

TRIAL PRACTICE GUIDE UPDATE

(July 2019)

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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 also was 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. An update to the Practice Guide was published on August 13, 2018, and is available at <https://go.usa.gov/xU7GP>. *See* 83 Fed. Reg. 39,989 (Aug. 13, 2018). Sections of the Practice Guide changed or added in this second update are set forth below.

I. General Procedures

A. Jurisdiction and Management of the Record

2. Prohibition on *Ex Parte* Communications

All substantive communications with the Board regarding a proceeding must include all parties

to the proceeding, except as otherwise authorized. 37 C.F.R. § 42.5(d). The prohibition on *ex parte* communications does not extend to: (1) ministerial communications with support staff (for instance, to arrange a conference call); (2) conference calls or hearings in which opposing counsel declines to participate; (3) informing the Board in one proceeding of the existence or status of a related Board proceeding; or (4) reference to a pending case in support of a general proposition (for instance, citing a published opinion from a pending case or referring to a pending case to illustrate a systemic problem).

Arranging a conference call with the Board

The Board encourages the use of conference calls to raise and resolve issues in an expedited manner. Prior to making a request for a conference call, the parties should meet and confer to resolve any disputes. If attempts to resolve the dispute fail, a party may request a conference call with the Board. The Board envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, *i.e.*, in a matter of days. When arranging a conference call, parties should be prepared to discuss with a Trial Section paralegal why the call is needed and what materials may be needed during the call, *e.g.*, a particular exhibit. When contacting the Board to arrange a conference call, a party to a proceeding should notify the Board if it intends to provide a court reporter for the call. If a court reporter is present for the conference call, the party that retained the court reporter should notify the panel at the beginning of the call that a reporter is on the line, and shall file the transcript of the call as an exhibit to the proceeding within one week of receiving the transcript.

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