

NYIPLA  
PTAB COMMITTEE  
July 5, 2021



## Key Milestones in IPR, PGR, and CBM Proceedings

Charles R. Macedo, Partner, co-chair of PTAB committee  
Christopher Lisiewski, Associate, coordinator of PTAB  
Committee and Co-Chair of Inventor of the Year Committee  
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Thomas Hart, Law Clerk

**Amster, Rothstein & Ebenstein LLP**

Jennifer Rea Deneault, Associate, co-chair of Young Lawyers  
Committee

**Paul, Weiss, Rifkind, Wharton & Garrison LP**



# Patent Trial And Appeal Board

# Disclaimer

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of the New York Intellectual Property Law Association, the PTAB Committee, the Young Lawyers Committee, or its members.

Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.



# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing
- Final Written Decision

# Agenda

- Overview of Proceedings

# New CBMs are No Longer Available

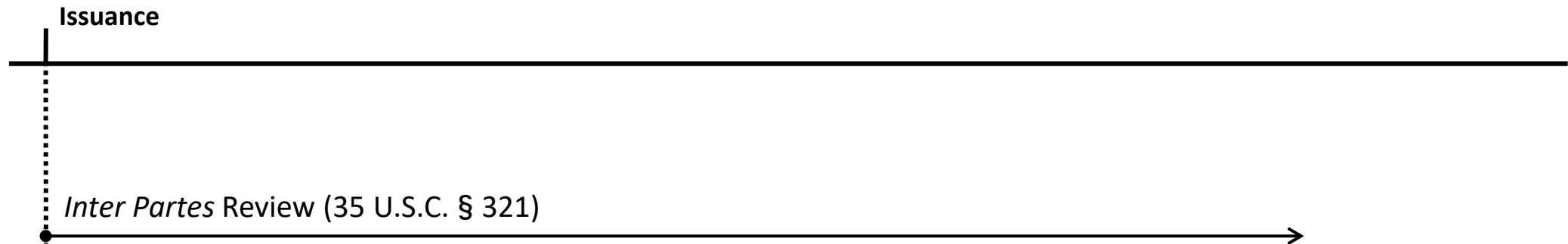
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Effective Sept. 16, 2020, the statutory time period for a petition to bring a new covered business method proceeding (CBM) expired, and new petitions may not be filed.

Pub. L. 112-29, §18, Sept. 16, 2011, 126 Stat. 329 and 77 FR 48679

# Petition Timing

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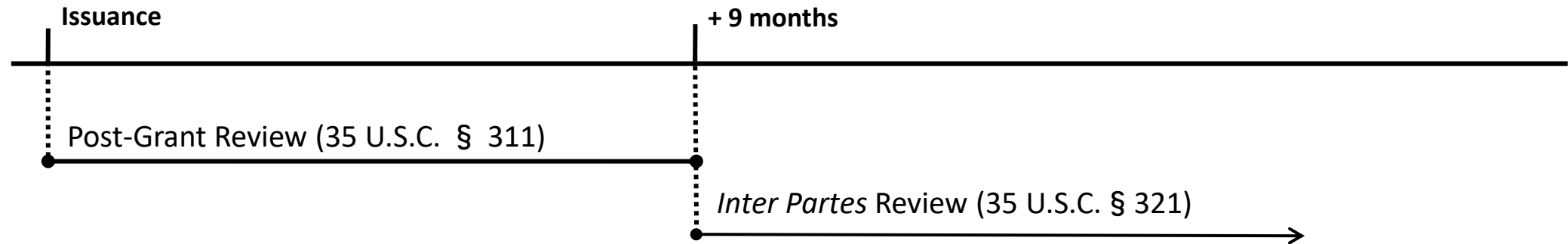
## Pre AIA:

- IPR may be filed from patent issue date
- PGR not available for:
  - Patents filed under the 'first to invent' regime (before March 16, 2013).
  - Patents which claim priority to a first-to-invent application. *SweeGen, Inc. v. PureCircle USA, Inc.*, 2021 WL 203202 (PTAB Jan. 19, 2021).

See 37 C.F.R. § 42.102(a)

# Petition Timing

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## Pre AIA:

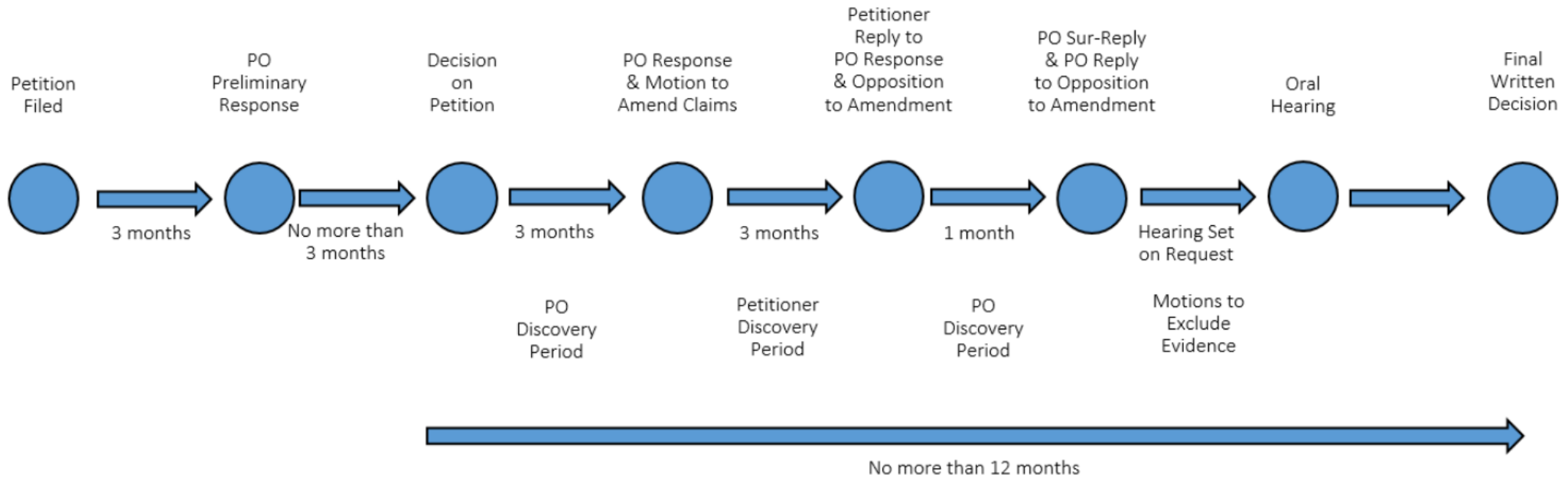
- IPR may be filed from patent issue date
- PGR not available for:
  - Patents filed under the 'first to invent' regime (before March 16, 2013).
  - Patents which claim priority to a first-to-invent application. *SweeGen, Inc. v. PureCircle USA, Inc.*, 2021 WL 203202 (PTAB Jan. 19, 2021).

## Post AIA:

- PGR may be filed within 9 months of issue date
- IPR may be filed by the later of:
  - 9 months after issue date
  - Termination of any PGR of the patent

See 37 C.F.R. § 42.102(a)

# Typical Timeline for IPR and PGR





# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
  - T-6 Months: The Petition

# T-6 Months: The Petition

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Petition Filed





# Filing Requirements Checklist

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- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits
- Service Requirements





# Filing Requirements Checklist

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- Petition (and its Content)



# Petition Content

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“**Each petition or motion** must be filed as a separate paper and must include:

- (1) A statement of the precise relief requested; and
- (2) 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.”



# Petition Content

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## (1) A statement of the precise relief requested:

- Must specify the statutory grounds for the petition
  - IPR – 35 U.S.C. §§ 102 or 103
  - PGR – 35 U.S.C. §§ 101, 102, 103, or 112
- Must show how the PTAB should construe each claim
  - *Phillips*-type approach, not “broadest reasonable construction,” used (83 Fed. Reg. 51340).
- Must explain where each claim element is found in the prior art.
  - Typically paragraph form (prior practice is claim charts)
- Must include specific citations to exhibit numbers for the supporting evidence.





# Petition Content

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Petitioners may also include a statement of material facts with the petition; this is not required.

- Statements should identify each fact in separate paragraphs, including specific citations to the supporting portions of the record.





# Petition Standard for Institution

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## IPR Standard

“The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 **shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.**”

## PGR Standard

“The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that **it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.**”

35 U.S.C. §§ 314(a), 324(b)







# Petition Content

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## Not Notice Pleading – Put Your Best Foot Forward

- PTAB Strictly limits the petitioner to the challenge grounds identified in the petition
- To the extent possible, include detailed arguments and all evidence supporting may challenges
- PTAB will reject redundant or inferior arguments in favor of the strongest argument, in the strongest petition filed against a claim (see *Macauto U.S.A. v. BOS GmbH & KG*, 2013 WL 5947694 (PTAB Jan. 24, 2013)).



# Petition Word Count Limits

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## Petitions are limited to:

- 14,000 words for IPRs.
- 18,700 words for PGRs.

## Word count limits do not include:

- Table of Contents
- Table of Authorities
- Mandatory Notices
- Certificates of service or word count
- Appendix of exhibits or claim listings

Petitions must include a certification stating the number of words in the paper (37 C.F.R. § 42.24(d)).

PTAB will accept this word count, except when:

- Includes excessive words in figures, drawings, or images
- Deletes spacing between words
- Uses excessive acronyms or abbreviations





# Rule 11-Type Certification

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All papers filed with the PTAB in a proceeding must comply with the signature requirements set forth in 37 C.F.R. § 11.18(a) (37 C.F.R. § 42.11(b)).

By presenting a paper to the PTAB, an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under 37 C.F.R. § 11.18(b)(2)(37 C.F.R. § 42.11(c)).



# Filing Requirements Checklist

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Petition (and its Content)

Fees



# Fees

Type of Fee	IPR	PGR
Request Fee	\$19,000 (basic fee) plus \$375 (for each claim over 20, included unchallenged claims dependent on challenged claims)	\$20,000 (basic fee) Plus \$475 (for each claim over 20, included unchallenged claims dependent on challenged claims)
Post Institution Fee	\$22,500 (basic fee) plus \$750 (for each claim over 20, included unchallenged claims dependent on challenged claims)	\$27,500 (basic fee) plus \$1050 (for each claim over 20, included unchallenged claims dependent on challenged claims)
Total	\$41,500 plus excess claim fees	\$47,500 plus excess claim fees

All fees must be paid up-front at time of filing. If trial is not instituted, the post institution fee is returned. Fees are paid electronically on the USPTO's website.

37 C.F.R. § 42.15(a) and (b)





# Filing Requirements Checklist

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Petition (and its Content)

Fees

Mandatory Notices



# Mandatory Notice Requirement

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Petition must include a list of mandatory notices identifying:

- Each real party in interest
- Related judicial or administrative matters
- Lead and back-up counsel
- Service Information

Patent Owner must file the same mandatory notices within **21 days of service**, and parties must, when the information in the notice changes, file revised mandatory notices within **21 days of the change**.

If update occurs before institution and is made in good faith, without prejudice to patent owner, petitioner may update without changing the filing date of the petition (see *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019)(precedential)).



# Filing Requirements Checklist

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- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel





# Designating Counsel

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Parties must designate lead, as well as back-up counsel. (37 C.F.R. § 42.10(a))

- Lead counsel expected to participate in all proceedings, but back-up counsel expected to participate when lead counsel cannot
- Either lead or back up counsel may conduct actions not before the USPTO

Power of attorney must be filed with the designation of counsel, unless the designated counsel is already counsel of record. (37 C.F.R. § 42.10(b))

Pro hac vice:

- Board may recognize counsel *pro hac vice*
- Lead counsel must be a registered practitioner (37 C.F.R. § 42.10(c))



# Designating Counsel

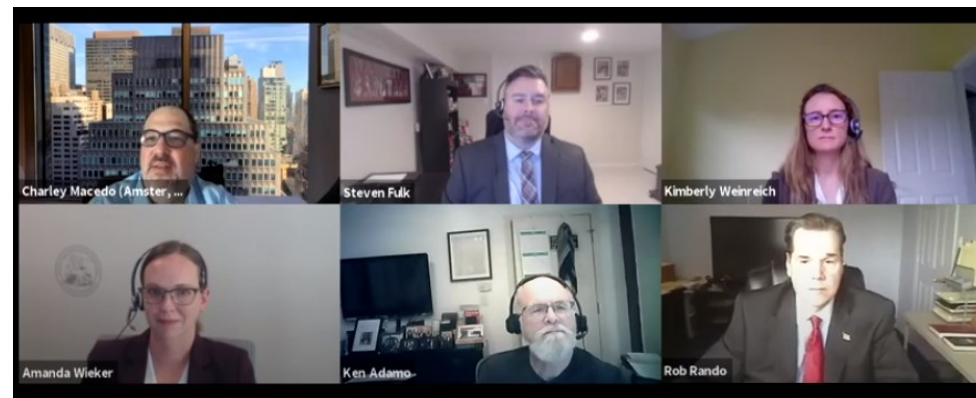
**NYIPLA  
PTAB Committee Meeting**

Kimberly Weinreich, Attorney, Office of Enrollment and Discipline  
Amanda Wieker, Administrative Patent Judge, PTAB  
Steven J. Fulk, Supervisory Patent Attorney, PTAB  
May 4, 2021

## ***Pro hac vice* – best practices checklist**

- File PHV motion as paper
  - Filed by registered counsel of record
  - Includes "good cause" statement – litigation experience and specific familiarity with subject matter/record (§ 42.10(c); *Unified Patents Order*)
- File affidavit or declaration as exhibit
  - Properly executed/signed per § 42.2
  - Includes statements attesting to items i-viii of *Unified Patents Order*, or explanation of circumstances
- Pay proper fee
  - \$250 per attorney, per proceeding
  - E2E system links to PTO Financial Manager website – [return to E2E after payment and submit documents](#)
- Update power of attorney (§ 42.10(b)) and mandatory notices (§ 42.8)

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For more information, see a recent PTAB Committee meeting with members of the USPTO, “Insights on Ethics Issues at the USPTO,” [https://www.linkedin.com/posts/nyipla\\_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B](https://www.linkedin.com/posts/nyipla_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B)

Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest Committee Presentations!



# Filing Requirements Checklist

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- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement



# Parallel Petitions Ranking Statement

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More than one petition may be necessary (i.e. because patent owner has asserted many claims or parties dispute priority date and must submit multiple prior art arguments).

Petitioners must, in a separate five-page filing:

- Rank the petitions based on merit.
- Explain:
  - The material differences between the petitions (preferably in table form); and
  - Why the Board should institute two petitions if it determines the petitioner has satisfied the institution threshold for one of them under Section 314(a).





# Filing Requirements Checklist

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- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits



# Supporting Declarations and Evidence

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## TYPICAL LIST:

Ex1001: Patent in Suit

Ex1002: Expert Declaration

Ex1003: CV of Expert

Ex1004: Prosecution History of Patent-In-Suit

Ex1005: Parallel Litigation Documents (e.g. Complaint against Petitioner)

Ex1006: Prior Art Document

Etc.



# Filing Requirements Checklist

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- Petition (and its Content)
- Fees
- Mandatory Notices
- Designating Counsel
- Parallel Petitions Ranking Statement
- Supporting Declarations and Exhibits
- Service Requirements





# Service Requirements

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- Service must be by means as fast and reliable as Priority Mail Express, unless parties agree to electronic service.
- Each document filed must be served simultaneously on each opposing party
- Service must be on counsel of record
- Service must include a certificates of service
  - Certificate of service included at the end of the document
  - Certificate must state:
    - The date and manner of service
    - The name and address of every person served
- When filing exhibits separately, a transmittal letter must be filed incorporating the certificate of service
  - One transmittal letter can be used for multiple exhibits and must state the name and exhibit for every exhibit filed with the letter





# Agenda

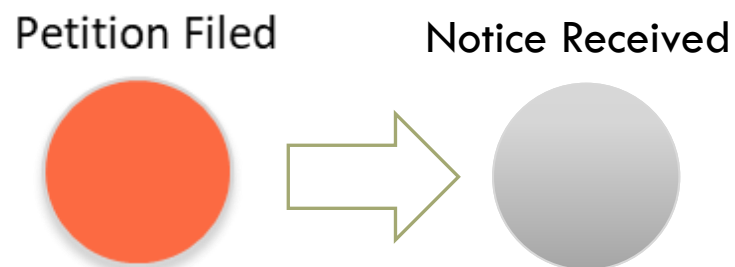
- Overview of Proceedings
- Pre-Institution Proceedings
  - T-6 Months: The Petition
  - T-6+ Months: Initial Post Filing Activity



# Initial Post-Filing Activities

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- Notices In Response to Petition (e.g., Notice to Accord Filing Date)
- Patent Owner's Mandatory Disclosure and Appearances (mandatory)
- Motions in Response to Notices (e.g., Motion to correct clerical mistakes) (optional)





# Notice In Response to Petition

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PTAB will issue a notice in the weeks following filing if it detects defects in the petition.

Sample notices include:

- Notice of Filing Date Accorded (see *Askeladden L.L.C. v. Authwallet, LLC*, IPR2021-00005, Paper 3, (PTAB Oct. 26, 2020))
- Notice of Defective Petition (see *Unified Patents, LLC v. Dolby Labs. Licensing Corp.*, IPR2021-00275, Paper No. 3 (Dec. 23, 2020))
- Notice of Incomplete Petition (see *Automotive Data Sols., Inc., et al. v. AAMP of Florida, Inc.*, IPR2016-00061, Paper No. 5 (PTAB Oct. 23, 2015))



# Notice of Filing Date Accorded

[Trials@uspto.gov](mailto:Trials@uspto.gov)  
571-272-7822

Paper No. 3

Case IPR2021-00005  
Patent 8,280,776 B2

UNITED STATES PATENT AND TRADEMARK OFFICE  
\_\_\_\_\_  
BEFORE THE PATENT TRIAL AND APPEAL BOARD  
\_\_\_\_\_

ASKELADDEN L.L.C.,  
Petitioner,

v.

AUTHWALLET LLC,  
Patent Owner.

\_\_\_\_\_  
Case IPR2021-00005  
Patent 8,280,776 B2  
\_\_\_\_\_

Mailed: October 26, 2020

Before PATRICK E. BAKER, *Trial Paralegal*.

NOTICE OF FILING DATE ACCORDED TO PETITION  
AND  
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review filed in the above proceeding has been accorded the filing date of October 1, 2020.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is limited to setting forth the reasons why the requested review should not be

instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), which is available on the Board Web site at <http://www.uspto.gov/PTAB>.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel pro hac vice requires a showing of good cause. The parties are authorized to file motions for pro hac vice admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under “Representative Orders, Decisions, and Notices.” **The parties are reminded that, in order for any motion for pro hac vice admission to be considered by the Board, the requisite fees must first be paid.** The current fee schedule is available at <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>.

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in Patent Trial and Appeal Board End to End (PTAB E2E), accessible from the Board Web site at <http://www.uspto.gov/PTAB>. To file documents, users must register with PTAB E2E. Information regarding how to register with and use PTAB E2E is available at the Board Web site.



# Notice of Defective Petition

[Trials@uspto.gov](mailto:Trials@uspto.gov)  
571-272-7822

Paper No. 3

IPR2021-00275  
Patent 10,237,577

UNITED STATES PATENT AND TRADEMARK OFFICE  
\_\_\_\_\_  
BEFORE THE PATENT TRIAL AND APPEAL BOARD  
\_\_\_\_\_

UNIFIED PATENTS, LLC,  
Petitioner,

v.

DOLBY LABORATORIES LICENSING CORPORATION,  
Patent Owner.

\_\_\_\_\_  
Case IPR2021-00275  
Patent 10,237,577  
\_\_\_\_\_

Mailed: December 23, 2020

Before STEVEN M. AMITRANI, *Trial Paralegal*

NOTICE OF FILING DATE ACCORDED TO PETITION  
AND  
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review in the above proceeding has been accorded the filing date of December 11, 2020.

A review of the petition identified the following defect(s):

Exhibit 1016 is referenced on Petition page 34 and listed in E2E as “Redline comparison of US Application 14/609,472 and US Application 13/877,253.” However, the exhibit lacks both redlining and identifying information. Please file the correct exhibit as “Corrected Exhibit 16.”

Petitioner must correct the defect(s) within **FIVE BUSINESS DAYS** from this notice. Failure to correct the defect(s) may result in an order to show cause as to why the Board should institute the trial. No substantive changes (e.g., new grounds) may be made to the petition.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is limited to setting forth the reasons why the requested review should not be instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), which is available on the Board Web site at <http://www.uspto.gov/PTAB>.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under



# Notice of Incomplete Petition

[Trials@uspto.gov](mailto:Trials@uspto.gov)  
571-272-7822

Paper No. 5

Case IPR2016-00061  
Patent 9,165,593

UNITED STATES PATENT AND TRADEMARK OFFICE  
\_\_\_\_\_  
BEFORE THE PATENT TRIAL AND APPEAL BOARD  
\_\_\_\_\_

AUTOMOTIVE DATA SOLUTIONS, INC. and  
AUDIONICS SYSTEM, INC.,  
Petitioner,

v.

AAMP OF FLORIDA, INC.,  
Patent Owner.

\_\_\_\_\_  
Case IPR2016-00061  
Patent 9,165,593  
\_\_\_\_\_

Mailed: October 30, 2015

Before BRECK A. REITTER, *Trial Paralegal*

## NOTICE OF INCOMPLETE PETITION

The petition for *inter partes* review filed on October 20, 2015 in the above proceeding has not been accorded a filing date due to the following deficiencies:

Petitioner does not include the patent at issue, US 9,165,593, as an exhibit. Under 37 C.F.R. § 42.6(c), “. . . Each exhibit must be filed with the first document in which it is cited . . . .”

Petitioner does not serve Patent Owner by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®. Under 37 C.F.R. § 42.6(e)(1), “. . . Service may be by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®.”

Petitioner does not state the date of service or the name and address of every person served in the Certificate of Service. Under 37 C.F.R. § 42.6(e)(4)(iii), “[t]he certificate of service must state: (A) The date and manner of service and (B) The name and address of every person served.”

Under 37 C.F.R. § 42.106(b), Petitioner may correct the deficiencies within ONE MONTH from the date of this notice. If the statutory deficiency is corrected (and no other deficiency is introduced) within one month, the petition will be accorded the filing date of the supplemental submission. The incomplete petition will be retained for one month such that Petitioner need not resubmit previously submitted documents in any supplemental submission. If the deficiency is not corrected within one month, the petition will be dismissed.

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in the Patent Review Processing System (PRPS), accessible from the Board Web site at <http://www.uspto.gov/PTAB>.

If there are any questions pertaining to this notice, please contact Breck A. Reitter at 571-272-5866 or the Patent Trial and Appeal Board at 571-272-7822.



# Motions in Response to Notices

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Petitioner may also file a motion to correct a clerical or typographical mistake without changing the filing date of the petition (37 C.F.R. § 42.104(c)). Must explain:

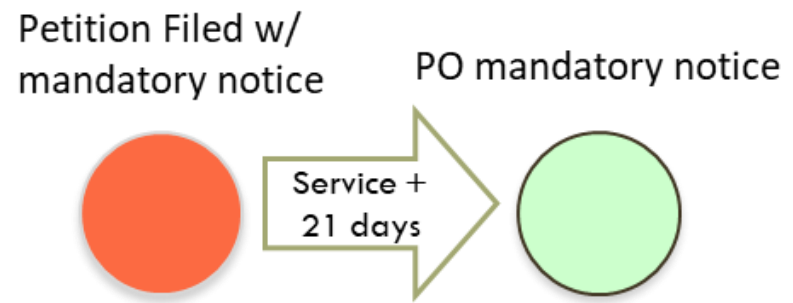
- The nature of the error, and whether the petitioner provides adequate explanation for how the error occurred and was discovered.
- The amount of time between learning of the error and bringing the error to the Board's attention.
- Prejudice to the patent owner, if any, by allowing the proposed corrections.
- Whether the proposed corrections have any impact on the proceeding.

Corrections cannot add “substantive new evidence” (*Sweegen, Inc. v. Purecircle Sdn Bhd*, PGR2020-00070, Paper 9 at 5 (PTAB September 22, 2020)).



# Patent Owner's Disclosures (Mandatory)

Patent Owner **must** file the same mandatory notices within **21 days of service**, and parties must, when the information in the notice changes, file revised mandatory notices within **21 days of the change**.







# Patent Owner's Appearances (Mandatory)

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Patent owners may proceed pro-se, but organizations must be represented by counsel.

Parties must designate lead, as well as back-up counsel. (37 C.F.R. § 42.10(a))

- Lead counsel expected to participate in all proceedings, but back-up counsel expected to participate when lead counsel cannot.
- Either lead or back up counsel may conduct actions not before the USPTO.

Power of attorney must be filed with the designation of counsel, unless the designated counsel is already counsel of record. (37 C.F.R. § 42.10(b))

Pro hac vice:

- Board may recognize counsel *pro hac vice*.
- Lead counsel must be a registered practitioner (37 C.F.R. § 42.10(c)).

# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
  - T-6 Months: The Petition
  - T-6+ Months: Initial Post Filing Activity
  - T-6 Months to T-3 Months: Initial Disclosures



# Initial Disclosures

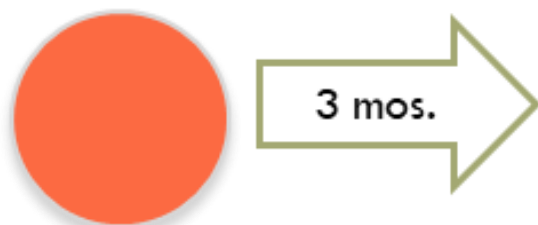
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## Two Options for Mandatory Initial Disclosures:

No Agreement Reached

Agreement Reached

Petition Filed





# No Agreement Reached

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While Parties may reach an agreement as to initial disclosures, the most likely scenario is that they do not. Parties may file motions as to obtain the discovery they seek (see 37 C.F.R. § 42.51(a)(2)).



# Agreement Reached

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Once the petition is filed, the parties may begin negotiating the scope of mandatory initial disclosures.



# Agreement Reached

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## Option 1

Modeled after the Federal Rule of Civil Procedure (FRCP) 26(a)(1)(A) and requires a basic exchange of information, such as:

- the names, addresses, and telephone numbers of individuals likely to have discoverable information; and
- copies of documents that a party may use to support its position.

## Option 2

Includes:

- the disclosures from Option 1;
- additional contact information of individuals with knowledge of non-published prior art if the petition seeks to cancel claims based on a non-published disclosure; and
- additional information regarding secondary considerations of non-obviousness if the petition seeks to cancel claims based on obviousness.

Trial Practice Guide, 77 Fed. Reg. at 48762 and *Carestream Health, Inc. v. Smartplates, LLC*, IPR2013-00600, Paper 8 (PTAB Dec. 26, 2013)





# Agreement Reached

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If the parties agree to the scope of initial disclosures, they must submit that agreement by the earlier of:

- The time the patent owner files its preliminary response.
- The preliminary response due date (T-3 months).

# NY CLE CODE

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# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
  - T-6 Months: The Petition
  - T-6+ Months: Initial Post Filing Activity
  - T-6 Months to T-3 Months: Initial Disclosures
  - T-3 Months: PO Preliminary Response (POPR)



# T-3 Months: POPR (optional)

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Response Timing

Response Details

Reply to POPR

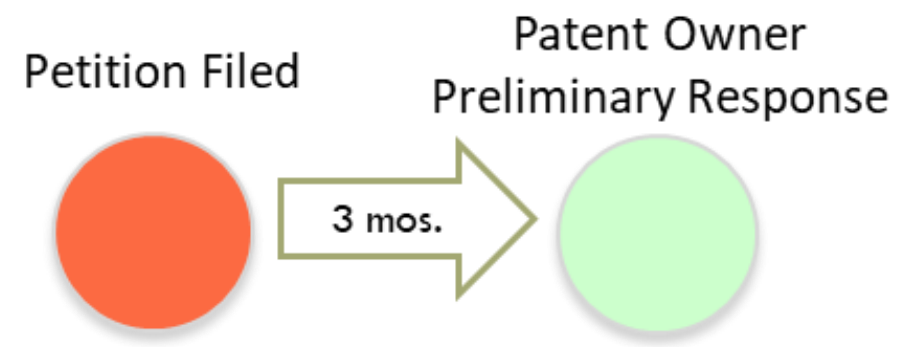
Sur-Reply

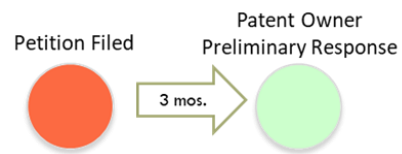


# Response Timing

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The patent owner may elect to file a POPR to a petition within three months of the PTAB's notice according a filing date to the petition.





# POPR Details

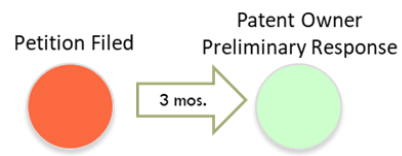
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Limited to stating the reasons why the PTAB should not institute a trial. Patent owner:

- May present supporting evidence, including new testimonial testimony (for example, expert declaration).
- May not include any claim amendment.
- May disclaim challenged patent claims, which precludes review of those claims (see *General Elec. Co. v. United Techs. Corp.*, 2017 WL 2891110 (PTAB July 6, 2017)(precedential) (challenged claims disclaimed under 37 C.F.R. 42.107(e)).

Arguments commonly undercut the petitioner’s prior art, characterize the petitioner’s proposed claim construction as unreasonable, and otherwise attempt to demonstrate how the threshold for institution is not met.

37 C.F.R. §§ 42.107, 42.207, Trial Practice Guide, 77 Fed. Reg. at 48764 and PTAB Trial Practice Guide July 2019 Update at 19



# POPR Details

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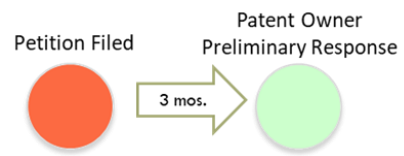
## **POPRs are limited to:**

- 14,000 words for IPRs.
- 18,700 words for PGRs.

## **Word count limits do not include:**

- Table of Contents
- Table of Authorities
- Mandatory Notices
- Certificates of service or word count
- Appendix of exhibits or claim listings

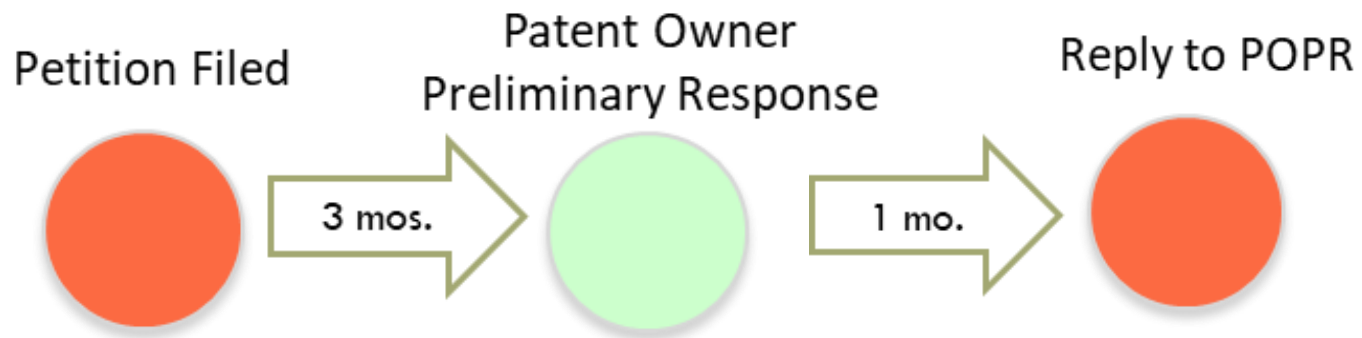
Preliminary response may contain an expert declaration ((37 C.F.R. §§ 42.107(a) and 207(a))

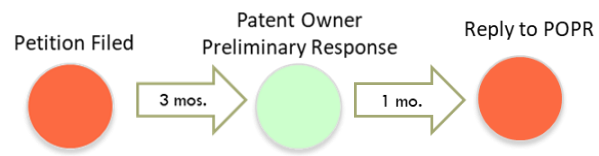


# Reply to POPR

Petitioners may seek leave to file a reply to the POPR, which the board may grant upon a showing of good cause. Replies are limited to arguments raised in the POPR. The reply to POPR is limited to five pages in length.

A reply is due **one month** after service of the POPR. This period can be, and often is, shortened.



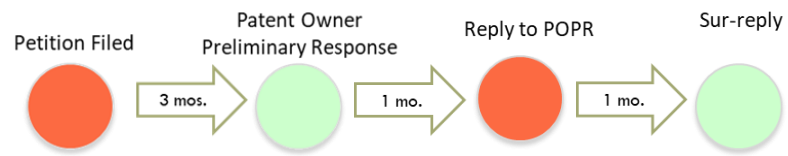


# Reply to POPR

---

## Replies are limited to 5600 words, which does not include:

- table of contents
- a table of authorities
- a listing of facts that are admitted, denied, or cannot be admitted or denied
- a certificate of service or word count
- an appendix of exhibits.

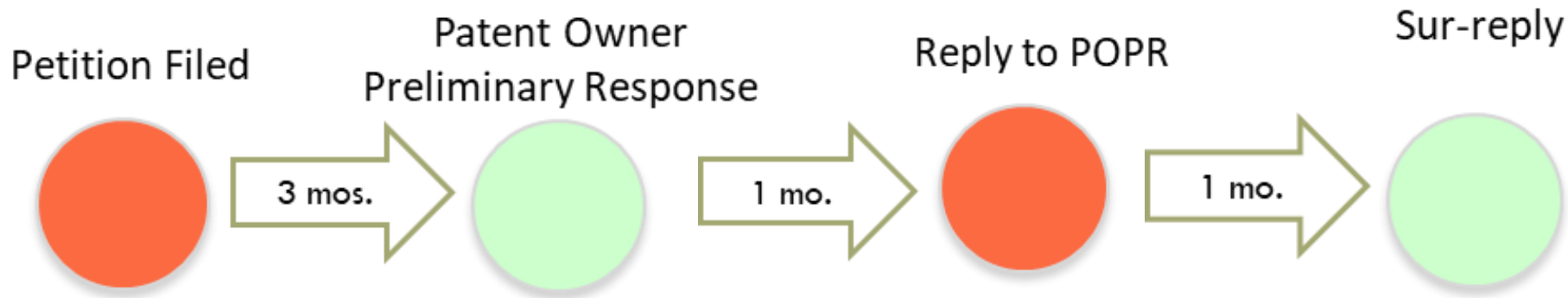


# Sur-Reply to POPR

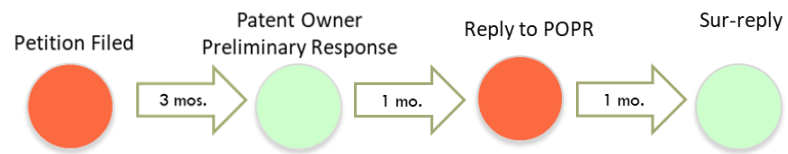
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Patent Owners may seek to file a sur-reply to the POPR. Sur-replies may only address arguments raised in the reply to the POPR and may not include any new evidence other than any deposition transcripts of the cross-examination of any reply witness.

A reply is due **one month** after service of the reply to the POPR. This period can be, and often is, shortened.







# Sur-Reply to POPR

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## Replies are limited to 5600 words, which does not include:

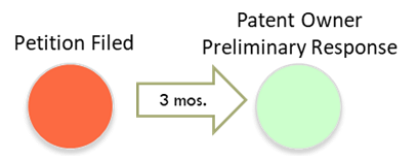
- table of contents
- a table of authorities
- a listing of facts that are admitted, denied, or cannot be admitted or denied
- a certificate of service or word count
- an appendix of exhibits.

# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- **Decision on Institution**

# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
  - Timing
  - Institution Threshold
  - Discretionary Denials
  - Factors Considered

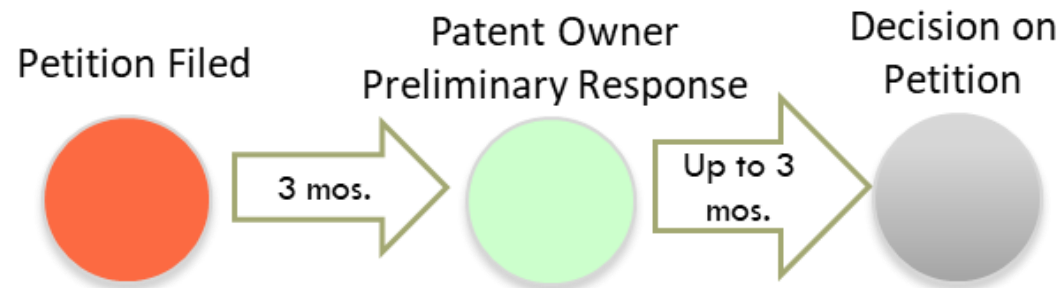


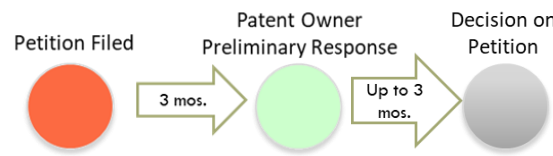
# Timing

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The PTAB must determine whether to institute a trial **within three months** of the earlier of:

- The patent owner's preliminary response filing.
- The preliminary response due date





# Institution Threshold

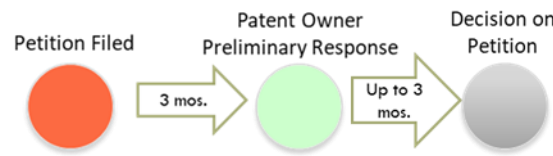
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## Threshold for IPR

The petition and any preliminary response must show that there is a reasonable likelihood that the petitioner would prevail on at least one of the challenged claims (35 U.S.C. § 314(a)).

## Threshold for PGR

The petition and any preliminary response must show that it is more likely than not (greater than 50%) that at least one of the challenged claims is unpatentable. The petition also may satisfy the “more likely than not” standard if it raises a novel or unsettled legal question that is important to other patents or patent applications (35 U.S.C. § 324(a)).

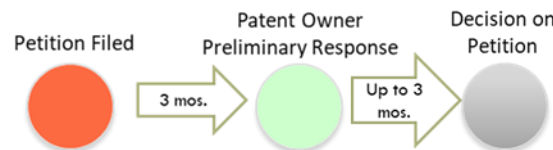


# Institution Threshold – All Claims

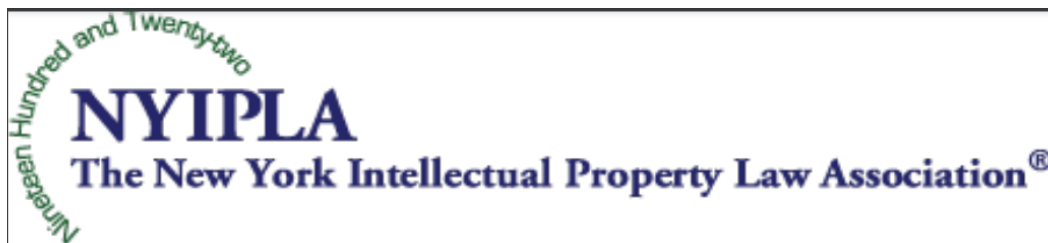
---

## Institution Threshold:

- A petitioner “is entitled to a final written decision addressing all of the claims it has challenged.” *SAS Institute Inc. v. Iancu*, 548 U.S. \_\_\_\_ (2018).
- The Board will also proceed on all grounds of unpatentability for each challenged claim when instituting a trial (37 C.F.R. §§ 42.108(a), 208(a)).



# Institution Threshold - SAS



## Adjusting Your Strategies in Preparing and Responding to Petitions Before the PTAB after SAS Inst. Inc. v. Iancu

**Moderated by:**  
**Peter G. Thurlow**  
*Polsinelli PC*

**Speakers:**  
**Charles R. Macedo**  
**Christopher Lisiewski**  
*Amster, Rothstein & Ebenstein LLP*

**Kenneth R. Adamo**  
*Kirkland & Ellis LLP*  
**Brian Murphy**  
*Haug Partners LLP*

**Special Guest:**  
**William M. Fink**  
*Vice Chief Administrative  
 Patent Judge  
 USPTO*

### Agenda

#### Background

#### Petitioner's Perspective

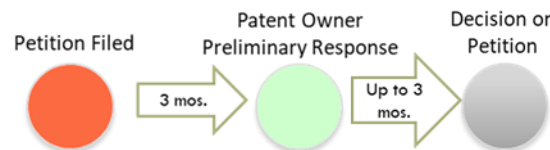
#### Patent Owner's Perspective

#### Former PTAB Judge's Perspective

- Background of *SAS Institute Inc. v. Iancu*
- Petitioner's Perspective After SAS
- Patent Owner's Perspective After SAS
- Former PTAB Judge's Perspective After SAS
- PTAB's Perspective After SAS

For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/assnfe/ev.asp?ID=1265>

Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars!



# Discretionary Denials

## ***Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016)**

The Patent Office's decision to initiate inter partes review is "preliminary," not "final." *Ibid.* And the agency's decision to deny a petition is a matter committed to the Patent Office's discretion. See § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review); see also *post*, at 2153, and n. 6.

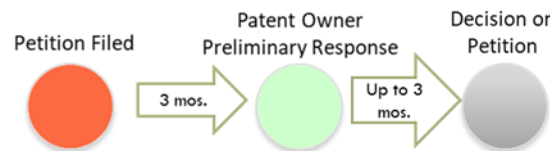
## ***Oil States Energy v. Greene's Energy Group*, 138 S. Ct. 1365, 1371 (2018)**

The decision whether to institute inter partes review is committed to the Director's discretion. See *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. , , 136 S.Ct. 2131, 2140, 195 L.Ed.2d 423 (2016).

For more information, visit the NYIPLA site for a copy of the presentation: <https://www.nyipla.org/assnfe/ev.asp?ID=1363>

Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars!





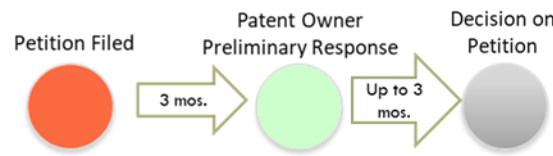
# General Plastic Factors

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Factors PTAB considers in exercising discretion:

- Whether the same petitioner previously filed a petition directed to the same claims of the same patent.
- Whether, when the petitioner filed the first petition, it knew, or should have known, of the prior art asserted in the second petition.
- Whether, when the petitioner filed the second petition, it already received the patent owner's preliminary response to the first petition or received the PTAB's decision on whether to institute review on the first petition.
- The time period between when the petitioner learned of the prior art asserted in the second petition and the filing of the second petition.
- Whether the petitioner provides an adequate explanation for the delay between the filing of multiple petitions directed to the same claims of the same patent.
- The PTAB's resources.
- The requirement for the PTAB to issue a final determination not later than one year after the date of institution.

*General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, 2017 WL 3917706 (PTAB Sept. 6, 2017) (precedential) and Consolidated Trial Practice Guide (November 2019)



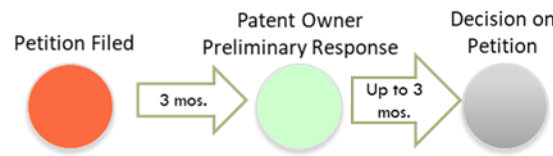
# *Beckton Dickinson Factors*

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When presented with prior art which is similar to prior art previously cited, the PTAB considers:

- The similarities and material differences between the asserted art and the prior art previously evaluated.
- The cumulative nature of the asserted art and the prior art previously evaluated.
- The extent to which the asserted art was previously evaluated.
- The extent of the overlap between the previous arguments and the manner in which the petitioner relies on or the patent owner distinguishes the prior art.
- Whether the petitioner sufficiently explained how the USPTO erred in evaluating the prior art.
- The extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson and Co. v. B. Braun Melsungen AG*, 2017 WL 6405100 (PTAB Dec. 15, 2017)(precedential) and Consolidated Trial Practice Guide (November 2019)



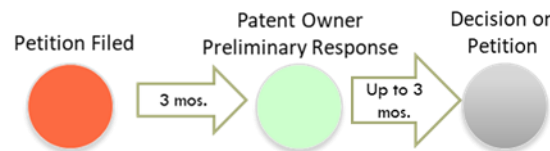
# *Fintiv* Factors

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For Proceedings in parallel with District Court litigation:

- Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.
- Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision. The Board is more likely to deny institution where the district court trial date is before the final written decision deadline, and less likely to deny institution where the trial date is contemporaneous with or later than the final written decision date, in view of the other factors.
- Investment in the parallel proceeding by the court and the parties.
- Overlap between issues raised in the petition and in the parallel proceeding.
- Whether the petitioner and the defendant in the parallel proceeding are the same party.
- Other circumstances that impact the Board’s exercise of discretion, including the merits.

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential as of May 5, 2020)



# Update on Latest PTAB Rules

## Fintiv Factors

In determining whether *to exercise discretion to deny institution under 35 U.S.C. § 314(a) in view of a parallel district court proceeding dealing with the same issues*, the Board considers the factors set out in *Apple Inc. v. Fintiv, Inc.*, IPR 2020-00019, Paper 11 (March 20, 2020) ("*Fintiv*"):

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party;
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

For more information, visit the NYIPLA site for a copy of the presentation : <https://www.nyipla.org/assnfe/ev.asp?ID=1364>

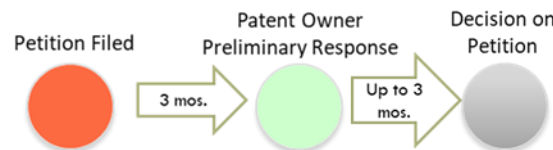
Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars!

# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution

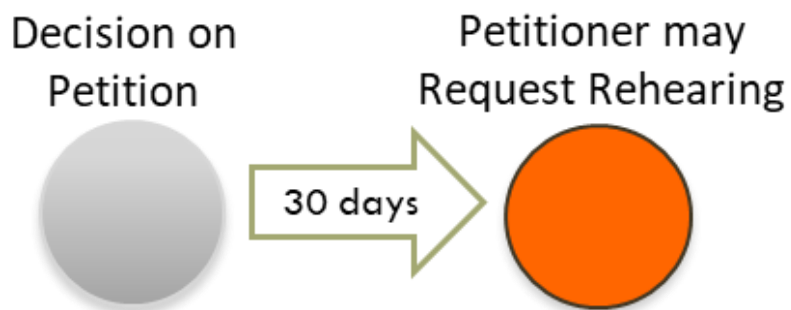
# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
  - Decision Not to Institute Trial



# T+30 Days – Rehearing Request

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For decisions not to instate trial, the petitioner may file a rehearing request, without the PTAB’s prior authorization, **within 30 days** of the PTAB’s entry of its decision (37 C.F.R. § 42.71(d)(2))

The rehearing request must specifically identify:

- All matters the PTAB misapprehended or overlooked.
- Where each matter was previously addressed in a motion, opposition, or reply.

(See 37 C.F.R. § 42.71(d) and *MicroStrategy, Inc. v. Zillow, Inc.*, 2013 WL 6327763 (PTAB Apr. 22, 2013))



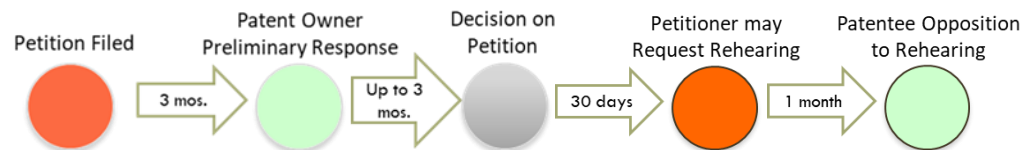
# T + 2 months – Patent Owner Opp.

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A patent owner’s opposition to a rehearing request is due **one month after service** of the rehearing request (37 C.F.R. § 42.25). This requires PTAB authorization, and the PTAB may decline to consider any unauthorized requests.

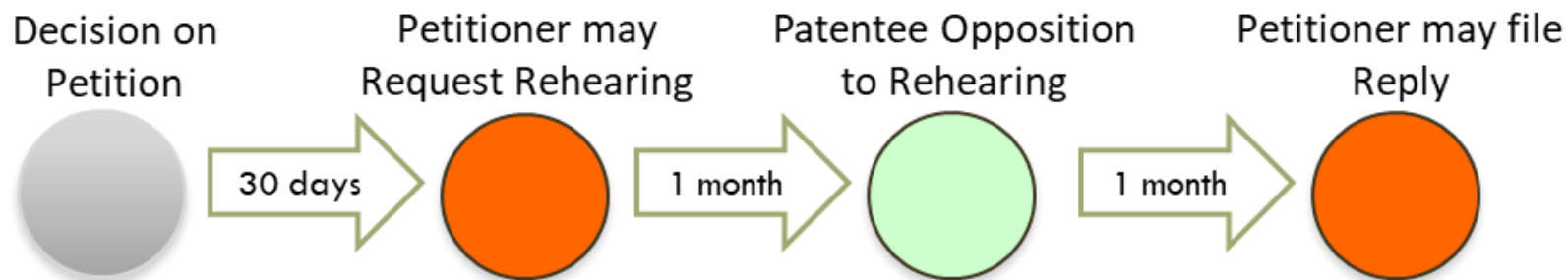






# T + 3 months – Pet. Reply Brief

A petitioner’s reply brief is due **one month after service** of the opposition (37 C.F.R. § 42.25). Again, this requires PTAB authorization, and the PTAB may decline to consider any unauthorized requests.



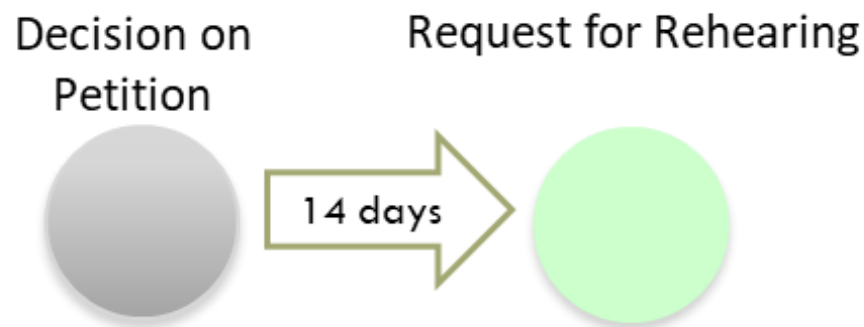
# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
  - Decision Not to Institute Trial
  - Decision to Institute Trial



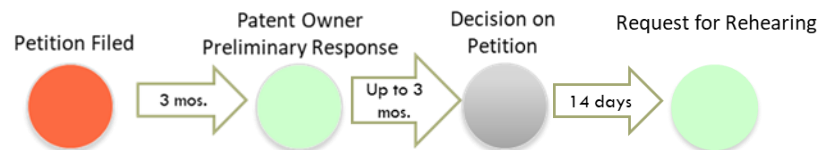
# T + 15 days – Rehearing Request

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Unlike a decision not to institute a trial, a decision to institute an IPR is a non-final decision, and a party must file any rehearing request within **14 days** of the PTAB’s entry of the decision (37 C.F.R. § 42.71(d)(1)).

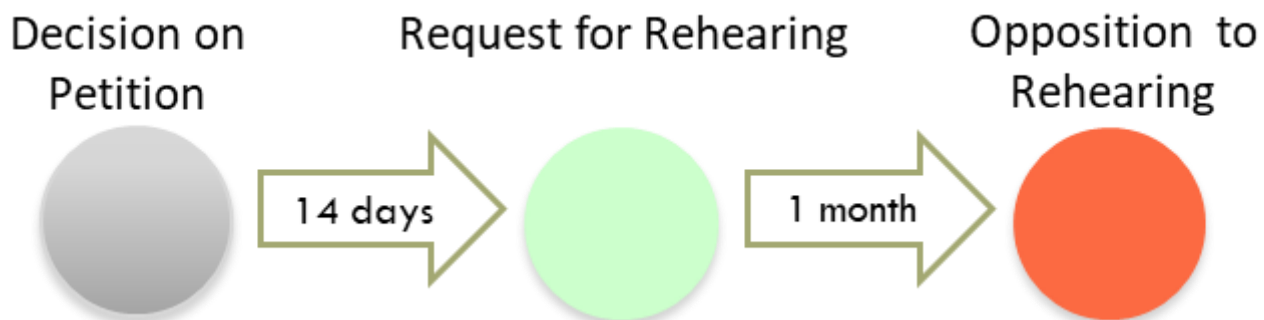
The rehearing request must specifically identify all matters the PTAB misapprehended or overlooked and where the matter was previously addressed in the record (37 C.F.R. § 42.71(d) and Trial Practice Guide, 77 Fed. Reg. at 48768).



# T+ 1.5 Months: Petitioner Opp.

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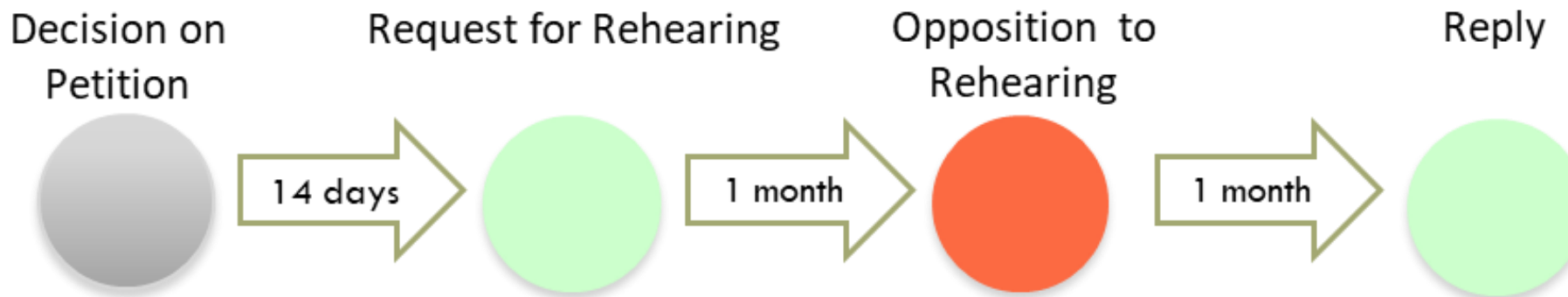
As with other oppositions, authorization is required. If authorization is received, opposition by petitioner is due one month after service of the rehearing request (37 C.F.R. § 42.25).

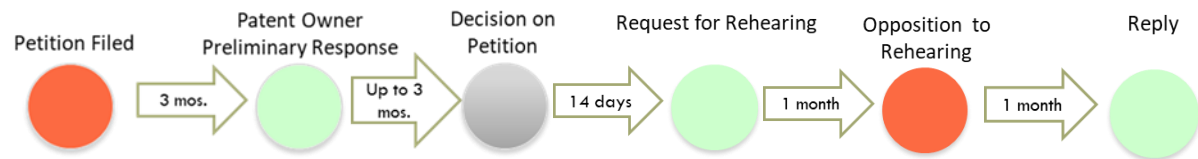




# T+2.5 Months: Patent Owner Reply

As with other reply, authorization is required. If authorization is received, reply by patent owner is due within **one month** after service of petitioner's opposition (37 C.F.R. § 42.25).

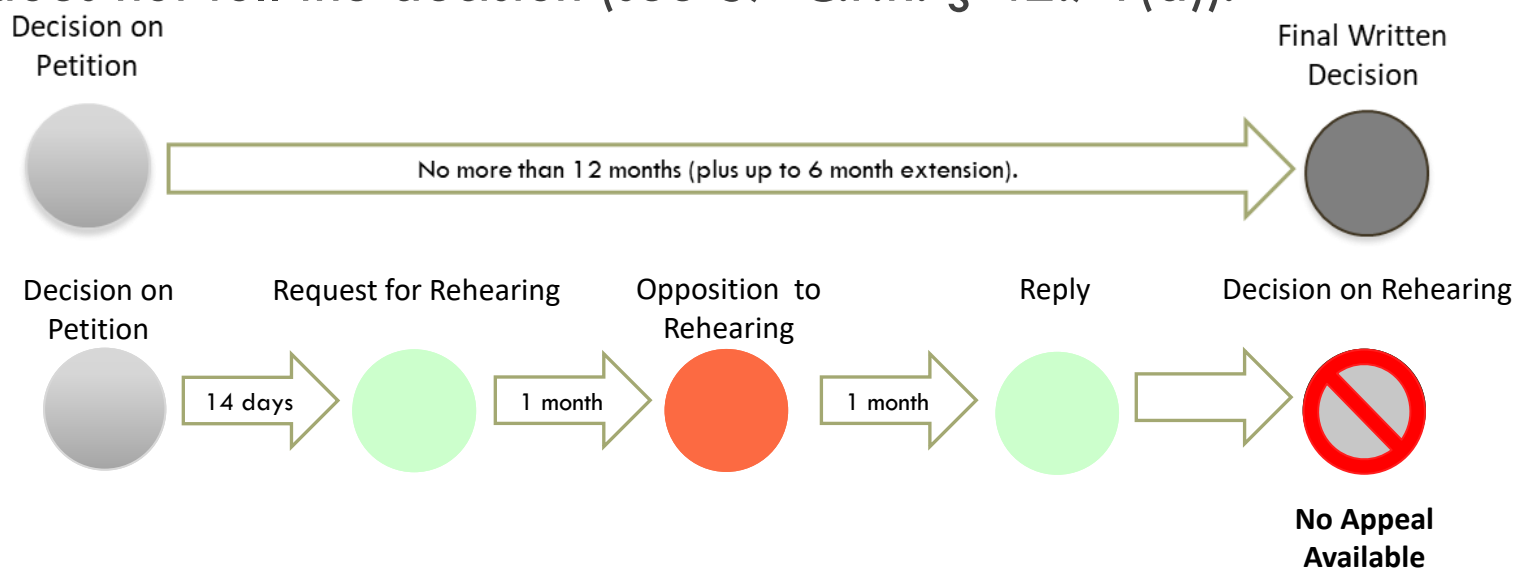


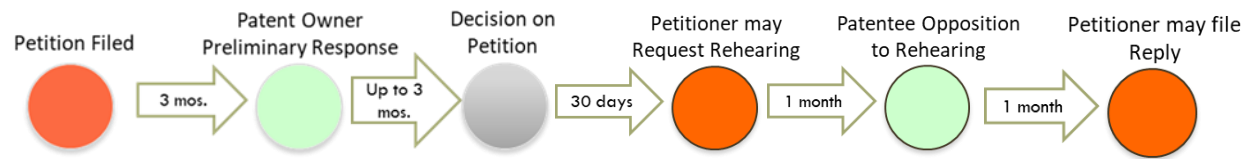


# T > 2.5 months: Decision on Rehearing

The PTAB determines whether to grant rehearing any time after the parties have either exhausted or been denied their requested rehearing filings.

The trial will continue in parallel with the request for rehearing, and the request for rehearing does not toll the decision (see 37 C.F.R. § 42.71(d)).

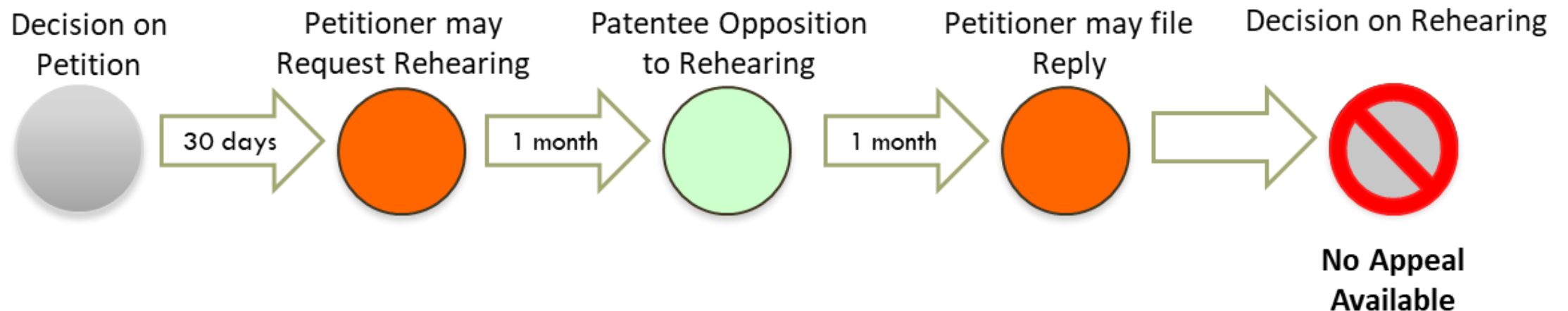


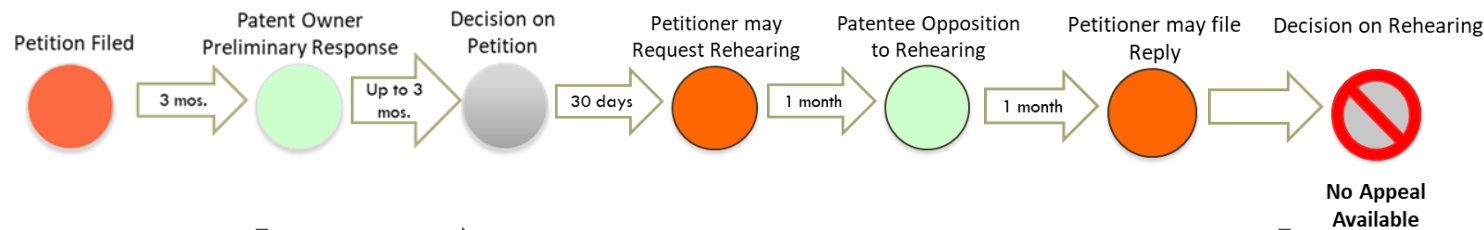


# Effect of *Cuozzo* and *Thryv* (2020)

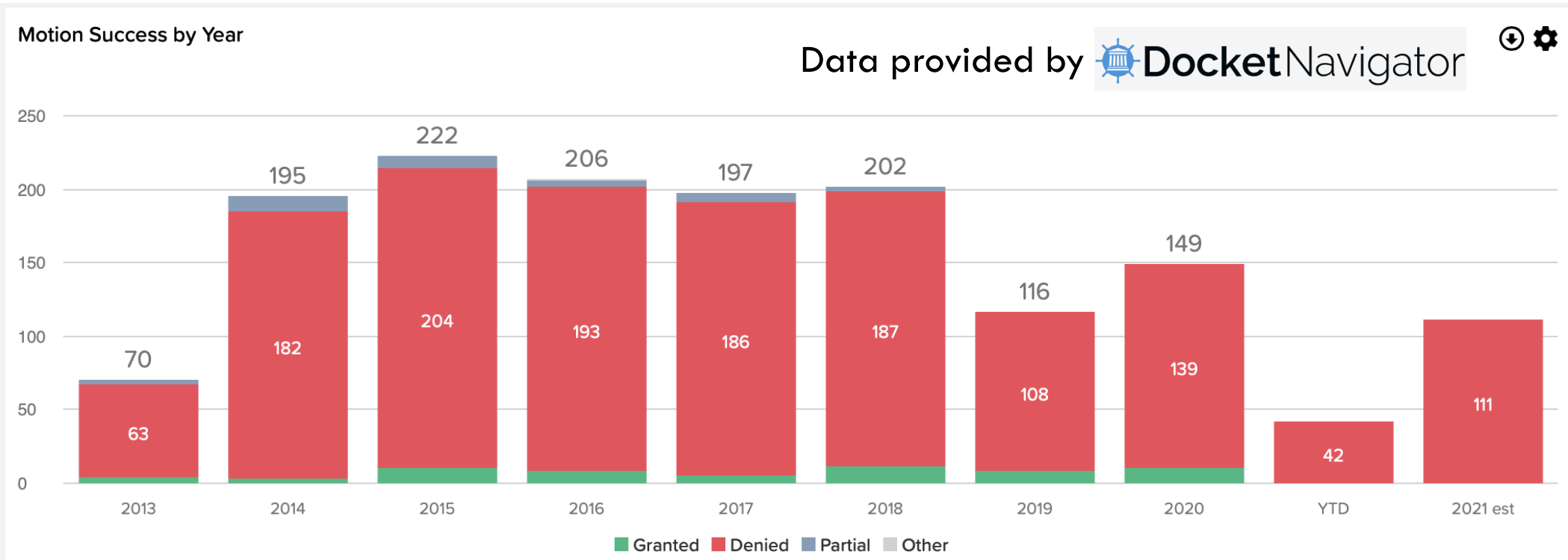
*Cuozzo* held that “§ 314(d) bars review at least of matters closely tied to the application and interpretation of statutes related to the institution decision.” *Thryv, Inc. v. Click-to-Call Technologies, Inc.*, 590 U.S. \_\_\_\_ (2020) (citing *Cuzzo Speed Technologies, LLC v. Lee*, 579 U.S. \_\_\_\_, \_\_\_\_ (2016) (slip op., at 11)) (internal quotes omitted).

*Thryv* held that this includes rejections of arguments based on the 315(b) time limitation.





# Docket Navigator— Rehearing Success Rate



For more PTAB data, see a copy of the presentation at the event: <https://www.nyipla.org/assnfe/ev.asp?ID=1397>. The Summer 2021 NYIPLA Report will also feature a de-brief on some of these statistics!

Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars and publications!



# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing

# Agenda

- Proceedings Leading to the Hearing
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB

# T-0 Months: Scheduling Order

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Decision on  
Petition





# Scheduling Order

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**DUE DATE 1:** Patent owner response to the petition and authorized motion to amend (three month default time).

**DUE DATE 2:** Petitioner reply to the patent owner's response and opposition to patent owner's motion to amend (three month default time).

**DUE DATE 3:** Patent owner sur-reply to reply and reply to the petitioner's opposition (one month default time).

**DUE DATE 4:** Petitioner sur-reply to reply to opposition to motion to amend and parties' motion to exclude evidence (one month default time).

**DUE DATE 5:** Opposition to motion to exclude (one week default time).

**DUE DATE 6:** Reply to opposition to motion to exclude and request for prehearing conference (one week default time).

**DUE DATE 7:** Oral argument (two week default time).

The parties may:

Stipulate different dates for DUE DATES 1-5, but no later than DUE DATE 6.

Not stipulate to an extension of DUE DATES 6-7 or to the requests for oral hearing.



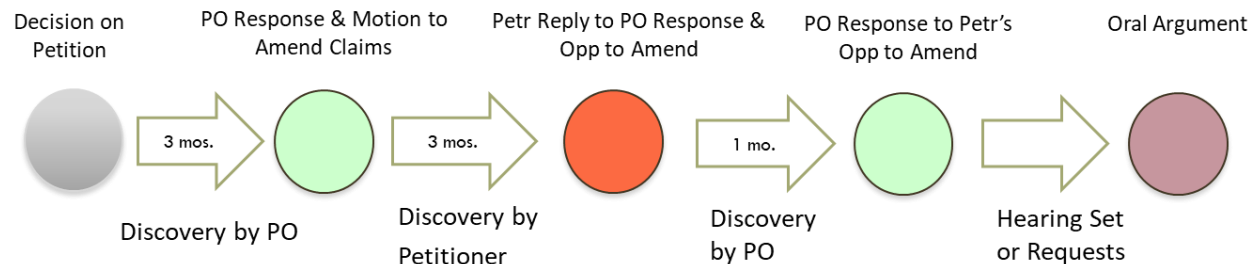
# Initial Conference Call

- Held within **one month** of institution decision
- List of proposed motions required at least **two business days** before the conference call.

Decision on  
Petition



Initial  
Conference Call



Trial Practice Guide, 77 Fed. Reg. at 48765

# Agenda

- Proceedings Leading to the Hearing
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner



# Discovery by P.O.

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Decision on  
Petition



Discovery by PO

Discovery includes:

- The information the parties exchange through agreed-upon initial disclosures and mandatory notices
- Routine discovery
  - Scheduling order will specify timeline
- Additional discovery
  - Parties must either agree (rare) or patent owner must file a motion.



3 mos.

Discovery by PO

# Depositions (Cross-Examination) and Uncompelled Testimony

---

Parties may depose declarants that submit affidavit testimony.

- A party seeking a deposition must file a notice at **least ten business days** before the deposition.
- Cross-examination should take place after any supplemental evidence is due and should conclude **more than one week before** the filing date for any paper in which the parties expect to cite the cross-examination testimony
- Testimony, such as a deposition transcript, must be filed as an exhibit, but either party may file the testimony





Discovery by PO

# Objections to Evidence

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Objections to depositions must be raised **within five days** of service of the evidence or risk waiver.

Parties may file supplemental evidence in response to objection **within 10 business days** of service.

Objections to evidence submitted before institution should be made **within 10 days** of institution.

# Agenda

- Proceedings Leading to the Hearing
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response



Discovery by PO

# T+3 Months: Patent Owner Response

Decision on  
Petition

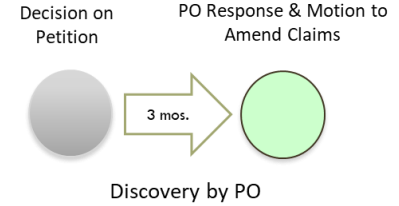
PO Response & Motion to  
Amend Claims



Discovery by PO

Patent Owner may file, **within 3 months** of institution, a response to the challenger to substantively challenge the claims.

35 U.S.C. §§ 316(a)(8) and 326(a)(8);  
37 C.F.R. §§ 42.120 and 42.220



# T+3 Months: Patent Owner Response

## Responses are limited to:

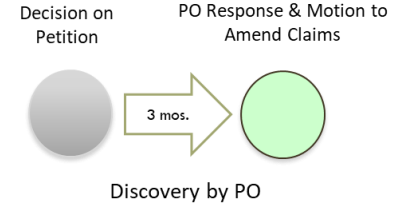
- 14,000 words for IPRs.
- 18,700 words for PGRs.

## Word count limits do not include:

- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listings

The response may contain exhibits or claim listings attached as appendices.

37 C.F.R. §42.24(b)



# T+3 Months: Patent Owner Response

## Examples of Patent Owner Exhibits

Ex2001 Declaration of PO Expert

Ex2002 CV of PO Expert

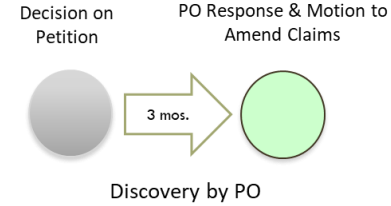
Ex2003 Deposition of Petitioner's Expert

Ex2004 Document Relied on by PO



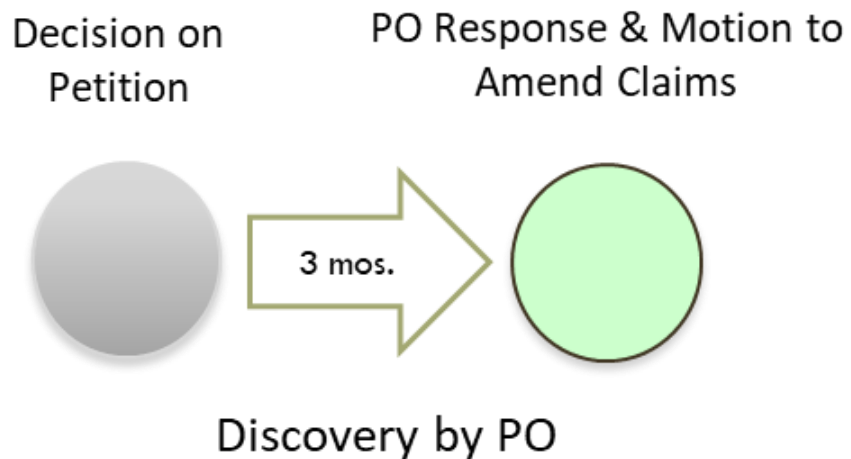
# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: **Motion to Amend Claims**



# Motion to Amend Claims (optional)

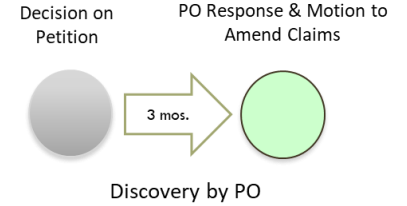
A patent owner may file a motion to amend instituted claims, which is typically due **three months** after a trial is instituted along with the patent owner's response to the petition (37 C.F.R. §§ 42.121(a) and 42.221(a)).



A motion to amend:

- May not enlarge claim scope or add new matter.
- Must clearly identify the support for the amended claims in the original patent disclosure.

(See 35 U.S.C. §§ 316(d)(3) and 326(d)(3))



# Motion to Amend Claims (optional)

## Motions are limited to:

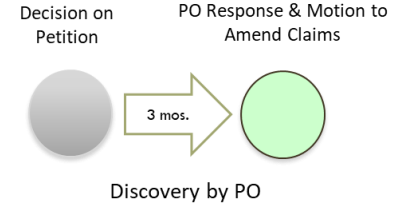
- 25 pages

## Word count limits do not include:

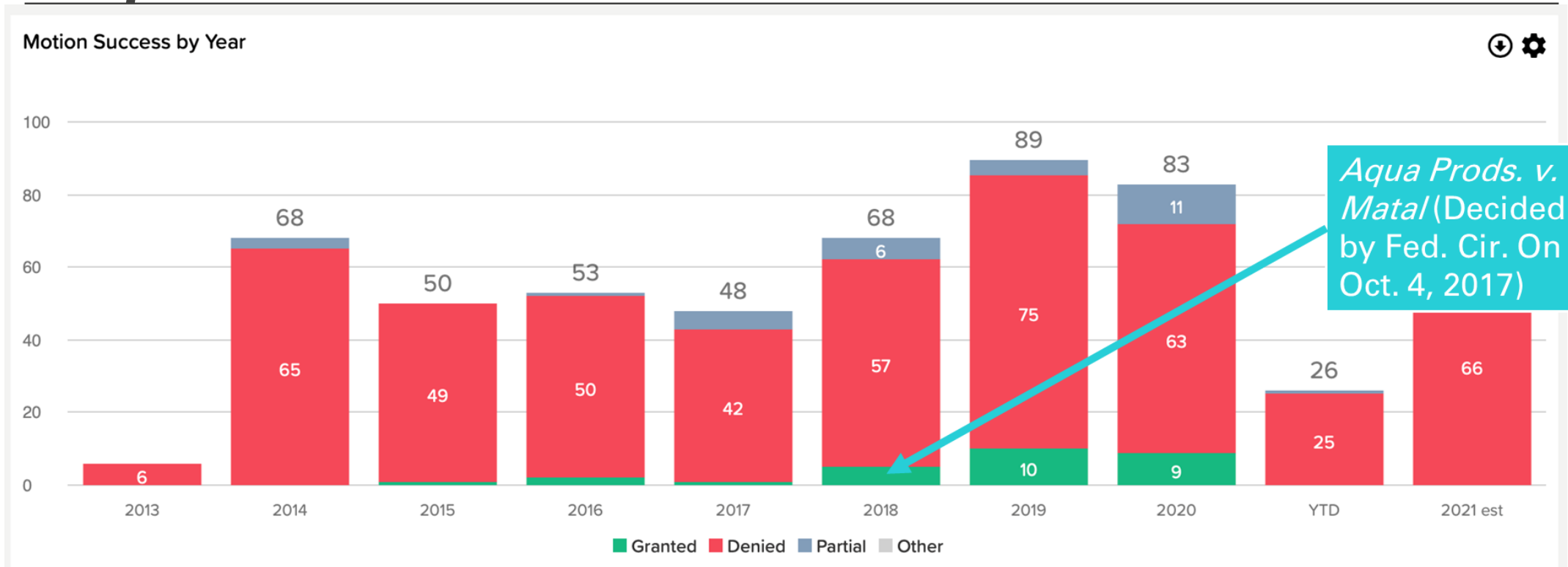
- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listings

Patent Owners may also choose an option under the pilot program (discussed later) (84 Fed. Reg. 9497 (Mar. 15, 2019))





# Aqua Products' & Motions to Amend

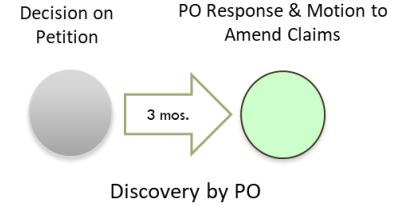


For more PTAB data, see a copy of the presentation at the event: <https://www.nyipla.org/assnfe/ev.asp?ID=1397>. The Summer 2021 NYIPLA Report will also feature a de-brief on some of these statistics!

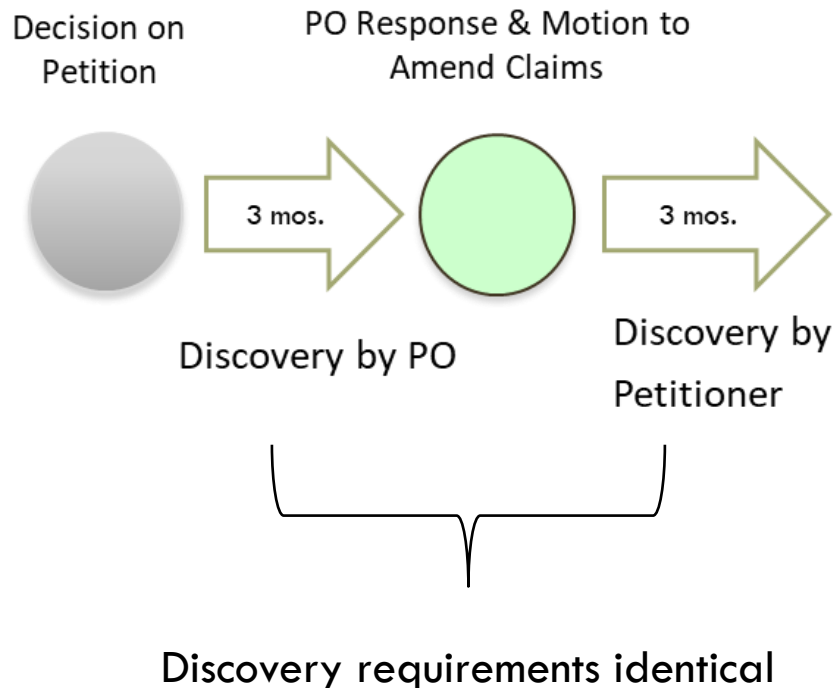
Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars and publications!

# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner

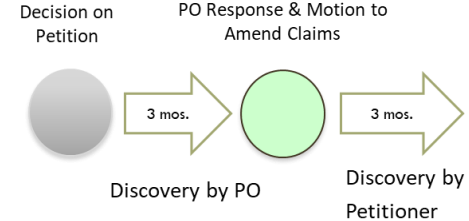


# Petitioner Discovery



## Discovery includes:

- The information the parties exchange through agreed-upon initial disclosures and mandatory notices
- Routine discovery
  - Scheduling order will specify timeline
- Additional discovery
  - Parties must either agree (rare) or patent owner must file a motion.

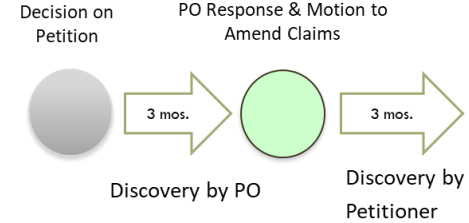


# Depositions (Cross-Examination) and Uncompelled Testimony

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Parties may depose declarants that submit affidavit testimony.

- A party seeking a deposition **must file a notice at least ten business days before** the deposition.
- Cross-examination should take place **after any supplemental evidence is due** and should **conclude more than one week before the filing date for any paper** in which the parties expect to cite the cross-examination testimony
- Testimony, such as a deposition transcript, must be filed as an exhibit, but either party may file the testimony



# Objections to Evidence

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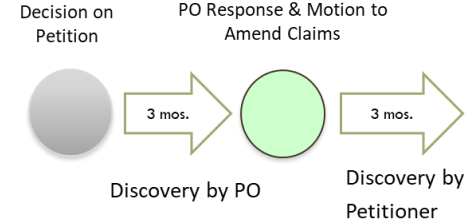
Objections to depositions must be raised **within five days of service** of the evidence or risk waiver.

Parties may file supplemental evidence in response to objection **within 10 business days of service.**

Objections to evidence submitted before institution should be made **within 10 days of institution.**

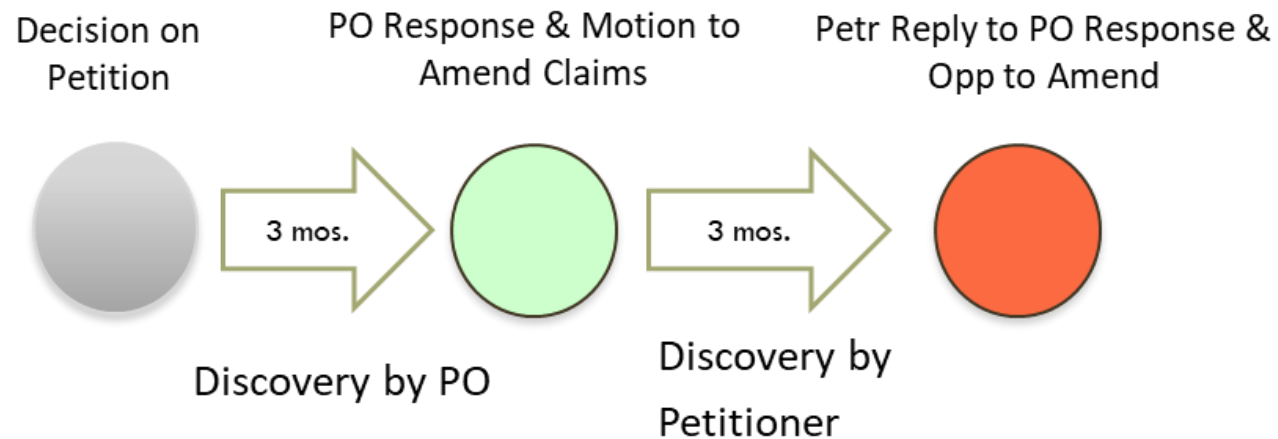
# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition



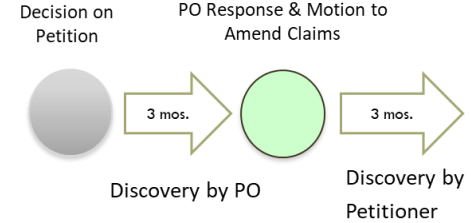
# Pet. Reply to P.O. Response

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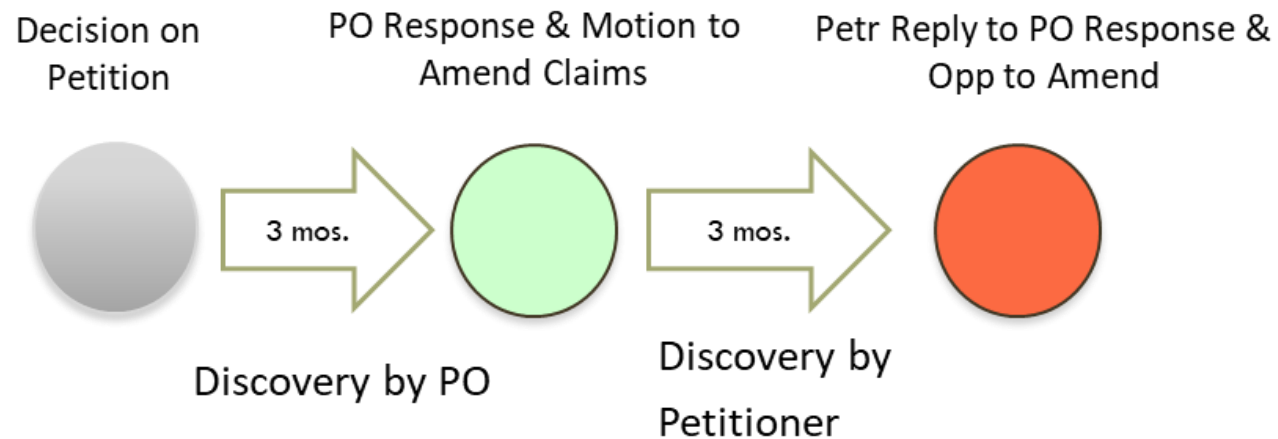
The scheduling order may provide up to **three months** for the petitioner to reply to any patent owner response.

Trial Practice Guide, 77 Fed. Reg. at 48757 and 37 C.F.R. §§ 42.120, 42.220



# Pet. Reply to P.O. Response

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The scheduling order may provide up to **three months** for the petitioner to reply to any patent owner response.

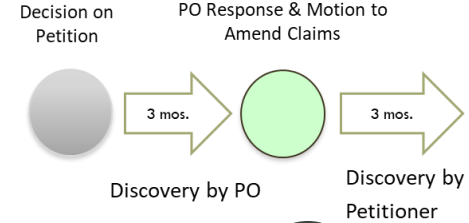
Replies to the response are limited to **5,600 words**. Sur-replies are likewise limited.

Trial Practice Guide, 77 Fed. Reg. at 48757, and 37 C.F.R. §§ 42.24(c)(3), 42.120, 42.220



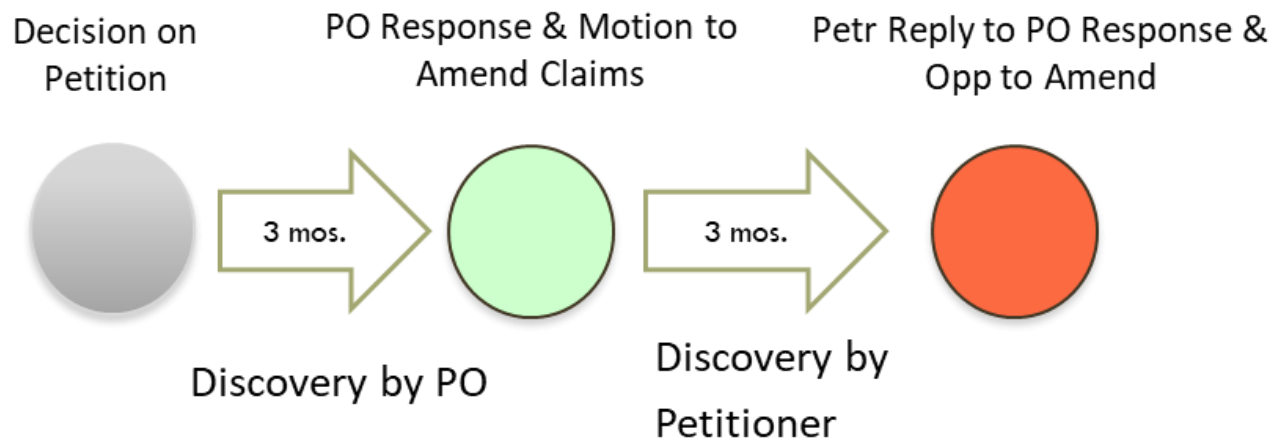
# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition
  - T+6 Months: Petitioner's Reply to M.A.



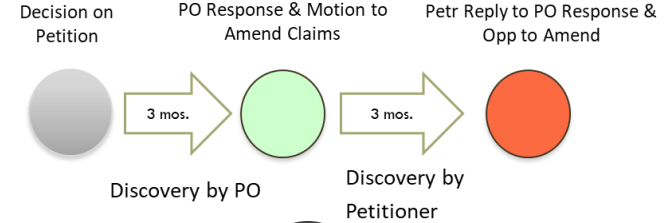
# Opp. To Motion to Amend

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A petitioner may file an opposition to a motion to amend without the PTAB's authorization. The opposition may respond to new patentability issues arising from the patent owner's proposed substitute claims (35 U.S.C. §§ 316(a) and 326(a); and Trial Practice Guide, 77 Fed. Reg. at 48767).

The Burden of proof is on the petitioner (*Aqua Products v. Matal*, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017, O'Malley, K.)).



# Opp. To Motion to Amend

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## Motions are limited to:

- 25 pages

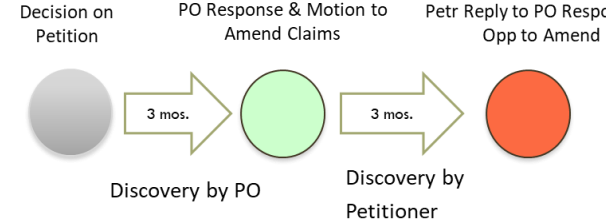
## Page count limits do not include:

- Table of Contents
- Table of Authorities
- Certificates of service or word count
- Appendix of exhibits or claim listing

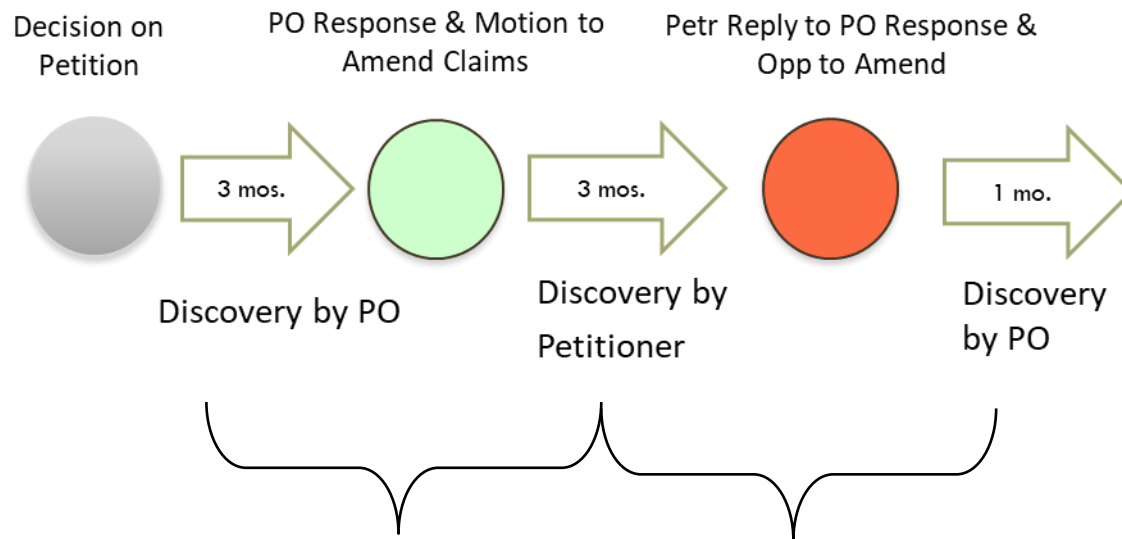
Consider asking the board for a waiver of the 25 pages of the opposition-brief.

# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition
  - T+6 Months: Petitioner's Reply to M.A.
  - T+6 to T+7 Months: P.O. 2<sup>nd</sup> Discovery Period



# Second Patent Owner Discovery



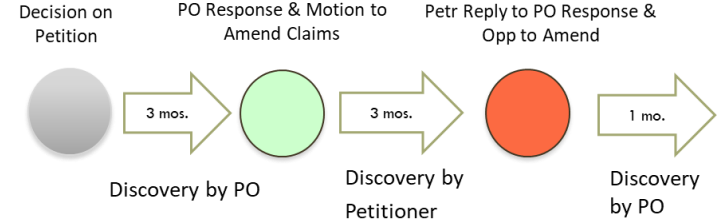
Discovery requirements (besides time) identical

After the petitioner has filed any reply to the patent owner's response and any opposition to the patent owner's motion to amend, the patent owner typically has **one month** to conduct any further discovery relating to the petitioner's opposition, including deposing the petitioner's declarants.

Trial Practice Guide, 77 Fed. Reg. at 48757-48758 and *Respironics, Inc., v. Zoll Med. Corp.*, IPR2013-00322, Paper 26, at 3 (PTAB May 7, 2014)).

# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition
  - T+6 Months: Petitioner's Reply to M.A.
  - T+6 to T+7 Months: P.O. 2<sup>nd</sup> Discovery Period
  - T+6 to T+7 Months: M.A. Pilot Program



# Motion to Amend Pilot Program

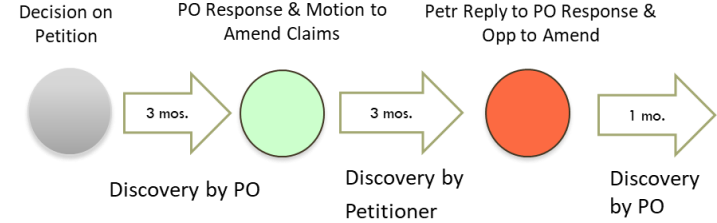
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Under a pilot program effective *March 15, 2019*, the patent owner may choose to:

1. Receive non-binding preliminary guidance from the PTAB on its motion to amend. The PTAB will provide the preliminary guidance will be provided no later than **four weeks** after the due date for the petitioner's opposition to the motion to amend and include an initial discussion of whether:

- the motion to amend meets statutory and regulatory requirements; and
- the petitioner establishes a reasonable likelihood that the substitute claims are unpatentable.

84 Fed. Reg. 9497 (Mar. 15, 2019))



# Motion to Amend Pilot Program

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Under a pilot program effective March 15, 2019, the patent owner may choose to:

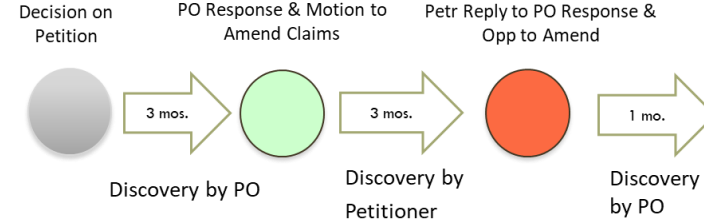
[...]

2. File a revised motion to amend after receiving:

- the petitioner's opposition to the original motion to amend; and/or
- the PTAB's preliminary guidance, if requested.

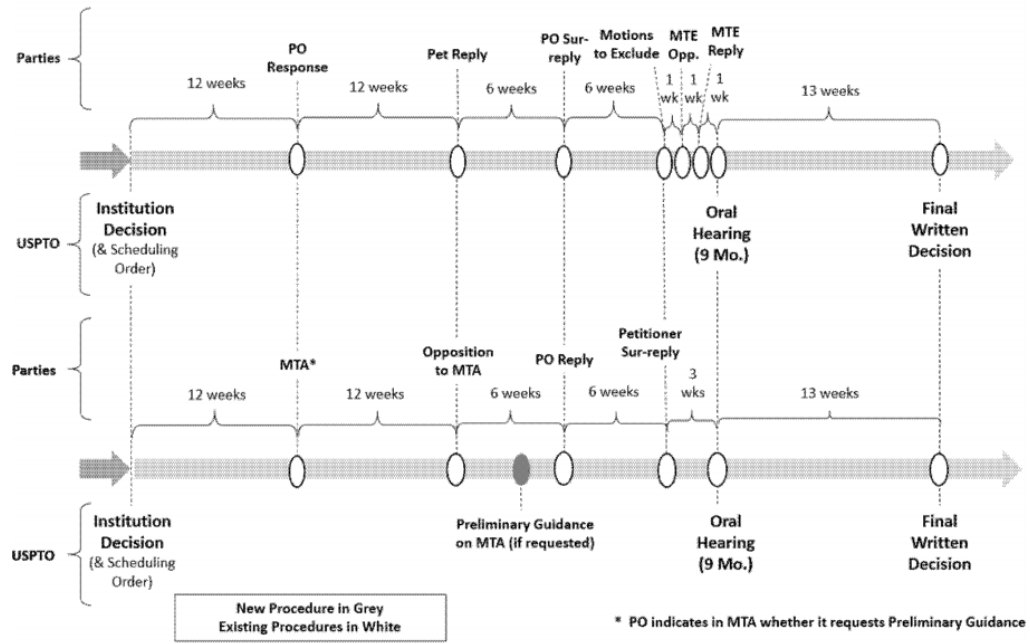
84 Fed. Reg. 9497 (Mar. 15, 2019))



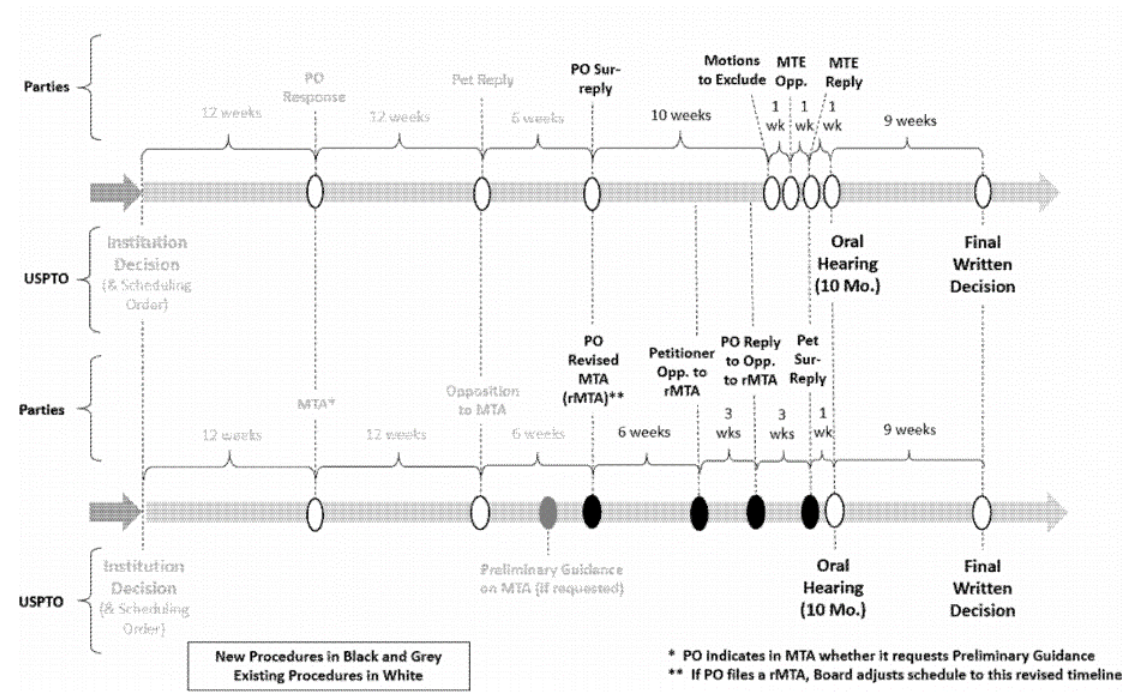


# Motion to Amend Pilot Program

## Preliminary Guidance Requested



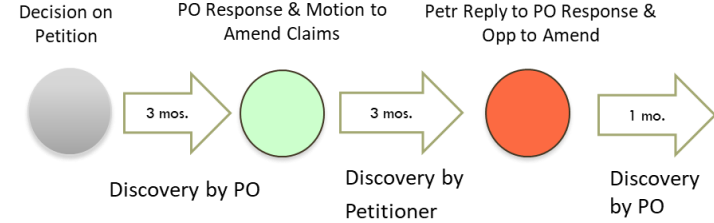
## Revised Motion Filed



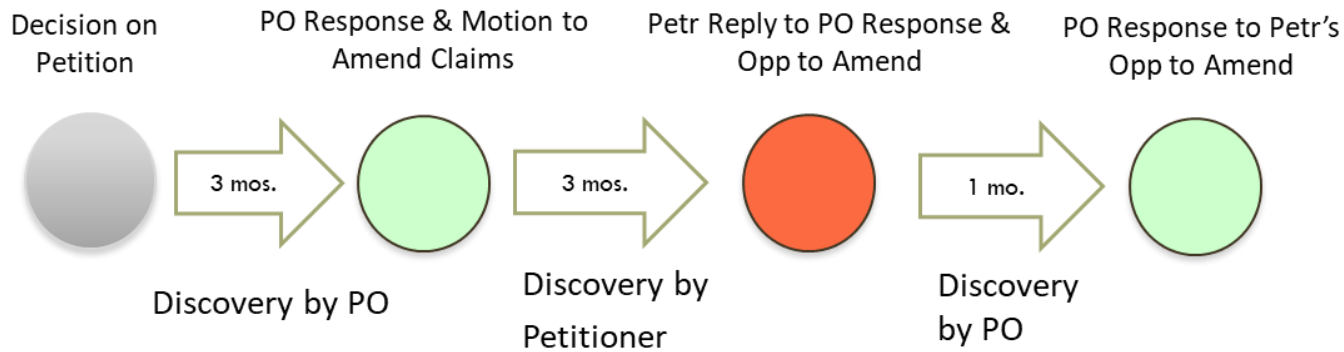
84 Fed. Reg. 9497 (Mar. 15, 2019))

# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition
  - T+6 Months: Petitioner's Reply to M.A.
  - T+6 to T+7 Months: P.O. 2<sup>nd</sup> Discovery Period
  - T+6 to T+7 Months: M.A. Pilot Program
  - T+7 Months: P.O. reply to Opp. on M.A. and Sur-Reply

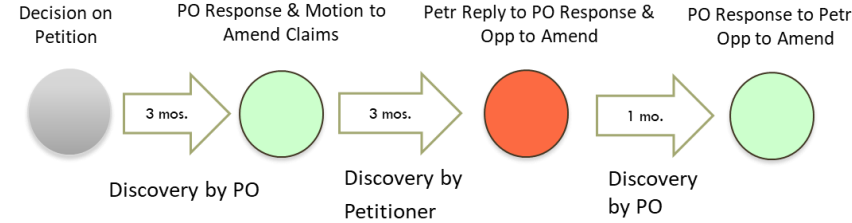


# Patent Owner Reply to Opposition to Motion to Amend



There is a **1-month** limit to file any reply to the petitioner's opposition to a motion to amend. 37 C.F.R. §§ 42.23(b) and 42.25(a)(2)).

As in all reply briefs, arguments should address each point of the petitioner.

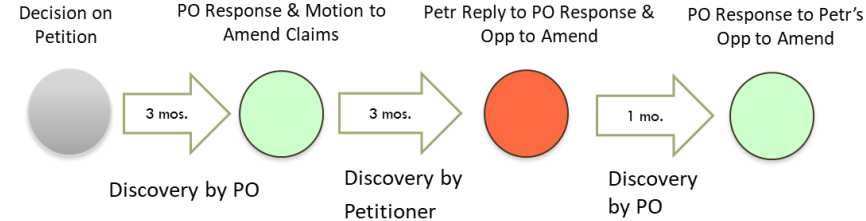


# Sur-Reply to Motion to Amend

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Replies to oppositions to motions to amend are limited to 12 pages (37 C.F.R. § 42.24(c)(3)).

Sur-replies, if authorized and unless the PTAB orders otherwise, are limited to 12 pages (Consolidated Trial Practice Guide (November 2019)).



# T+7 Months: Sur-Reply

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## Sur-replies responding to:

- Motions are not generally permitted, but may be authorized on a case-by-case basis.
- Principle briefs are normally authorized by the scheduling order.

## The sur-reply:

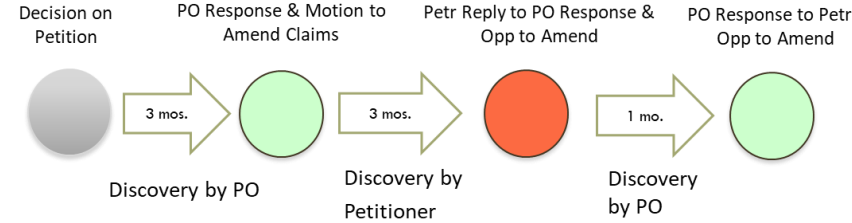
- May not be accompanied by new evidence other than deposition transcripts of any reply witness' cross-examination.
- Should only:
  - respond to arguments made in reply briefs;
  - comment on reply declaration testimony; or
  - point to cross-examination testimony.
- May address the institution decision if necessary to respond to the petitioner's reply.

# Agenda

- **Proceedings Leading to the Hearing**
  - T+0 Months: Entry of a Scheduling Order and Initial Conference Call with PTAB
  - T+0 to T+3 Months: Discovery by Patent Owner
  - T+3 Months: Patent Owner Response
  - T+3 Months: Motion to Amend Claims
  - T+3 to T+6 Months: Discovery by Petitioner
  - T+6 Months: Petitioner's Reply to P.O. Opposition
  - T+6 Months: Petitioner's Reply to M.A.
  - T+6 to T+7 Months: P.O. 2<sup>nd</sup> Discovery Period
  - T+6 to T+7 Months: M.A. Pilot Program
  - T+7 Months: P.O. reply to Opp. on M.A. and Sur-Reply
- **Pre-hearing proceedings**

# Agenda

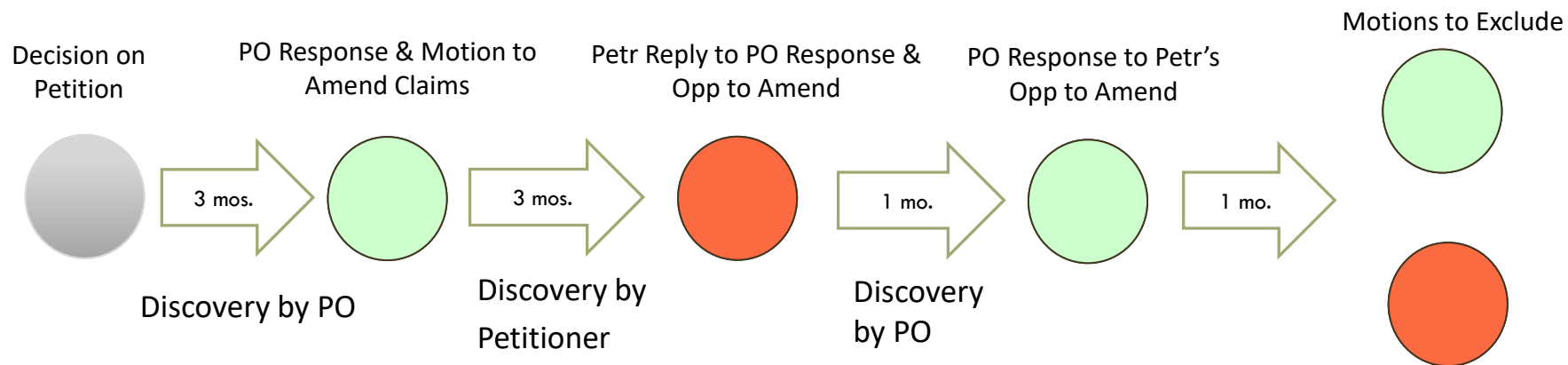
- Proceedings Leading to the Hearing
  - Pre-hearing proceedings
    - Objections to Evidence and Motions to Exclude



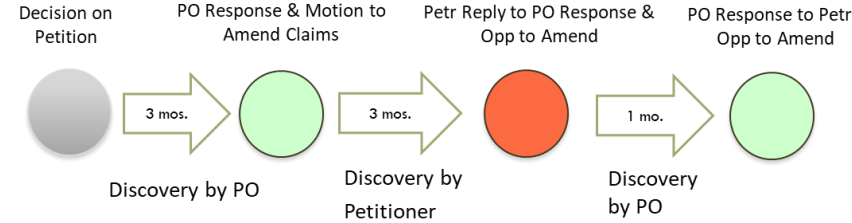
# Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after P.O. reply in support of motion to amend.



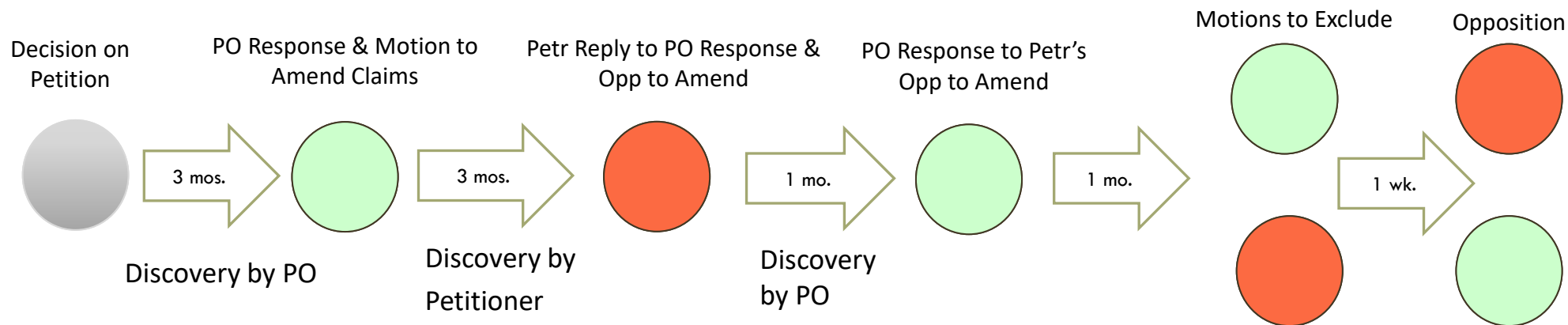


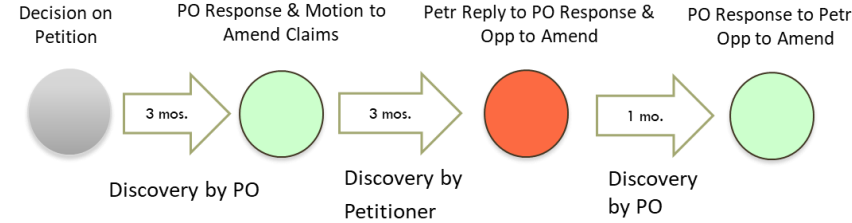


# Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after P.O. reply in support of motion to amend.
- Any opposition is typically due one week later.

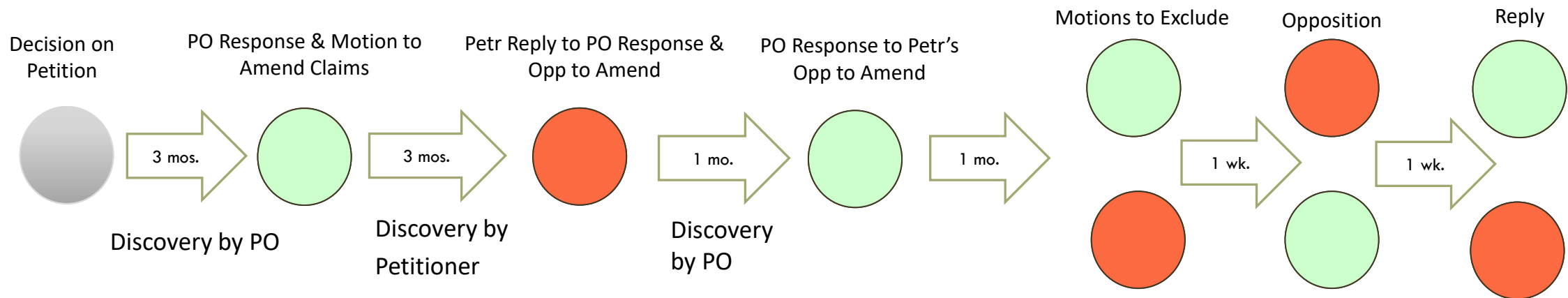


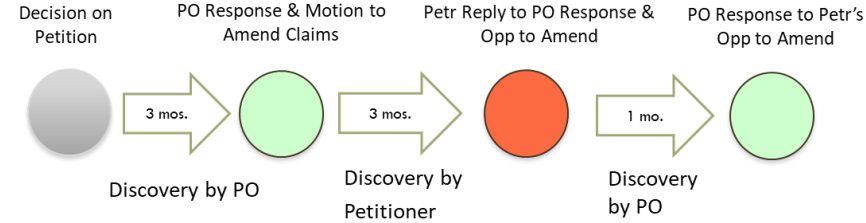


# Motions to Exclude

Scheduling order typically sets deadline. Typically:

- Deadline for motions to exclude set one month after P.O. reply in support of motion to amend.
- Any opposition is typically due one week later.
- Any reply to opposition due one week after that.

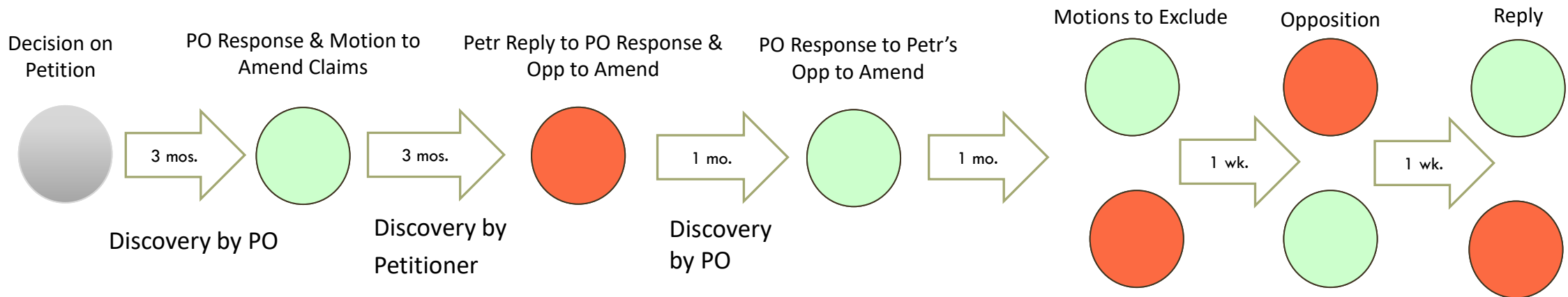




# Motions to Exclude

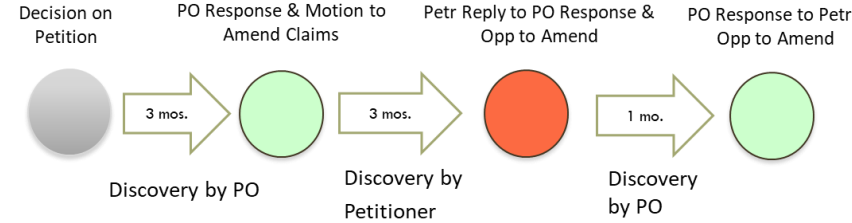
A motion to exclude evidence must:

- Identify where in the record the objection originally was made.
- Identify where in the record the evidence sought to be excluded was relied on by an opponent.
- Address objections to exhibits in numerical order.
- Explain each objection.



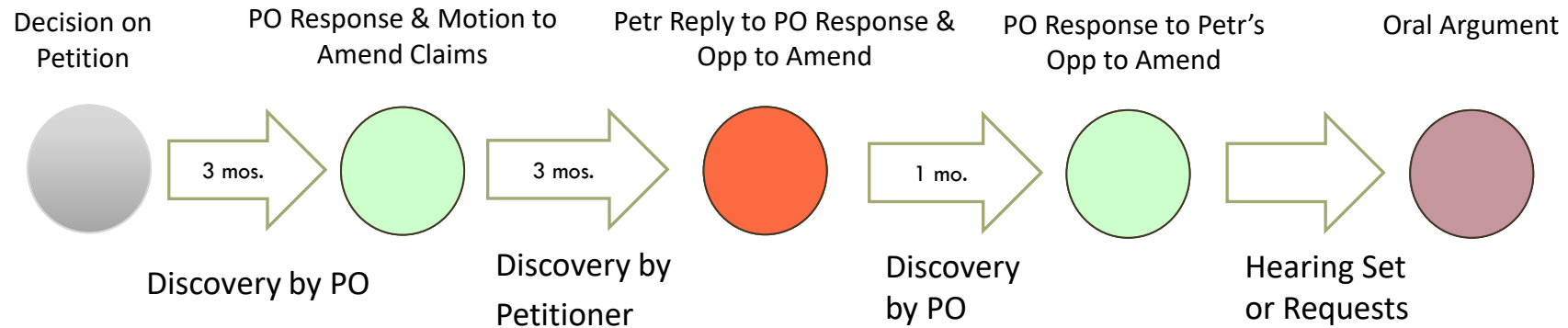
# Agenda

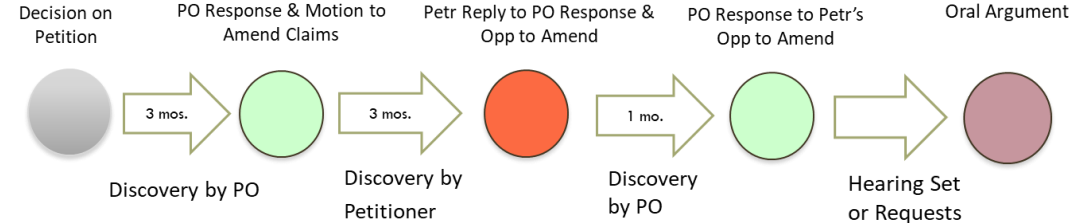
- Proceedings Leading to the Hearing
  - Pre-hearing proceedings
    - Objections to Evidence and Motions to Exclude
    - Oral Argument



# Oral Argument

- (a) A party may request oral argument on an issue raised in a paper at a time set by the Board. The request must be filed as a separate paper and must specify the issues to be argued.
- (b) Demonstrative exhibits must be served at least **seven business** days before the oral argument and filed no later than the time of the oral argument.

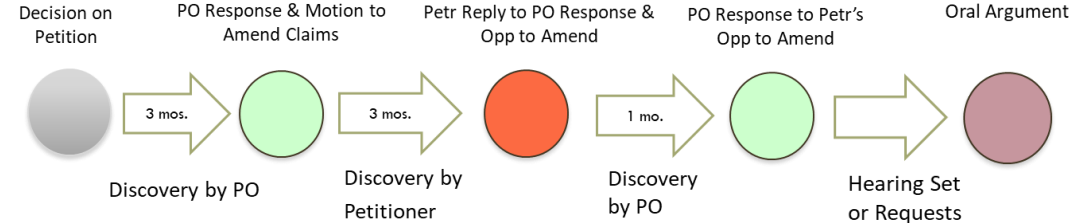




# Oral Argument

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Either party may request a pre-hearing conference call at least **three days** before the oral argument to preview the issues to be discussed at the oral argument and seek the PTAB's guidance on any particular issue the PTAB would like the parties to address.

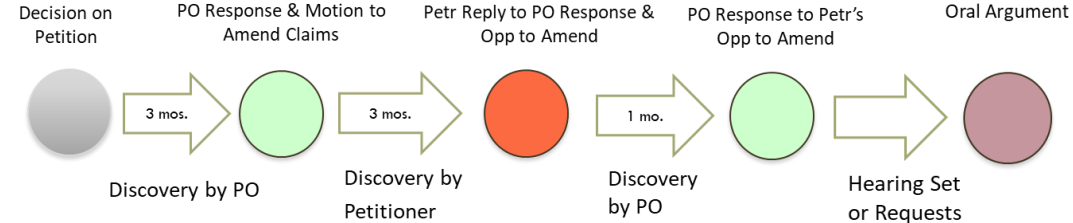


# Oral Argument: Covid-19 Procedure

**March 13, 2020**

“Until further notice, examiner and examining attorney interviews, Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB) oral hearings, and other similar in-person meetings with parties and stakeholders scheduled to take place at USPTO offices on or after Friday, March 13, 2020 will be conducted remotely by video or telephone. Parties will receive further instructions on how to participate by video or telephone in advance of the interview, hearing, or meeting.”

*USPTO Notices Regarding COVID-19; Interviews, Oral Hearings and In-Person Meetings, USPTO (Mar. 13, 2020), <https://www.uspto.gov/coronavirus>*



# Oral Argument: Covid-19 Procedure

[Trials@uspto.gov](mailto:Trials@uspto.gov)  
571-272-7822

Paper 20  
Date: March 13, 2020

IPR2019-00271  
Patent 7,148,043

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGENT TECHNOLOGIES INC.,  
Petitioner,

v.

BIO-RAD LABORATORIES INC,  
Patent Owner.

IPR2019-00271  
Patent 7,148,043

*Before Deputy Clerk, Hearing Operations.*

ORDER  
Conduct of the Proceeding  
35 U.S.C. §§ 42.5, 42.70

An oral hearing before a panel of the Patent Trial and Appeal Board has been scheduled for Wednesday, March 18, 2020, at 1:00 EDT in Alexandria, Virginia. The parties are advised that this oral hearing will be conducted by video.

You must contact PTAB Hearings at (571) 272-9797 five business days prior to the oral hearing date to receive video set-up information. As a reminder, all arrangements and the expenses involved with appearing by video, such as the selection of the facility to be used from which a party will attend by video, must be borne by that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above telephone number five business days prior to the hearing to receive dial-in connection information.

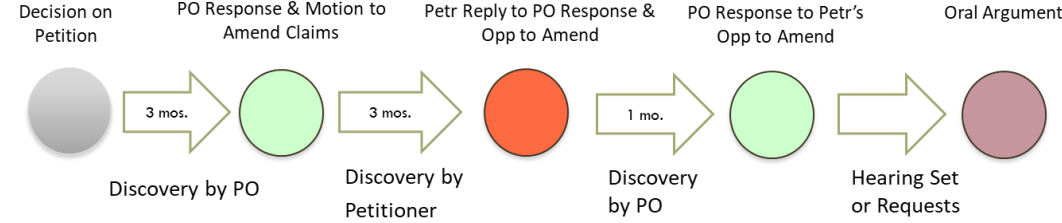
The panel will have access to all papers filed with the Board, including demonstratives. During the oral hearing, the parties are advised to identify clearly and specifically each demonstrative referenced (e.g., by slide or screen number) to ensure the clarity and accuracy of the court reporter's transcript. In addition, the parties are advised to identify themselves each time they speak. Furthermore, the remote nature of the oral hearing may also result in an audio lag, and so Appellant is advised to observe a pause prior to speaking, so as to avoid speaking over others.

Other than the logistics discussed in this Order, the remainder of the Board's Hearing Order (Paper 19) remains in effect.



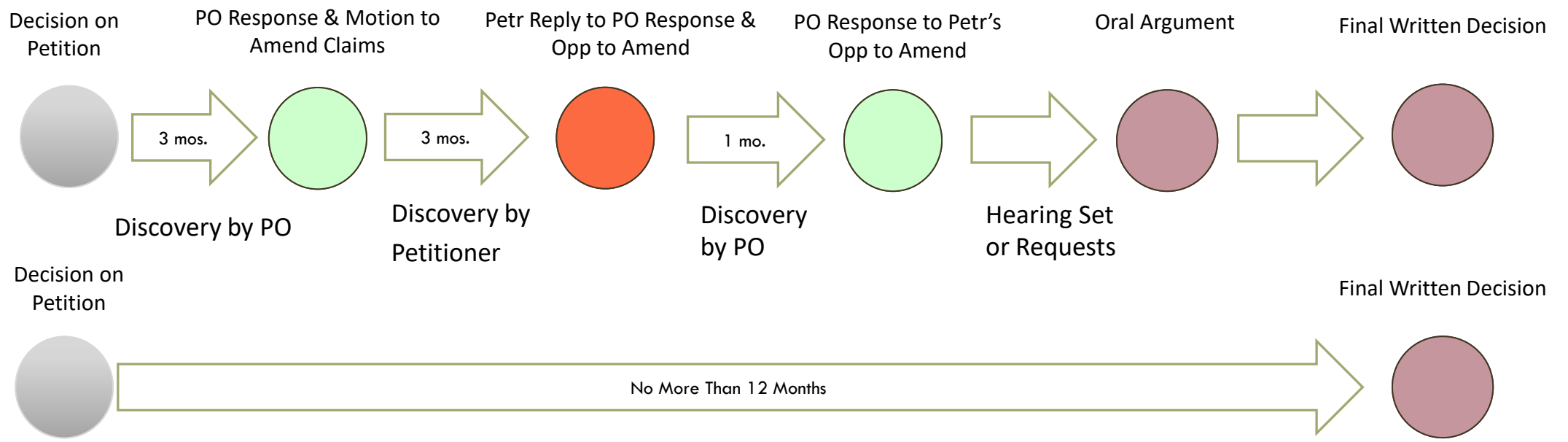
# Agenda

- Overview of Proceedings
- Pre-Institution Proceedings
- Decision on Institution
- Seeking Rehearing of the Decision on Institution
- Post-Institution Proceedings Leading to the Hearing
- Final Written Decision
  - Timing
  - Decision itself

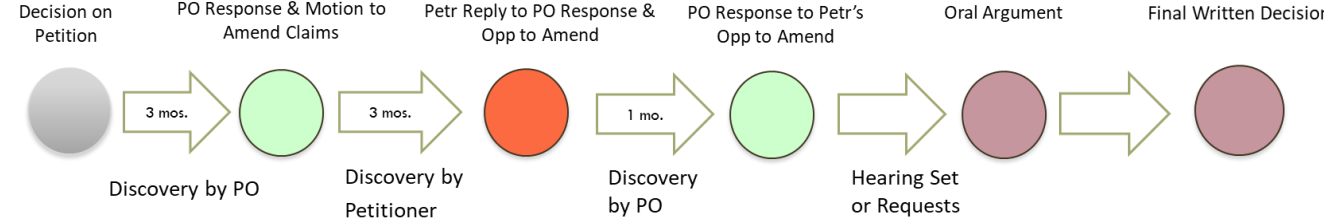


# Final Written Decision: Timing

The PTAB must enter a final written decision no later than one year after instituting trial. The Chief Administrative Patent Judge may extend the one-year period in a case for good cause.



35 U.S.C. §§ 316(a)(11) and 326(a)(11)



# Final Written Decision

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In its final written decision, the PTAB may cancel all or some of the reviewed claims based on the permissible patentability challenges for each type of proceeding. In an IPR, the PTAB may cancel claims as anticipated under 35 U.S.C. § 102 or obvious in view of prior art under 35 U.S.C. § 103 (see, for example, *Illumina Inc. v. Columbia Univ.*, 2014 WL 1252940 (PTAB Mar. 6, 2014) (cancelling claims as obvious and denying the patent owner's motion to amend)).

In PGR and CBM reviews, the PTAB may cancel claims as anticipated or obvious, failing to claim patent eligible subject matter under 35 U.S.C. § 101, or failing to satisfy the enablement or written description requirements of 35 U.S.C. § 112.

PTAB may also choose not to cancel claims.

# Post-Final Written Decision

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Please join the PTAB Committee next month as we look at the appeals and rehearing process which patent owners and petitioners can take after the PTABs final written decision. We will explore what *Arthrex* means for this process at the PTAB and will also discuss Appeals at the Federal Circuit.

We hope to see you there!

# Questions?

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For more information, please contact:

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Christopher Lisiewski  
Devin Garrity  
Thomas Hart, Law Clerk  
**Amster, Rothstein &  
Ebenstein LLP**  
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[cmacedo@arelaw.com](mailto:cmacedo@arelaw.com)  
[clisiewski@arelaw.com](mailto:clisiewski@arelaw.com)  
[dgarrity@arelaw.com](mailto:dgarrity@arelaw.com)  
[thart@arelaw.com](mailto:thart@arelaw.com)

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Jennifer Rea Deneault

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Wharton & Garrison LP**  
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New York, NY 10019  
[jdeneault@paulweiss.com](mailto:jdeneault@paulweiss.com)

[www.paulweiss.com](http://www.paulweiss.com)

# Resources

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## **NYIPLA Events:**

*Insights on Ethics Issues at the USPTO*, PTAB Committee with USPTO, May 4, 2020,  
[https://www.linkedin.com/posts/nyipla\\_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B](https://www.linkedin.com/posts/nyipla_insights-on-ethics-issues-at-the-uspto-activity-6801578149369978880-jW8B)

*Adjusting Your Strategies in Preparing and Responding to Petitions Before the PTAB after SAS Inst. Inc. v. Iancu*, NYIPLA, October 4, 2018, <https://www.nyipla.org/assnfe/ev.asp?ID=1265>

*Discretionary Denials at the PTAB*, PTAB Committee, December 1, 2020  
<https://www.nyipla.org/assnfe/ev.asp?ID=1363>

*Explore PTAB Successes, Outcomes and Results with Docket Navigator*, PTAB Committee with Amy Powell, June 1, 2020, <https://www.nyipla.org/assnfe/ev.asp?ID=1397>

*Update on Latest PTAB Rules and Precedential Decisions*, PTAB Committee, January 5, 2021,  
<https://www.nyipla.org/assnfe/ev.asp?ID=1364>

**PTAB Milestones available at:** <https://arelaw.com/publications/>

# Resources

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## **USPTO Guidance:**

*Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board*, 84 FR 9497 (Mar. 15, 2019)

*PTAB Consolidated Trial Practice Guide November 2019*, USPTO, available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>

*PTAB Practice Guide July 2019 Update*, USPTO, available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>

*Office Patent Trial Practice Guide*; 77 Fed. Reg. 48,756 (Aug. 14, 2012)

*USPTO Notices Regarding COVID-19; Interviews, Oral Hearings and In-Person Meetings*, USPTO (Mar. 13, 2020), <https://www.uspto.gov/coronavirus>

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## **Public Laws:**

Pub. L. 112-29, §18, Sept. 16, 2011, 126 Stat. 329

## **US Code:**

35 U.S.C. §§ 101-103

35 U.S.C. § 112

35 U.S.C. § 311, 14, 16

35 U.S.C. § 321, 24, 26



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## Code of Federal Regulations:

37 C.F.R. § 42.6, .8, .10–11

37 C.F.R. § 42.15

37 C.F.R. § 42.22–25

37 C.F.R. § 42.51 & .53

37 C.F.R. § 42.64

37 C.F.R. § 42.70, .71

37 C.F.R. § 42.102, .104

37 C.F.R. § 42.107, .108

37 C.F.R. § 42.120, .121

37 C.F.R. § 42.204

37 C.F.R. § 42.207, .208

37 C.F.R. § 42.220, .221

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## **Court Decisions:**

*SAS Institute Inc. v. Iancu*, 548 U.S. \_\_\_\_ (2018).

*Thryv, Inc. v. Click-to-Call Technologies, Inc.*, 590 U.S. \_\_\_\_ (2020)

*Cuzzo Speed Technologies, LLC v. Lee*, 579 U.S. \_\_\_\_ (2016)

*Aqua Products v. Matal*, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017, O'Malley, K.)

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## **PTAB Decisions and Papers (1/2):**

*Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019) (Precedential))

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential as of May 5, 2020)

*Becton, Dickinson and Co. v. B. Braun Melsungen AG*, 2017 WL 6405100 (PTAB Dec. 15, 2017)(precedential)

*Carestream Health, Inc. v. Smartplates, LLC*, IPR2013-00600, Paper 8 (PTAB Dec. 26, 2013)

*General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, 2017 WL 3917706 (PTAB Sept. 6, 2017) (Precedential)

*Illumina Inc. v. Columbia Univ.*, 2014 WL 1252940 (PTAB Mar. 6, 2014)

*Macauto U.S.A. v. BOS GmbH & KG*, 2013 WL 5947694 (PTAB Jan. 24, 2013))

*MicroStrategy, Inc. v. Zillow, Inc.*, 2013 WL 6327763 (PTAB Apr. 22, 2013))

*Respironics, Inc., v. Zoll Med. Corp.*, IPR2013-00322, Paper 26, at 3 (PTAB May 7, 2014)

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## **PTAB Decisions and Papers (2/2):**

*Sweegen, Inc. v. Purecircle Sdn Bhd*, PGR2020-00070, Paper 9 at 5 (PTAB September 22, 2020)).

*SweeGen, Inc. v. PureCircle USA, Inc.*, 2021 WL 203202 (PTAB Jan. 19, 2021)

## **Sample Notices and Orders:**

Conduct of the Proceeding (see *Aligent Technologoies Inc. v. Bio-Rad Labs. Inc.*, IPR2019-00271, Paper 20 (PTAB Mar. 13, 2020))

Notice of Filing Date Accorded (see *Askeladden L.L.C. v. Authwallet, LLC*, IPR2021-00005, Paper 3, (PTAB Oct. 26, 2020))

Notice of Defective Petition (see *Unified Patents, LLC v. Dolby Labs. Licensing Corp.*, IPR2021-00275, Paper No. 3 (PTAB Dec. 23, 2020))

Notice of Incomplete Petition (see *Automotive Data Sols., Inc., et al. v. AAMP of Florida, Inc.*, IPR2016-00061, Paper No. 5 (PTAB Oct. 23, 2015))