

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Boardside Chat: Advanced AIA Trial Practice

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July 20, 2023



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Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

About Today's Program

- Today's program is based on the existing rules and procedures that apply to AIA proceedings.
- The information that we share in our programming is intended to be of general applicability. It is not intended to be legal advice.
- The practitioners on our panel today are providing their own opinions and are not speaking on behalf of the Board.



Program format

- Hypothetical
- Client question
- Discussion of relevant law
- Decision

Hypothetical I – Petition

Hypothetical I

- Your client was sued for infringement in district court and served with a complaint.
- Plaintiff must serve preliminary infringement contentions identifying asserted claims and the accused instrumentalities by August 15.

Hypothetical I

- Your team has been diligently preparing an inter parties review (IPR) petition, but they've run into a few snags due the number of claims and issues:
 - 30 claims total
 - 12 means-plus-function claims
 - 3 prior art references
 - Current draft is well over the 14,000 word limit.

Client question #1 – Number of petitions

- Your client, Petitioner, wants to know whether it would be better to file multiple petitions in light of the numerous claims and issues. What advice do you give?
 1. File a **single petition** now challenging all 30 claims in the patent, make creative short cites to eliminate spaces (e.g., Ex1001¶¶30-31), offload some explanations into an expert declaration, and get under the word limit.
 2. File **two petitions** now (18 claims in one and the 12 means-plus-function claims in the other) to stay under the word limit.
 3. **Wait to get the preliminary infringement contentions** next month, see what claims are asserted, and then decide what claims to challenge and issues to raise.

Limitations on petitioning

- **37 C.F.R. § 42.6(a)(3)** – No incorporation by reference of arguments.
- **37 C.F.R. § 42.104(b)** – Detailed identification of grounds, claim constructions, including construction of means-plus-function (MPF) terms, and where each element of the claim is found in the prior art.
- **37 C.F.R. § 42.24(a)(1)(i)** – Limit of 14,000 words/petition, but under 42.24(a)(2), petitioner can seek waiver.
- **Consolidated Trial Practice Guide (Nov. 2019) § II.D.2 (pgs. 55-61)**
 - **Parallel petitions:** “one petition should be sufficient.”
 - **Multiple petitions:** “may place a substantial and unnecessary burden on the Board and the patent owner,” and “are not necessary in the vast majority of cases.”

Client question #1 - Decision

- You advise the client to wait to get the preliminary contentions and see what claims are asserted.

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Hypothetical II – Preliminary Reply to POPR

Hypothetical II

- You filed the petition for your client, Petitioner.
- In its POPR, Patent Owner raises three arguments:
 - Your expert declaration should be disregarded because it largely “parrots” the Petition and is attorney argument.
 - The Petition should be denied based on *Fintiv* because the trial is scheduled for about 2 months before a Final Written Decision.
 - The Petition should be denied on the merits.

Client Question #2 – Should we ask for a Preliminary Reply?

- Your client, Petitioner, is anxious to address some of the additional points Patent Owner has raised in its POPR. What advice do you give?
 1. Don't worry about it. These arguments rarely get traction.
 2. Seek a **10-page Preliminary Reply** to respond point-by-point.
 3. Seek a **5-page Preliminary Reply** focusing specifically on what you could not have foreseen in the Petition.



Rules on POPRs and Preliminary Replies

- **37 C.F.R. § 42.108(c)** – Petitioner may seek leave to file a reply to the POPR; such request must show good cause.
- **37 C.F.R. § 42.23(b)** – Reply may only respond to... patent owner preliminary response; sur-reply may only respond to the reply.
- Potential bases for preliminary replies: 314(a)/*Fintiv*; 325(d); whether reference qualifies as prior art; change in law or PTAB guidance; interim claim construction or other ruling in district court.

Relevant caselaw

- ***Equipmentsshare.com Inc. v. Ahern Rentals, Inc.***, IPR2021-00834 Paper 33, at 18 (PTAB Nov. 10, 2022) (agreeing with Patent Owner that expert testimony that closely mirrors the language in a petition, without more “is not necessarily deficient or entitled to no weight... [W]e evaluate the specific testimony of an expert to determine the amount of weight attributable to that testimony”).
- ***Xerox Corp. v. Bytemark, Inc.***, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential) (determining that an expert declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning).



Client Question #2 - Decision

- You advise the client to seek to file a Preliminary Reply focused on issues that were not foreseeable when the Petition was filed.

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Hypothetical III – New Evidence and Motions to Strike

Hypothetical III

- The Board institutes the IPR based on Petitioner's argument and evidence that a combination of a patent by Fineman and other prior art references would render the claimed subject matter obvious.
- In the PO Response (POR), Patent Owner offers the declaration of Dr. Fineman, the lead inventor of Fineman, who is now retired and living on an alpaca farm in Italy.
- In his declaration, Dr. Fineman addresses the "true meaning" of the teachings in his patent that Petitioner relies upon in its case. Dr. Fineman characterizes the teachings in a manner that would severely damage Petitioner's obviousness case.

New evidence arises

- Petitioner asks Patent Owner to produce Dr. Fineman in the United States to be deposed.
- Patent Owner responds that Dr. Fineman refuses to travel to the United States for deposition because it is spring and he cannot leave his eleven pregnant alpacas.
- Patent Owner states that it does not represent or control Dr. Fineman, who is not a party to the proceedings or employee of Patent Owner.

Client question #3 - Deposition

- Your client, Petitioner, wants to know how to obtain Dr. Fineman's deposition. What advice do you give?
 1. Ask the Board for authorization to file a motion to compel Patent Owner to produce Dr. Fineman for **deposition in the U.S.**
 2. Ask the Board for authorization for a motion to compel Dr. Fineman **to testify in Italy** and offer to travel there to depose him.
 3. Move to **strike** Dr. Fineman's declaration.

37 C.F.R. § 42.51 – General discovery provisions

(1) Routine discovery. Except as the Board may otherwise order:

(ii) Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.

37 C.F.R. § 42.20(b) – Motions generally will not be entered without prior Board authorization.

Compelling testimony – 37 C.F.R. § 42.52

(a) Authorization required. A party seeking to compel testimony or production of documents or things must file a motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:

(1) In the case of testimony, identify the witness by name or title; and

(b) Outside the United States. For testimony or production sought outside the United States, the motion must also:

(1) In the case of testimony.

(i) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the travel expenses of the witness to testify in the United States.

Client question #3 - Decision

- You advise the client to seek authorization from the Board for a motion to compel Patent Owner to produce Dr. Fineman for deposition in the U.S.

Board conference

- The panel suggests the parties cooperate and attempt to depose Dr. Fineman in Italy.
- Efforts to arrange a deposition of Dr. Fineman in Italy devolve when Dr. Fineman asks whether he may bring his eleven pregnant alpacas to the deposition and is told he cannot.
- Dr. Fineman refuses to appear for deposition in any capacity, including by videotape, claiming “My alpacas are my life now and no one important cares about semiconductors anyhow.”

Client question #4 – Motion to strike

- Your client wants to know whether to move to strike Dr. Fineman's declaration given that Petitioner cannot depose him. What do you advise?
 1. No. Reliance on the declaration is **not improper** because the declaration is signed under penalty of perjury.
 2. No. It would be best to **respond on the merits** and allow the panel to assign appropriate weight to Dr. Fineman's evidence.
 3. Yes. A party **must have the opportunity to cross examine** a witness on declaration evidence and the inability to do so is grounds for a motion to strike.

Law on motions to strike declarations

- **Consolidated Trial Practice Guide (Nov. 2019) § II.D.2 (pg. 23)**
 - Routine discovery includes... the cross-examination of the other sides declarants
 - a party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses
- ***John's Lone Star Distrib., Inc. v. Thermolife Int'l, Inc.*, IPR2014-01201, Paper 31 (PTAB May 13, 2015)**
 - Where cross-examination is unavailable, the Board may exercise its authority to strike such a declaration under 37 C.F.R. § 42.12(a), (b)

Client question #4 - Decision

- You advise the client to file the motion to strike Dr. Fineman's declaration because Petitioner did not have an opportunity to depose him despite its best efforts.

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