



Petition and Motion Practice Before the Patent Trial and Appeal Board

The Leahy-Smith America Invents Act¹ ushered in a new era of administrative trials before the Patent Trial and Appeal Board (the “Board”) in connection with *inter partes* review (“IPR”), postgrant review, the transitional program for covered business method patents, and derivation proceedings. Following enactment came the Board’s Final Rules of Practice (the “Rules”),² a consolidated set of rules governing trial practice for these proceedings. This *Commentary* provides an overview of petition and motion practice before the Board. While other articles and *Commentaries* in this series have focused on specific petitions or motions and relevant Board decisions,³ here, we discuss rules specifically addressing exemplary petitions and motions, rules of practice governing petition and motion practice, formal filing requirements (e.g., notice, prior authorization, and timing), and practice tips.

Exemplary Motions

Many types of motions (or petitions and requests) are expressly provided for by the Rules, such as:

- Motions to appear *pro hac vice* (42.10);⁴
- Motions to waive page limits (42.24);
- Motions for mandatory initial disclosures (42.51(a)(2));
- Motions for additional discovery (42.51(b)(2));

- Motions to compel testimony or production (42.52);
- Motions for live testimony (42.53);
- Motions to seal (42.54(a));
- Motions to expunge confidential information (42.56);
- Motions to exclude and motions *in limine* (42.64);
- Requests for rehearing on a decision by the Board (42.71);
- Requests for adverse judgment (42.73);
- Motions to amend a patent (42.121);
- Requests for joinder (42.122); and
- Motions to file supplemental information (42.123).

Parties have filed other motions, petitions, and requests not expressly provided for in the Rules. These include, for example, motions for additional briefing⁵ and requests for the Board to take over jurisdiction and suspend related prosecution.⁶

Even in instances where the parties have not requested relief via motion, the Board, in its discretion, may issue an Order *sua sponte*. For example, in IPR2013-00033, the Board *sua sponte* issued an Order to stay concurrent reexamination.⁷ In so deciding, the Board noted that “[a]lthough all of the claims being challenged in the instant proceeding are different than those claims

subject to reexamination, all of the independent claims are being reexamined.”⁸ Therefore, the Board concluded that “[c]onducting the reexamination concurrently with the instant proceeding ... would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings.”⁹ Here, the Board acted with special dispatch, issuing the Order within two weeks of the date on which the IPR petition was filed (and more than five months before the parties filed their motions lists).

Rules of Practice Governing Petition and Motion Practice

Several codified rules specifically address petition and motion practice: 37 C.F.R. §§ 42.20, 42.21, 42.22, 42.23, 42.24, and 42.25. A brief discussion of each rule is provided below.

Rule 42.20. This rule sets forth the general conduct of petition and motion practice before the Board. For example, **Rule 42.20(a)** requires that “relief, other than a petition to institute a trial, *must be requested in the form of a motion.*” The requirement for a motion notwithstanding, the Board has held that even where a party does not file a formal motion, it can exercise discretion to treat any request as a motion.¹⁰ **Rule 42.20(b)**, discussed in further detail in “Prior Authorization,” below, provides in part that “[a] motion will not be entered absent Board authorization.” **Rule 42.20(c)** places the burden of proof on the moving party. “A motion that fails to justify the relief on its face could be dismissed or denied without regard to subsequent briefing.”¹¹ Finally, **Rule 42.20(d)** provides that “[t]he Board may order briefing on any issue” appropriate for a final written determination on patentability.

Rule 42.21. As discussed in more detail in “Notice and Basis for Relief,” below, this rule sets forth the requirements for notice and states the basis for the relief sought in a particular petition or motion.¹² “[F]ailure to provide sufficient notice of request for relief or providing basis will result in denial of the relief requested.”¹³

Rule 42.22. This rule sets forth the requirements concerning the general content of petitions and motions. **Rule 42.22(a)** requires that “[e]ach petition or motion must be filed as a separate paper” to reduce the chance that an argument would be overlooked and reduce the complexity of any given

paper. **Rules 42.22(a)(1)** and **(a)(2)** provide for a statement of precise relief requested and a statement of the reasons for relief. “Vague arguments and generic citations to the record are fundamentally unfair to an opponent and do not provide sufficient notice to an opponent and create inefficiencies for the Board.”¹⁴ **Rule 42.22(b)** requires the movant to make showings ordinarily required for the requested relief in other parts of the Rules. **Rule 42.22(c)** provides that a “petition or motion may include a statement of material fact” with “specific citations to the portions of the record that support the fact.” “Providing specific citations to the record gives notice to an opponent of the basis for the fact and provides the Board the information necessary for effective and efficient administration of the proceeding.”¹⁵ **Rule 42.22(d)** allows the Board to “order additional showings or explanations as a condition for authorizing a motion.” “Experience has shown that placing conditions on motions helps provide guidance to the parties as to what issues and facts are of particular importance and ensures that the parties are aware of controlling precedent that should be addressed in a particular motion.”¹⁶

Rule 42.23. This rule largely mirrors opposition and reply practice in federal district court litigation. It provides in part that “[o]ppositions and replies must comply with the content requirements” for a motion, and that a reply may respond only to arguments raised in the corresponding opposition and may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant’s motion.

Rule 42.24. This rule provides page limits for petitions, motions, patent owner preliminary responses, patent owner responses, oppositions, and replies.

Rule 42.25. As discussed in more detail in “Timing,” below, this rule provides default times for filing oppositions and replies. The expectation, however, is that the Board would tailor the schedule to each individual case, as opposed to relying upon the default times set by rule.¹⁷

Formal Requirements

Enough emphasis cannot be placed on the importance of meeting the various formal requirements for petition and

motion practice before the Board. Outlined below are a few key requirements that parties should strive to meet.

Notice and Basis for Relief. The Board may, per **Rule 42.21(a)**, require a party to file a notice stating the relief it requests and the basis for its entitlement to such relief. The Board typically makes this requirement near the end of its Institution Decision in a case, where the Board states that the initial conference call will be conducted according to the guidelines provided in the Trial Practice Guide.¹⁸ The Board has interpreted this to require parties to file a motions list at least two days prior to that initial conference call with the Board.¹⁹ This list serves to provide adequate notice to the Board and the opposing party in preparing for the initial call and the proceeding. Subsequent to the initial conference call, parties have further opportunities to provide notice by scheduling a conference call with the Board to discuss a proposed motion with the Board and the opposing party.²⁰

In a case concerning covered business methods, the Board issued an Order chastising the parties for failing to file a proper motions list as required under 37 C.F.R. § 42.21(a). In particular, the Board noted that the parties used their purported “motions lists” to substantively argue the merits of their requested motions. In this case, the Board took the opportunity to clarify that “[a] motions list ... is not the opportunity for a party to submit the motion itself. Rather, the list should contain a short, concise statement generally relaying enough information for the Board and opposing counsel to understand the proposed motion.”²¹ In addition, the Board observed that some of the parties’ requested motions were not required, because the parties would have other opportunities to argue the merits of their requested motions. For example, the patent owner had “request[ed] that the Board have a separate claim construction proceeding prior to any of the other scheduled events.”²² The Board denied this request because the patent owner would “have opportunity to explain, with evidence, why the claim construction adopted by the Board should not be followed and/or what construction should apply” in its post-institution response.²³ Thus, in drafting their respective motions lists, parties should be cognizant of the following considerations: (i) the substantive merits of requested motions should not be detailed in a motions list; and (ii) a motion will be denied if the standard operating procedure in IPR proceedings already provides a

party with the opportunity to argue the merits of its requested motion.

Prior Authorization. The requirement for seeking prior authorization when filing a motion is set forth explicitly in **Rule 42.20(b)**: “A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding.” Thus, unless a party includes a motion in its motions list or otherwise seeks authorization for filing a motion (e.g., motion for additional briefing in view of recent case law), any motion, petition, or request will not be entertained by the Board. The Board has “noted that any relief must be requested in the form of a motion and a motion ordinarily will not be entered without prior Board authorization.”²⁴ In addition, “an unauthorized paper may be expunged with prejudice.”²⁵ Prior authorization is generally granted or denied for early noticed motions in the initial conference call with the Board, and authorization is granted for later motions in conference calls that are requested by the moving party.²⁶

In a case concerning covered business methods, the Board specifically noted that “The Board could treat [the patent owner’s] request as an improper paper because [it] did not seek prior Board authorization and the request was not filed in the form of a motion.”²⁷ Thus, careful planning is warranted in the initial filing of a motions list so that a party may notify the Board of relevant motions in advance.

Timing. As discussed above, **Rule 42.25** addresses the timing for filing a motion. **Rule 42.25(a)** states in part that “[a] motion may only be filed according to a schedule set by the Board.” Accompanying the Board’s decision to institute a proceeding such as, for example, *inter partes* review, the Board will issue a Scheduling Order setting forth the date and time for the initial conference call with the Board and due dates for filing various motions. Such motions include motions to amend, to exclude evidence, and for observation on the cross-examination of a witness. During the call, the Board will also address the parties’ proposed motions listed on their respective motions lists and will generally grant or deny such motions during the call. Default filing times are also provided in **Rule 42.25(a)(1)** and **(2)**. Moreover, **Rule 42.25(b)** expresses the importance of seeking relief *promptly*: “A party should seek

relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.”

Thus, for motions that were not anticipated prior to the initial conference call, a conference call with the Board and the opposing party should be requested as soon as possible to avoid any appearance of delay, especially in cases where the relief requested could put pressure on the trial schedule, given that the Board will seldom grant relief that will extend the trial beyond one year from institution.

Practice Tips

Several themes have emerged from reviewing the Rules of Practice and the Trial Practice Guide and from our practical experience with the Board. Below are a few key practice tips that parties should carefully bear in mind when participating in proceedings before the Board:

- Become intimately familiar with the Rules of Practice and the Trial Practice Guide.
- If the relief sought is not expressly provided for in the Rules, file a motion.
- Seek relief promptly so as to avoid any appearance of delay.
- Always seek prior authorization before filing a motion.
- Make sure all timing requirements are met.
- To the extent possible, provide statutory or regulatory authority in support of any contemplated motion, as the Board is expected to adhere strictly to the text of any applicable statutes or regulations.
- Limit the number of requested motions to the truly essential.

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Endnotes

- 1 Pub. L. 112-29, 125 Stat. 284 (2011).
- 2 Fed. Reg. Vol. 77, No. 157 (Aug. 14, 2012), eff. Sep. 16, 2012.
- 3 See, e.g., Choi et al., *Jones Day Commentary*, “Amending Claims During *Inter Partes* Review: Patent Practitioners Beware” (Aug. 2014).
- 4 Rule references are to 37 C.F.R.
- 5 CBM2013-00042, Paper 33 (July 11, 2014) (granting patent owner’s request for additional briefing in light of the Supreme Court’s recent decision in the case of *Alice Corp. v. CLS Bank*, 134 S. Ct. 734 (2013)).
- 6 IPR2013-00028, Paper 8, at 4 (Nov. 28, 2012) (denying CMI’s request for the Board to exercise exclusive jurisdiction over related pending applications and to suspend prosecution of those applications, or in the alternative to review and authorize any further patent application filings or changes to the claims prior to submitting such papers to the examiner handling those applications).
- 7 IPR2013-00033, Paper 15 (Nov. 6, 2012).
- 8 *Id.* at 1–2.
- 9 *Id.* at 2.
- 10 See IPR2013-00028, Paper 8, at 2 n.2 (Nov. 28, 2012) (citing 37 C.F.R. § 42.1(b) and 37 C.F.R. § 42.5 (b)).
- 11 Fed. Reg. Vol. 77, No. 157, at 48619–20.
- 12 37 C.F.R. § 42.21(a).
- 13 *Id.* § 42.21(c)(1).
- 14 Fed. Reg. Vol. 77, No. 157, at 48620.
- 15 *Id.*
- 16 *Id.*
- 17 *Id.* at 48621.
- 18 77 Fed. Reg. 48756 at 48765–78766; see, e.g., IPR2012-00004, Paper 18, at 27 (Jan. 24, 2013).
- 19 See CBM2012-00005, Paper 31, at 2 (Feb. 13, 2013); Trial Practice Guide 77 Fed. Reg. 48766 at 78765.
- 20 The detailed process is provided in the Trial Practice Guide, Fed. Reg. Vol. 77, No. 157, at 48763.
- 21 CBM2012-00005, Paper 31, at 2.
- 22 *Id.* at 3.
- 23 *Id.*
- 24 CBM2013-00005, Paper 15, at 2 (Dec. 3, 2012) (citing 37 C.F.R. § 42.20; Section II of the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48762 (Aug. 14, 2012)).
- 25 CBM2013-00005, Paper 15, at 2 (citing 37 C.F.R. §§ 42.7(a) and 42.12(b)).
- 26 Fed. Reg. Vol. 77, No. 157, at 48763.
- 27 CBM2013-00005, Paper 15, at 3.

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