



Evidentiary Extravaganza

Strategic Use of Evidence at the PTAB

March 16, 2023

FISH.

Meet The Speakers



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Overview

- Housekeeping
 - CLE
 - Questions
 - Materials
 - <http://www.fr.com/webinars>



The Basics of Design Patents

Thursday, March 23, 2023 | 1:30 - 2:30 p.m. ET

Design patents are a crucial component of a comprehensive IP protection plan. Unlike utility patents, which protect the way a product functions, design patents protect the way a product looks. Because they often protect the most recognizable, consumer-facing aspects of the products they cover, design patents can be tremendously valuable to their owners.

In the first installment of our three-part design patent webinar series, Principals [Joseph Herriges](#) and [Grace Kim](#) will illuminate the basics of design patents and address common questions.

REGISTER

PRESENTED BY:



[Joseph Herriges](#)
Principal



[Grace Kim](#)
Principal

WHAT YOU'LL LEARN

Joe and Grace will discuss the following topics and more:

- What are design patents?
- How do design patents differ from utility patents?
- Why should you obtain design patent protection?
- How can you best prepare your design patent application for prosecution?

Agenda

- **Effective Use of Corroborating Evidence**
- **Supplemental Evidence and Information**
- **Discovery**
- **Motions to Strike and Motions to Exclude**



Effective Use of Corroborating Evidence

Effective Use of Corroborating Evidence

- “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 CFR § 42.65.
- Panels routinely afford limited or no weight to uncorroborated expert testimony
- Watch out for any statement in the expert declaration that does not have a supporting citation
- E.g., provide corroboration for what “a POSITA would have known or understood”

Effective Use of Corroborating Evidence

- **Common Mistakes:**
 - Only relying on ground references to demonstrate motivations to combine
 - Corroborating evidence can be most impactful when used to show motivation to combine
- **Arguing predictable results without any support (other than expert testimony)**
 - Persuasive to show obviousness of a combination that describes the result of the combination

Xerox v. Bytemark (precedential)

- Petitioner relied on arguments relating to the perspective of a POSITA and provided an expert declaration in support of those arguments
- Expert declaration merely recited verbatim the petition language without additional testimony or evidence
- Board determined that Petitioner did not provide sufficient evidence or sufficient reasoning to support its invalidity positions
- Board determined that Petitioner's expert's declaration did not provide an additional reasoning or evidence and was entitled to little weight

Xerox Corp. v. Bytemark, Inc., IPR2022-00624, Paper 9 (August 24, 2022) (precedential).



Supplemental Evidence and Supplemental Information

Supp. Evidence and Supp. Information

	Supplemental Information 37 CFR § 42.123	Supplemental Evidence 37 CFR § 42.64
What is	<p>Evidence that is relevant to the merits of a party's case</p> <p>May or may not be relevant to a claim on which trial has been instituted</p>	Evidence offered <u>only</u> to support admissibility of originally filed evidence
Timing	<p>Once Board authorizes filing motion to submit supp info and grants the same</p> <p>Seek authorization:</p> <ol style="list-style-type: none"> 1. Within one-month after institution 2. More than one month after – higher burden showing 	<p>Served within ten business days of service of an objection to evidence</p> <p>Filed only in support of opposition to motion to exclude</p>

Pop Quiz: Supp. Info. or Supp. Evid.?

- Petitioner submits an expert declaration in support of its Petition
- In its POPR, Patent Owner offers a definition of a POSITA's skill level that is different from one offered in Petition
- After institution, Patent Owner objects that expert testimony of Petitioner's expert is inadmissible because the expert is not qualified (or expert does not meet Patent Owner's definition of a POSITA)
- **What can Petitioner do?**

37 C.F.R. § 42.123 Filing of Supplemental Information

(a) Motion to submit supplemental information. Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

- (1) A **request for the authorization to file a motion** to submit supplemental information is made **within one month of the date the trial is instituted.**
- (2) The supplemental information **must be relevant to a claim for which the trial has been instituted.**



- Additional considerations:
 - Changes to invalidity grounds or evidence presented to support those grounds
 - Information reasonably could not have been submitted with petition

37 C.F.R. § 42.123 Filing of Supplemental Information

(b) Late submission of supplemental information.

- A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information **reasonably could not have been obtained earlier**, and that **consideration of the supplemental information would be in the interests-of-justice**.

Interests of Justice Factors

PTAB may consider several different factors, including the following:

1. that the Supplemental Information **did not change the authorized grounds or add additional grounds of unpatentability**;
2. that the Supplemental Information **merely constituted additional evidence related to a relevant exhibit**, e.g., admissibility (i.e., public accessibility);
3. that the Supplemental Information **was not withheld intentionally**;
4. that [party] **appears to have made “continuous attempts” to obtain the Supplemental Information**;
5. that the submission of the Supplemental Information at the current time would **not appear to limit the PTAB’s ability to complete the proceedings in a timely manner**;
6. Whether opposing party will suffer **undue prejudice** from introduction of evidence

37 C.F.R. § 42.123 Filing of Supplemental Information

(c) Other supplemental information.

A party seeking to submit supplemental information **not relevant to a claim for which the trial has been instituted** must request authorization to file a motion to submit the information. The motion must show why the supplemental information **reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.**

POP QUIZ - #1

- After institution, Petitioner files its petitioner reply supported by a reply declaration from its expert
- During deposition of Petitioner's expert in connection with the expert's reply declaration, Patent Owner cross-examined expert with two exhibits—a patent and a web page—to challenge an argument raised for the first time in the reply declaration
- New exhibits likely contradict testimony in the reply declaration
- **Can Patent Owner file a motion to submit supplemental information? And if so, would Patent Owner prevail?**

POP QUIZ - #1

- **Can Patent Owner file a motion to submit supplemental information? And if so, would Patent Owner prevail?**
 - (1) Yes. But motion is being made more than 30 days after institution. So, motion will need to explain why exhibits reasonably could not have been entered earlier and why interests of justice are served by their entry
 - (2) Yes. New unforeseeable argument and interests of justice favored entry because evidence contradicted Petitioner's expert testimony and would allow Board to weigh credibility and would provide more complete record

Group III Int'l, Inc. et al. v. Targus Int'l LLC, IPR2021-00371, Paper 76 (Mar. 28, 2022)

POP QUIZ - #2

- Board instituted an IPR and noted reasonably likelihood of prevailing for a first set of claims but not for a second set of claims.
- For second set of claims, Board expressed confusion about a particular claim mapping in the Petition.
- **What can Petitioner do?**

POP QUIZ - #2

- **What can Petitioner do?**

- Request authorization to submit motion for supplemental information with 30 days of ID
- Seek submission of expert declaration clarifying mapping—noting that no invalidity ground or evidence for the same is being changed.

Apple Inc. v. Telefonaktiebolaget LM Ericsson, IPR2022-00343, Paper 14 (Nov. 10, 2022)



Discovery

Basis for Discovery

- The parties may agree to additional discovery, or a party may move for additional discovery, showing “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2).
- Discovery in IPR proceedings is limited to (1) depositions of declarants and (2) “what is otherwise necessary in the interest of justice.” 35 U.S.C. § 316(a)(5).
- **The *Garmin* Factors**
 - (1) more than a possibility and mere allegation that something useful will be discovered;
 - (2) requests that do not seek other party’s litigation positions and the underlying basis for those positions;
 - (3) ability to generate equivalent information by other means;
 - (4) easily understandable instructions;
 - (5) requests that are not overly burdensome to answer.

See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).

Samsung v. Netlist

- **Post institution, Netlist requested discovery on Samsung's relationship with Google**
 - Petition was otherwise time barred if Google was an RPI or privy of Netlist
- **Director granted review *sua sponte***
 - Discovery requests were found timely because Netlist attempted to meet and confer with Samsung, and the rules permitted the request

Samsung Elecs. Co., Ltd. v. Netlist, Inc., IPR2022-00615, Paper 40 (February 3, 2023) (Vidal).

Samsung v. Netlist (continued)

- **Netlist's Requests:**

- Requests 1 & 7: Non-public deposition testimony from Samsung's corporate representatives in a district court case between the parties (GRANTED)
- Requests 2 & 3:
 - Agreements between Samsung and Google related to products accused of infringing (GRANTED)
 - Agreements between Samsung and Google related to “the terms of any supplier agreements between” the parties (DENIED)
- Requests 4-6: Indemnification agreements and communications between Samsung and Google related to the corresponding patent litigation and IPR (GRANTED)

Samsung Elecs. Co., Ltd. v. Netlist, Inc., IPR2022-00615, Paper 40 (February 3, 2023) (Vidal).

Twitter v. Palo Alto Research Center

- Patent Owner sought **discovery of an unfiled draft declaration** that Petitioner's declarant referenced in his deposition, arguing that the draft was "routine discovery" and that the declarant had waived privilege by using it for deposition preparation
- Petitioner argued that the declarant inadvertently relied on one sentence from the draft declaration relating to claim construction and that it did not waive privilege; did not seek to "claw back"
- **Board determined that FRCP 26 allows for discovery of "facts and data" but not mental impressions of attorneys or expert opinion evidence based on facts and data and that Patent Owner did not show how a claim construction theory represents "facts and data"**
- **Board stated that a draft declaration exposes a lawyer's mental processes and is protected work product until filed**

Twitter, Inc. v. Palo Alto Research Center Inc., IPR2021-01398, Paper 33 (November 18, 2022)



Motions to Strike and Motions to Exclude

Motion to Exclude

- ***What it is used for:*** To exclude evidence submitted by another party in the proceeding (objections based on evidence admissibility under FRE)
- ***What it cannot be used for:*** Challenge sufficiency of the evidence offered to prove a fact or the weight that should be given to the evidence
- ***Procedure for filing motion to exclude*** (37 CFR § 42.64)
 - Timely object (10-business days for pre-institution evidence; 5-business days for post-institution evidence)
 - Objection must have “sufficient particularity”
 - File motion to exclude for objected-to evidence by date specified in Scheduling Order

Objections

- **§ 42.64 Objection; motion to exclude**
 - **(a) *Deposition evidence.*** An objection to the admissibility of deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition, unless the parties to the deposition stipulate otherwise on the deposition record.
 - **(b) *Other evidence.*** For evidence other than deposition evidence:
 - **(1) *Objection.*** Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be filed within five business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.
 - **(2) *Supplemental evidence.*** The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.

Motion to Exclude

- ***Will the Board Rule on Motion to Exclude Prior to Oral Hearing:*** Generally no, unless evidence is central to the parties' dispute. Ruling generally provided along with FWD.
- ***Likelihood of success on motion to exclude:*** 90+% denial rate
- ***Winning issues:*** challenges to authenticity of evidence; printed publication status
- ***Losing issues:*** Qualifications of expert
- ***Motivations for objections and motions to exclude***
 - Preserve issue for appeal
 - Convince Board to give less weight to certain evidence

Pop Quiz: Can I move to exclude?

- Patent Owner does not believe that Petitioner's expert is a qualified witness because the expert did not have the qualifications of a POSITA [as of the critical date].
 - *Kyocera Senco Indus. Tools Inc. v. ITC*, No. 20-1046 (Fed. Cir. Jan. 21, 2022)
 - *Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC*, IPR2020-01386, Paper 37, at 73-74 (Jan. 31, 2022)
 - *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01131, Paper 30, at 32-34 (Dec. 20, 2022)

Motion to Strike

- ***What it is used for:*** Strike portions of an opposing party's briefing that (1) raises new issues, (2) is accompanied by belatedly presented evidence, or (3) exceeds the proper scope of a reply/sur-reply.
- ***What it cannot be used for:*** Challenge admissibility of evidence
- ***Procedure for filing motion to strike***
 - Seek Board's authorization to file the motion QUICKLY (generally within “**one week of the allegedly improper submission**”)
 - Be specific and limited in portion of briefing you are seeking to strike (wholesale striking of briefs is considered “an exceptional remedy”)
 - Consider alternative remedies in motion (e.g., additional briefing, observations)
- ***Will the Board rule on motion to strike prior to oral hearing:*** Maybe but not guaranteed

Motion to Strike

- ***Likelihood of success:*** Depends on how clear the violation is
 - ***High Likelihood:*** New evidence submitted with sur-reply
 - ***Lower Likelihood:*** New arguments/evidence that exceed the scope of a prior paper
- ***Practical considerations***
 - How clear is the violation?
 - Does evidence in record rebut the argument/issue?
 - Consider alternative remedies (additional briefing, observations)

Pop Quiz: Can I move to strike?

- (1) Patent Owner submitted, with sur-reply, expert declaration rebutting positions in Petitioner's Reply.
- (2) Patent Owner submitted, with sur-reply, exhibits introduced to cross-examine Petitioner's expert with respect to declaration submitted with Petitioner's Reply.



Appendix



Motions for Observations

Motions for Observations

- **Useful for raising issues after the close of substantive briefing**
 - E.g., after PO Sur-Reply
- **No argument allowed, can only identify evidence in the record.**
- **Useful as a hook to later raise issues at oral hearing.**



Leveraging “Unusual” Prior Art

Leveraging “Unusual” Prior Art

- Only “patents or printed publications” can form the basis of prior art grounds asserted in IPR. See 35 U.S.C. § 311(b).
- Per the Fed. Circuit, Applicant admitted prior art (AAPA) cannot form “the basis” of an IPR ground.
 - AAPA “is not contained in a document that is a prior art patent or prior art printed publication.”

Leveraging “Unusual” Prior Art

- But AIPA can be used as supporting or corroborating evidence in an IPR. For example:
 - To “establish[] the background knowledge possessed by a person of ordinary skill in the art;
 - To “furnish[] a motivation to combine;” or
 - Even to “supply[] a missing claim limitation.”

See Qualcomm v. Apple, 24 F. 4th 1367, 1376 (Fed. Cir. 2022).

Leveraging “Unusual” Prior Art

- With AAPA, be wary of hindsight
- Make absolutely sure that statements in the AAPA are describing the prior art, and ***not the invention***
 - If there is any question, consider developing other evidence
 - Regardless, expect PO to argue hindsight, and get ahead of it if possible
 - ***E.g., in Petition, explain why the statements are admissions about the prior art, not invention***

Leveraging “Unusual” Prior Art

- **Printed Publication Art v. System Art**

- CalTech’s broad estoppel is controlling law – encompasses all grounds “which reasonably could have been asserted against the petitioned claims”
- Conventional wisdom is that IPR estoppel does not encompass system art (IPR estoppel only applies to printed publications and patents).
- BUT: What if features of a system are fully captured in a printed publication? Does estoppel apply?

Leveraging “Unusual” Prior Art

- ***Wasica Finance GmbH v. Schrader Int’l, Inc.*, C.A. No. 13-1353-LPS, D.I. 193 (D. Del. Jan. 21, 2020)**
 - After FWD where one claim survived, Petitioner/accused infringer argued invalidity in view of system art (certain sensors).
 - Court reasoned an article disclosed all features of the prior art sensors and was materially identical prior art publication. So, accused infringer was estopped from relying on the system art
- **Practical considerations**
 - *Petitioner*: When developing IPR strategy, think through litigation invalidity options to map out system-art based invalidity.
 - *Patent Owner*: If a claim has survived IPR, search for printed publications of asserted system art to preclude invalidity challenge via estoppel
- ***Final Thoughts***: What if all features are not disclosed in an article but a crafty lawyer argues obviousness (e.g., single reference, multiple references) to supply the missing features?



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