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PTAB Issues 2nd Update to Trial Practice Guide—Access the Complete Trial Practice Guide, including all revisions to date, here!

by John C. Alemanni , Justin L. Krieger

Yesterday (July 15th), the PTAB published a second update to its Trial Practice Guide (https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf). This second update is twice as long as the August 2018 update and relies extensively on the many recently-designated precedential and informative decisions. The new second revision touches on many topics, but some of the more interesting changes were in relation to parties filing multiple petitions and the treatment of testimonial evidence in preliminary responses. The Board also more explicitly set out the petitioner's burden in relation to claim construction, discussed the differing standards for when additional discovery will be granted and provided updates to the default protective order and the treatment of confidential information. As the first and second revisions to the Trial Practice Guide only include the individual sections of the Guide that have been modified, we have prepared an ***Integrated PTAB Trial Practice Guide*** that incorporates all revisions to date. We also have shown the changes in Rev. 1 (in red) and Rev. 2 (in blue) in a separate ***track-changes version***.

In relation to multiple petitions challenging the same patent, the Board noted that in its experience, one petition should be sufficient and filing more than one at the same time "may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." Page 26 (citing 35 U.S.C. § 316(b)). Thus, the Board now suggests that if a petitioner files multiple petitions for the same patent, the petitioner "should" rank the petitions and provide an explanation for the differences between the petitions and why the Board should institute more than one. Page 27. If the petitioner does so, then the patent owner "could" respond to the explanation in its preliminary response. Page 28. This suggestion follows the procedure the panel adopted recently in *Comcast v. Rovi*, Case No. IPR2019-00279, Paper 7 (April 22, 2019).

In relation to claim construction, the updated practice guide notes that the Petitioner must set out any claim construction positions in the Petition. The update then states explicitly that "the petitioner may respond to any such new claim construction issues raised by the patent owner, but cannot raise new claim construction issues that were not previously raised in its petition." Page 13. The update also notes that a "petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3)." *Id*.

In relation to testimonial evidence submitted with a preliminary response, the update states that the patent owner may choose post-institution to affirmatively withdraw the testimony submitted with a preliminary response.

Page 20. If the Patent Owner does so, then the declarant is not subject to cross-examination during the trial. *Id*. Conversely, failure to withdraw such testimony would usually subject the declarant to cross-examination during trial. *Id*.

Concerning requests for additional discovery, the update focuses primarily on the *Garmin* factors but also offers an explanation for the differing standards in IPR proceedings (interest of justice) versus PGR and CBM proceedings (good cause). Page 7.

The default protective order also has been largely reorganized somewhat but substantively is similar to the prior default protective order. The Guide now expressly indicates, however, that the parties may propose modifications to the default protective order, including providing additional tiers or categories of confidential information, such as “Attorneys’ Eyes Only,” but notes that prosecution bars are rarely appropriate. Page 58.