioner raised or reasonably could have raised.”
  - District Courts/ITC: “any ground that the Petitioner raised or reasonably could have raised.”
- **Key Authority to Know:**
  - 35 U.S.C. §§ 101-112, 282, 321-329;
  - 42 C.F.R. §§ 42.1-42.80, 42.200-42.224;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73); and
  - Trial Practice Guide Update (August 2018).

# Post-Grant Options: Covered Business Method (CBMR)

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- **Eligible Patents:**
  - Non-AIA “financial services” patents and AIA “financial services” patents nine months after grant; excluding “technological inventions.”
- **Eligible Petitioners:**
  - Any individual or entity who is not the Patent Owner **and** who itself, its real party-in-interest, or its privy, has been sued or charged with infringement of the challenged patent, unless:
    - The Petitioner or Petitioner’s real party-in-interest filed a civil action challenging the validity of a claim of the patent; or
    - The Petitioner, the Petitioner’s real party-in-interest, or Petitioner’s privy is estopped from challenging the claims on the grounds in the Petition.
- **Eligible Grounds:**
  - All available grounds under 35 U.S.C. § 282(b)(2) or (3), except as modified by section 18(a)(1)(C) of the AIA.

# Covered Business Method (CBMR)

- **Claim Construction Standard:** *Phillips* for petitions filed on or after Nov. 13, 2018; BRI for non-expired petitions filed before Nov. 13, 2018.
- **Institution Standard:**
  - More likely than not that at least one challenged claim is unpatentable.
- **Estoppel:**
  - PTO: “any ground that the Petitioner raised or reasonably could have raised.”
  - District Courts/ITC: “**any ground that the Petitioner raised.**”
- **Key Authority to Know:**
  - Pub. Law. 112-29, 125 Stat, 329-31, § 18 (AIA);
  - 35 U.S.C. §§ 321-329;
  - 42 C.F.R. §§ 42.1-42.80, 42.203, 42.205-42.224, 42.300-42.305;
  - Office Patent Trial Practice Guide (77 Fed. Reg. 48756-73);
  - Trial Practice Guide Update (August 2018); and
  - 2019 Revised Patent Subject Matter Eligibility Guidance.

# PTAB Bar Association “Boot Camp”—Agenda

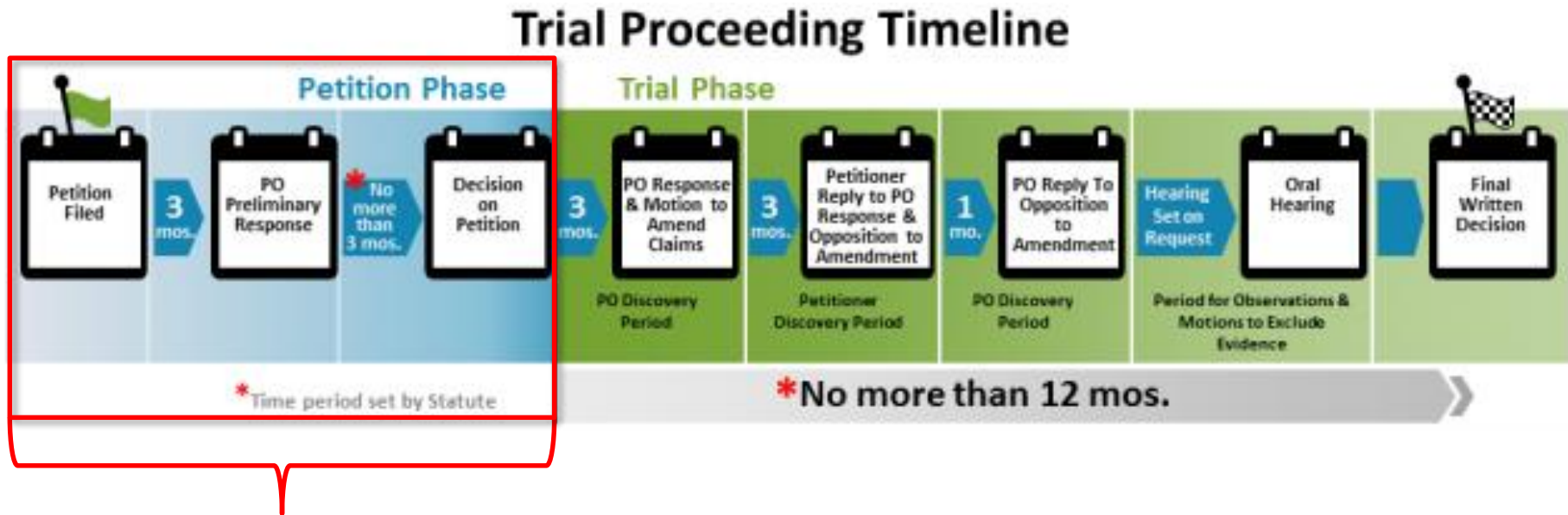
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# Overview of PTAB Proceedings



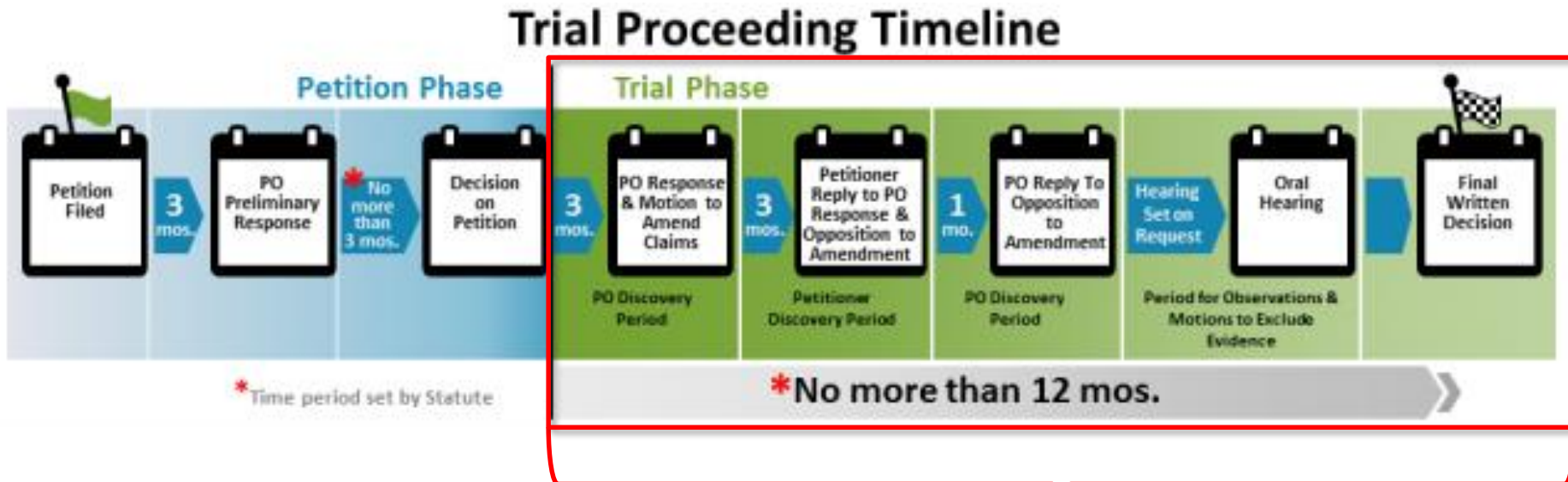
# “Petition” Phase



- Also referred to as the “preliminary proceeding” phase.
- Begins with the filing of a Petition and ends with an Institution Decision.
- A few rules depend on whether you are in the preliminary phase or the subsequent “trial” phase.
  - E.g., how long you have to object to evidence.



# “Trial” Phase



- Begins with Institution Decision and ends with Final Written Decision.
- Statutorily required to be completed within one year of institution.
  - Except that the time may be extended up to six months for good cause or adjusted in the case of joinder.

# Petition



- The most important document filed by the Petitioner.
- Petition must carry the threshold burden that the Petitioner will prevail with respect to at least one challenged claim.
  - IPR: Reasonable likelihood of success.
  - PGR/CBMR: More likely than not.

# Petition “Must Haves”

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- Every Petition must identify the Petitioner, real-parties-in-interest, counsel, etc.
  - CBMR requires additional analysis regarding why patent subject to CBMR review and showing that Petitioner has been charged with infringement.
- Must include a statement of the precise relief requested.
- Must include a full statement of the reasons for the relief requested (i.e., detailed explanation of why the claims are invalid).
  - IPR/PGR/CBMR – prior art (i.e., patents/printed publication) analysis (102/103).
  - PGR/CBMR – analysis of additional grounds (101, 112).
- Must set forth any claim constructions needed to interpret the claims.

# Petition “Must Haves”

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- The Petition must be in size 14, font TNR, and double spaced; although there are some exceptions. See Rule § 42.6(a)(2)(iii).
  - Claim charts, however, can be single spaced.
- Petitions have strict word limits (as opposed to page limits):
  - IPR: 14,000 words; PGR/CBMR: 18,700 words.
- No incorporation of arguments by reference to other documents.
  - E.g., may be unable to meet threshold burdens with arguments only incorporated by reference from expert declaration, or via incorporating papers from another proceeding.
- For non-substantive issues, PTAB may authorize filing corrected Petitions to fix minor informalities.
  - But you only get one chance to submit a winning Petition.

# Real Party-in-Interest/Privy

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- The Board considers RPI/privy issues when, e.g., a missing RPI or a privy would result in a 315(b) bar.
- The Federal Circuit has clarified the parties' respective burdens regarding an RPI or privy issue:
  - The IPR petitioner bears the burden of persuading the Board that the petition is not time-barred under Section 315(b);
  - The Board should accept the petitioner's initial identification of RPIs unless and until disputed by the patent owner; and
  - The patent owner must produce "some evidence" that a particular third party should have been named an RPI and was not. *Worlds Inc. v. Bungie, Inc.*, 930 F.3d 1237 (Fed. Cir. Sep. 7, 2018).

# Real Party-in-Interest/Privy

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- Who is an RPI?
  - A RPI is “the party that desires review of the patent,” which may be the petitioner itself or “the party or parties at whose behest the petition has been filed.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012).
  - “Determining whether a nonparty is a ‘real party in interest’ demands a flexible approach that takes into account both the equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time v. RPX Corporation*, 897 F.3d 1336 (Fed. Cir. 2018).
  - A nonparty to an IPR can be a RPI even without entering into an express or implied agreement with the petitioner to file a petition. *Id.*

# Real Party-in-Interest/Privy

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- Who is a privy?
  - Privy is an inquiry into whether the parties have a “substantive legal relationship.” *Taylor vs. Sturgell*, 553 U.S. 880 (2008).
  - The Trial Practice Guide and Board analyze the following *Taylor* factors:
    1. The existence of an agreement that the non-party be bound by a determination of issues in an action between the parties.
    2. The existence of a pre-existing substantive legal relationship between the non-party and a party.
    3. Representation in an action by someone with the same interests as the non-party.
    4. The assumption of control over an action by the non-party.
    5. Re-litigation of issues through a proxy.
    6. The existence of a special statutory scheme.

# Claim Construction

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- For Petitions filed on or after November 13, 2018, the previous “broadest reasonable interpretation” standard has been replaced with the federal court claim construction standard that is used to construe a claim in a civil action under 35 U.S.C. § 282(b).
  - This is the same claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.
- When construing a claim term in an IPR (or PGR and CBMR), the PTAB will take into consideration any prior claim construction determination that has been made in a civil action, or a proceeding before the International Trade Commission (ITC), if timely made of record.



# Section 112 Issues

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- Section 112 issues cannot be raised in an IPR.
- Before *SAS*, the Board occasionally refused to institute an IPR as to certain claims that were indefinite under Section 112, and the challenges to those claims would not be part of the Board's final written decisions. Post *SAS*, the Board can no longer take a selective, claim-by-claim approach.
- Section 112 issues can arise in an IPR when determining the earliest effective filing date assigned to the challenged patent claims, in the context of which prior art applies, and also in the context of whether PGR applies.

# Selecting Prior Art

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- The petitioner has the burden of demonstrating that a reference qualifies as prior art.
- The burden of persuasion always remains with the petitioner to prove “unpatentability by a preponderance of evidence” under 35 U.S.C. § 316(e).
- In evaluating the prior art, the petitioner should consider the scope of any later estoppel under 35 USC §§ 315(e), 325(e).

# Prior Art Eligibility: Printed Publication

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- If relying on an article or publication, Petitioners are required to establish references as printed publications.
- Factors to be considered in determining whether information qualifies as a printed publication are set forth in *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004):
  - (i) the length of time the display was exhibited;
  - (ii) the expertise of the target audience;
  - (iii) the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied; and
  - (iv) the simplicity or ease with which the material displayed could have been copied.

# Prior Art Eligibility: Printed Publication

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- Strategies for qualifying a reference as a printed publication:
  - Provide evidence when filing a petition establishing a reference as a printed publication. For example:
    - Declarations from people with personal knowledge regarding the publication.
    - Evidence as to indexing at a library.
    - Evidence as to release in a well-known journal.
  - Consider showing multiple instances of publication.
- See USPTO, Best Practices for Proving a Document is a Printed Publication, Dec. 7, 2017.  
([https://www.uspto.gov/sites/default/files/documents/proving\\_a\\_document\\_is\\_a\\_printed\\_publication\\_12\\_7\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/proving_a_document_is_a_printed_publication_12_7_2017.pdf))

# Best Practices – Petition

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- Discussion with Judges related to:
  - Dos and don'ts for petitions
    - Number and presentation of grounds.
    - Use and content of expert declaration.
  - Impact of claim construction change?
  - Other best practices.

## Roundtable Discussion – Petition

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- Roundtable discussion regarding:
  - Strategies for petition drafting.
  - Public availability of prior art.
  - Real Party-in-Interest/Privy issues.

# Patent Owner Preliminary Response (POPR)



- Any POPR is due within three months of a Notice of Filing Date Accorded - Not Petition filing date.
- Rules now allow Patent Owners to submit new testimonial evidence with Preliminary Response.
  - The Board, for purposes of its Institution Decision, will find any dispute of material fact in favor of Petitioner.

# Patent Owner Preliminary Response (POPR)

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- Patent Owner's opportunity to make arguments against institution, such as:
  - Statutory Bars (e.g., outside one year window (IPR), Patent Owner not sued or charged with infringement (CBMR), and estoppel).
  - Board should use discretion to deny (e.g., arguments already considered by Office, redundant grounds, etc.).
  - Incomplete Petition.
    - Failure to meet Petition content requirements (e.g., claim constructions).
- Failure to meet institution thresholds.
- Consider making arguments that the prior art lacks a material element of the claims, teaches away, or doesn't actually qualify as prior art.



## Best Practices – POPR

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- Discussion with Judges related to:
  - Effective POPR arguments.
  - Use and content of expert declaration.
  - Requesting a Petitioner Sur-Reply.
  - Other best practices.

# Roundtable Discussion – POPR

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- Roundtable discussion regarding:
  - POPR strategies.
  - Use of expert testimony.

# Institution Decision



- Within three months of the POPR, PTAB will issue an Institution Decision
  - Sets out which claims are instituted and under what grounds.
- Accompanied by a Scheduling Order for the “trial phase.”
- Starts the one-year clock to issue a Final Written Decision.

# Scheduling Order

DUE DATE APPENDIX	
<b>DUE DATE 1</b>	
Patent owner's response to the petition	<b>3 months</b>
Patent owner's motion to amend the patent	
<b>DUE DATE 2</b>	
Petitioner's reply to patent owner response to petition	<b>3 months</b>
Petitioner's opposition to motion to amend	
<b>DUE DATE 3</b>	
Patent Owner's sur-reply to reply	<b>1 month</b>
Patent Owner's reply to opposition to motion to amend	
<b>DUE DATE 4</b>	
Petitioner's sur-reply to reply to opposition to motion to amend	<b>1 month</b>
Motion to exclude evidence	
<b>DUE DATE TO FILE REQUESTS FOR ORAL ARGUMENT</b>	<b>Same as Due Date 4 (but parties may not stipulate an extension)</b>
<b>DUE DATE 5</b>	
Opposition to motion to exclude	<b>1 week</b>
<b>DUE DATE 6</b>	
Reply to opposition to motion to exclude	<b>1 week</b>
Request for prehearing conference	
<b>DUE DATE 7</b>	
Oral argument	<b>2 weeks</b>

# Institution Decision “Takeaways”

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- The Board will institute as to all claims or none. *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, (U.S. Apr. 24, 2018).
- Request for Reconsideration an option.
- Institution Decisions are final and non-appealable.

# Board Considerations in Instituting a Review

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- Board considers various non-exclusive factors in determining whether to institute trial.
  - See 35 USC §§ 314(a), 324(a), 325(d).
- Sections §§ 314(a) and 324(a) provide the Director with discretion to deny a petition.
  - In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board “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).
  - *General Plastic* enumerated non-exclusive factors that the Board will consider in exercising discretion on instituting IPR.
    - *General Plastic* factor analysis especially relevant as to “follow-on” petitions.

## Board Considerations in Instituting a Review (§§ 314(a) and 324(a))

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- *General Plastic* non-exclusive factors include:
  1. Whether the same petitioner previously filed a petition directed to the same claims of the same patent;
  2. Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
  3. Whether at the time of filing of the second petition the petitioner already received the POPR 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.

## Considerations in Instituting a Review - § 325(d)

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



## Considerations in Instituting a Review - 35 U.S.C. § 325(d)

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- 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.

# Joinder

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- The Board has the discretion to join multiple petitions under 35 U.S.C. § 315(c).
- A request for joinder must be filed within one month after the institution date of a petition for which joinder is requested. 37 CFR §§ 42.122(b).
- The Board has addressed whether a time-barred petitioner can join its own prior instituted proceeding and raise new issues in *Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, Paper No. 28 (Feb. 12, 2015). The POP is reviewing this issue in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2018-00914.

## Best Practices – Institution Decision

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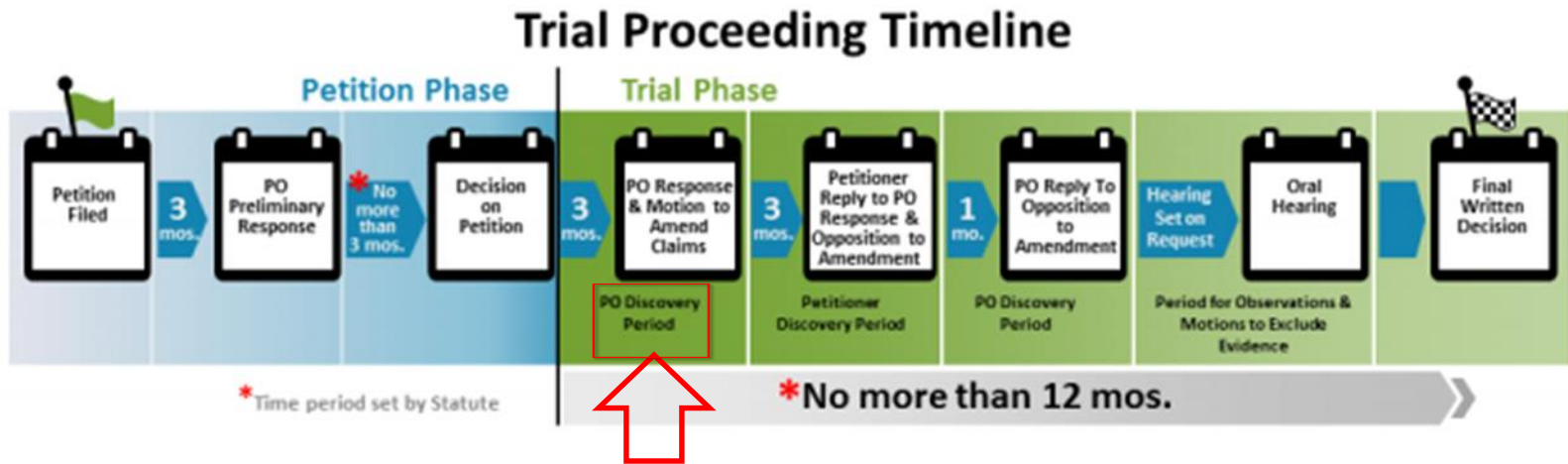
- Discussion with Judges related to:
  - Best practices for addressing the *General Plastic* and *Becton Dickinson* factors.
  - Best practices for motions for joinder.
  - Best practices for request for reconsiderations.

# Roundtable Discussion – Institution Decision

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- Roundtable discussion regarding:
  - Strategies and practical changes post-SAS.
  - Change in claim construction standard.
  - Joinder.

# Patent Owner Discovery Period



- Institution Decision begins Patent Owner Discovery Period.
  - Typically includes cross-examination of Petitioner’s expert.
- Discovery is limited to three types:
  - Routine, Mandatory, and additional discovery.

# Routine Discovery

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- Three general categories:
  - A party must serve any exhibit cited in a paper or in testimony, unless it has already been served or the parties agree otherwise.
  - A party must serve relevant information that is *inconsistent* with a position advanced by the party concurrent with the filing of the documents that include the inconsistency.
  - A party may cross-examine the other party's declarants.

## "Mandatory" Initial Disclosures

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- Parties may agree to mandatory discovery that requires initial disclosures, but this rarely happens.
- There are two options available for initial disclosures:
  - Option 1 is modeled after Rule 26(a) of the Federal Rules of Civil Procedure.
  - Option 2 is more extensive and generally requires the petitioner to:
    - Identify persons and information relating to the basis of any alleged obviousness, secondary considerations, and, if a challenge is based on alleged prior nonpublished public disclosure, information relating to it.

# Additional Discovery

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- Additional discovery is discovery that goes beyond routine discovery (or mandatory discovery, if applicable).
  - For example, the production of documents not referred to in the Petition or Preliminary Response may be additional discovery.
- Parties may agree to additional discovery between themselves, and when they do not agree, a party may seek authorization to move for additional discovery.
- Opposed requests for additional discovery require a joint conference call with the Board to discuss the request.



# Additional Discovery

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- A party seeking additional discovery must show that the additional discovery is in the interests of justice (for IPRs) or for good cause in the proceedings (for PGRs/CBMRs).
- These two standards are closely related but, on balance, the interests-of-justice standard is slightly higher than the good-cause standard.
- And, additional discovery in PGR proceedings is limited to evidence directly related to factual assertions advanced by either party.

# Additional Discovery

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- *Garmin* Factors:
  - More than a possibility and mere allegation that something useful will be discovered;
  - requests that do not seek other party's litigation positions and the underlying basis for those positions;
  - ability to generate equivalent information by other means;
  - easily understandable instructions; and
  - requests that are not overly burdensome to answer.

# Best Practices – Discovery

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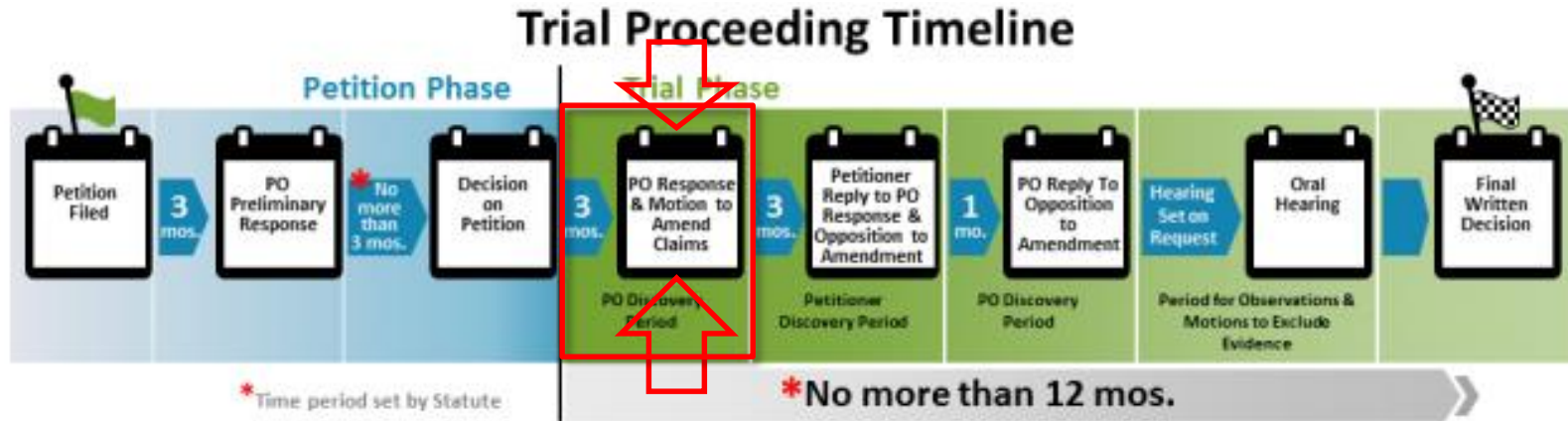
- Discussion with Judges related to:
  - Use of routine discovery.
  - Effective motions for additional discovery.
  - Other best practices.

# Roundtable Discussion – Discovery

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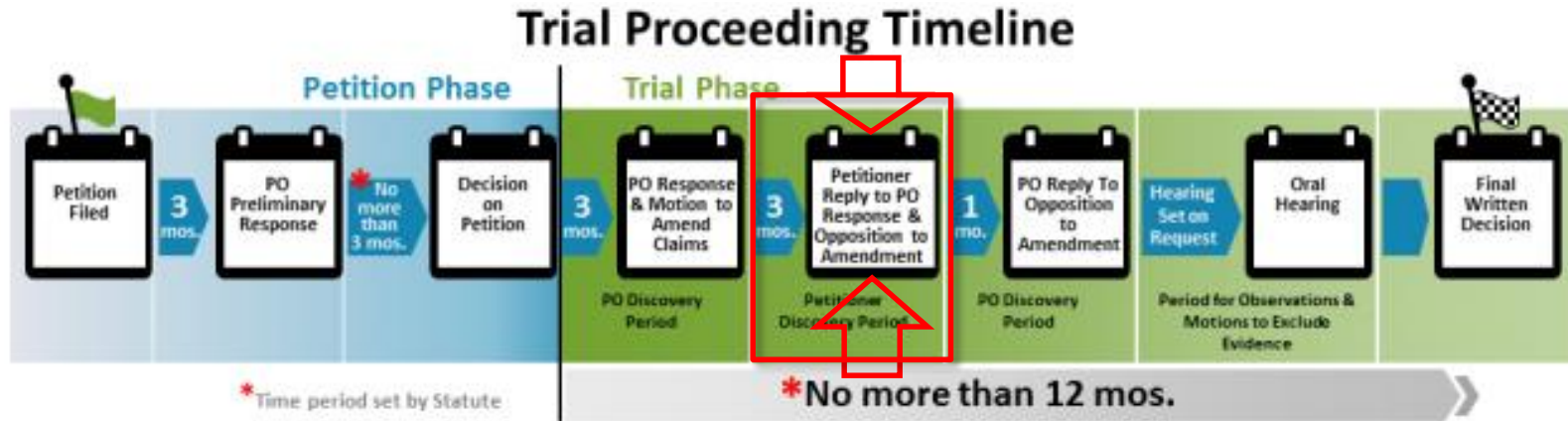
- Roundtable discussion regarding:
  - Effective motions for discovery authorization.
  - *Garmin* factors discussion.
  - Supplemental information vs. supplemental evidence.

# Patent Owner Response (POR)



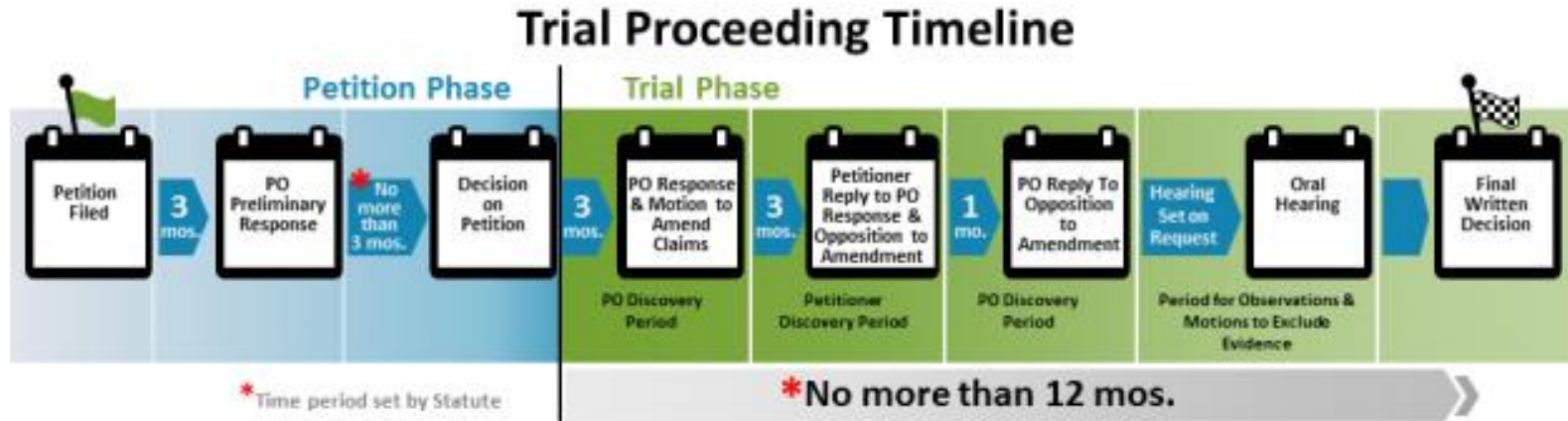
- Patent Owner must file a Response typically due within 2-3 months.
  - Due date set by Scheduling Order.
- Patent Owner is permitted to fully address the merits of the challenger's Petition on the instituted grounds and present evidence.

# Petitioner Reply to Patent Owner Response



- Petitioner may submit new evidence/expert declaration (but this triggers a new Patent Owner Discovery period).
- Scope limited to responding to Patent Owner Response.
  - Reply may explain petition arguments in responding to Patent Owner Response, but no new arguments are permitted.

# Patent Owner Sur-Reply to Patent Owner Response



- Patent Owner Sur-Replies to a Petitioner's Reply to Patent Owner Response will normally be authorized by the scheduling order entered at institution. Trial Practice Guide Update (August 2018).
  - Sur-reply practice essentially replaces the previous practice of filing observations on cross-examination testimony.

# Best Practices – Trial Briefing

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- Discussion with Judges related to:
  - Effective trial brief writing.
  - Effective use of expert testimony in trial phase.
  - Use of Patent Owner Sur-Replies.
  - Other best practices.

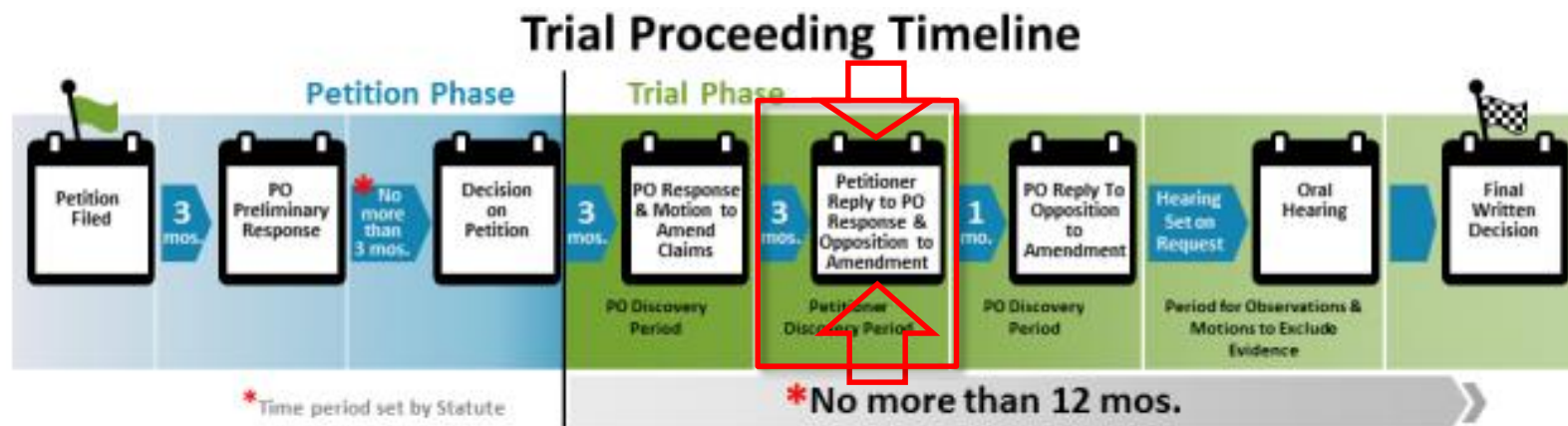


# Roundtable Discussion – Trial Briefing

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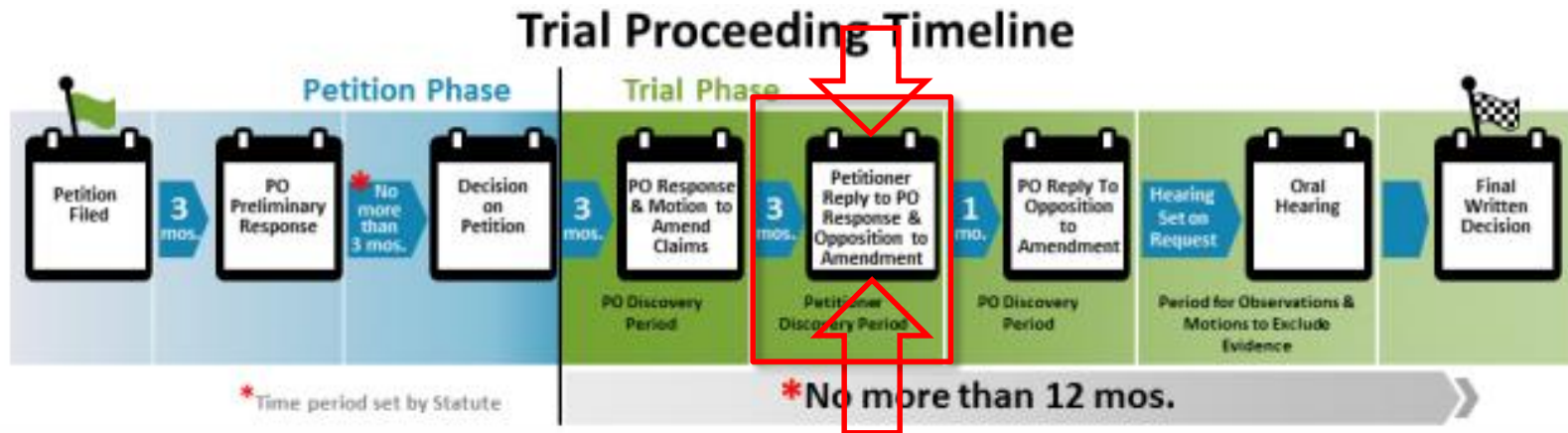
- Roundtable discussion related to:
  - Raising new arguments in trial briefing.
  - Sur-Replies.

# Motion to Amend Claims



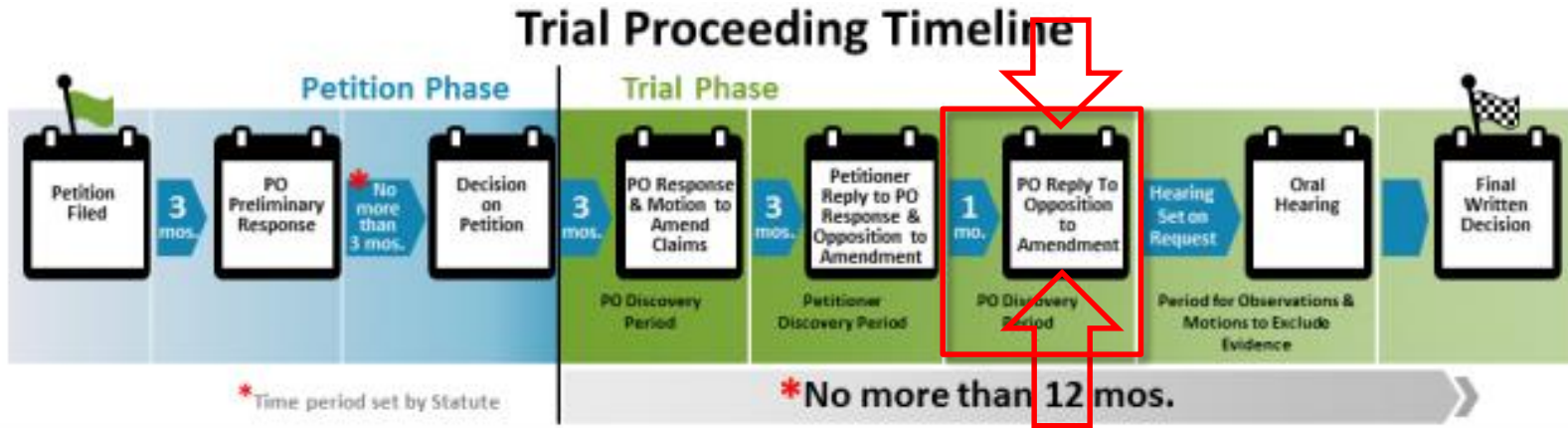
- Motion to Amend Claims currently due with the Patent Owner Response.
  - A single Motion to Amend may be filed as of right, additional motions require a showing of “good cause.”
  - The same *Phillips* claim construction standard will be used for proposed substitute claims in a motion to amend.
- The PTAB recently designated *Lectrosonics* as precedential regarding motion to amend practice.

# Petitioner Opposition to Motion to Amend



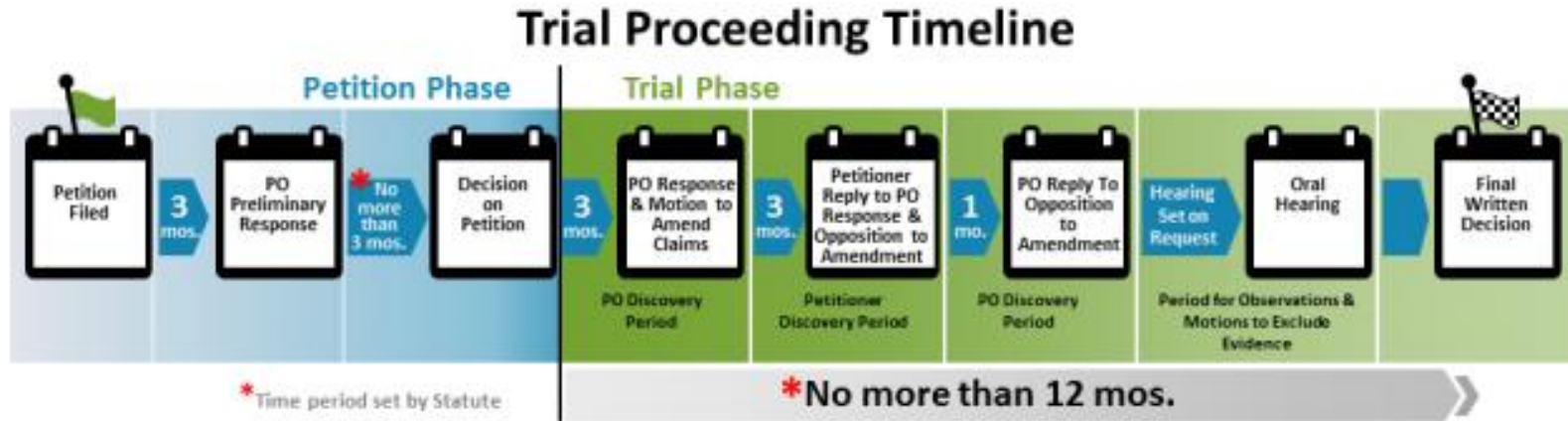
- Petitioner may argue reasons the claim amendments do not distinguish over all known prior art.
- Petitioner may submit new evidence/expert declaration (triggers a new Patent Owner Discovery period).

# Patent Owner Reply ISO Motion to Amend



- Patent Owner may submit a new evidence/expert declaration (triggers a new Petitioner discovery period).
- Scope limited to responding to Petitioner Opposition.

# Pet. Sur-Reply to PO Reply ISO Motion to Amend



- Petitioner Sur-Replies to a Patent Owner’s Motion to Amend will normally be authorized by the scheduling order entered at institution. Trial Practice Guide Update (August 2018).
- Scope limited to responding to Patent Owner Reply.

# Best Practices – Amendment Practice

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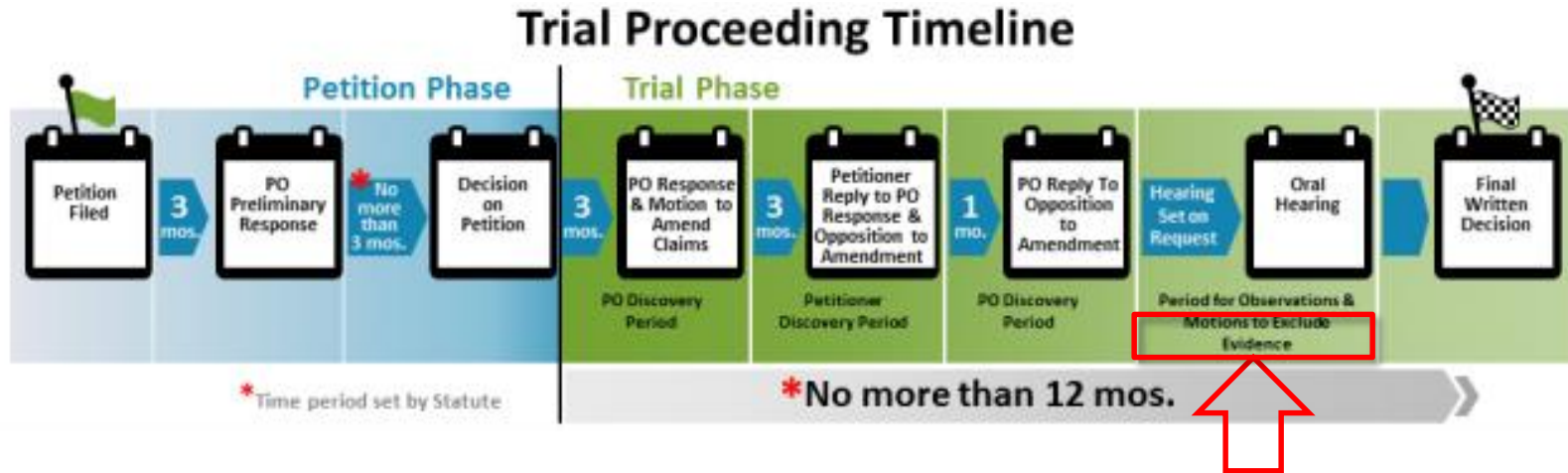
- Discussion with Judges regarding:
  - Effective amendment briefing.
    - Arguments that help make a motion to amend effective?
    - Arguments that do not?
  - Effective use of expert testimony at the amendment stage.
  - *Lectrosonics*.
  - Other best practices.

# Roundtable Discussion – Amendment Practice

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- Roundtable discussion related to:
  - Considerations for filing motions to amend.

# Motions to Exclude/Strike



- The parties may motion the Board to exclude evidence and strike arguments from the record.
- The Board may rule on motions to exclude/strike on the pre-conference call, at the oral hearing, and/or in the FWD.



# Motions to Exclude

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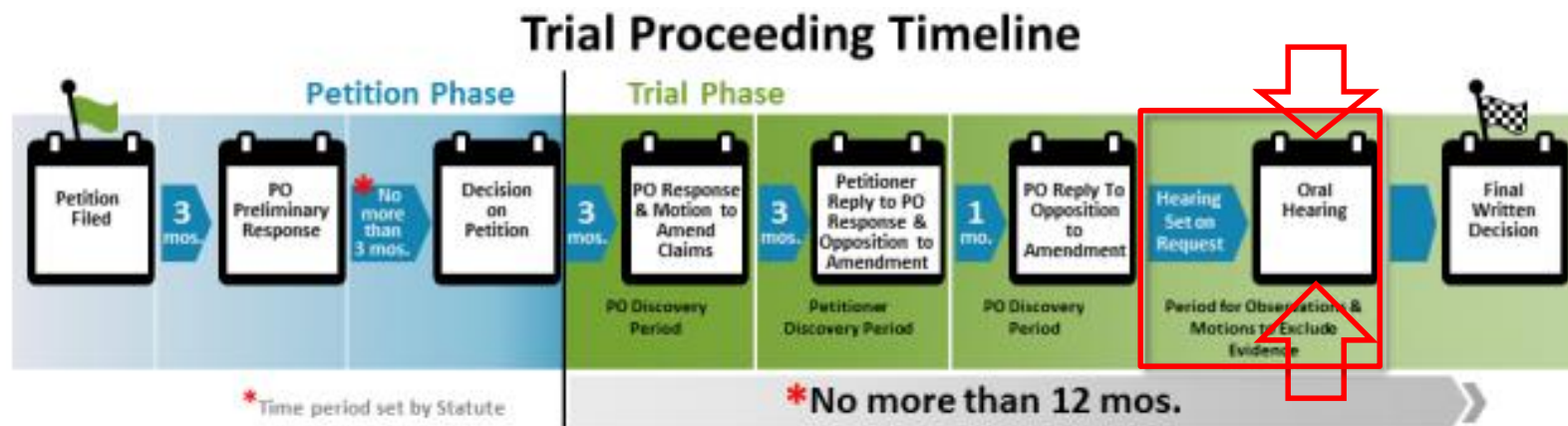
- Objections to Evidence: To challenge the admissibility of evidence, objections must be filed within five business days of service of evidence to which the objection is directed, or ten days after institution of trial. 37 C.F.R. §§ 42.64(a), 42.64(b)(1).
- Motions to Exclude: Objections may be preserved only by filing a motion to exclude the evidence. 37 C.F.R. § 42.64(c).
  - The due dates for filing a motion to exclude evidence, an opposition, and a reply for a motion to exclude are usually set in the Scheduling Order.

# Motions to Strike

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

# Oral Hearing



- The parties may request oral argument.
- Live testimony may be permitted when requested and approved by the Board.
- The parties may file demonstrative exhibits.
  - Demonstrative must only include material from the record.

# Oral Hearing

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- Board expects to ordinarily provide for an hour of argument per side for a single proceeding, but a party may request more or less time depending on the circumstances of the case.
- The Board encourages the parties to confer before filing a request for oral hearing and, if possible, jointly agree regarding the appropriate argument time needed for each side.

# Oral Hearing

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- A pre-hearing conference call may be held at either party's request.
- The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties.
- Board may also permit patent owners the opportunity to present a brief sur-rebuttal, if requested.

# Final Written Decision



- Required within one year of institution (subject to possible extension for good cause and joinder).
- Decides all instituted grounds.
  - If the claims are deemed unpatentable, the Board will order them “cancelled” (as opposed to invalid).
- Issuing the Final Written Decision creates estoppel for issues raised (or reasonably could have been raised for IPRs and PGRs) during the “proceeding.”

# Post-Final Written Decision

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- Rehearing
  - Any party dissatisfied with the Final Written Decision may file one Request for Reconsideration.
  - Rehearing request is due 30 days from the Final Written Decision.
- Appeal
  - Parties may appeal the PTAB's Final Written Decision to the United States Court of Appeals for the Federal Circuit.
  - Notice of Appeal is due within 63 days unless tolled by a timely filed Request for Rehearing.

# Remand

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- Standard Operating Procedure 9 governs cases remanded from the Federal Circuit.
- The Board's has set a goal of issuing decisions within 6 months after the Federal Circuit's mandate.
- The Board has set forth default procedures for trials and ex parte appeals regarding whether further briefing, evidence, or oral hearings are warranted in individual case and whether prosecution will be reopened. See Standard Operating Procedure 9, Appendix 2.



# Best Practices – Hearing, FWD, Rehearing Requests

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- Discussion with Judges regarding:
  - Use of live testimony.
  - Preparing effective (and proper) demonstratives.
  - Patent Owner sur-rebuttal.
  - Timing and use of pre-hearing conference call.
  - Other best practices.

## Roundtable Discussion – Hearing, FWD, Rehearing Requests

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- Roundtable discussion regarding:
  - Considerations for filing Motions to Exclude/Strike.
  - Strategies at Oral Argument.

# PTAB Practice and Procedure Resources

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- PTAB Website:
  - <http://www.uspto.gov/ip/boards/bpai/index.jsp>
- PTAB Rules and Trial Practice Guide:
  - [http://www.uspto.gov/ip/boards/bpai/board\\_trial\\_rules\\_and\\_practice\\_guide.jsp](http://www.uspto.gov/ip/boards/bpai/board_trial_rules_and_practice_guide.jsp)
- Fees:
  - <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>
- Revised Trial Practice Guide (August 2018)
  - <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-trial-practice-guide-august-2018>

# QUESTIONS?