



PETITION PRACTICE TIPS

CITATIONS

General Considerations

IPR for AIA patents: Wait for 9-month PGR window	(35 U.S.C. § 311(c))
No sovereign immunity for state-owned patents	<i>Rgts. Minn. v. LSI</i> , 926 F.3d 1327 (Fed. Cir. 2019)
Consider two or more petitions; no partial institution Rank & explain multiple petitions	<i>SAS Inst. v. Iancu</i> , 138 S. Ct. 1348 (2018); TPG July, 2019; <i>Bentley Motors v. Jaguar</i> , IPR2019-01539, Paper 3
No standing for petitioner to appeal final decision	<i>JTEKT v. GKN</i> , 898 F.3d 1217 (Fed. Cir. 2018) (cert. den.)
Do not duplicate prosecution history arguments	<i>Hospira v. Genentech</i> , IPR2017-00739, Paper 16 Inform.

Word Count Limits (37 C.F.R. § 42.24)

14,000 words: IPR Petition, POPR, Response; 5600 words: Reply, Sur-Reply; 18,700 words: PGR, CBM	Trial Practice Guide Update, August 2018 <i>EMC Corp. v. IV I</i> , IPR2017-00429, Paper 11
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Confidential Information (37 C.F.R. §§ 42.54-55)

File motion to seal & protective order as appendix	<i>Polygroup v. Willis Electric</i> , IPR2016-00800, Paper 28
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Confidential Information (37 C.F.R. § 42.56)

Expunge confidential information within 45 days after institution denial or final decision	<i>Jiawei Tech. v. Simon Nicholas</i> , IPR2014-00935 Paper 67 <i>RPX Corp. v. VirnetX</i> , IPR2014-00171, Paper 62 Consolidated Trial Practice Guide Nov. 2019, p. 21
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PETITION RULES COMPLIANCE

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Mandatory Notices (37 C.F.R. § 42.8(b)(1); 35 U.S.C. § 315(b))

Identify immediate parent as RPI - 315(b) bar	<i>Sirius v. Fraunhofer</i> , IPR2018-00681, Paper 12
Update RPI — no prejudice or bad faith	<i>Proppant v. Oren Tech.</i> , IPR2017-01917, Paper 86 Prec.
Update RPI w/in 21 days of merger or acquisition	<i>Lumentum v. Capella</i> , IPR2015-00739, Paper 38 Prec.

Translations (37 C.F.R. § 42.63)

Translator certifies translation & may be deposited Evidence of translator credibility	<i>Daifuku v. Murata</i> , IPR2015-00085, Papers 22, 66 <i>Sumitomo v. UTC</i> , IPR2017-00966, Paper 19
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Claim Construction (37 C.F.R. §§ 42.100(b), 42.104(b)(3))

<i>Phillips</i> interpretation: Effective Nov. 13, 2018	83 Fed. Reg. No. 197, 51340 (Oct. 11, 2018)
Construe necessary limitations; address District Court construction; prosecution disclaimer?	<i>Apple v. VirnetX</i> , IPR2014-00481, Paper 35 <i>Ford v. TMC Fuel</i> , IPR2014-00272, Paper 36
Preamble limiting	<i>Mylan v. Aventis</i> , IPR2016-00712, Paper 9
Means-plus-function identification of structure/algorithm	<i>Seabery v. Lincoln Global</i> , IPR2016-00840, Paper 11 <i>Sega v. Uniloc</i> , IPR2014-01453, Paper 27

Content of Petition (37 C.F.R. §§ 42.104(b)(4), (b)(5))

Use claim charts; Explain figures & tables	<i>GN Resound v. Oticon</i> , IPR2015-00103, Paper 13
Inherency — is the claim element “necessarily present” in prior art?	<i>Luye Pharma v. Alkermes</i> , IPR2016-01096, Paper 74 <i>Baxter Int’l v. Millenium</i> , IPR2013-00582, Paper 48
Obviousness — why POSA would have (not “could have”) combined references with reasonable expectation of success	<i>In re Nuvasive</i> , 842 F.3d 1376 (Fed. Cir. 2016) <i>Belden v. Berk-Tek</i> , 805 F.3d 1064 (Fed. Cir. 2015) <i>Seabery v. Lincoln Global</i> , IPR2016-00904, Paper 12
Analogous art — general assertions insufficient	<i>Airbus v. Firepass</i> , 941 F.3d 1347 (Fed. Cir. 2019) <i>Coalition v. Anacor</i> , IPR2015-01776, Paper 70 <i>Pure Fishing v. Globberide</i> , IPR2015-01252, Paper 30
Applicant admitted prior art 35 U.S.C. § 311(b)	<i>One World v. Chamberlain</i> , IPR2017-00126, Paper 67 <i>Intri-Plex v. Saint-Gobain</i> , IPR2014-00309, Paper 83 <i>Kingbright v. Cree</i> , IPR2015-00741, Paper 8

Public Accessibility (37 C.F.R. § 42.104)

Threshold showing of accessibility required	<i>Hulu v. Sound View</i> , IPR2018-01039, Paper 29 (POP) <i>Frontier Therapeutics v. Medac</i> , IPR2016-00649, Paper 10
Catalog distributed at trade show without restriction	<i>GoPro v. Contour</i> , 908 F.3d 690 (Fed. Cir. 2018)
Copyright notice insufficient by itself	<i>Sprint v. TC Techn.</i> , IPR2017-00771, Paper 14 <i>Microsoft v. Corel</i> , IPR2016-01083, Paper 14
Internet Archive (“Wayback Machine”) declaration	<i>Amneal v. Jazz Pharm.</i> , IPR2015-00545, Paper 69
Thesis: ProQuest declaration; WorldCat database	<i>Samsung v. Image Processing</i> , IPR2017-00336, Paper 15 <i>OneD Material v. Nexeon</i> , IPR2016-01528, Paper 10
Federal Register notice hyperlinked on FDA website	<i>Jazz Pharm. v. Amneal</i> , 895 F.3d 1347 (Fed. Cir. 2018)

Rule 132 Declarations in Prosecution History

Rule 132 Declarant deposition	<i>Mylan v. Qualicaps</i> , IPR2017-00203, Paper 35 <i>Mylan v. Allergan</i> , IPR2016-01127, Paper 28
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Lead Compound Theory

Proofs are demanding	<i>Incyte v. Concert Pharm.</i> , IPR2017-01256, Papers 9, 14 <i>Mylan v. AstraZeneca</i> , IPR2015-01340, Paper 79
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RESPONSE PRACTICE TIPS

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Preliminary Response (37 C.F.R. § 42.107(a))

§ 315(b) bar: unidentified RPI clear beneficiary Patent Owner cannot appeal denial of time-bar defense Federal Circuit cannot review joinder decision	<i>Appl’ns v. RPX</i> , 897 F.3d 1336 (Fed. Cir. 2018) <i>Thryv v. Click-To-Call</i> , 140 S. Ct. 1367 (2020) <i>Facebook v. Windy City</i> , 2018-1400 (Fed. Cir. 2020) Pending
§ 315(b) bar: petition filed > 1 yr. after complaint served on RPI or privy, even if voluntary dismissal	<i>LG v. Mondis</i> , IPR2015-00937, Paper 8 Prec. <i>Ventex v. Columbia</i> , IPR2017-00651, Paper 148 Prec. <i>GoPro v. 360Heros</i> , IPR2018-01754, Paper 38 (POP)
§ 315(b) bar: post-petition merger time-barred RPI	<i>Power Integ. v. SCI</i> , 926 F.3d 1306 (Fed. Cir. 2019)
§ 314(a), § 325(d) denial — prior petition/prior exam. substantially the same art or argument Similarly situated infringement defendants Co-pending district court case nearing trial	<i>General Plastic v. Canon</i> , IPR2016-01357, Paper 19 Prec. <i>Becton, D. v. B. Braun</i> , IPR2017-01586, Paper 8 Prec. <i>Valve Corp. v. Elec. Script.</i> , IPR2019-00062 Paper 11 Prec. <i>NHK Spring v. Intri-Plex</i> , IPR2018-00752, Paper 8 Prec. <i>Apple v. Fintiv</i> , IPR2020-00019, Paper 11 Prec.
Insufficient evidence of public accessibility	<i>Blue Calypso v. Groupon</i> , 815 F.3d 1331 (Fed. Cir. 2016) <i>Shenzhen Zhiyi v. iRobot</i> , IPR2017-02133, Paper 8 <i>Mylan v. Boehringer</i> , IPR2016-01566, Paper 15

Not all challenges meet reasonable likelihood std.	<i>Deeper, UAB v. Vexilar</i> , IPR2018-01310, Paper 7 Inform.
Claim limitation not disclosed in reference	<i>Nidec Motor v. Zhongshan</i> , 851 F.3d 1270 (Fed. Cir. 2017)
Board may not give “unreasonable” construction	<i>In re Smith</i> , 871 F.3d 1375 (Fed. Cir. 2017)
Clear, unambiguous prosecution disclaimer?	<i>Trivascular v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016)
Inherency not established as necessarily present	<i>Luye Pharma v. Alkermes</i> , IPR2016-01096, Paper 74
Conclusory explanation of reason to combine	<i>Daifuku Co. v. Murata</i> , IPR2015-00084, Paper 10
Rule 132 decl. unexpected results not addressed	<i>Mylan v. Aventis</i> , IPR2016-00712, Paper 9

Disclaim Challenged Patent Claims (37 C.F.R. § 42.107(e))

No institution where all challenged claims disclaimed	<i>Gen'l Elec. v. United Tech.</i> , IPR2017-00491, Paper 9 Prec.
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New Testimonial Evidence (37 C.F.R. § 42.108(c))

Use NTE for “rifle shot” issues: claim construction Misinterpretation of prior art	<i>Mastercraft Boat v. Malibu</i> , IPR2016-01057, Paper 12 <i>The Clorox Co. v. Auto-Kaps</i> , IPR2016-00821, Paper 7 <i>Illumina v. Cornell Research</i> , IPR2016-00549, Paper 15
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Antedate §§ 102(a), (e) Reference (37 C.F.R. § 42.53(a))

Use corroborating documentary evidence for invention story	<i>NFC Tech. v. Matal</i> , 871 F.3d 1367 (Fed. Cir. 2017) <i>Green Cross v. Shire</i> , IPR2016-00258, Paper 89
Use deposition clips, live testimony is rare PTAB authorization required Inventor dec. req'd for live testimony at oral hearing	<i>K-40 Electr. v. Escort</i> , IPR2013-00203, Paper 34 Prec. <i>Corning v. DSM IP</i> , IPR2013-0043, Paper 41 <i>DePuy v. MEDIDEA</i> , IPR2018-00315, Paper 29 Prec.

Object to Evidence (37 C.F.R. § 42.64)

PO file objections ≤ 10 bus. days after institution; Otherwise file 5 bus. days after evidence served	<i>Factual v. Locata</i> , IPR2015-00224, Paper 21
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MOTION PRACTICE TIPS

CITATIONS

Motion Supplemental Info. (37 C.F.R. § 42.123)

Confirm public accessibility of printed publication	<i>TLM Ericsson v. TCL</i> , 941 F.3d 1341 (Fed. Cir 2019) <i>Seabery v. Lincoln Global</i> , IPR2016-00840, Paper 40
Intervening court decision	<i>Curt G. Joa v. Fameccanica.Data</i> , IPR2016-00906, Paper 62
Challenge new claims added in litigation	<i>Facebook v. Windy</i> , 2018-1400, U.S. Br. n.5 (Fed. Cir. 9/17/19)

Motion Join Instituted IPR (37 C.F.R. § 42.122(b))

Within one month after institution; impact on 1 st IPR	<i>Kyocera v. Softview</i> , IPR2013-00004, Paper 15
Same party new issue joinder — ltd. circumstances	<i>Proppant v. Oren Tech.</i> , IPR2018-00914, Paper 38 Prec.

Motion Add'l Discovery (37 C.F.R § 42.51(b)(2))

Specific requests, docs. not otherwise available	<i>Garmin v. Cuozzo</i> , IPR2012-00001, Paper 26 Prec.
Protective Order relief in District Court required?	<i>Daifuku v. Murata Machinery</i> , IPR2015-00085, Paper 17 <i>Meyer Prods. v. Douglas</i> , IPR2015-01247, Paper 12
Patent Owner secondary considerations evidence from Petitioner – copying, praise	<i>Polygroup v. Willis</i> , IPR2016-00800, Paper 28 <i>Daifuku v. Murata Machinery</i> , IPR2015-00085, Paper 17
Real party in interest evidence	<i>Ventex v. Columbia</i> , IPR2017-00651, Papers 73, 93

Motion Exclude Evidence (37 C.F.R. § 42.64(c))

Expert opinion testimony (Fed. R. Evid. 611(c))	<i>Universal Remote v. Universal</i> , IPR2014-01146, Paper 36
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Hearsay not subject to exception (Fed. R. Evid. 802)	<i>Google v. Meiresonne</i> , IPR2014-01188, Paper 38
Unauthenticated documents (Fed. R. Evid. 901)	<i>Xactware v. Pictometry</i> , IPR2016-00594, Paper 46
Motion Correct Claim Errors (37 C.F.R. §§ 42.20, 1.323)	
Only for clerical errors having no affect on claim scope	<i>Phibro v. Micron.</i> , IPR2016-00435, Paper 10 (granted) <i>Douglas Dyn. v. Meyer</i> , IPR2015-01839, Paper 51 (denied)
Motion Amend Claim (37 C.F.R. § 42.121)	
Board may raise new ground of unpatentability	<i>Nike v. Adidas</i> , 955 F.3d 45 (Fed Cir. 2020) <i>Hunting Titan v. Dyna</i> , IPR2018-00600, Paper 67 (POP)
Narrow claims; no new matter; respond to instituted ground; burden of proof on Petitioner	<i>Aqua Prod. v. Matal</i> , 872 F.3d 1290 (Fed. Cir. 2017) (en banc) <i>Lectrosonics v. Zaxcom</i> , IPR2018-001129, Paper 15 Prec.
Two chances to amend claims — prelim. guidance Board may consider §§ 101 and 112 issues	<i>Mylan v. Sanofi</i> , IPR2018-01679, Paper 55 <i>Uniloc v Hulu</i> , 2020 WL 4197750 (Fed. Cir. 2020) <i>Amazon v. Uniloc</i> , IPR2017-00948, Paper 34 Prec.
Request late filing of MTA	<i>F5 Networks v. Radware</i> , IPR2017-00124, Paper 24
Petitioner Sur-Reply, cross-examine MTA reply witness	Trial Practice Guide Update, August 2018 <i>Samsung v. Promos</i> , IPR2017-00037, Paper 21
REPLY PRACTICE TIPS	
CITATIONS	
Reply (37 C.F.R. § 42.23(b))	
New, responsive evidence permissible	<i>Genzyme v. Biomarin</i> , 825 F.3d 1360 (Fed. Cir. 2016)
Response Options for Patent Owner	
Depose Reply declarant	<i>Respironics v. Zoll Medical</i> , IPR2013-00322, Paper 26
Sur-Reply, ID improper Reply evidence/arguments	Trial Practice Guide Update, August 2018 <i>Google v. Vedantis Systems</i> , IPR2016-00212, Paper 26
Raise issue at oral hearing	<i>Genzyme v. Biomarin</i> , 825 F.3d 1360 (Fed. Cir. 2016)
ORAL ARGUMENT & DEMONSTRATIVES	
CITATIONS	
Object to new arguments at hearing	<i>Dell v. Acceleron</i> , 884 F.3d 1364 (Fed. Cir. 2018)
Object to new evidence or argument in demonstrative	<i>Medtronic v. Barry</i> , IPR2015-00780, Paper 48
Highlight expert testimony, claim limitations, prior art	<i>Medtronic v. Barry</i> , IPR2015-00780, Paper 48
ESTOPPEL	
CITATIONS	
Petitioner Estoppel (35 U.S.C. § 315(e))	<i>Great West v. IV II</i> , IPR2016-01534, Paper 13 <i>Zitovault v. IBM</i> , No. 16-0962 (N.D. Tex. Apr. 4, 2018)
“Reasonably could have raised” Estoppel	<i>Sionyx v. Hamamatsu</i> , 330 F. Supp. 3d 574 (D. Mass. 2018) <i>Kingston v. SPEX</i> , IPR2018-01002, Paper 12
Estoppel applied claim-by-claim	<i>Westlake v. Credit Accept.</i> , CBM2014-00176, Paper 28 Prec.
Patent Owner Estoppel (37 C.F.R. § 42.73(d)(3))	<i>Arthrex v. Smith & Nephew</i> , 880 F.3d 1345 (Fed. Cir. 2018)
No Assignor Estoppel in IPR proceedings	<i>Arista v. Cisco</i> , 908 F.3d 792 (Fed. Cir. 2018)
PGR WRITTEN DESCRIPTION	
CITATIONS	
Dosing regimen unpatentable	<i>Grünenthal v. Antecip</i> , PGR2017-00008, Paper 43