

TRIAL PRACTICE GUIDE UPDATE

(August 2018)

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Introduction

The Office published the Office Patent Trial Practice Guide (“Practice Guide”) in August 2012, concurrent with the promulgation of the AIA Trial Rules. *See* 77 Fed. Reg. 48,756 (Aug. 14, 2012). The Practice Guide was intended to apprise the public of standard practices before the Board during AIA trial proceedings, including *inter partes* reviews, post-grant reviews, covered business method reviews, and derivation proceedings. The Practice Guide was also intended to encourage consistency of procedures among panels of the Board.

The Office is committed to updating the Practice Guide to take into account stakeholder feedback, lessons learned during the years since the first AIA trial, and the natural evolution of the Board’s practices. In order to expedite these updates and provide guidance to the public as quickly as possible, the Office has chosen to issue updates to the Practice Guide on a section-by-section, rolling basis, rather than a single, omnibus update addressing all aspects of the current Practice Guide. Sections of the Practice Guide changed or added in this update are set forth below.

I. General Procedures

G. Expert Testimony

Expert testimony may be submitted with the petition, preliminary response, and at other appropriate stages in a proceeding as ordered or allowed by the panel overseeing the trial.

Expert opinion testimony is generally permitted where the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue. Fed. R. Evid. 702(a).

An expert witness must be qualified as an expert by knowledge, skill, experience, training, or education to testify in the form of an opinion. Fed. R. Evid. 702. There is, however, no requirement of a perfect match between the expert’s experience and the relevant field. *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010). A person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702, but rather must be “qualified in the pertinent art.” *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363–64 (Fed. Cir. 2008). For example, the absence of an advanced degree in a particular field may not preclude an expert from providing testimony that is helpful to the Board, so long as the expert’s experience provides sufficient qualification in the pertinent art.

Expert testimony is presented in the form of an affidavit or declaration. See 37 C.F.R.

§ 42.53(a). Expert testimony may have many uses. For example, it may be used to explain the relevant technology to the panel. It may also be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims. Expert testimony may also be offered on the issue of whether there would have been a reason to combine the teachings of references in a certain way, or if there may have been a reasonable expectation of success in doing so. If evidence of objective indicia of nonobviousness has been entered into the record, an expert may also provide testimony as to how this evidence should be weighed against evidence of unpatentability, or may explain the nature and import of such objective evidence.

The Board has broad discretion to assign weight to be accorded expert testimony. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010). However, the testimony must be based on sufficient facts and data. Fed. R. Evid. 702(b). “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). Furthermore, the testimony must be the product of reliable principles and methods. Fed. R. Evid. 702(c). Moreover, an expert must reliably apply the principles and methods to the facts of the case. Fed. R. Evid. 702(d).

The rules governing the conduct of AIA trial proceedings were designed to promote fairness and efficiency. For instance, 37 C.F.R. § 42.24(a) sets word limits for petitions, motions, and replies, and § 42.6(a)(3) prohibits incorporating arguments by reference from one document into another. Thus, parties that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board. *See Cisco Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative).

Expert testimony may be presented to establish the scope and content of the prior art for determining obviousness and anticipation. Such testimony may be helpful in evaluating, for example, the “prior art as viewed with the knowledge of one of skill in the art at the time of invention.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002). Expert testimony, however, cannot take the place of a disclosure in a prior art reference, when that disclosure is required as part of the unpatentability analysis. For example, because “[a] claim is anticipated only if each and every element as set forth in the claim is found, either

expressly or inherently described, in a single prior art reference,” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987), a petitioner asserting anticipation cannot rely on its expert to supply disclosure of a claim element that is not expressly or inherently present in the reference. Similarly, in an obviousness analysis, conclusory assertions from a third party about general knowledge in the art cannot, without supporting evidence of record, supply a limitation that is not evidently and indisputably within the common knowledge of those skilled in the art. *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014).

Furthermore, because an *inter partes* review may only be requested “on the basis of prior art consisting of patents or printed publications,” 35 U.S.C. § 311(b), expert testimony cannot take the place of disclosure from patents or printed publications. In other words, expert testimony may explain “patents and printed publications,” but is not a substitute for disclosure in a prior art reference itself.

II. Petitions and Motions Practice

A. General Motions Practice Information

3. Word Count and Page Limits

A word count limit applies to petitions, patent owner preliminary responses, patent owner responses, and petitioner replies to patent owner responses, and any sur-replies filed in AIA trial proceedings. For all other briefing, a page limit applies. 37 C.F.R. § 42.24. The rules set a limit of 14,000 words for petitions requesting IPR and derivation proceedings, and a limit of 18,700 words for petitions requesting PGR and CBM proceedings. § 42.24(a). Motions, other than motions to amend, are limited to 15 pages. *Id.* Motions to amend are limited to 25 pages. *Id.* Patent owner preliminary responses and patent owner responses to a petition are subject to the

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