Practice before the Patent Trial and Appeals Board
Part Two

Practicing Law Institute
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Trial Proceedings

Petition Filed → PO Preliminary Response → Decision on Petition → PO Response & Motion to Amend Claims → Petitioner Reply to PO Response & Opposition to Amendment → PO Reply to Opposition to Amendment → Oral Hearing → Final Written Decision

3 months → No more than 3 months → 3 months → 3 months → 1 month → Hearing Set on Request

PO Discovery Period → Petitioner Discovery Period → PO Discovery Period → Period for Observations & Motions to Exclude Evidence

No more than 12 months

PO = Patent Owner
The Board will enter a Scheduling Order concurrent with the decision to institute a trial.

The Scheduling Order will set due dates for the trial taking into account the complexity of the proceeding but ensuring that the trial is completed within one year of institution.
Initial Conference Call

- An initial conference call will be conducted within about one month from the date of institution of the trial to discuss:
  - the Scheduling Order and
  - any motions that the parties anticipate filing during the trial

- A list of proposed motions should be filed no later than two business days prior to the conference call
• AIA authorizes the Office to set standards and procedures for the taking of discovery
• Discovery rules allow parties to agree to discovery between themselves
• Final rules provide for:
  ➢ mandatory initial disclosures;
  ➢ routine discovery; and
  ➢ additional discovery
Protective Orders

• The parties are encouraged to agree on the entry of a stipulated protective order
  – Absent such agreement, the default standing protective order will be automatically entered

• The protective order take effect upon the filing of a Motion to Seal by a party and remain in place until lifted or modified by the Board

• The Board has the authority to enforce the terms of the Protective Order, to provide remedies for its breach, and to impose sanctions
Depositions

• Taking testimony - § 42.53

• Testimony guidelines - Practice Guide, Appendix D

• Compelling testimony and production - § 42.52(a)
  – A party seeking to compel testimony or production of documents or things must file a motion for authorization

• Coaching and objections