

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**uspto**

# Patent Trial and Appeal Board Boardside Chat: AIA Motions Practice

Erica Franklin, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Agenda

- Rules and guidance
- Common motions

# Rules and guidance

- a. General considerations
- b. Requesting authorization
- c. Burden of proof
- d. Content
- e. Page limits
- f. Timing

# General considerations

- Rules 37 C.F.R. § 42.20–25
- Trial Practice Guide ([www.uspto.gov/TrialPracticeGuideConsolidated](http://www.uspto.gov/TrialPracticeGuideConsolidated))
- In addition to the merits, the Board may consider the following when deciding whether to authorize a motion or to grant the relief requested in an authorized motion:
  - Burden on parties
  - Efficient, effective resolution of issues
  - Documenting for due process and Administrative Procedure Act
  - Statutory deadlines
  - Effect on schedule

# Requesting authorization

- Authorization obtained via conference call with panel
- Common procedure – requesting email:
  - Should copy all parties
  - Should indicate generally the relief requested or subject matter of the call
  - Should not include substantive argument or attachments (e.g., draft motions)
  - Should include multiple times when all parties are available
  - Should state any opposition and address the meet & confer requirement

# Burden of proof for motions

- Burden of proof to establish entitlement to requested relief is on moving party: § 42.20(c)



# Content of motions

- **Motion contents (filed as separate paper): § 42.22**
  - Statement of precise relief requested
  - Full statement of reasons for request, including detailed explanation of significance of evidence, material facts, and law
  - All showings required by rules
- **Oppositions and replies: § 42.23**
  - Comply with requirements for motions
  - Identify any disputed material facts (avoids unintentional admission)
  - Replies directed only to corresponding opposition

# Page limits for motions

- Page limits
  - Motions - 15 pages: § 42.24(a)(1)(v)
    - Unless waiver granted in advance: 42.24(a)(2)
  - Oppositions - same number of pages as corresponding motion: § 42.24(b)(3)
  - Replies to motions - 5 pages: § 42.24(c)(2)
- Limits INCLUDE any statement of material facts to be admitted or denied: § 42.24(a)(1)
- Limits EXCLUDE table of contents, certificate of service, appendix of exhibits: § 42.24(a)(1)
- Board may set other page constraints, e.g., fewer pages set when granting authorization to file

# Timing for filing motions

- Set in Scheduling Order
  - Patent owner motion to amend (and opposition/reply)
  - Revised motion to amend (if filed)
  - Motion(s) to exclude evidence (and opposition/reply)
- Opposition default – 1 month: § 42.25(a)(1)
  - Typically set much shorter
- Board can deny relief not promptly sought: § 42.25(b)

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# LEAP

- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
  - Aid in development of the next generation of patent practitioners
  - Encourage a diverse group of advocates to develop their skills before the Board
- To qualify, a patent agent or attorney must have:
  - Three or fewer substantive oral arguments in any federal tribunal, including PTAB, *and*
  - Seven or fewer years of experience as a licensed attorney or agent



# Common motions

- a. Pro hac vice
- b. To submit supplemental information
- c. To join proceedings
- d. To seal
- e. To exclude
- f. For additional discovery
- g. To terminate

# Pro hac vice motion: 37 C.F.R. § 42.10

- Authorized in Notice of Filing Date
  - No sooner than 21 days after service of petition (i.e., time for patent owner mandatory notices)
  - Oppose w/in 1 week; no reply to opposition, unless Board authorizes
  - Content requirements, *see* IPR2013-00639, Paper No. 7, Oct. 15, 2013
- Needed when attorney not registered to practice at USPTO
- Eligible only as back-up counsel
- May not withdraw without Board authorization



# Pro hac vice motion: 37 C.F.R. § 42.10

- Motion must show that:
  - Counsel has sufficient legal and technical qualifications
  - Counsel has an established familiarity with the subject matter at issue in proceeding
  - Party intends to be represented by attorney
- Motion must be accompanied by affidavit of counsel seeking *pro hac vice* admission
  - Required affidavit contents (8 items),  
see IPR2013-00639, Paper 7, Oct. 15, 2013



# Supplemental information versus supplemental evidence

- “Supplemental information” is different than “supplemental evidence” in connection with 37 C.F.R. § 42.64(b)(2). Only supplemental information requires an authorized motion. 37 C.F.R. § 42.123.
- “[S]upplemental evidence—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental information, on the other hand, is evidence a party intends to support an argument on the merits. Such evidence may only be filed if a § 123 motion is both authorized and granted.” *Handi Quilter, Inc. v. Bernina Int’l AG*, IPR2013-00364, Paper 30 at 2-3 (PTAB June 12, 2014)
- *See, e.g.*, CBM2013-00033, Paper 29 (distinguishing admissibility vs sufficiency)

# **Motion to submit supplemental information: 37 C.F.R. §§ 42.123, 223**

- Criteria (authorization to file is required)
  - Within 1 month of instituting trial
  - Relevance to a claim on which trial instituted (not the grounds)
  - If more than 1 month, must show: (1) why the information could not reasonably have been obtained earlier; and (2) why in the interests of justice

# **Motion to submit supplemental information: 37 C.F.R. §§ 42.123, 223**

- Not automatic, even if criteria met; Board considers efficient administration and completing IPR on time
- Motion to submit should not include the exhibit itself – exhibit submitted only if motion is granted

# Motion for joinder: 37 C.F.R. §§ 42.122, 222

- No later than 1 month after institution date
- Request for authorization to file motion is not required
- Board considers impact on schedule/efficiency
  - Can Board avoid major changes to scheduling order?

# Motion for joinder: 37 C.F.R. §§ 42.122, 222

- Motion for joinder should:
  - Provide reasons why joinder is appropriate
  - Explain what impact (if any) joinder would have on schedule and costs of existing proceeding
  - Address how briefing and/or discovery can be simplified
    - Consolidated filings; limit separate filings to joined party's points of disagreement with consolidated filing (page limit)
    - Consolidated depositions – no extension of allotted time unless requested and authorized first

# Motion to seal: 37 C.F.R. §§ 42.14, 54

- Confidential information only – public policy to make all information available
- Standard = good cause
- Motion must include:
  - Proposed protective order (if one has not already been entered) – Board’s default protective order is NOT automatically entered (entry must be requested) – show differences from Board’s default order
  - Certification that moving party attempted/conferred in good faith with opposing party on scope of order
  - Explanation of why info is confidential

# Motion to seal: 37 C.F.R. §§ 42.14, 54

- Production of same information in district court as confidential alone is not good cause, but provides context
- Information likely not confidential if previously available publicly (particularly if still available)
- Irrelevant personal information more likely confidential – consider redactions, e.g., account number on a check
- Move to expunge confidential information after final judgment, if appropriate: 37 C.F.R. § 42.56

# Motion to exclude

- Federal Rules of Evidence generally apply to proceedings: § 42.62
- Objections prior to institution typically are premature
  - Addressed during trial (e.g., lack of authentication)
- **Objections required**
  - Objections to be filed w/in 10 business days of institution of trial to evidence submitted during preliminary phase: § 42.64(b)(1)
  - During trial – file objection within 5 business days of service: § 42.64(b)(1)
  - Respond by serving supplemental evidence w/10 business days of objection: § 42.64(b)(2)
  - Objections themselves are not motions to exclude
  - Motion to exclude required to preserve objection: § 42.64(c) – due date in Scheduling Order
  - Identify grounds with sufficient particularity to allow correction with supplemental evidence, e.g., authentication by testimony
- **If party objects after supplementation, party moves to exclude**



# Motion to exclude

- Contents of motion to exclude
  - Identify each objection in the record and where evidence sought to be excluded was relied upon
  - Explain each objection (may be exhibits to motion) - explain why info/evidence is not admissible
- Motion to exclude is NOT a substantive sur-reply
- Motion to exclude is NOT a vehicle to challenge sufficiency of evidence to prove a fact
- Motion to exclude is NOT a vehicle to argue whether a reply or supporting evidence is of appropriate scope: *Conopco, Inc. v. Procter & Gamble Co.*, IPR2013-00505, Paper 69 at 29 (PTAB Feb. 10, 2015)

# Motions for additional discovery: 37 C.F.R. § 42.51

- Authorization to file required
- Consideration is case specific
- Parties may agree to additional discovery between themselves

# Motions for additional discovery: 37 C.F.R. § 42.51

- Content of motion
  - Address *Garmin* factors concerning whether additional discovery is in interests of justice, see IPR2012-00001, Paper 26 for IPR
    1. More than a possibility and mere allegation
    2. Litigation positions and underlying basis
    3. Ability to generate equivalent information by other means
    4. Easily understandable instructions
    5. Requests not overly burdensome to answer
  - See also, *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005, Paper 32 for CBM and PGR (good cause)

# Motion to terminate: 37 C.F.R. §§ 42.72–42.74

- Termination: § 42.72
  - Of a party – Board may proceed to final written decision (even if no petitioner remains)
  - Of the proceeding – Board enters judgment; terminates proceeding
- A party may request adverse judgment: § 42.73(b)
  - Disclaimer of patent, claim cancellation, concession of unpatentability, and abandonment of contest may be construed as such a request
- Settlement: § 42.74
  - Parties can settle any issue via joint request: 35 U.S.C. § 317(a), § 327(a)
  - All agreements/understandings in writing & filed with Board; no side agreements (panel may require parties to represent that no side agreements exist in the motion): 35 U.S.C. § 317(b), § 327(b)
  - May be treated as business confidential – request to keep separate
  - Board not a party to the settlement

# Motion to terminate: 35 U.S.C. § 315(e)(1)

- Section 315(e)(1) provides:

## (e) Estoppel. —

(1) Proceedings before the office.—The petitioner in an inter partes review of a claim . . . that results in a final written decision . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 315(e)(1); *see* 37 C.F.R. § 42.73(d).

- Termination

– Of a second proceeding – Board enters judgment in a first proceeding and terminates a second proceeding (no joinder) having a ground that *reasonably* could have been raised in first proceeding.

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# Fast-Track Appeals Pilot Program

- One-year pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Last month's Boardside Chat (February 18, 2021) provides additional information, including statistics:
  - Available at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/appeals/learn-about-recent-developments-ex-parte-appeals>



# Next Boardside Chat

- April 22, 2021, at 12-1 pm ET
- Remote Hearings
  - PTAB procedure for video and telephonic hearings
  - Recommendations for practitioners
  - Applicable to AIA proceedings and ex parte appeals





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# Appendix

# Common motions

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

# More common motions

Motion	Authorization Req'd.	37 CFR §	Trial Practice Guide-Fed. Reg.
To File Supplemental Info	Yes	42.123; 42.223	75-76
PO Sur-reply	No (Due Dates 4 & 5)		7-8, 73-74
To Expunge	Yes	42.56	20-22, 92, 100
To Terminate	Yes	42.72; 42.73	4, 53, 86
To Strike	Yes		80

