

PTAB Discovery and Motions Practice Made Perfect

Kevin McNish

McNish PLLC

Presenter

Kevin McNish

McNish PLLC

Portland, Maine

www.mcnishpllc.com



McNish PLLC is a cloud-based law firm for IPRs, PGRs, *ex parte* reexams, and Federal Circuit appeals.

What We'll Cover Today

- Basics
- Discovery Motions
- Motions Addressing Papers and Exhibits
- Motions Addressing Related Patent Office Proceedings
- Miscellaneous Motions
- Appellate Review

Basics

Why file a motion?

- “*Relief*. Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion.”

37 C.F.R. § 42.20(a).

- “Relief” is anything that you want to do (or that you want the Board to do for you) that you’re not already entitled to do (or to have the Board do for you).

The authorization requirement.

- “*Prior authorization. A motion will not be entered without Board authorization.*

Authorization may be provided in an order of general applicability or during the proceeding.”

37 C.F.R. § 42.20(b).

- Obtaining authorization is a multi-step process, so start that process as soon as the need for relief is identified.

37 C.F.R. § 42.25(b).

Obtaining authorization for a motion.

1. Meet and confer with opposing counsel.
2. *Email trials@uspto.gov to request a conference call.*
3. *Retain a court reporter for the conference call and notify opposing counsel.*
4. *Discuss your motion with the panel on the conference call.*
5. *If authorized, file your motion.*

- For any motion that requires authorization, the Board expects the parties to meet and confer before the movant requests authorization.

E.g., Activision Blizzard, Inc. v. Acceleration Bay, LLC, Case IPR2015-01951, Paper 22 (PTAB June 17, 2016).

- The Board requires parties to meet and confer before filing discovery motions.

Consolidated Trial Practice Guide (November 2019) at 92.

- Find out when opposing counsel is available for a conference call with the Board.

Obtaining authorization for a motion.

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2. Email trials@uspto.gov to request a conference call.

3. *Retain a court reporter for the conference call and notify opposing counsel.*

4. *Discuss your motion with the panel on the conference call.*

5. *If authorized, file your motion.*

- Provide a **non-argumentative** and succinct description of the relief sought—or else.

E.g., Kingston Tech. Co. v. CATR Co., Ltd.,
Case IPR2015-00149, Paper 22, at 2 (PTAB June 5, 2015).

- Provide a list of times when both parties are available for a conference call.
- State whether the other side opposes the relief sought.
- If the other side opposes the relief sought, certify that an in-person or telephonic meet and confer has occurred, or explain why no meet and confer occurred.
- Cc: all parties to the proceeding.

37 C.F.R. § 42.5(d).

Obtaining authorization for a motion.

1. *Meet and confer with opposing counsel.*
2. *Email trials@uspto.gov to request a conference call.*
3. Retain a court reporter for the conference call and notify opposing counsel.
4. *Discuss your motion with the panel on the conference call.*
5. *If authorized, file your motion.*

- The Board sometimes makes oral rulings on the conference call without entering a separate written order.
- The transcript may be the only record of your efforts to obtain relief.

Obtaining authorization for a motion.

1. *Meet and confer with opposing counsel.*
2. *Email trials@uspto.gov to request a conference call.*
3. *Retain a court reporter for the conference call and notify opposing counsel.*
4. Discuss your motion with the panel on the conference call.
5. *If authorized, file your motion.*

- Dial in 5 to 10 minutes early to confirm your court reporter is there.
- Be prepared to argue not only why the Board should authorize your motion, but also why you should win.

Obtaining authorization for a motion.

1. *Meet and confer with opposing counsel.*
2. *Email trials@uspto.gov to request a conference call.*
3. *Retain a court reporter for the conference call and notify opposing counsel.*
4. *Discuss your motion with the panel on the conference call.*
5. If authorized, file your motion.

- Upon authorizing a motion, the Board will set a briefing schedule.

37 C.F.R. § 42.25(a).

- If the Board denies authorization, the movant can seek review by:
 - Requesting rehearing;
or
 - Raising the issue during a subsequent appeal.

37 C.F.R. § 42.71; 37 C.F.R. § 42.73.

Motions that don't require prior authorization.

- Motions filed concurrently with the petition.
 - Motions to waive word count or page limits.
 - Motions for joinder.

Consolidated Trial Practice Guide (November 2019) at 37.

- Motions to seal.
 - Still must confer with opposing counsel.

37 C.F.R. § 42.54(a).

- Motions to exclude evidence.

37 C.F.R. § 42.64(c).

- Motions for *pro hac vice* admission.
 - Conferring with opposing counsel is recommended.

37 C.F.R. § 42.10(c).

- Motions for additional discovery (?)
 - Still must confer with opposing counsel.

37 C.F.R. § 42.51(b)(2)(i);

VirnetX Inc. v. Mangrove Partners Master Fund, Ltd., No. 2017-1368, slip op. (Fed. Cir. July 8, 2019) (non-precedential).

Components of a motion.

- Generally, each distinct request for relief requires its own motion (*i.e.*, no omnibus motions).

See 37 C.F.R. § 42.22(a).

- A motion must include:
 - A statement of the precise relief requested; and
 - A full statement of the reasons for relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing laws, rules, and precedent.

Id.

- A motion may include a statement of material facts in numbered paragraphs with citations to the record.

37 C.F.R. § 42.22(c).

- Motions and oppositions are limited to 15 pages; replies are limited to 5 pages.

37 C.F.R. § 42.24(a)(1)(v); 37 C.F.R. § 42.24(b)(3); 37 C.F.R. § 42.24(c)(2).

Discovery Motions

Routine Discovery

Additional Discovery

Application for a District Court Subpoena

Patent Trial and Appeal Board discovery.

- Limited by design.

37 C.F.R. § 42.51(b); *see also* 37 C.F.R. § 42.1(b) ("just, speedy, and inexpensive resolution of every proceeding").

- Two principal flavors of discovery:

- Routine discovery.

37 C.F.R. § 42.51(b)(1).

- Additional discovery.

37 C.F.R. § 42.51(b)(2).

- Unless the parties agree otherwise, all discovery other than routine discovery requires a motion.

37 C.F.R. § 42.51(a)(1); 37 C.F.R. § 42.51(b)(2)(i).

Routine discovery.

- Any exhibit cited in a paper or in testimony, unless previously served.

37 C.F.R. § 42.51(b)(1)(i).

- “Cross examination of affidavit testimony prepared for the proceeding.”

37 C.F.R. § 42.51(b)(1)(ii).

- Does not include testimony prepared for prosecution.

E.g., Eli Lilly & Co. v. Trustees Univ. Penn., Case IPR2016-00458, Paper 53, at 2-4 (PTAB Dec. 16, 2016).

- Does not include testimony prepared for litigation.

E.g., Medtronic, Inc. v. Teleflex Innovations S.A.R.L., Case IPR2020-00126, Paper 77 (PTAB Dec. 8, 2020).

- “[R]elevant information that is inconsistent with a position advanced by the party during the proceeding.”

37 C.F.R. § 42.51(b)(1)(iii); *see also* 37 C.F.R. § 42.11(a) (duty of candor and good faith to the Office).

Additional discovery.

- In *inter partes* reviews, additional discovery is only available in the “interests of justice.”

35 U.S.C. § 316(a)(5)(B); 37 C.F.R. § 42.51(b)(2)(i).

- In post-grant reviews, additional discovery is available for “good cause,” but limited to “evidence directly related to factual assertions advanced by either party in the proceeding.”

35 U.S.C. § 326(a)(5)(B); 37 C.F.R. § 42.51(b)(2)(i); 37 C.F.R. § 42.224(b).

- The standards have largely converged.

Consolidated Trial Practice Guide (November 2019) at 25.

Five factor test for additional discovery.

- More than a possibility and mere allegation.
- Litigation positions and underlying basis.
- Ability to generate equivalent information by other means.
- Easily understandable instructions.
- Requests not overly burdensome to answer.

Garmin Int'l, Inc. v. Cuozzo Speed Techs., LLC, Case IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (designated precedential);

Bloomberg Inc. v. Markets-Alert Pty Ltd., Case CBM2013-00005, Paper 32 (PTAB May 29, 2013) (designated precedential);

Consolidated Trial Practice Guide (November 2019) at 25-28 (discussing example PTAB decisions addressing the factors).

Application for a district court subpoena.

- A party in a PTAB proceeding can move for permission to subpoena a third party.

35 U.S.C. § 24; 37 C.F.R. § 42.52(a).

- Because discovery via subpoena is “additional discovery,” the *Garmin / Bloomberg* factors apply.

E.g., Google LLC v. IPA Techs., Inc., Case IPR2019-00730, Paper 34 (PTAB Dec. 6, 2019);

Canon Inc. v. Avigilon Fortress Corp., Case IPR2019-00311, Paper 24 (PTAB Sept. 6, 2019).

- Typical use case: author or librarian depositions addressing the public accessibility of a non-patent reference.

Discovery motions – practice tips.

- Exhaust all other sources first.
- For your discovery requests:
 - Start with the end in mind.
 - Keep the requests simple, short, and few.
- For the motion itself:
 - Show that “where there’s smoke, there’s fire.”
 - Stick to the facts.

Do you actually need to move for discovery?

- Is the evidence you need publicly available?
 - Public PAIR (prosecution documents)
 - PACER (litigation documents)
 - EDGAR (SEC filings)
- Can a friendly witness (willing to sit for a deposition) get that evidence for you?
- Can you get (or do you already have) the evidence you need from discovery in co-pending litigation?

Litigation materials and protective orders.

- District court protective orders almost always ban the use of confidential or AEO materials outside of the litigation.
- Using confidential or AEO materials at the PTAB without clearance can result in sanctions.

E.g., LunarEye, Inc. v. Gordon Howard Assocs., Inc., 78 F.Supp.3d 671 (E.D. Tex. 2015)
(\$2,500 sanction for discussing protected materials during unrecorded PTAB conference call).

- Get permission from the producing party to use those materials at the PTAB, or move the district court for relief from the protective order.

E.g., GeigTech East Bay LLC v. Lutron Elec. Co., No. 1:18-cv-05290, ECF No. 135 (S.D.N.Y. Oct. 20, 2020)
("I am perfectly happy to allow documents produced pursuant to a protective order in this case to be used at the PTAB. In fact, I encourage it.").

Motions Addressing Papers and Exhibits

Motion to Submit Supplemental Information

Motion to Exclude

Motion to Strike

Motion to Seal

Motion to Expunge

Motion to submit supplemental information.

- Supplemental information is evidence other than that submitted with a principal brief that relates to some issue in the proceeding.
- To submit supplemental information:
 - A party must request authorization for a motion to submit supplemental information within a month of the decision to institute trial; and
 - The supplemental information must be relevant to a claim for which trial has been instituted.

37 C.F.R. § 42.123(a); 37 C.F.R. § 42.223(a).

- Requests made more than a month after institution, or requests to submit information not relevant to an instituted claim, require the movant to demonstrate:
 - The supplemental information could not have been obtained earlier; and
 - Consideration of the supplemental information would be in the interests of justice.

37 C.F.R. § 42.123(b)-(c); 37 C.F.R. § 42.223(b)-(c).

Supplemental information – practice tips.

- Even if the timing and content requirements are met, the PTAB still has discretion to deny motions to submit supplemental information.

Redline Detection, LLC v. Star Envirotech, Inc., 811 F.3d 435, 446-47 (Fed. Cir. 2015).

- If you have a principal brief available and you can submit evidence as of right with that brief (e.g., patent owner response or petitioner's reply), you can often skip the supplemental information process.
- Supplemental information addresses the sufficiency or weight of the evidence; supplemental evidence is used to show that other evidence is admissible.

37 C.F.R. § 42.64(b)(2); *Valeo N. Am., Inc. v. Magna Elec., Inc.*, Case IPR2014-01203, Paper 15 (PTAB Mar. 4, 2015).

Motion to exclude - objections.

- The Federal Rules of Evidence (nominally) govern PTAB proceedings.

37 C.F.R. § 42.62(a).

- If a party serves potentially objectionable evidence, the other party generally has five business days after service to file and serve objections on the proponent.
 - Exception: the opposing party has ten business days after the institution decision for evidence submitted in the preliminary phase.

37 C.F.R. § 42.64(b)(1).

- The proponent then has ten business days to serve (but NOT file) supplemental evidence addressing the evidentiary objection.

37 C.F.R. § 42.64(b)(2).

Motion to exclude - briefing.

- The opening motion to exclude is due on Due Date 4.

Consolidated Trial Practice Guide (November 2019) at 95.

- A party can only move to exclude evidence based on timely served objections.

37 C.F.R. § 42.64(c).

- The motion to exclude should identify objections in the record in order; identify where the proponent relied on the evidence to be excluded; address objections to exhibits in numerical order; and explain the objections.

Id.; Consolidated Trial Practice Guide (November 2019) at 78.

- A party opposing a motion to exclude must file any supplemental evidence it intends to raise with its opposition brief (to the extent not already of record).

Consolidated Trial Practice Guide (November 2019) at 78.

Motion to strike.

- A party may seek authorization to file a motion to strike where a reply or sur-reply:
 - Raises new issues;
 - Is accompanied by belatedly presented evidence; or
 - Otherwise exceeds the proper scope of reply or sur-reply.

Consolidated Trial Practice Guide (November 2019) at 80.

- “Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission.”

Id. at 81.

- The PTAB only rarely strikes briefs or portions of briefs: the infraction must be so clear or the prejudice so severe that striking is the only real remedy.

Id. at 80-81.

Motion to seal.

- A motion to seal must be filed concurrently with the information that a party seeks to seal.

37 C.F.R. § 42.14.

- Filing a motion to seal doesn't require prior authorization, but the parties must first meet and confer to agree on a protective order.

37 C.F.R. § 42.54(a).

- The first motion to seal filed in a proceeding must be accompanied by a protective order, preferably the Trial Practice Guide's Default Protective Order. Modifications require good cause and a redline.

Id.; Consolidated Trial Practice Guide (November 2019) at 19-20.

Motion to seal – practice tips.

- For each item to be sealed, the movant must show:
 - (1) The information sought to be sealed is truly confidential;
 - (2) A concrete harm would result upon public disclosure;
 - (3) There exists a genuine need to rely in the trial on the specific information sought to be sealed; and
 - (4) On balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum Pharm. LLC v. Alcon Research, Ltd., Case IPR2017-01053, Paper 27 (PTAB Jan. 19, 2018)
(designated informative).

- Concurrently public redacted versions of documents to be sealed is usually necessary; provide a non-confidential summary of the redacted material in the motion to seal.
- Panels can vary on how to approach a motion to seal by a party submitting the other party's confidential information. When in doubt, confer with opposing counsel and request guidance from the panel.

Motion to expunge.

- Confidential information subject to a protective order ordinarily becomes public 45 days after either (1) denial of a petition to institute a trial or (2) final judgment in a trial.

Consolidated Trial Practice Guide (November 2019) at 21-22.

- After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.

37 C.F.R. § 42.56.

- The PTAB expects that information discussed in an institution decision or FWD will become public.

Consolidated Trial Practice Guide (November 2019) at 22;

Argentum Pharm. LLC v. Alcon Research, Ltd., Case IPR2017-01053, Paper 27 (PTAB Jan. 19, 2018)
(designated informative).

Motions Addressing Related Patent Office Proceedings

Motion for Joinder

Motion to Take Jurisdiction Over Related
Proceeding

Motion to Cede Jurisdiction

Motion for joinder.

- A party may join an instituted proceeding (or a proceeding to be instituted) by filing its own IPR or PGR petition and a motion for joinder.

35 U.S.C. § 315(c); 35 U.S.C. § 325(c); 37 C.F.R. § 42.122(b); 37 C.F.R. § 42.222(b).

- The motion for joinder must be filed no later than one month after the decision to institute.

37 C.F.R. § 42.122(b); 37 C.F.R. § 42.222(b).

- For IPRs, the joinder petition must be substantively identical to the instituted petition.
 - No newly challenged claims
 - No new unpatentability grounds or arguments

Facebook, Inc. v. Windy City Innovations, LLC, 973 F.3d 1321, 1333 (Fed. Cir. 2020).

Motion for joinder – practice tips.

- Be prepared to accept an “understudy” role in the instituted proceeding.
- The discretionary factors bearing on institution still apply.

Apple Inc. v. Uniloc 2017 LLC, Case IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (designated precedential) (applying *General Plastic* factors to deny joinder).

- Your motion for joinder has up to 15 pages; use them wisely.

37 C.F.R. § 42.24(a)(1)(v).

Motion to take jurisdiction over related proceeding.

- “The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order.”

37 C.F.R. § 42.3(a); *see also* 37 C.F.R. § 42.122(a) (providing for stay, transfer, consolidation, or termination of additional matters involving the patent); 37 C.F.R. § 42.222(a) (same).

- The PTAB's exclusive jurisdiction over the “involved” patent or application does not extend to related applications or patents.

- “Typical” use cases:

- Petitioner: staying an *ex parte* reexam or reissue application

E.g., Acrux DDS Pty Ltd. v. Kaken Pharm. Co., Ltd., Case IPR2017-00190, Paper 31 (PTAB Aug. 31, 2017 (staying reissue)).

- Patent Owner: terminating an *ex parte* reexam

Ariosa Diagnostics, Inc. v. Illumina, Inc., Case IPR2014-01093, Paper 81, at 9 (PTAB May 24, 2016) (terminating *ex parte* reexaminations requested shortly before the IPR's final written decision).

Motion to cede jurisdiction.

- “The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order.”

37 C.F.R. § 42.3(a).

- But, a patent owner can seek a certificate of correction by moving the PTAB to cede its exclusive jurisdiction.

Honeywell Int'l Inc. v. Arkema Inc., 939 F.3d 1345 (Fed. Cir. 2019).

- The patent owner must:
 - (1) obtain authorization to file a motion;
 - (2) move the Board to cede jurisdiction
 - (3) petition the Director for a certificate of correction.

NXP USA, Inc. v. Impinj, Inc., Case IPR2020-00552, Paper 12, at 4 (PTAB July 21, 2020) (citing *Honeywell*, 939 F.3d at 1349).

Miscellaneous Motions

Motion for *Pro Hac Vice* Admission

Motion for Sanctions

Motion to Settle / Terminate

Miscellaneous Relief

Motion for *pro hac vice* admission.

- By motion, an attorney without a USPTO reg number can appear *pro hac vice* in a PTAB proceeding.

37 C.F.R. § 42.10(c)

- Requirements:

- Lead counsel must be a registered practitioner.

Id.

- The attorney seeking *pro hac vice* admission must submit an affidavit demonstrating good cause for admission and agreeing to submit to the USPTO's disciplinary authority.

Unified Patents, Inc. v. Parallel Iron, LLC, Case IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013).

- A \$250 fee.

37 C.F.R. § 42.15(e).

- Practice tips:

- Meet and confer with opposing counsel before filing.
- Timing matters.

Motion for sanctions.

- 37 C.F.R. § 42.11
 - Analogous to Fed. R. Civ. P. 11
 - Addresses signed written submissions filed in a proceeding
 - Includes a 21-day safe harbor
- 37 C.F.R. § 42.12
 - Not limited to signed written submissions
 - Covers more forms of misconduct

Motion to settle / terminate.

- To settle a proceeding, the parties must file a joint motion to terminate.

37 C.F.R. § 42.72; 37 C.F.R. § 42.74(a).

- The parties must file any settlement agreement and any collateral agreements as exhibits.

35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b); *see also*

DTN, LLC v. Farms Tech., LLC, Case IPR2018-01412, Paper 21 (PTAB June 14, 2019) (designated precedential).

- The parties should concurrently file a separate joint motion to keep the settlement agreement and collateral agreements confidential.

37 C.F.R. § 42.74(c).

Miscellaneous relief.

- “The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.”

37 C.F.R. § 42.5(a).

- If you want it, ask for it.

Appellate Review

Preserving the Issue
Standard of Review

Preserving the issue.

- If the Board denies authorization, seeking authorization is usually enough to preserve the underlying issue for appeal.

VirnetX Inc. v. Mangrove Partners Master Fund, Ltd., No. 2017-1368, slip op. (Fed. Cir. July 8, 2019) (non-precedential);
see also *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1342 (tribunal must be "fairly put on notice as to the substance of the issue");
cf. *Belden Inc. v. Berk-Tek LLC*, 806 F.3d 1064, 1081 (Fed. Cir. 2015) ("concrete, focused requests" needed to preserve issues).

- Filing a motion or opposition that raises and supports your position is generally sufficient to preserve the underlying issue for appeal.

Nike, 812 F.3d 1342.

- Requesting rehearing is usually not necessary to preserve an issue.

See *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1377 (Fed. Cir. 2016)
("Nowhere does the statute granting parties the right to appeal a final written decision in an [inter partes review] require that the party first file a request for rehearing before the Board . . .").

- Address the Board's decision in your notice of appeal, docketing statement, and your opening brief.

37 C.F.R. § 90.2(a)(3)(ii) (notice of appeal); Fed. Cir. Form 26 (docketing statement);
Becton Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 800 (Fed. Cir. 1990)
("[A]n issue not raised by an appellant in its opening brief . . . is waived.").

Standard of review.

- Motions related to the PTAB's management of a proceeding are reviewed for abuse of discretion.

E.g., Redline Detection, LLC v. Star Envirotech, Inc., 811 F.3d 435, 442 (Fed. Cir. 2015)
("We review the PTAB's decision of how it manages its permissive rules of trial proceedings for an abuse of discretion.")

- Evidentiary rulings are also reviewed for abuse of discretion.

Belden v. Berk-Tek, LLC, 805 F.3d 1064, 1078 (Fed. Cir. 2015).

- "An abuse of discretion occurs if the decision:
 - (1) is clearly unreasonable, arbitrary, or fanciful;
 - (2) is based on an erroneous conclusion of law;
 - (3) rests on clearly erroneous fact findings; or
 - (4) involves a record that contains no evidence on which the Board could rationally base its decision."

Redline Detection, 811 F.3d at 442.

Thank You!

Tell me about other topics that interest you!

kmcnish@mcnishpllc.com