

Rules of Practice for Trials Before the Patent Trial and Appeal Board

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The Pillsbury logo, featuring the word "pillsbury" in a lowercase, orange, sans-serif font.

Rules of Practice for Trials Before the Patent Trial and Appeal Board



RULES OF PRACTICE FOR TRIALS BEFORE THE PATENT TRIAL AND APPEAL BOARD

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The United States Patent and Trademark Office (PTO) published proposed rules for implementing the various provisions of the Leahy-Smith America Invents Act that pertain to trials before the Patent Trial and Appeal Board (the “Board”) (AIA – 35 U.S.C. §§6, 135, 291, and 311-329). Written comments on the proposed rules are due on or before April 9, 2012, and April 10, 2012. The rules are scheduled to go into effect prior to September 16, 2012.

I. Key Elements of Patent Trials

- Substantial fees will be required for requesting and conducting trials at the Board (37 C.F.R. §42.15). The fees increase incrementally depending on the number of claims challenged. For *inter partes* review of less than 20 claims, the fee is \$27,200, and for post grant review of less than 20 claims, the fee is \$35,800;
- A petition must be filed to institute a trial. With the exception of derivation proceedings, before trial is ordered the patent owner will have an opportunity to provide a response within two months from the notice that a filing date has been granted to a petition (37 C.F.R. §42.107 for *inter partes* review and 37 C.F.R. §42.207 for post grant review). The patent owner response cannot introduce new evidence or amendments but rather is limited to arguments regarding the deficiencies of the petition and why *inter partes* review or post grant review should not proceed (37 C.F.R. §42.107(c), (d) for *inter partes* review, and 37 C.F.R. §42.207(c), (d) for post grant review);
- The petition for *inter partes* review is limited to 50 pages, a petition for post grant review or for transitional proceeding is limited to 70 pages, and a petition to institute a derivation proceeding is limited to 50 pages. All motions, replies to motions, etc., have specified page limits (37 C.F.R. §42.24).
- The Board’s decision regarding whether or not to proceed to trial is not appealable (*inter partes* review – 35 U.S.C. §314(d), post grant review – 35 U.S.C. §324(e), and derivation proceedings – 35 U.S.C. §135(a));

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- Non-registered attorneys can represent parties before the Board in a patent trial, but only on motion for pro hac vice (37 C.F.R. §42.10(c));
- The trial will be similar to interference proceedings – beware of “Standing Orders” by the Board similar to interference practice – Standing Orders control the proceedings before the Board and may not be consistent with the rules. Aspects of trials include:
 - Initial Conference with the Board in which all motions expected to be filed are discussed and granted or denied – similar to interference practice;
 - Additional motions to amend may be granted, and other motions may be granted;
 - Patent Owner has first opportunity to respond, amend, present evidence, and take limited discovery, and then petitioner will have an opportunity to reply to the patent owner, present evidence, and take limited discovery – additional discovery may be permitted but only on a showing of good cause (for post grant review – 37 C.F.R. §42.224(a)) or in the interests of justice (for all others - 37 C.F.R. §42.51(c)(a));
 - Admissibility of evidence is governed by the Federal Rules of Evidence
 - Practice Guide includes sample scheduling order and sample protective order for submission of confidential information
- For deposition testimony, notice must be given that provides a list of exhibits and documents to be used at the deposition, and a general description of the scope and nature of the testimony elicited (37 C.F.R. §42.53(c));
- Each party must submit non-cumulative information that is inconsistent with a position advanced by the patent owner or petitioner during the trial. The submission must specify the relevance of the information, including where the information is presented in a document and, where applicable, how the information is pertinent to the claims (37 C.F.R. §42.51(b)(3))
- The Board must render a final decision within one year from the decision to proceed to trial, but this period may be extended six additional months (for *inter partes* – 35 U.S.C. §316(a)(11); and for post grant review – 35 U.S.C. §326(a)(11)), but there are no limits for derivation proceedings. The Board states, however, that it likely will render a final written decision in a derivation proceeding within one year.
- The final written decision by the Board triggers the estoppel provisions of the act (*inter partes* review – 35 U.S.C. §315(e), for post grant review - 35 U.S.C. §325(e). The statute

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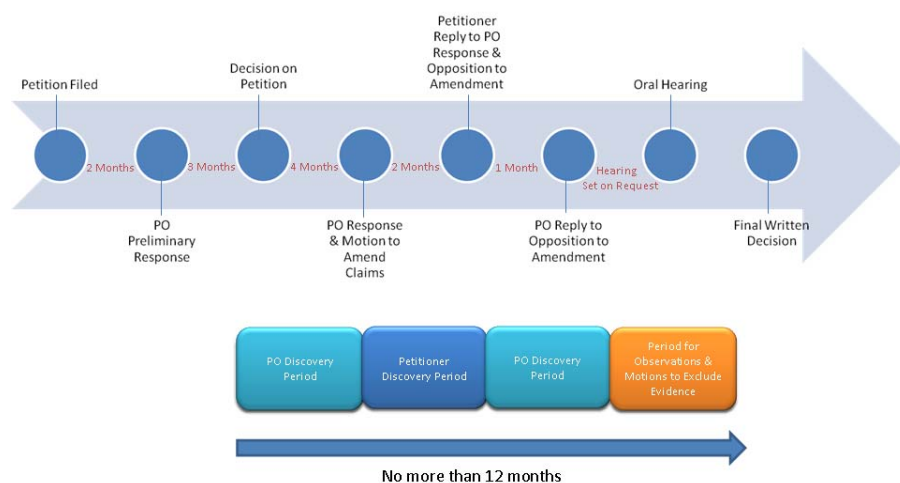


and rules only require the petition to identify the real party in interest (35 U.S.C. §312(a)(2) and 35 U.S.C. §322(a)(2)), but the estoppel applies to the real party in interest and a “privy” to the real party in interest. *See* 37 C.F.R. §42.201(a) and (b), and 37 C.F.R. §42.101 (a)-(c)).

- Estoppel to the patent owner for any claim refused or finally rejected in a trial includes the inability to obtain a claim in a later filed application to substantially the same subject matter, *or a claim that could have been filed* in response to a properly raised objection to the claim (37 C.F.R. §42.73(d)). Thus, a patent owner that loses a claim in a post grant review or *inter partes* review will be estopped from pursuing a claim (in a continuation application or any other) that could have been filed in response to a properly raised objection. This encourages filing multiple new claims in a post grant review and *inter partes* review.

II. General Timeline for Post Grant Review and *Inter Partes* Review

The following timeline was adapted from the timeline provided in the Federal Register (“Practice Guide for Proposed Trial Rules,” Proposed Rule, 58 Fed. Reg. 6868-6879, 6869 (February 9, 2012)):



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III. Petition

A. Types of Trials

Petitions may be filed for the following four types of trial proceedings that will take place before the Board:

1. Petition for *Inter Partes* Review – 37 C.F.R. §§42.100-42.106;
2. Petition for Post Grant Review – 37 C.F.R. §§42.200-42.206;
3. Petition for Transitional Program for Covered Business Methods – 37 C.F.R. §§42.302-42.304; and
4. Petition for Derivation Proceeding – 37 C.F.R. §§42.402-42.407.

The particular contents and requirements of the petition for *inter partes* review, post grant review (including transitional program), and derivation proceedings, are discussed briefly below. The trials before the Patent Trial and Appeal Board are only those listed above (*see* definitions in 37 C.F.R. §42.2), and do not include interferences, which are governed under Part 41 of Title 37.

B. Fees for Filing a Petition

The cost of filing the petition for the various trials is set forth in 37 C.F.R. §42.15. They are as follows:

(a) On filing a petition for *inter partes* review of a patent, payment of the following fee is due based upon the number of challenged claims:

(1) 1 to 20 claims	\$27,200.00
(2) 21 to 30 claims	\$34,000.00
(3) 31 to 40 claims	\$40,800.00
(4) 41 to 50 claims	\$54,400.00
(5) 51 to 60 claims	\$68,000.00
(6) Additional fee for each additional 10 claims or portion thereof	\$27,200.00

(b) On filing a petition for post-grant review or covered business method patent review of a patent, payment of the following fee is due based upon the number of challenged claims:

(1) 1 to 20 claims	\$35,800.00
(2) 21 to 30 claims	\$44,750.00

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(3) 31 to 40 claims	\$53,700.00
(4) 41 to 50 claims	\$71,600.00
(5) 51 to 60 claims	\$89,500.00
(6) Additional fee for each additional 10 claims or portion thereof	\$35,800.00

(c) On the filing of a petition for a derivation proceeding a fee of: \$400.00

(d) Any request requiring payment of a fee under this part, including a written request to make a settlement agreement available: \$400.00

NOTE: The number of claims is calculated based on the claims from which they depend. If a party challenges claims 1-20, 32, 36, 38, and 51, and claim 51 depends from 6 other claims, none of which is challenged, then the total number of claims challenged is 30 for purposes of calculating the fee.

NOTE FOR COMMENT: What happens when a petition is filed challenging 40 claims, the fee is paid for 40 claims, but the PTO only institutes review of 15 claims? Does petitioner get a refund of the difference?

C. Petition Filing Particulars

The page limits for petitions are set out in 37 C.F.R. §42.24, and are exclusive of the table of contents, the table of authorities, the certificate of service, or the appendix of exhibits.

- (i) Petition requesting *inter partes* review: 50 pages
- (ii) Petition requesting post-grant review: 70 pages
- (iii) Petition requesting covered business method patent review: 70 pages
- (iv) Petition requesting derivation proceeding: 50 pages
- (v) Motions: 15 pages.

The petition must be electronically filed, unless accompanied by a motion requesting acceptance of a paper copy (37 C.F.R. §42.6(b)), and, like all other papers filed in the trial (motions, oppositions, replies, etc.), must satisfy the formatting requirements of 37 C.F.R. §42.6(a) – 8.5 x 11 inch paper (except some exhibits), proportional or monospaced font, 14-point or larger, more than 4 characters per centimeter (10 characters per inch), double spacing, except in table of contents, authorities, headings, and block quotations, and margins at least 2.5 cm (1 inch) on all sides.

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NOTE: If the page limit will be exceeded, or if there are too many claims to address in a single petition, nothing precludes a petitioner from filing multiple petitions against a single patent. These petitions may or may not be merged into a single trial, depending on the overlap.

1. *Inter Partes* Review

The requirements for a petition to institute an *inter partes* review are set forth in 37 C.F.R. §§42.101-42.106. A person who is not the owner may file a petition, but only if that person is not estopped from doing so, either because the real party in interest already filed a DJ action challenging the validity of the patent (37 C.F.R. §§42.101(a)), waited more than a year after being sued for patent infringement (37 C.F.R. §§42.101(b)), or is estopped due to a prior final written decision in another PTO proceeding (37 C.F.R. §§42.101(c)). The petition also cannot be filed until 9 months after the date of issuance of the patent, or the date of post grant review, if post grant review were initiated (37 C.F.R. §§42.102(a)).

NOTE FOR COMMENT: The 9 month period should only apply to those patents that are subject to post grant review, which means those patents issuing from applications having an effective filing date after March 16, 2013. But 37 C.F.R. §§42.102(a) will be in effect on September 16, 2012, long before any patents issue that would be subjected to post grant review (other than the transitional program, but this provision would not apply to them either because for the transitional program, the petitioner has to have been sued (or threatened with suit) on the patent, and it covers any patent, not just those subjected to the first inventor to file provisions of the AIA). The comments should request that this be clarified so that it only applies to those patents issuing on applications that were subjected to the first inventor to file provisions of the AIA.

The content of the petition is governed by 37 C.F.R. §§42.104, which states that the petition must set forth:

- Grounds for standing (must certify that the patent is available for the review sought, and that the petitioner is not estopped);
- Identification of challenge – must provide a statement for the precise relief requested, which must include:
 - The claim
 - The statutory grounds under Section 102 or 103 on which the challenge is based;
 - How the challenged claim is construed;

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- How the construed claim is unpatentable (specify where each element is found in the prior art); and
- The exhibit number of supporting evidence, and state the relevance of the evidence.

The petition must be served on the patent owner. A complete petition will be given a filing date. Petitioners who file incomplete petitions will be given one month to correct the deficiencies (37 C.F.R. §42.106(b)).

NOTE: For both *inter partes* review and post grant review, the rules require the petition to construe the claims. Judge Tierney stated in a presentation that what the Board is looking for is an interpretation of all of the language of the claims, but that a petitioner need only include in the argument section of the petition construction of terms and phrases that are ambiguous. All other terms and phrases that are given their ordinary construction can be construed by reference to an expert affidavit.

2. Post Grant Review

The requirements for a petition to institute a post grant review are set forth in 37 C.F.R. §§42.201-42.206. A person who is not the owner may file a petition, but only if that person is not estopped from doing so, either because the real party in interest already filed a DJ action challenging the validity of the patent (37 C.F.R. §§42.201(a)), or is estopped due to a prior final decision in another PTO proceeding (37 C.F.R. §§42.201(b)). The petition also must be filed within 9 months from the date of issuance of the patent and only pertains to those patents issuing from applications examined under the first-inventor-to-file provisions, and does not pertain to reissue patents whose claims are identical to or narrower than a claim in the original patent that issued more than 9 months prior (37 C.F.R. §§42.202(a)).

The content of the petition is governed by 37 C.F.R. §§42.204, which states that the petition must set forth:

- The grounds for standing (must certify that patent is available for the review sought, and petitioner is not estopped);
- An identification of the challenge – must provide a statement for the precise relief requested, which must include:
 - The claim

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- The statutory grounds under 282(b)(2) or (3) on which the challenge is based (no best mode);
- How the challenged claim is construed;
- How the construed claim is unpatentable (specify where each element is found in the prior art for prior art challenges, and for non-prior art challenges, the petition must identify the specific part of the claim (or specification, as the case may be) that fails to comply with the statutory grounds raised); and
- The exhibit number of the supporting evidence, and state the relevance of the evidence.

The petition must be served on the patent owner. A complete petition will be given a filing date. Petitioners who file incomplete petitions will be given one month to correct the deficiencies (37 C.F.R. §42.206(b)).

3. Derivation Proceedings

The requirements for a petition to institute a derivation proceeding are set forth in 37 C.F.R. §§42.402-42.207. Only an applicant for patent may file a petition to institute a derivation proceeding (37 C.F.R. §42.402). The rules package states, contrary to the statutory language, that the petition must be filed within one year after the first publication of the derived claim in the derived patent or pending application (37 C.F.R. §42.403, and accompanying discussion in the proposed rules package).

The content of a petition to institute a derivation proceeding is governed by 37 C.F.R. §42.405, which states the petition must:

- Establish the grounds for standing, which include compliance with 37 C.F.R. §42.402 and 37 C.F.R. §42.403, and show that the petitioner has a claim that is the same or substantially the same as the respondent's claimed invention, and not patentably distinct from the invention disclosed to the respondent;
- Identify the patent or application for which petitioner seeks a derivation proceeding;
- Demonstrate that an invention was derived from an inventor named in petitioner's application, and the earlier respondent's application or patent was filed without authorization;
- For each derived claim, the petition must:

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- Show why the claimed invention is not patentably distinct from the invention disclosed to the respondent; and
- Identify how the claim is to be construed
- The petition must be supported by substantial evidence, including at least one affidavit addressing communication (communication must be corroborated) of the derived invention and lack of authorization that, if un-rebutted, would support a determination of derivation.

The petition must be served on the respondent. A complete petition will be awarded a filing date. Petitioners who file incomplete petitions will be given one month to correct the deficiencies (37 C.F.R. §42.407(b)).

IV. Patent Owner Preliminary Response

The patent owner has 2 months from the date notified that the petition has been granted a filing date (in some instances, the petition may be denied on formal grounds, and the petitioner permitted a month to cure the deficiencies, in which case the filing date will be later than the original date the defective petition was filed). The response is limited to setting forth reasons why no *inter partes* review or post grant review should be instituted, and cannot include new testimonial evidence beyond that already of record.

A. *Inter Partes* Review

The patent owner preliminary response is governed by 37 C.F.R. §42.107. This rule states that the response is limited to setting forth the reasons why no *inter partes* review should be instituted. Evidence may be included, except that no testimonial evidence beyond that already of record may be submitted (37 C.F.R. §42.107(c)). No amendments are allowed (37 C.F.R. §42.107(d)), although the patent owner can disclaim patent claims by filing a disclaimer (no *inter partes* review will be instituted based on disclaimed claims – 37 C.F.R. §42.107(e)).

The patent owner preliminary response must be filed no later two months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date (37 C.F.R. §42.107(b)).

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B. Post Grant Review

The patent owner preliminary response is governed by 37 C.F.R. §42.207. This rule states that the response is limited to setting forth the reasons why no post grant review should be instituted. Evidence may be included, except that no testimonial evidence beyond that already of record may be submitted (37 C.F.R. §42.207(c)). No amendments are allowed (37 C.F.R. §42.207(d)), although the patent owner can disclaim patent claims by filing a disclaimer (no post grant review will be instituted based on disclaimed claims – 37 C.F.R. §42.207(e)).

The patent owner preliminary response must be filed no later two months after the date of a notice indicating that the request to institute an post grant review has been granted a filing date (37 C.F.R. §42.207(b)).

C. Preliminary Owner Response timing and content:

- Must file within two (2) months of notice of filing date, and is limited to 15 pages (37 C.F.R. §42.24(c));
- Argue that petitioner does not have standing (estopped from bringing suit – not the real party in interest):
 - Some additional discovery may be permitted to challenge standing;
- Rely on evidence already of record to refute the invalidity charge;
- Respond early to expedite proceeding;
- Waive preliminary owner response (no adverse inference will be drawn where patent owner elects not to file a response or elects to waive the response);
- For post grant review, argue that petition does not raise a novel or unsettled legal question that is important to other patents or patent applications; and
- Other possible preliminary responses include arguments that references are not prior art, references lack a material limitation, prior art teaches away or suggests away, and/or petitioner's claim interpretation is unreasonable.

NOTE: The rules package accompanying the proposed post grant review rules states that 35 U.S.C. §324 does not require that a preliminary patent owner response be considered, but the Board expects to consider the response. This cannot be true, and interestingly, this language is not included in the *inter partes* review proposed rules package. The statute, 35 U.S.C. §323 states that the patent owner SHALL have the right to file a preliminary response, mirroring the provisions of 35 U.S.C. §313 governing *inter partes* review. The PTO therefore must consider

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the preliminary response because the statute provides the explicit authorization to file (it would seem odd to provide a statutory basis to file a response, but then give the PTO the option of considering the response).

The patent owner in a derivation action does not have the opportunity to file a preliminary response.

V. Institution of Trial

The decision whether or not to proceed to trial is not an appealable decision – for *inter partes* review – 35 U.S.C. §314(d), for post grant review – 35 U.S.C. §324(e), and for derivation proceedings – 35 U.S.C. §135(a).

For *inter partes* review, the Director may not authorize *inter partes* review unless the Director determines that the information presented shows that there is a ***reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged*** (35 U.S.C. §314(a)).

For post grant review, the Director may not authorize post grant review unless the Director determines that the information presented demonstrates that it is ***more likely than not that at least one of the claims challenged in the petition is unpatentable*** (35 U.S.C. §324(a)).

For derivation proceedings, the Director may institute derivation proceeding if the Director determines that the petition demonstrates that the standards for instituting derivation are met. The standards are that the petition must be supported by substantial evidence (35 U.S.C. §135(a)).

The Board institutes a trial on behalf of the Director (37 C.F.R. §42.4), and sends a Notice to all parties. The Board may propose scheduling order (sample provided). The rules also state that the Board may modify by order the times set forth in the rules, which is similar to interference practice where the Board issues a “Standing Order,” establishing the guidelines for interference proceedings.

The Board will identify the grounds upon which the trial will proceed on a claim-by-claim basis. The rules state that the Board may authorize the review to proceed on all or some of the challenged claims, and on all or some of the grounds of unpatentability. At any time prior to institution of the review, the Board may deny some or all grounds for unpatentability for some or all of the challenged claims, and denial is a Board decision not to institute the review – and hence, is not appealable (37 C.F.R. §42.108 for *inter partes* review and 37 C.F.R. §42.208 for post grant review).

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The Board may require a party to file a Notice stating the relief it requests and the basis for that relief (37 C.F.R. §42.21(a)). Correction of a Notice may be permitted but only if entry of the correction was in the interests of justice (37 C.F.R. §42.21(c))

A. Initial Conference with Trial Judge

Like interference proceedings, the rules contemplate an initial conference with the trial judge to discuss all potential motions that may be filed during the trial. If similar to interference practice, the initial conference will be a telephone conference between the judge and lead and backup counsel for each party. The rules package states that the Board expects to initiate the conference within one month from the date of institution of the trial. No less than two (2) business days prior to that conference, each party will submit a list of motions that it intends to file during the trial. The judge then will decide whether to grant the motions, deny the motions, or stay the motions pending the decision on others. All relief requested in trial proceedings must be in the form of a motion – 37 C.F.R. §42.20

Like interference practice, it is contemplated in the rules that the Board will issue a “Standing Order” that will govern the trial. 37 C.F.R. §42.5. This Standing Order may be inconsistent with the rules.

1. Mandatory Notices – 37 C.F.R. §42.8

The following mandatory notices must be on separate pages with a title identical to that below:

- Real Party-In-Interest – Identify each real party-in-interest (no requirement to identify “privy” even though privies are estopped). The rules package states that what constitutes a “privy” is a highly fact-dependent question, and that actual control or the opportunity to control the previous proceeding is an important clue. *See* 18A WRIGHT & MILLER FED. PRAC. & PROC. §§ 4449, 4451; *Taylor v. Sturgell*, 553 U.S. 880 (2008). The proposed rules package also states that the same rules that apply to *res judicata* or statutory estoppel may apply in determining whether a party is a privy to the real party in interest;
- Related Matters – Identify other judicial and administrative matters that will be affected by a decision in this proceeding. This includes every application and patent that claims, or may claim, the benefit of the priority of the filing date of the application or patent at issue in the trial;
- Lead and Back-up Counsel – If party is represented by counsel, lead and back-up counsel must be identified. The Board will permit non-registered attorneys to represent a party upon *pro hac vice* motion (37 C.F.R. §42.10(c)) but on a discretionary basis;

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- Service Information – The service information must include an e-mail address, a mailing address, a hand delivery address (if different from mailing), and telephone and fax numbers.

2. Scheduling Order

The Board will issue a scheduling order. A sample scheduling order is attached as Appendix A, and this scheduling order will be revised during the initial conference, if needed. The sample scheduling order provides the timing for certain events in an *inter partes* review or post grant review (either regular, or transitional program) trial at the Board. As shown, the patent owner will have about 4 months from institution of trial (about 9 months from the granted filing date of the petition) to present its response and motions to amend. The petitioner then will only have about 2 months to file its reply and its motions. The patent owner then will be given one month to file its reply to the petitioner's response, and the petitioner will have 3 weeks after that to request cross examination of reply witnesses, if any, file motions to exclude evidence (motions in limine), file observations, and to file a request for oral argument. Within two weeks of that time, the patent owner will file its motions to exclude evidence, (and other motions, if appropriate), and its response and/or opposition to the petitioner's observations and motions to exclude. The petitioner will have 1 week to file its reply to the opposition to the motion to exclude, and then the trial will proceed to oral argument.

B. Conduct of Attorneys Representing Parties at Trial

A limited delegation to the Board will regulate conduct of counsel in Board proceedings (37 C.F.R. §42.10(d), 35 U.S.C. §2(b)(2) and 32. The Chief Administrative Patent Judge has the authority to make final a decision to disqualify counsel.

Counsel has a duty of candor in proceedings before the Board – 37 C.F.R. §42.11. Failure to comply with this duty may result in sanctions, which may arise for abuse of discovery, abuse of process, and any other improper use of the proceeding. Misconduct includes a failure to comply with an applicable rule, abuse of discovery, abuse of process, improper use of proceeding and misrepresentation of a fact – 37 C.F.R. §42.12(a). Sanctions include entry of:

- (1) An order holding facts to have been established in the proceeding;
- (2) An order expunging, or precluding a party from filing a paper;
- (3) An order precluding a party from presenting or contesting a particular issue;
- (4) An order precluding a party from requesting, obtaining, or opposing discovery;
- (5) An order excluding evidence;

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- (6) An order providing for compensatory expenses, including attorney fees;
- (7) An order requiring terminal disclaimer of patent term; or
- (8) Judgment in the trial or dismissal of the petition.

NOTE: Judge Tierney stated during a presentation that the Board would hope that the parties will be able to resolve discovery issues, but recognizes that sometimes they cannot. If the Board finds abuse with respect to discovery, (e.g., refusing to permit cross examination of an expert), or any other portion of the trial, the Board has the ability to impose sanctions, which may include a final judgment (in this case, the decision would be made by a panel of 3 judges).

C. Public Availability

The record of a proceeding, including documents and things, will be made available to the public, (37 C.F.R. §42.14) except for information covered by a protective order, which protects trade secret or other confidential information (37 C.F.R. §42.54). A sample protective is attached to the proposed rules.

A party may file a motion to seal confidential information (37 C.F.R. §42.14). Only individuals who have signed the protective order may review the information provided under seal (37 C.F.R. §42.55). Confidential information will become public 45 days after termination of the proceedings (or after denial of a petition to institute a trial), unless a party seeking to maintain the confidential nature of the information files a motion to expunge the information (37 C.F.R. §42.56).

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VI. Trial

The trial in an *inter partes* review and post grant review (including transitional program for covered business methods) proceeds in accordance with the scheduling order. The scheduling order may vary with respect to timing, but typically will contain the following:

- Patent owner response – initial response by the patent owner after institution of trial. The patent owner may have discovery (depone petitioner’s declarants) and may file a motion to amend;
- Petitioner’s reply to patent owner response. The petitioner may have discovery (depone patent owner’s declarants) and present additional evidence;
- Patent owner reply – may permit amendment and additional evidence, but in limited circumstances;
- Observations and Motions to Exclude;
- Oral hearing;
- Final written decision.

A. Patent Owner Response

The patent owner goes first. The patent owner files a response, or opposition to the petition, together with any motions or affidavits needed. The patent owner will be accorded limited discovery, which is governed by the rules regarding testimony and production (37 C.F.R. §§42.51-42.65).

1. Who files patent owner response?

The owner of the entire interest may act to the exclusion of the inventor (37 C.F.R. §42.9), or an owner of a part interest may move to act to the exclusion of an inventor. The rules say this will be rare, and typically will occur only when the partial assignee was in a proceeding against its co-assignee – *Ex parte Hinkson*, 1904 Comm’r Dec. 342.

2. Due date and page requirements of patent owner response

The patent owner response is governed by 35 U.S.C. §316(a)(8) for *inter partes* review, and 35 U.S.C. §326(a)(8) for post grant review. The patent owner in a derivation proceeding will be provided an opportunity to respond to the petition once the trial has been instituted. The patent owner response must be filed on the date provided in the scheduling order, and if no date

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provided, the default date is within two (2) months from the date the review was instituted (37 C.F.R. §42.120(b) for *inter partes* review and 37 C.F.R. §42.220(b) for post grant review).

PRACTICE TIP – Begin preparing the patent owner response long before the Board institutes the trial. Try to anticipate what grounds the Board will adopt and work on those first. If evidence is needed to refute an invalidity charge in the petition, begin preparing that evidence shortly after the petition is filed. The patent owner response will be due about 9 months after the filing date of a petition (2 months for patent owner preliminary response + 3 months for PTO to render decision on whether to institute trial + 4 months before patent owner response is due).

The patent owner response is subject to the page limits for oppositions – 37 C.F.R. §42.120 for *inter partes* review and 37 C.F.R. §42.220 for post grant review. The page limit is set forth in 37 C.F.R. §42.24 – page limits for oppositions are the same as those for the corresponding petitions and motions. For the first response after institution of trial, the page limit would be 50 pages for *inter partes* review and derivation proceedings, and 70 pages for post grant review.

3. Amendments

The patent owner will be given an opportunity to amend the claims. The patent owner will have to file a motion, but will need to identify their intent to file the motion in the initial conference call with the Board. During the call, the patent owner will be expected to identify the number and general scope of substitute claims, but will not be required to identify a fully developed claim set (37 C.F.R. §42.121(a) for *inter partes* review, and 37 C.F.R. §42.221(a) for post grant review). If amendments are sought later in the proceeding (e.g., after petitioner's reply), then the patent owner will be required to show good cause. Cancellation of claims and correction of minor errors will generally be permitted even late in the proceeding.

For derivation proceedings, the petitioner or patent owner will be authorized to file an amendment only by a showing of good cause (an example of good cause is that the amendment materially advances settlement between the parties).

Amendments should state the status of the claims (original, canceled, replaced by proposed substitute, proposed substitute for original claim X), and state where the specification supports the amendment. Amendments should state the patentably distinct features of the amended claims. The number of substitute claims must be "reasonable." The proposed rules state that there is a presumption that only one substitute claim would be needed to replace each challenged claim, but Judge Tierney indicated the Board will consider more than a 1:1 correspondence, so long as it is reasonable and necessary.

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NOTE: In the proposed new proceedings, if the Board determines that the amendment introduces new matter or attempts to enlarge the scope of the claims, or does not respond to a ground of unpatentability raised in the trial, then the Board will not permit the amendment to be made (*see* 37 C.F.R. §42.121(c)(2) for *inter partes* review and 37 C.F.R. §42.221(c)(2) for post grant review). This has been interpreted by some commentators to run afoul of the statute, which appears to provide a patent owner with a right to amend. This interpretation, however, is not consistent with the comments included in the rules package, and the language of these sections of the regulations.

The language of the regulations (37 C.F.R. §42.121(a) for *inter partes* review and 37 C.F.R. §42.221(a) for post grant review) states that patent owner may file one motion to amend the patent but only after conferring with the Board. The second sentence of these sections then states that any additional motions to amend may not be filed without Board authorization. The proposed rules package states that proposed 37 C.F.R. §42.121(a) (and proposed 37 C.F.R. §42.221(a)) “would make it clear that the first motion to amend need not be authorized by the Board. Thus, the language in Section 37 C.F.R. §42.121(c)(2) for *inter partes* review and 37 C.F.R. §42.221(c)(2) for post grant review, providing the Board with the authority to deny a motion to amend appears to only pertain to the second sentence of 37 C.F.R. §42.121(a) for *inter partes* review and 37 C.F.R. §42.221(a) for post grant review, which pertains to “additional motions to amend.”

So what happens when a patent owner files a first motion to amend that enlarges the scope of the claims, or does not respond to a ground of unpatentability? The petitioner will have to oppose the amendment, and request that the Board refuse entry. The Patent Owner then will have to file an additional motion to amend, but this may be denied.

PRACTICE TIP – Do NOT file any amendment that enlarges the scope of a claim (even just one element), or that does not respond to a ground of unpatentability. You may end up with no ability at all to amend the claims.

NOTE: Judge Tierney stated during a presentation that a patent owner could include in the motion to amend, an auxiliary set of claims, much like the practice before the European Patent Office during an opposition. A patent owner may present no amendment, or an amendment with a reasonable number of substitute claims (can only present substitute claims (35 U.S.C. §§316(d), 326(d))), along with an auxiliary set of substitute claims to consider in the event the Board is not convinced of the patent owner’s arguments concerning patentability.

4. Motions

The patent owner may file the motions authorized in the initial conference with the judge. Motions are limited to 15 pages, and oppositions to motions are limited to 15 pages (37 C.F.R.

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§42.24). Motions typically will rely on affidavits of experts, and affidavits expressing an opinion must disclose the underlying facts or data upon which the opinion is based (Fed. R. Evid. 705; 37 C.F.R. §42.65). Patent owners relying on secondary indicia of non-obviousness typically will submit that information in the form of expert affidavits or declarations. The rules state that the Board *may* review such evidence.

Patent owner may file additional motions, but only if authorized by the Board (37 C.F.R. §42.20(b)).

The content of motions are governed by 37 C.F.R. §42.22, reproduced below

37 C.F.R. § 42.22 Content of petitions and motions.

(a) Each petition or motion must be filed as a separate paper and must include:

- (1) A statement of the precise relief requested;
- (2) A statement of material facts (see paragraph (c) of this section); and
- (3) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.

(b) Relief requested. Where a rule in part 1 of this title ordinarily governs the relief sought, the petition or motion must make any showings required under that rule in addition to any showings required in this part.

(c) Statement of material facts. Each material fact shall be set forth as a separately numbered sentence with specific citations to the portions of the record that support the fact.

(d) The Board may order additional showings or explanations as a condition for authorizing a motion (see § 42.20(b)).

5. Discovery

Discovery in trials before the Board is governed by 37 C.F.R. §42.51 - 37 C.F.R. §42.65. This discussion of discovery pertains to both the patent owner's discovery and the petitioner's discovery. The rules provide for limited discovery by both the patent owner and the petitioner – neither party is entitled to discovery except as authorized in subpart 42 of the rules. Discovery can be what is considered “routine” discovery or “compelled” discovery. Uncompelled discovery must be submitted in the form of an affidavit, and all other testimony must be in the

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form of a deposition transcript (optionally with live or video-recorded testimony). 37 C.F.R. §42.53(a). The parties may agree amongst themselves the types and extent of discovery (37 C.F.R. §42.51(a)).

a. Routine Discovery

Routine discovery is governed by 37 C.F.R. §42.51(b), and includes discovery of all exhibits cited in a paper or testimony. Routine discovery will be permitted by the Board. The rules require that such exhibits must be served together with the citing paper. Routine discovery also includes cross-examination of affidavit testimony, such cross-examination being authorized within such time period as the Board may set (37 C.F.R. §42.51(b)(2)). For patent owner's response to the petition, that time period would likely be within the window of time from when the trial is instituted and the patent owner's response is due.

The rules also present a rather serious burden on both parties to present and serve on the opposing party any noncumulative information that is inconsistent with a position advanced by the patent owner or petition during the proceeding (37 C.F.R. §42.51(b)(3)). The information must be presented either in one of the submissions, if applicable, (petition, motion, etc.) or as part of a motion identifying supplemental information. The party submitting the information has to provide where the information is presented in a document and, where applicable, how the information is pertinent to the claims.

NOTE: The rules recognize that this provision may dissuade some parties from participating in the new trial proceedings, and this proposed rule differs from Rule 1.56, but states that the benefits outweigh any impact on participation. This requirement exposes the patent to inequitable conduct charges, and exposes the petitioner to sanctions. This requirement also pertains to the petition as filed, so any party filing the petition needs to make sure they present all information that is inconsistent with a position advanced.

Parties may move for additional discovery but must show, for *inter partes* review, that the additional discovery is in the interest of justice, and for post grant review, that the additional discovery is for good cause (37 C.F.R. §42.51(c)). Interests of justice is allegedly a higher standard.

NOTE for Comments: Judge Michael Tierney stated during a discussion of the rules that he views the difference in standard as the good cause standard being: "tell me a good story," whereas the interests of justice requires not only a good story, but also a real, legitimate need for the relief. In other words, good cause requires a party to show a specific factual reason to justify the discovery, and interest of justice requires the specific showing, plus a showing that the party has been diligent in seeking the information, and will be prejudiced without the information. It

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may be worth commenting on this difference in standard, whether more explanation is required, or why not just adopt the same standard.

b. Compelled testimony

Compelled testimony is governed by 37 C.F.R. §42.52, which states the prior authorization is required and that the party seeking the compelled testimony must file a motion for that authorization. The motion must describe the general relevance of the testimony, document, or thing, and must identify the witness by name or title, or the general nature of the document or thing. Upon grant of the motion, the party seeking the testimony will file a subpoena. If no prior authorization is provided, the compelled evidence will not be admitted (37 C.F.R. §42.52(a)).

For compelled testimony outside the United States, the party seeking testimony must identify the foreign country and explain why the witness can be compelled, and demonstrate that the moving party has made reasonable efforts to secure the agreement of the witness to testify but was unsuccessful, even though the moving party offered to pay the travel expenses (37 C.F.R. §42.52(b)(1)). Similar requirements exist for seeking documents or things.

Deposition testimony is governed by 37 C.F.R. §42.53. Prior to taking a deposition, all parties must agree on a time and place, and if they cannot agree, the Board will set a time and place. Deposition testimony will be similar to the deposition of Rule 30(b)(6) witnesses in district court litigation. In other words, prior to the parties agreeing to the deposition, the party seeking the direct testimony deposition must serve a list and copy of each document on which the party intends to rely, and a list of anything other than a document (37 C.F.R. §42.53(c)(3)). The party must also file a notice of deposition at least 2 business days before the deposition. For direct testimony, that notice limits the scope of the testimony and must list, in addition to the name, time, and place, and name and address of the witness, a list of exhibits to be relied upon and a general description of the scope and nature of the testimony to be elicited (37 C.F.R. §42.53(c)(5)). For cross examination, the scope of examination is limited to the scope of direct testimony. Cross examination begins after any supplemental evidence is due (37 C.F.R. §42.64(b)(2)), and ends five business days before the next due date.

A party can file motions to quash deposition notices for defects in the notice, although this would seem rare since the Board has to authorize the filing of the notice in the first instance.

The manner of taking the testimony is similar to civil litigation. Testimony is sworn before an officer, all exhibits used must be served if not previously served, and attached, all objections noted on the record, the witness reads and signs, unless waived, and a certified transcript is provided. Any objection to the content, form, or manner of taking the deposition,

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including the qualifications of the officer before whom the testimony is taken, must be made on the record – otherwise it is waived (37 C.F.R. §42.53(e)).

Confidential information is treated in accordance with a protective order (37 C.F.R. §42.54 and 37 C.F.R. §42.55). This information would otherwise be made available to the public within 45 days after denial of a petition to institute a trial or after final judgment, unless a party files a motion to expunge the confidential information (37 C.F.R. §42.56)

c. Evidence

Any evidence not taken, sought or filed in accordance with the rules is not admissible (37 C.F.R. §42.51(a)). Certification is not required for official PTO documents, like file histories, but a patent is admissible only to prove what the specification and drawings describes. If there is data in the specification or drawing upon which a party intends to rely to prove the truth of the data (e.g., to support an argument of non-obviousness), an affidavit by an individual having first-hand knowledge of how the data was generated must be submitted (37 C.F.R. §42.61(c); *Wojciak v. Nishiyama*, 61 USPQ2d 1576, 1581 (B.P.A.I. 2001)).

PRACTICE TIP: Submit affidavit testimony early from inventor or someone with first-hand knowledge of any data in the specification that might support an argument of non-obviousness, or an enablement argument.

The Federal Rules of Evidence apply to trials before the Board, except as otherwise provided (37 C.F.R. §42.62). 37 C.F.R. §42.63 governs the form of the evidence, including:

- all evidence must be filed in the form of an exhibit;
- translations are required for non-English documents, if the party intends on relying on the translation, together with an affidavit attesting to the accuracy of the translation;
- exhibit must be uniquely numbered (e.g., petitioner number range from 1001-1999, and patent owner range from 2000-2999);
- exhibits must be labeled (37 C.F.R. §42.63(d)(1));
- each page must be uniquely numbered in sequence; and
- each party must maintain an exhibit list.

Expert testimony is governed by 37 C.F.R. §42.65, which states that any expert testimony that does not provide the underlying facts or data on which the opinion is based is entitled to little or no weight, and testimony regarding US patent law or examination practice is not permitted. For test data, the party that relies on the data must provide an affidavit that complies with 37 C.F.R. §42.65(b)(1)-(5).

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B. Petitioner's Reply

The petitioner's reply is due on the date set forth in the Scheduling order, (proposed scheduling order provides for two months), or if no period is set, the default time is within one month from the date of service of the patent owner's response (37 C.F.R. §42.25(a)(2)). The reply is limited to 15 pages (37 C.F.R. §42.24(c)(1)), which includes the statement of facts in support of the reply. The reply also can be in the form of any opposition to patent owner motions, in which case, each opposition can be 15 pages (the same number of pages as the motion being opposed).

If the patent owner amends the claims, the petitioner may file an opposition to that motion. Petitioners may supplement evidence submitted with their petition in order to respond to new issues arising from proposed substitute claims (including new expert declarations that are directed to the proposed substitute claims).

The petitioner's reply may only respond to arguments raised in the corresponding opposition (37 C.F.R. §42.23). The Board will not consider new evidence to support an obviousness argument for the unpatentability of an original claim. The Board will refuse entry of an argument that raises a new issue or that belatedly presents evidence.

NOTE for Comment: The rules do not provide an avenue for the petitioner to attack amendments made by the patent owner. If the amendments presented by the patent owner render the amended claims (e.g., substitute claims) invalid under, for example, 35 U.S.C. §101 or 35 U.S.C. §112, first or second paragraph, the petitioner will have to file a motion to contest the validity of the claims. But in *inter partes* review proceedings, the patentability of the claims can only be challenged on prior art grounds (Sections 102 and 103). The rules are silent on how to address this situation.

NOTE for Comment: The proposed rules do not make clear whether the 15 page limit to the petitioner's reply to the patent owner response includes arguments made in petitioner's oppositions filed in opposition to patent owner motions (e.g., motion to amend). Comments should request clarification (e.g., can a petitioner file a 15 page reply (together with a 100 page affidavit), and two 15 page oppositions to patent owner motions?

During the period between the patent owner's opposition to the petition and the petitioner's reply (two months provided in the proposed scheduling order), the petitioner will be given the opportunity for discovery. The same rules discussed above apply to the petitioner's discovery. That is, the petitioner will be entitled to cross examine any individual who presented affidavit testimony, and compel testimony, but only upon prior authorization from the Board.

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C. Patent Owner's Reply

The patent owner will be given the opportunity to reply to the petitioner's reply, and, in some instances, may be authorized to file additional motions to amend. The proposed scheduling order provides a one month period from service of petitioner's reply before the patent owner's reply is due. If the petitioner presented new testimony, the patent owner will be permitted discovery.

D. Observations and Motions to Exclude

The proposed scheduling order provides a period for Observations and Motions to Exclude. A motion for observations is a tool available to the parties to draw the Board's attention to relevant cross examination testimony of a witness, since at this point in time, no further substantive paper is permitted after the reply. The observations must be a concise statement of the relevance of the testimony – typically about one paragraph. The other party will be given an opportunity to respond with an equally concise statement.

The parties also may file motions to exclude certain evidence, including evidence presented by affidavit or deposition. Procedures for challenging the admissibility of the evidence are provided in 37 C.F.R. §42.64. Objections to the admissibility of deposition evidence must be made during the deposition. The default time for serving objections to evidence (other than testimony) is ten days after service of the evidence. The other party will have ten days after service of the objection to cure any defect.

Other additional motions may be presented during this period, including motions for judgment, motions for joinder, motions to file supplemental information, etc. If 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 a conference call.

The Board has discretion in when to consider any petition or motion (37 C.F.R. §42.71). The Board also may issue an interlocutory decision, in which case a three-member panel will issue the decision. A party dissatisfied with the decision should immediately seek rehearing, which will be reviewed using the deferential abuse-of-discretion standard.

E. Oral Hearing

Oral arguments are governed by 37 C.F.R. §42.70. Any party may request oral argument on an issue raised in a paper filed during the trial – the time for requesting oral argument being

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set by the Board (typically in the scheduling order). Demonstrative exhibits that will be used during oral argument must be served at least five (5) business days before oral argument. The Board recommends NOT having fancy exhibits, but rather the use of a compilation with each exhibit separately tabbed.

As a general rule, the petitioner will go first, but the order may be reversed where the only issue is whether the patent owner's substitute claims overcome the grounds of unpatentability. The rules package do not discuss the amount of time that may be given to either party, and/or how either party might move for additional time, if needed.

If any special equipment or needs are required (wheelchair access, hearing impaired equipment, etc.), the party should contact the Board paralegal well in advance of oral argument (571-272-9797).

Live testimony will rarely be heard at an oral argument, unless the Board determines that having a witness live will be useful (e.g., to assess the demeanor of the witness).

F. Final Decision

The final written decision will be issued not more than one year from institution of trial, which is expected even for derivation proceedings, although not required by statute. The one year period may be extended up to six (6) additional months. The written decision will address all the issues required to resolve the proceedings. For derivation proceedings, 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.

G. Request for Rehearing

Requests for rehearing are governed by proposed rule 37 C.F.R. § 42.71(c). 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. Evidence not already of record at the time of the decision will not be admitted absent a showing of good cause.

The Board will apply the deferential abuse-of-discretion standard to decisions on rehearing.

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VII. Settlement

Settlement of trials is governed by 37 C.F.R. §42.74. The rules package states that there are strong public policy reasons to favor settlement between the parties, and the Board is available to assist in settlement. The rules, however, and the comments accompanying proposed Rule 42.74 state that the Board is not a party to a settlement agreement and may take any necessary action, including determination of patentability notwithstanding settlement. The statute (35 U.S.C. §317 for *inter partes* review, and 35 U.S.C. §327 for post grant review) also provides that the Board may proceed to a final written decision even if no petitioner remains in the proceeding.

The language of the statute and rules might dissuade the parties from settling a trial, especially if the Board can proceed to a final written decision anyway, and the parties might be estopped by that decision. Rule 37 C.F.R. §42.73 states, however, that estoppel shall not apply to a petitioner, or real party in interest or privy who has settled under 35 U.S.C. §§317 or 327. The Comments from the Practice Guide for Proposed Trial Rules also states that “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”

Any settlement must be in writing (37 C.F.R. §42.74(b)), and a party to the settlement may request that the settlement be kept separate from the involved patent or application (37 C.F.R. §42.74(c)).

VIII. Estoppel

The statute and rules provide that the final written decision by the Board triggers estoppel (*inter partes* review – 35 U.S.C. §315(e), for post grant review - 35 U.S.C. §325(e), and the estoppel applies to the real party in interest and a “privy” to the real party in interest. See 37 C.F.R. §42.201(a) and (b), and 37 C.F.R. §42.101 (a)-(c)).

For petitioner in *inter partes* review and post grant review, the petitioner is estopped in the patent office (and in court proceedings) from taking any action that is inconsistent with a judgment as to any ground that the petitioner raised or reasonably could have raised during the trial (37 C.F.R. §42.73(d)). Estoppel only applies to the claims on which a final decision is based.

In a derivation proceeding, the losing party who could have properly moved for relief on an issue, but did not so move, may not take any action in the patent office after the judgment that

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is inconsistent with that party's failure to move. No estoppel applies to any contested subject matter for which that party was awarded a favorable judgment (37 C.F.R. §42.73(d)(2)).

Estoppel to patent owner for any claim refused or finally rejected includes the inability to obtain a claim in a later filed application to substantially the same subject matter, **or a claim that could have been filed** in response to a properly raised ground of unpatentability for a finally refused or canceled claim (37 C.F.R. §42.73(d)(3)). Accordingly, a patent owner that loses a claim in a post grant review or *inter partes* review will be estopped from pursuing a claim (in a continuation application or any other) that could have been filed in response to a properly raised objection. This encourages filing multiple new claims in a post grant review and *inter partes* review.

NOTE: Having the estoppel attach when the Board issues a final written decision, without any provision of removing that estoppel if the Board's decision is reversed either during a rehearing by the Board itself, or by reversal from a higher authority. For example, if a Board final written decision finds a claim unpatentable in an issued patent that participated in a post grant review, but the United States Court of Appeals for the Federal Circuit reversed the Board's decision, will the patentee be able to obtain that claim, despite the estoppel provisions that state otherwise. A similar scenario exists for a petitioner who loses at the Board, but prevails on appeal or rehearing.

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SAMPLE SCHEDULING ORDER FOR TRIALS BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTER PARTES REVIEW AND POST GRANT REVIEW

A. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. The parties may stipulate different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate an extension of DUE DATES 6-7. In stipulating different times, the parties should consider the effect of the stipulation on times to object to evidence (proposed § 42.64(b)(1)), to supplement evidence (proposed § 42.64(b)(2)), to conduct cross examination, and to draft papers depending on the evidence and cross examination testimony (see section B, below).

1. DUE DATE 1

The patent owner is not required to file anything in response to the petition. The patent owner may file—

- a. A response to the petition, and
- b. A motion to amend the patent, if authorized.

Any response or amendment must be filed by DUE DATE 1. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board.

2. DUE DATE 2

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Any reply to the patent owner's response and opposition to amendment filed by petitioner under proposed § 42.23 must be filed by this date.

3. DUE DATE 3

The patent owner must file any reply to the petitioner's opposition by this date.

4. DUE DATE 4

- a. The petitioner must file any motion for an observation on the cross examination testimony of a reply witness (see section C, below). Proposed § 42.20.
- b. Each party must file any motion to exclude evidence (proposed § 42.64(c)) and any request for oral argument (proposed § 42.70(a)).

5. DUE DATE 5

- a. The patent owner must file any response to a petitioner observation on cross examination testimony.
- b. Each party must file any opposition to a motion to exclude.

6. DUE DATE 6

Each party must file any reply for a motion to exclude.

B. CROSS EXAMINATION

Except as the parties might otherwise agree, for each due date—

- 1. Cross examination begins after any supplemental evidence is due (proposed § 42.64(b)).
- 2. Cross examination ends five business days before the next due date (proposed § 42.64(b)).

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C. MOTION FOR OBSERVATION ON CROSS EXAMINATION

A motion for observation on cross examination provides the petitioner with a mechanism to draw the Board's attention to relevant cross examination testimony of a reply witness, since no further substantive paper is permitted after the reply. The observation must be a concise statement of the relevance of the precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph. The patent owner may respond to the observation. Any response must be equally concise and specific.

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DUE DATE APPENDIX

DUE DATE 1 Patent owner post-institution response to the petition Patent owner post-institution motion to amend patent	4 months
DUE DATE 2 Petitioner reply to patent owner response Petitioner opposition to patent owner amendment	2 months
DUE DATE 3 Patent owner reply to petitioner opposition	1 month
DUE DATE 4 Petitioner motion for observation regarding cross examination of reply witness Motion to exclude Request for oral argument	3 weeks
DUE DATE 5 Patent owner response to observation Opposition to motion to exclude	2 weeks
DUE DATE 6 Reply to opposition to motion to exclude	1 week
DUE DATE 7 Oral argument	Set on request