

Motions to Exclude and Motions to Strike in AIA Trials

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Administrative Patent Judges
Patent Trial and Appeal Board
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UNITED STATES
PATENT AND TRADEMARK OFFICE



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Jun 5, 2018 12:00 PM ET

Motions to Exclude and Motions to Strike in AIA Trial Proceedings
Jun 7, 2018 12:00 PM ET

PTAB/TTAB Stadium Tour at University of San Diego School of Law
Sep 20, 2018 10:00 AM PT
San Diego, CA



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Outline

- General motion rules and considerations
- Rules for presenting evidence
- Objections to evidence and supplemental evidence
- Authority for excluding or striking
- Reply testimony and evidence

General Rules for Motions - §§ 42.20-25

- Prior Board authorization required for entry, § 42.20(b)
 - **Motion to strike**
- Exceptions:
 - Impractical
 - Motions to seal
 - Motion filed with petition, e.g. to waive page limits § 42.24(a)(2)
 - Automatically authorized
 - Request for rehearing
 - Observations on cross examination
 - **Motion to exclude evidence**

Burden of Proof for Motions - §§ 42.20-21

- Board may order briefing on any issue involved in trial
 - Board can request parties to brief an issue, e.g., the effect of a new Fed. Cir. or S. Ct. decision on the proceeding
- Burden of proof to establish entitlement to requested relief is on the moving party, § 42.20(c)
- Notice of basis for relief, § 42.21
 - Board may require party to file and set times
 - Must state relief requested and basis for entitlement
 - Must provide sufficient detail to put Board and opponent on notice of precise relief requested
 - Party limited to filing motions consistent with notice

Content of Motions - §§ 42.22-23

- Motion contents (separate paper), § 42.22
 - Statement of precise relief requested
 - Full statement of reasons for request; detailed explanation of significance of evidence, material facts, law; showings required by rules
- Oppositions and replies, § 42.23
 - Comply with requirements for motion
 - Identify any disputed material facts (if motion contained a statement of material facts), otherwise admitted
 - Replies directed only to corresponding opposition

Page Limits for Motions - § 42.24

- Motions (excluding motions to amend) - 15 pages, § 42.24(a)(1)(v), unless waiver granted in advance, § 42.24(a)(2)
- Oppositions - same number of pages as corresponding motion, § 42.24(b)(3)
- Replies to motions (excluding motions to amend) - 5 pages, § 42.24 (c)(2)
- Limits INCLUDE any statement of material facts to be admitted or denied, § 42.24(a)(1)
- Limits EXCLUDE table of contents, certificate of service, appendix of exhibits, § 42.24(a)(1)
- Board may set other page constraints, e.g., fewer pages set when granting authorization to file

Times for Filing Motions - § 42.25

- Set in Scheduling Order
 - PO motion to amend (Due Date 1), Pet. opposition (Due Date 2), and PO reply (Due Date 3)
 - Observations on cross examination of reply Witness (Due Date 4) and Response to Observations (Due Date 5)
 - Motion to exclude evidence (Due Date 4), opposition (Due Date 5), and reply (Due Date 6)
- Set during conference
 - Initial conference (if ordered or requested, typically within one month of institution)
 - Special conference seeking authorization; can decide procedural matters during call or shortly thereafter without additional briefing
- Board can deny relief not promptly sought, § 42.25(b)
- Default time period for oppositions is one month, § 42.25(a)(2) – typically set much shorter

Considerations in Authorizing Motions

- Maintain control of the proceeding
- Effect on schedule
 - Board has statutory deadlines to meet
 - Seek efficient, effective resolution of issues
- Effect on the parties

Rules for Presenting Evidence

- **Rule 42.61 Admissibility**
- **Rule 42.62 Applicability of the Federal Rules of Evidence**
 - “Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.”
- **Rule 42.63 Form of Evidence**
 - “Evidence consists of affidavits, declarations, transcripts of depositions, documents, and things.”
 - “All evidence must be filed in the form of an exhibit.”
 - For non-English documents, a translation and an affidavit (or declaration) attesting to the accuracy of the translation must be filed with the document

Rules for Presenting Evidence

- **Rule 42.53 Taking Testimony**

- Uncompelled direct testimony must be submitted in the form of an affidavit or declaration.
- All other testimony, including testimony compelled under 35 U.S.C. § 24, must be in the form of a deposition transcript
- Declarants must be made available for cross examination
- Parties may agree to video-recorded testimony, but may not submit such testimony without prior authorization of the Board
- The Board may authorize or require live or video-recorded testimony

Rules for Presenting Evidence

- **Rule 42.65 Expert testimony; tests and data**
 - “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”
 - “Testimony on United States patent law or patent examination practice will not be admitted.”
 - If a party relies on a technical test or data from such a test, the party must provide an affidavit to explain the test or data
- **Rules 42.104(b)(5), 42.204(b)(5), 42.304(b)(5)**
 - “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”
 - *See also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012)

Objections – Deposition Evidence

- **Rule 42.64 Deposition evidence**
 - An objection to the admissibility of deposition evidence must be made during the deposition
 - Evidence to cure the objection must be provided during the deposition, unless the parties to the deposition stipulate otherwise on the deposition record
- **Rule 42.53(f)(8)** – Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed motion to exclude
- *See also* Testimony Guidelines in the Trial Practice Guide, 77 Fed. Reg. at 48,772.

Objections to Other Evidence Under § 42.64(b)

- Any objection to evidence submitted during a preliminary proceeding must be **filed** within ten business days of the institution of the trial
- Once a trial has been instituted, any objection must be **filed** within five business days of service of evidence to which the objection is directed
- The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence

Supplemental Evidence Under § 42.64(b)

- The party relying on evidence to which an objection is timely **served** may respond to the objection by serving supplemental evidence within ten business days of service of the objection
- Supplemental evidence should not be filed at the time of service because it may be sufficient to overcome the admissibility objection
 - If it does not, the evidence may be filed as supporting evidence with an opposition to a motion to exclude

Motion to Exclude Evidence Under § 42.64(c)

- A motion to exclude must be filed to preserve any objection
- The motion must:
 - Identify where in the record the objection originally was made;
 - Identify where in the record the evidence sought to be excluded was relied upon;
 - Address objections to exhibits in numerical order; and
 - Explain each objection
- The motion must explain why the evidence is not admissible (e.g., authenticity or inadmissible hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact

Admissibility vs. Sufficiency of Evidence

- **Admissibility of evidence** may be challenged by submitting arguments in a motion to exclude evidence (e.g., authenticity or inadmissible hearsay)
- **Sufficiency of evidence** to prove a particular fact (e.g., credibility or the weight of the evidence) may be challenged by submitting arguments in a patent owner response or reply

Authority for Motions to Strike

- Not discussed expressly in the rules or Trial Practice Guide
- **Rule 42.5(a)** – “The Board may determine the proper course of conduct in a proceeding . . .”
- **Rule 42.7(a)** – “The Board may expunge any paper . . . that is not authorized under this part or in a Board order or that is filed contrary to a Board order.”
- **Rule 42.12(b)(2)** – The Board may impose sanctions including “[a]n order expunging . . . a paper”
- **Rule 42.20(a)** – “Relief, other than a petition requesting institution, must be requested in the form of a motion.”

Timing of Motions

- **Motions to exclude:** Typically decided in final written decision, but can be decided earlier
 - Parties can request a conference call if circumstances warrant an earlier disposition
- **Motions to strike:** Typically decided prior to final written decision
 - Alternative relief (e.g., filing a list of allegedly improper arguments) may be granted prior to the hearing

Reply Testimony and Evidence

- **Rule 42.23(b)** – “A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.”
- Panel typically decides, without additional briefing
- Shifting theories vs. proper reply evidence
- *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (Board did not abuse its discretion in refusing to consider reply brief arguments advocating a “**new theory**” of unpatentability under 37 C.F.R. § 42.23(b))
- *Apple Inc. v. e-Watch, Inc.*, Case IPR2015-00412, slip op. at 44 (PTAB May 6, 2016) (Paper 50) (“‘Respond,’ in the context of 37 C.F.R. § 42.23(b), does not mean embark in a **new direction** with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new arguments would be unjust to the Patent Owner and we decline to do so.”)

Motion to Exclude Dos and Don'ts

- **Do**
 - Focus on the exhibits that really matter
 - Focus on the best basis for exclusion
 - Explain the basis for excluding the evidence --- the movant has the burden
 - Be succinct!
 - Cite authority --- cases and treatises --- to support your position
- **Don't**
 - Seek to exclude as many exhibits as possible
 - Have a laundry list of possible bases for excluding (e.g., "Exhibit 2001 should be excluded under Fed. R. Evid. 401, 402, 403, 602, 701, 802, 901, and/or 1002.")
 - Merely cite the rule and assert that the exhibit should be excluded
 - Treat the Motion to Exclude as an additional merits brief

Motion to Strike Dos and Don'ts

- **Do**
 - Be narrowly focused
 - Propose alternative relief --- e.g., chart identifying new arguments --- if panel does not wish to authorize motion
 - Be succinct! --- Shorter motions are more likely to be authorized
 - Explain why it matters
- **Don't**
 - Seek to strike broad swathes of evidence or briefing
 - Have a laundry list of possible reasons for excluding
 - Include *ad hominem* attacks against opposing counsel
 - Fail to explain the importance of what you seek to strike

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PTAB on Patent Quality	June 12, 2018	Best Practices Before the Patent Trial and Appeals Board	Kalyan Deshpande Susan Mitchell Michael Zecher
Boardside Chat	Oct 4, 2018	Motions to Seal, Protective Orders, and Confidential Information in AIA Trials	Mike Kim Amanda Wieker

Judicial Conference Schedule

- Thursday, June 28: Alexandria
- Monday, July 9: Detroit
- Wednesday, July 11: Denver
- Thursday, July 26: San Jose
- Tuesday, July 31: Dallas

July 2018 						
Su	Mo	Tu	We	Th	Fr	Sa
1	2	3	<u>4</u>	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

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Judicial Conference Agenda

Time	Topic	Speakers
9 to 9:10 am	Opening Remarks	Vice Chief Janet Gongola
9:10 to 9:20 am	Director Remarks	Director Iancu
9:20 to 10 am	Best Practices for Written and Oral Advocacy	Judge Panel with Moderator Judge Bruce Wieder
10 to 11 am	Practicum: Written Advocacy	Lead Judges Aaron Moore and Georgianna Braden
11 am to 11:15 am	BREAK	
11:15 am to 12:15 pm	Practicum: Oral Advocacy	Judge Meredith Petravick and Lead Judge Matt Clements
12:15 to 1:30 pm	LUNCH	
1:30 to 2:00 pm	State of the Board	Deputy Chief Scott Boalick
2:00 to 2:50 pm	Small Group Discussion: Section 101	Lead Judge Jessica Kaiser
2:50 to 3:00 pm	BREAK	
3:00 to 3:50 pm	Small Ground Discussion: Motion to Amend	Lead Judge Melissa Haapala
3:50 to 4:30 pm	Interview with the Chief	Chief David Ruschke

Thank You

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