

DETAILED TABLE OF CONTENTS

Preface to the Second Edition	v
Preface to the First Edition.....	vii
About the Contributors.....	ix
Summary Table of Contents.....	xi
CHAPTER 1. INTRODUCTION	1
I. The PTAB	1
II. Organization of This Book	10
CHAPTER 2. GENERAL PREFILING CONSIDERATIONS	11
I. IPRs	14
A. Potential Limits on Number of IPRs.....	17
II. Post-Grant Reviews	17
A. Overview of PGRs.....	17
III. Covered Business Method Patent Reviews	19
A. Definition of “Covered Business Method”	22
B. Definition of “Financial Product or Service”	24
C. Definition of “Technological Invention”	26
D. “Sued” or “Charged With Infringement”	28
E. Burden of Proof.....	28
IV. Summary Table of IPRs, PGRs, and CBMs	29
V. Derivation Proceedings.....	29
VI. Claim Construction.....	31
VII. Parties	38
VIII. Timing and the Expected Duration of Reviews.....	38
A. Timing of an IPR	39
B. Timing of PGR	41
C. Timing of a CBM	42
IX. Mandatory Notice Requirements.....	42

X. District Court Complaints, Counterclaims, Dismissals, Declaratory Judgments and Their Ramifications on Timing	43
A. Counterclaims and Defenses	45
B. Declaratory Judgments.....	46
XI. Estoppel	47
XII. Consolidation.....	51
XIII. Settlement.....	52
XIV. Fees.....	53
A. IPR Fees	54
B. PGR and CBM Fees	55
C. Derivation Fees.....	55
 CHAPTER 3. GENERAL PROCEDURE	57
I. Counsel.....	59
II. Appearance and Designation of Counsel	61
A. <i>Pro Hac Vice</i> Motions	63
B. Changing Counsel	66
C. Disqualification of Counsel.....	67
D. Counsel at Oral Hearings	67
E. Withdrawal of Counsel.....	67
III. The Bench and Administrative Patent Judges	68
A. How to Contact the Board.....	70
B. Timing of a Request for a Board Hearing	71
C. Contents of a Request for a Board Hearing.....	71
D. Ex Parte Communications.....	72
E. Requesting Rehearing and Precedential Decisions	73
F. Managing the Record: Expunging and Vacating	75
IV. Format of Filings	75
V. Citations.....	77
VI. How to File	78
VII. Disclosure of Related PTO Proceedings	80
A. Service of Counsel	83
B. Certificates of Service	84
C. Service of Demonstrative Exhibits.....	84
VIII. Protective Orders	85
A. Standard Protective Order	87
B. Non-Standard Protective Order.....	87

C. Relationship to a Related District Court Protective Order	88
D. Protective Orders in Joined Proceedings.....	89
E. Expunging Confidential Information After Conclusion.....	89
IX. Evidence and Burdens	91
A. The Patent(s) at Issue and Filewrappers.....	91
B. Foreign Documents, Evidence, and Translations	92
C. Demonstratives.....	92
D. Experts.....	94
X. Use of Test Data and Experts	97
XI. Unavailable Expert	97
A. Objections.....	98
XII. Exhibits.....	100
A. What Exhibits to File.....	100
B. When to File an Exhibit	101
C. Exhibit Numbering, Labels, and Even Location.....	101
D. Corrections and Errata Sheets	102
 CHAPTER 4. THE PETITION.....	113
I. Filing and Completeness	114
II. The Petition	116
A. Word Count Limits.....	119
B. Avoid Redundancy	121
C. Filing Protective Order Material with the Petition	123
D. Service of the Petition	124
III. Other Requirements for the Petition.....	125
A. Mandatory Notices	127
B. Claim Charts.....	128
C. Standing Overview	130
D. Establishing Non-Patent Literature as Prior Art.....	131
E. Real Parties-in-Interest	134
F. Confidential Information in a Petition	140
G. Objections to Evidence at Preliminary Proceeding	140
H. Supplemental Evidence After an Objection	140

IV. Common Petition Defects.....	141
V. Corrections to Petitions	145
A. Limits on Scope of Correction	147
B. Company Name Correction.....	147
C. Expert Declaration Correction	148
VI. Serial Petitions.....	149
 CHAPTER 5. PATENT OWNER'S MANDATORY NOTICES AND PRELIMINARY RESPONSE	153
I. Mandatory Notices After a Petition Is Filed.....	154
II. Patent Owner's Preliminary Response	156
III. Delays in Filing a Preliminary Response	158
IV. Who May File Patent Owner's Preliminary Response.....	160
V. Format of Patent Owner's Preliminary Response.....	161
A. Technical Requirements for Preliminary Responses	161
B. Evidence Included as Part of a Preliminary Response.....	162
VI. Objections to Evidence.....	164
VII. Preliminary Response to Multiple Petitions	165
VIII. Replies to a Preliminary Response	166
IX. Expunging a Preliminary Response.....	168
 CHAPTER 6. DISCOVERY AND EVIDENCE	123
I. Mandatory Initial Disclosures	171
II. Routine Discovery	171
A. Cited Exhibits.....	172
B. Cross-Examination of Affidavit Testimony.....	172
C. Inconsistent Positions.....	174
III. Additional Discovery.....	176
A. Timing of Additional Discovery.....	180
B. <i>Garmin</i> Factors to Determine Whether Additional Discovery Is Needed	181
IV. Discovery and Evidence Specifics at the PTAB	185
A. Declarations and Affidavits	188
B. Depositions.....	189
1. Length of Time of Depositions	191
2. Scope of Cross-Examination	192

3. Who May Participate in the Deposition.....	197
4. Videotaping Depositions.....	197
5. When a Party Can Speak to Its Witness.....	198
6. Deposition Duration: 7/4/2 Hours.....	200
7. Deposition Notice	201
8. Motion to Quash	202
9. Costs.....	202
10. Deposition Transcript.....	203
11. Deposition Objections.....	204
12. After the Deposition.....	206
C. Document Requests.....	207
D. Production of Samples	207
E. Experts.....	208
F. Foreign Discovery	210
1. Foreign Depositions	210
2. Deposition in a Foreign Language.....	212
3. Foreign Production of Documents	215
G. Discovery Objections	215
H. Supplemental Information and Evidence	216
1. Motion to Submit Supplemental Information	216
2. Late Submission of Supplemental Information	218
3. Other Supplemental Information	219
CHAPTER 7. MOTIONS	221
I. Content of Motions.....	225
II. Content of Oppositions and Replies	227
III. Notice of Basis for Relief.....	227
IV. Oral Argument	228
V. Various Motions.....	228
A. Withdrawal of Claims.....	228
B. Motion to Amend	229
C. Motion to Expedite Schedule	231
D. Motions to Compel.....	231
E. Motion for Sanctions.....	233
F. Motion for Joinder.....	236
G. Supplemental Information and Supplemental Evidence	244

1. Late Submission of Supplemental Information	247
2. Other Supplemental Information	249
H. Observations on Cross-Examination	250
I. Motion to Exclude	254
J. Motion to Withdraw	260
K. Motion to Strike	263
L. Motion to Stay: Related Proceedings Inside and Outside the PTO	265
M. Motion to Correct Clerical Error/Certificate of Correction.....	270
N. Where No Motion Is Necessary or Permitted	271
O. Motion for Rehearing.....	271
1. Timing of Motion for Rehearing.....	274
2. Burden on Review.....	275
P. Motion to Seal	276
 CHAPTER 8. INSTITUTION	283
I. Instituting Post-Grant Proceedings.....	284
A. Sufficient Grounds	286
B. Redundant Grounds.....	286
C. Burden of Proof.....	287
II. Not Instituting Inter Partes Review: Lack of Standing.....	289
 CHAPTER 9. PRELIMINARY BOARD DECISIONS RELATING TO OTHER PROCEEDINGS	291
I. Consolidation.....	292
II. Motions to Stay.....	293
 CHAPTER 10. SCHEDULING ORDERS AND ISSUES	297
I. The Standard Scheduling Order	298
II. Scheduling Specifics and Reference to Opinions.....	300
A. Initial Scheduling	300
B. Changes to Timing	300
C. Scheduling Testimony	305
D. Miscellaneous Scheduling Issues: Filing Problems, Experts, Bankruptcy, and Other Delays.....	306

CHAPTER 11. PATENT OWNER'S RESPONSE AFTER INSTITUTION	311
I. Word Counts	312
II. Issues of Standing	313
III. Swearing Behind a Reference	314
IV. Challenge to Claim Interpretation	314
V. Waiver	315
VI. Inadvertent Errors	315
CHAPTER 12. PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE	317
I. Word Counts and Contents	317
II. Reply Evidence Must Be Responsive, Not New	318
III. Limited Surreplies	321
CHAPTER 13. AMENDING CLAIMS	323
I. Amending Claims Is Challenging	324
II. Preliminary Guidance	327
III. Page Limits	328
IV. Claim Listings: Appendix	331
V. Claim Listings: Substance	333
VI. Contents of Motion to Amend	334
A. Patentable Distinction	337
B. Written Description	340
C. Substitute Claims	342
VII. Reasons for Denial of Motion to Amend	344
VIII. Other Claim Amendment Strategies	346
IX. Opposition to a Motion to Amend and Replies	348
CHAPTER 14. ORAL HEARINGS AND POST-HEARING	351
I. Oral Hearings	351
A. Timing of Oral Hearing	354
B. Confidential Information at Oral Hearing	356
C. Evidence at Oral Hearing	357
D. Who Attends the Oral Hearing	361
II. Post-Hearing & Judgments	362
III. Request for Adverse Judgment	363

IV. Settlement	365
V. Appellate and Rehearing Procedure Within PTAB	371
CHAPTER 15. APPEALS TO THE FEDERAL CIRCUIT	375
I. Traditional Appeals to the Federal Circuit	375
A. Constitutionality Challenge	383
II. Writs of Mandamus to the Federal Circuit	384
III. Administrative Procedure Act Appeals	386
APPENDICES	389
Appendix A: Definitions	391
Appendix B: Pertinent Portions of 37 C.F.R. §§ 41, 42 and 90	397
Appendix C: USPTO Trial Practice Guide	423
Appendix D: Pertinent Portions of 35 U.S.C. §1 et seq.	443
TABLE OF CASES	489
INDEX	523