

PTAB Trial Practice: New Trial Guidance, and Precedential and Informative Decisions

Implications for Discretionary Institution, Discovery, Claim Construction, Joinder, Amendment Practice, and More

THURSDAY, OCTOBER 10, 2019

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

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October 10, 2019



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Overview

- 2019 Update to Trial Practice Guide
 - July 2019 Update is second update (first update in August 2018)
 - July 2019 Update based on Board’s precedential/informative decisions, stakeholder feedback, and evolution of the Board’s practices.
- Evolution of Board’s Practices on Discretionary Institution
 - Difference between §§ 314(a) and 325(d) discretion
 - Multiple Petitions
 - Filed against the same patent by the same petitioner
 - Follow-On
 - Concurrent (“Pile-On”)
 - Filed against the same patent by different petitioners
 - State of co-pending litigation involving the challenged patent
 - Efficiency post-SAS when only a few claims warrant institution
 - Consideration of petitions asserting prior art that was previously considered by the Office

Conference Calls with the Board

- Conference calls are encouraged
- Parties should meet and confer before requesting a conference call
- Avoid excessive argumentation in email to Board
- A party requesting a court reporter should notify the Board and file transcript as an exhibit
- Board has discretion to schedule a call even if a party refuses to participate and may order a recording and entry of the recording into the record

Revised Claim Construction Standard

- Switch to *Phillips* claim construction standard
 - Memorializes rule change for petitions filed after Nov. 13, 2018. The Board applies the same constructions standard used by district courts and the ITC (i.e., *Phillips*) in all AIA trial proceedings.
 - “Each party bears the burden of providing sufficient support for any construction advanced by that party.”
 - Point out specific portions of the specification, prosecution history, and relevant extrinsic evidence to be considered, and explain the relevance of any such evidence to the arguments advanced.
- Consideration of prior constructions
 - Parties should submit prior claim constructions (from other Board decisions, district court or ITC) as soon as they become available, preferably in petition, POPR, response, or reply.
 - Parties can request authorization for motion to submit supplemental information (37 C.F.R. 42.123).
 - Submission of prior construction determination is mandatory under 37 C.F.R. 42.51(b) if it is “relevant information that is inconsistent with a party advanced by the party during the proceeding.”

Guidance on Claim Construction Requirements

- Petitioner must provide an express construction if a construction is believed to be required
 - Patent owner may propose additional constructions in POPR.
 - Petitioner may respond to new claim construction issues raised by the patent owner, but cannot raise new claim construction issues that were not previously raised in its petition.
 - If the Board raises a construction issue on its own, the parties will be afforded an opportunity to respond before a final written decision is issued.

- Means-plus-function terms
 - Petitioner must construe terms (identify structure and function) pursuant to 37 C.F.R. 42.104(b)(3).
 - A party may choose to elaborate why § 112(f)/112 ¶6 should or should not apply.

Testimonial Evidence with Preliminary Response

- Testimonial evidence in POPR may create a genuine issue of material fact
 - A genuine issue of material fact created by “testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute [a review].” 37 C.F.R. §§ 42.108(c), 42.208(c).
 - “The mere existence in the record of dueling expert testimony does not necessarily raise a genuine issue of material fact.” *Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016)
 - Appropriate weight given on a case-by-case basis
 - Testimony with POPR may warrant granting a reply to POPR (if good cause is shown)

Testimonial Evidence with POPR (cont'd)

- Party can cross-examine petition or POPR declarant after institution
 - “In general, a party has the opportunity to cross-examine a witness providing declaration testimony submitted by another party, after institution, unless the Board orders otherwise. 37 C.F.R. § 42.51(b)(1)(ii).”
 - If a trial is instituted:
 - A patent owner may choose not to rely on testimony submitted with the preliminary response and the declarant will usually not be subjected to deposition.
 - On the other hand, a declarant continued to be relied on will usually be deposed in the ordinary court of the trial.

Reply to Preliminary Response

- Petitioner may request a reply to a preliminary response but must show good cause under 37 C.F.R. § 42.108(c).
 - “[T]he Board does not expect that such a reply will be granted due to the short time period the Board has to reach a decision on institution.”
 - Examples of situations where replies may be granted:
 - Patent owner presented claim construction or argument that petitioner reasonably could not have anticipated
 - Intervening case law
 - Patent owner questions qualification of asserted reference as a printed publication
 - Real party-in-interest dispute
- If a reply is granted, patent owner may request a sur-reply

Avoid Waiver of Arguments in POPR

- “Once a trial is instituted, the Board may decline to consider arguments set forth in a preliminary response unless they are raised in the patent owner response.”
 - See *In re Nuvasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (explaining that a patent owner waives an issue presented in its preliminary response if it fails to renew the issue in its response after trial is instituted).

Discretionary Institution: §§ 314(a), 316(b), 325(d)

- § 314(a)
 - “The Director *may not* authorize an inter partes review to be instituted unless the Director determines...that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”
- § 316(b)
 - PTAB *may* “consider the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.”
- § 325(d)
 - “In determining whether to institute..., the Director *may* take into account whether, and reject the petition...because, the same or substantially the same prior art or arguments were previously presented to the Office.”

Discretionary Institution

- At institution, the Board considers whether the petitioner met the relevant statutory institution standard.
- The Board also weighs:
 - § 314(a) considerations (e.g., *General Plastic, Valve I, Valve II*)
 - §325(d) considerations (*Becton Dickinson*), i.e., whether the same or substantially the same prior art or arguments were previously presented to the Office
 - § 316(b) considerations, including the “effect...on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.”
- Common scenarios:
 - Multiple petitions challenging the same patent
 - Patentability challenges are also being considered in another proceeding
 - Prior art previously considered

The Board Has Broad Discretion to Institute

- **CAFC:** “[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016).
- **SCOTUS:** “[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016).
- **SCOTUS:** “§ 314(a) invests the Director with discretion on the question [of] *whether* to institute review.” *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1356 (2018).

General Plastic Factors

- (1) whether the same petitioner filed a petition directed to the same claims of the same patent;
- (2) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
- (3) whether at the time of filing of the second petition the petitioner already received the POPR to the first petition or received the Board's institution decision for the first petition;
- (4) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
- (5) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
- (6) the finite resources of the Board; and
- (7) the requirement under § 316(a)(11) to issue a FWD not later than 1 year after the date of institution.

General Plastic Factors Not Exclusive

- Impact of § 316(b):
 - “The Director’s discretion is informed by 35 U.S.C. §§ 316(b) and 326(b), which require the Director to ‘consider the effect...on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.’” Second TPG Update, 9 (August 2018).
- Other considerations include:
 - Multiple petitions challenging the same patent
 - Fairness of the process for all parties
 - Events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC
 - Efficient administration of the Office

Other § 314(a) Decisions

- Denying institution due to prior petition
 - *Medtronic v. NuVasive*, IPR2014-00487, Paper 8 (Sept. 11, 2014) (informative).
 - *Unified Patents v. PersonalWeb*, IPR2014-00702, Paper 13 (July 24, 2014) (informative).
 - *Intelligent Bio-Sys. v. Illumina*, IPR2013-00324, Paper 19 at 5-7 (Nov. 21, 2013) (informative).
 - *ZTE v. ContentGuard*, IPR2013-00454, Paper 12 (Aug. 25, 2013) (informative).

General Plastic Factors Not Exclusive

- *Valve I*
 - Institution denied for a petition filed by co-defendant and licensor of technology of accused products (Valve), after institution denied for earlier petition filed by HTC. HTC's products accused of infringement incorporate Valve's technology.
 - “[A]pplication of the *General Plastic* factors is not limited to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”
 - Board found that Valve used prior art in HTC's petition and Board's denial of institution as a guide to addressing the deficiencies in HTC's petition.
- *Valve I* discussed in 2019 TPG Update
- Director Iancu was on *Valve I* panel

General Plastic Factors Not Exclusive

- *Valve II*
 - Valve previously joined an instituted petition filed by co-defendant HTC.
 - The first *General Plastic* factor applies to Valve because it joined a prior IPR proceeding and is therefore considered to have previously filed a petition directed to the same claims of the same patent.
 - As in *Valve I*, “application of the *General Plastic* factors is not limited to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”
 - Board found that Valve used prior art in HTC’s petition and Board’s denial of institution as a guide to addressing the deficiencies in HTC’s petition.
- Director Iancu was on *Valve II* panel

Example of *Valve Denial*

- *PayPal, Inc. v. IOENGINE, LLC*
 - Ingenico sued for infringement. PayPal is a customer of Ingenico, which has an indemnification agreement with PayPal. Ingenico filed its own petition challenging fewer claims than PayPal’s petition.
 - Separately, Ingenico filed a DJ action seeking a declaration that Ingenico and its customers, including PayPal, do not infringe the patent. Patent owner’s infringement complaint consolidated with Ingenico’s DJ action.
 - Board: the first *General Plastic* factor applies to PayPal. “Ingenico’s supplying products to Petitioner that Patent Owner alleges infringe the [] patent, the indemnification agreement between Petitioner and Ingenico, and the consolidated district court proceedings constitute a sufficiently significant relationship between Ingenico and Petitioner for purposes of applying the *General Plastic* factors.” (citing *Valve I*).
 - Board: non-overlapping claims challenged in PayPal’s petition did not warrant institution. 23 of 28 claims challenged in PayPal’s petition challenged in Ingenico’s petition.

General Plastic Applied to Different Petitioner

- *Shenzhen Silver Star v. iRobot*, IPR2018-00761, Paper 15 (Sept. 5, 2018)
 - Petitioners “similarly situated” because both “served with complaints at substantially the same time” and “likely members of a joint defense group.” Weighed in favor of institution.
 - In ITC investigation, the petitioner identified four of the five references and thus likely knew of the references when 1st petition was filed. Weighed slightly against institution.
 - 2nd petition filed after patent owner's preliminary response to the 1st petition or the Board's decision on whether to institute review in the 1st petition. Weighed strongly against institution.
 - Petitioner knew of four of the five references asserted in the 2nd petition for at least five and a half months before filing of the 2nd petition. Weighed strongly against institution.
 - No explanation for the time elapsed under factor 4. Weighed moderately against institution.
 - The finite resources of the Board was neutral to the analysis.
 - Requirement to finish trial within one year was neutral to the analysis.
- Considering factors as a whole, the Board exercised its discretion not to institute

Impact of Co-Pending Litigation

- *NetApp, Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9 (**Denied**)
 - Petition filed 8 months after NetApp was sued, after motion to stay denied
 - Dell’s earlier petition instituted approx. 11 mos. earlier (joined by two petitions)
 - Institution “would be a significant waste of the Board’s resources” due to forthcoming FWD in Dell IPR and prejudicial to PO, and any FWD “would not issue until well after the scheduled trial date in the NetApp Litigation [in EDTX].”
- *NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 (precedential) (**Denied**)
 - Primarily § 325(d) denial (Examiner previously considered same references)
 - Jury trial scheduled to begin approx. 6 months before any FWD “an additional factor that weighs in favor of denying the Petition under § 314(a).”
 - “[A]dvanced state of a parallel district court proceeding was an additional factor weighing in favor of denying institution” because “the district court proceeding involved the same prior art and arguments, had already construed claim terms, and was set for trial six months before the Board would complete its own proceeding.”

Impact of Co-Pending Litigation (cont'd)

- *Mylan Pharmas. Inc. v. Bayer Intellectual Prop. GmbH*, IPR2018-01143, Paper 13 (Denied)
 - Ground 1 denied under § 325(d)
 - District court trial 4 months after institution and denial of Ground 1 weighed in favor of denying Ground 2 under § 314(a)
- *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00162, Paper 16 (Denied)
 - Extensive overlap of prior art asserted in district court and IPR. District court rejected invalidity contentions, and issued a preliminary injunction and claim construction ruling
 - Given the extensive overlap of prior art and advanced stage of district court trial, “it would be an inefficient use of the Board’s resources to proceed with this *inter partes* review in parallel with the district court case.”
 - District court trial scheduled to begin before FWD would be due
 - Board separately determined that grounds of challenge were “weak and speculative”

Institution Decisions Distinguishing *NHK Spring*

- *Samsung Elecs. Co., Ltd. v. Immersion Corp.*, IPR2018-01499, Paper 11
(Instituted)
 - District court trial scheduled to occur 2 months after institution
 - DI distinguished *NHK* and *Mylan*, noting that it was petitioner's first petition filed before time bar of § 315(b), and first petition against patent
- *Amazon.com, Inc. v. CustomPlay, LLC*, IPR2018-01498, Paper 13 **(Instituted)**
 - District court trial scheduled to occur 6 months after institution
 - Petition filed one day before § 315(b) time bar. PO alleged that timing gave petitioner a tactical advantage in learning PO's litigation positions
 - DI distinguished *NHK* and *Mylan*, explaining that filing of petition within § 315(b) window did not constitute improper conduct or warrant denial of institution
- *Comcast Cable Comms., LLC v. Rovi Guides, Inc.*, IPR2019-00231, Paper 14
(Instituted)
 - Similar invalidity contentions presented in ITC. PO argued affirmance of invalidity contentions in ITC would have preclusive effect
 - DI distinguished *NHK*, noting petitioner challenged all claims of patent in IPR petition, including at least one claim not asserted in the ITC proceeding, and neither the Office nor any other court considered the invalidity contentions before

Parallel Petitions Challenging the Same Patent

- Board: One Chance is All You (Should) Need
 - “[O]ne petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time” (e.g., before first POPR) “may place a substantial and unnecessary burden on the Board and the patent owner and could raise, fairness, timing, and efficiency concerns.”
 - But “there may be circumstances in which more than one petition may be necessary” (e.g., large number of claims asserted in litigation, priority issue) “although this should be rare.”

Parallel Petitions (Cont'd)

- New Ranking Requirement for Multiple Petitions
 - If petitioner files multiple petitions at or near the same time, petitioner should, in petitions or separate 5 page paper filed with petitions, identify:
 - (1) a ranking of the petitions in the order in which petitioner wishes the Board to consider the merits, and
 - (2) a succinct explanation of the differences between the petitions (preferably using a table), why the differences are material, and why the Board should exercise its discretion to institute additional petitions.
- Similarly, patent owner could address discretionary institution factors on multiple petitions in POPRs or separate 5 page paper
- Examples:
 - IPR2019-00224 (instituted); IPR2019-00225 to -00229 (denied)
 - IPR2019-01638 and IPR2019-01639 (five-page paper filed with petitions)
 - IPR2019-01585 and IPR2019-01586 (five-page paper filed with petitions)

Catch-All Grounds Disfavored

- Petitioner must identify grounds with particularity.
35 U.S.C. § 312(a)(3)
- Adaptics’s petition was denied for not complying with particularity requirement.
 - Petition argued that “[i]f Bendel and Sartorius are not anticipatory, the challenged claims are obvious over these references in combination with each other, Williams, Turnage, Abrams, Bordin, Mettler, Digi-Star, Yuyama, and/or Wright.”
 - In denying institution, the Board explained that “the Petition suffers from a lack of particularity that results in voluminous and excessive grounds. Petitioner’s third obviousness ground—the ‘catch-all ground—is the worst offender.”

§ 325(d) Discretionary Institution

- Portion of *Becton Dickinson* made precedential.
- Non-exclusive factors:
 - (1) the similarities and material differences between the asserted art and the prior art involved during examination;
 - (2) the cumulative nature of the asserted art and the prior art evaluated during examination;
 - (3) the extent to which the asserted art was evaluated during examination;
 - (4) the extent of the overlap between the arguments made during examination and the manner in which a petitioner relies on the prior art or a patent owner distinguishes the prior art;
 - (5) whether the petitioner has pointed out sufficiently how the Office erred in evaluating the asserted prior art; and
 - (6) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Other § 325(d) Decisions

- Denying institution due to prior art considered during examination
 - *Kayak Software v. IBM*, CBM2016-00075, Paper 16 (Dec. 15, 2016) (informative).
 - *Cultec v. Stormtech*, IPR2017-00777, Paper 7 (Aug. 22, 2017) (informative).
 - *Hospira v. Genentech*, IPR2017-00739, Paper 16 (July 27, 2017) (informative).
 - *Unified Patents v. Berman*, IPR2016-01571, Paper 10 (Dec. 14, 2016) (informative).
 - *Prism Pharma v. Choongwae*, IPR2014-00315, Paper 14 (July 8, 2014) (informative).

Practice Tips on Discretionary Institution

- Explain why each discretionary institution factor weighs in favor of institution or non-institution.
- Address other factors that may be relevant. For example:
 - Equitable considerations (e.g., similarly situated co-defendant)
 - Relation to other proceedings
 - Conduct of the parties (e.g., patent owner has sued 10 parties)
- **Petitioners:** focus on best grounds; weak grounds may taint the entire petition.
- **Patent owners:** explain why the “efficient administration of the Office” (§ 316(b)) weighs in favor denying institution for prior art or arguments that were previously presented to the Office or are being considered in another forum.
- The Board balances the petitioner’s desire to be heard against the interest of the patent owner in avoiding duplicative challenges to its patent.

Practice Tips on Discretionary Institution

- To avoid denial of follow-on petition, the TPG Update states:
 - [P]arties may wish to address in their submissions whether any other such reasons exist in their case that may give rise to additional factors that may bear on the Board's discretionary decision to institute or not institute, and whether and how such factors should be considered along with the *General Plastic* factors.
- Petitioners failing to proactively address each *General Plastic* factor may not have a chance to address them before institution decision and after patent owner's preliminary response.

Practice Tips on Discretionary Institution

- Do not characterize second petition as correcting a deficiency in first petition, to avoid assertions of harassment. *Butamax v. Gevo*, IPR2014-00581, Paper 8 (Oct. 14, 2014).
- Consider providing search strategy/results used in first petition and explaining why art was omitted. *Butamax v. Gevo*; *but see Square v. Unwired Planet*, CBM2015-00148, Paper 14 (Dec. 28, 2015) (three search firms overlooked reference).
- Overcome “[r]easonable inference that new prior art references raised in second petition . . . were known to [petitioner] when it filed first petition.” *Conopco v. Unilever*, IPR2014-00628, Paper 23 (Mar. 20, 2015).
- Beware of estoppel if first petition results in FWD before conclusion of second case. *Dell v. ETRI*, IPR2015-00549, Paper 10 (Mar. 26, 2015).

Discretion to Institute and *SAS*

- The Board will either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution. *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).
- The Board generally will provide analysis of the strengths and weaknesses of all challenges in the petition in order to provide guidance to the parties for the upcoming trial.

Efficiency-Based Denials Post-SAS

- “The Board retains the discretion to deny institution of the petition as a whole under 35 U.S.C. §§ 314(a) and 325(d) under appropriate circumstances, even when the petition includes at least one claim subject to a challenge that otherwise meets the criteria for institution.”
 - *Chevron Oronite Co. LLC v. Infineum USA L.P.*, Case IPR2018-00923, Paper 9 (Nov. 7, 2018) (informative) (a reasonable likelihood of prevailing with respect to two dependent claims out of a total of twenty challenged of claims not sufficient)
 - *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310, Paper 7 (Jan. 24, 2019) (informative) (a reasonable likelihood of prevailing with respect to only two of twenty-three challenged claims as to only one of four asserted grounds of unpatentability not sufficient)

Efficiency-Based Denials Post-SAS (cont'd)

- *Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-00843, Paper 7 (Oct. 1, 2019)
 - The Board’s Trial Practice Guide “explains that the Board may consider the number of claims and grounds that meet the reasonable likelihood standard when deciding whether to institute.”
 - Here, petitioner challenged 5 independent claims but the Board determined that petitioner showed a reasonable likelihood of prevailing on only one claim (claim 5).
 - “On this record and based on the particular facts of this proceeding, instituting a trial with respect to all five claims based on evidence and arguments directed to claim 5 alone would not be an efficient use of the Board’s time and resources.”

Motion for Joinder

- A party may seek to join a first proceeding by filing a motion for joinder (with petition) within one month of the date of institution of a trial in the first proceeding. 37 C.F.R. 42.122.
- Factors the Board considers in determining whether joinder is appropriate:
 - Whether a new ground of unpatentability is raised in the second petition;
 - How the cost and schedule of the first proceeding will be impacted if joinder is granted; and
 - Whether granting joinder will add to the complexity of the briefing and/or discovery.

IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)
- The Board has the discretion to permit issue joinder (new challenges and/or arguments joined to first petition)
 - *Proppant Express Invs. v. Oren Techs.*, IPR2018-00914, Paper 38 (PTAB Mar. 13, 2019) (precedential)
- One-year time period for issuing FWD may be extended if joinder is granted

Motions to Amend

- “The burden of persuasion ordinarily will lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence.”
 - TPG Update at 34. See *Lectrosonics v. Zaxcom*, IPR2018-01129, Paper 15 (Feb. 25, 2019) (precedential) (citing *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)).
- On March 15, 2019, the Office issued a notice of a pilot program for motion to amend (MTA) practice and procedures that provides the patent owner with additional options regarding the MTA process. These options include (1) requesting preliminary guidance from the Board in its first MTA, and (2) filing a revised MTA.
- For claims in a MTA, the Board may also consider other grounds of invalidity such as § 101 and § 112.
 - *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (Jan. 18, 2019) (precedential).

Additional Discovery

- Satisfy *Garmin* Factors
 1. More than a possibility and mere allegation—the party requesting discovery should already be in the possession of evidence or reasoning tending to show beyond speculation that in fact something useful will be discovered
 2. Cannot ask for other party’s litigation positions or the underlying basis for those positions
 3. Ability to generate equivalent information by other means
 4. Easily understandable instructions
 5. Requests not overly burdensome to answer
- Requested discovery must be narrowly focused and have an impact on trial
- “Interests of justice” standard applies in IPRs (37 CFR 42.51(b)(2), while more liberal “good cause” standard applies in PGRs and CBMs (37 CFR 42.224)
- July 2019 TPG Update identifies RPI and secondary considerations as two areas where additional discovery is often sought

Protective Orders

- Protective order (whether standard or modified) is not automatically entered. Protective order must be proposed by at least one of the parties. The parties may propose that a protective order entered by a district court in concurrent litigation be adopted by the Board.
- Good cause must be shown
- If the motion for a protective order is not granted, the party submitting the confidential information will have an opportunity to have the confidential information expunged

Rehearing Requests

- A party dissatisfied with a decision of the Board may file a request for rehearing. 37 C.F.R. § 42.71.
 - “The rehearing request must specifically identify all matters the party believes the Board misapprehended or overlooked, and where each matter was previously addressed in a motion, an opposition, or a reply.”
 - Rehearing requests are not a vehicle to disagree with the Board’s reasoning. Rather, a party must sufficiently show that the Board misapprehended or overlooked an argument, testimony and/or teaching of reference.
- A party seeking to admit new evidence with a rehearing request should request a conference call with the Board prior to filing its request so that it can show “good cause” for admitting the new evidence.
- Board envisions deciding rehearing requests within one month of filing.

Remands

- Standard Operating Procedure 9 establishes default procedures
- Goal is to issue remand decision within 6 months from mandate
- Before a conference call with the Board, the parties are required to meet and confer with opposing counsel to reach an agreement regarding additional briefing, evidence, oral argument

Questions?

Thank you!

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