

Strategic Use of Evidence at the Patent Trial and Appeal Board (PTAB)

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Status: **Maintained** | Jurisdiction: **United States**

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A Practice Note discussing the strategic use of evidence in *inter partes* review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB). This Note discusses strategy and best practices for introducing and using corroborating evidence in support of expert testimony, submitting supplemental information, obtaining additional discovery under the PTAB's *Garmin* factors, and filing and responding to motions to exclude or strike.

The relatively fast-paced nature and limited discovery of *inter partes* review (IPR) proceedings at the Patent Trial and Appeal Board (PTAB) present significant challenges to patent owners and petitioners seeking to obtain and use evidence to support their positions on the challenged claims' patentability. IPR counsel therefore must be well versed in the various mechanisms and strategies for obtaining and using evidence during the IPR trial.

This Note discusses strategic considerations and best practices for:

- Using corroborating evidence to support expert testimony.
- Submitting post-institution supplemental evidence to introduce additional information into the IPR record.
- Obtaining additional discovery under the PTAB's *Garmin* factors.
- Filing and responding to motions to exclude or strike evidence.

For more on:

- Obtaining additional discovery in IPR, including model motions and responses, see [PTAB Proceedings Toolkit: Motions for Additional Discovery](#).
- Expert discovery in IPR, see [Practice Note, Inter Partes Review: Expert Considerations](#).
- Motions to exclude in IPR, including model motions and responses, see [PTAB Proceedings Toolkit: Motions to Exclude](#).

For more IPR resources, see [PTAB Proceedings Toolkit](#).

Corroborating Evidence

The PTAB gives little or no weight to expert testimony that does not disclose the underlying facts or data on which the opinion is based (37 C.F.R. § 42.65). The expert should therefore use corroborating evidence, including patents, papers, and other teachings, to support their testimony and ensure that the PTAB gives it the weight it deserves. When evaluating an expert's declaration, IPR counsel should work with the expert to ensure that statements in the declaration are supported or corroborated by the corroborating evidence. Corroborating evidence, in tandem with expert testimony, can be persuasive to demonstrate the obviousness or non-obviousness of the combination.

For example, counsel may use corroborating evidence to strengthen an expert's assertion of what a person of ordinary skill in the art (POSITA) would or would not have understood at the time of invention. When a petitioner or patent owner argues that a POSITA would have known or understood a particular fact or had a specific conclusion, practitioners should consider citing corroborating evidence (such as one or more additional prior art references) that supports the expert's assertion.

Parties can also use corroborating evidence to strengthen arguments regarding a motivation to combine prior art, and predictable results of a proposed combination. Petitioners often overlook the benefit of citing evidence corroborating a proposed combination and the associated motivations to combine the presented references. This evidence can amplify and validate a hypothetical

proposed combination while avoiding the appearance of impermissible hindsight bias in presenting a particular prior art combination.

Petitioners should also consider leveraging corroborating evidence in addition to expert testimony when arguing predictable results stemming from a proposed combination. Patent owners should likewise consider leveraging corroborating evidence in addition to expert testimony when arguing that:

- There would be no motivation to combine particular references.
- The proposed combination would not be combined in the manner proposed by the petitioner.

Parties should cite corroborating evidence in the expert's declaration as well as in the paper that references the expert's testimony. At the very least, citing the corroboration reference in the relevant paper that relies on the testimony may preclude the opposing party from asserting improper incorporation by reference (see, for example, 37 C.F.R. § 42.6(a)(3); *Hopkins Mfg. Corp. v. Cequent Performance Prods.*, IPR 2015-00616, Paper 9 at 14-15 (PTAB Aug. 17, 2015) (given pervasive incorporation by reference, focusing review on the argument and evidence actually presented in the petition); *Whole Space Indus. Ltd. v. Zipshade Industrial*, IPR2015-00488, Paper 14 at 12-13 (PTAB July 24, 2015) (refusing to consider arguments incorporated by reference to support conclusory statements in the petition)). These assertions can lead to the PTAB giving little or no weight to the cited testimony or evidence.

Uncorroborated Expert Testimony

In *Xerox Corp. v. Bytemark, Inc.*, the petitioner relied on arguments relating to the perspective of a POSITA and provided an expert declaration in support of those arguments. However, the expert declaration merely recited verbatim the petition language without additional testimony or evidence. The Board determined that:

- The petitioner did not provide sufficient evidence or reasoning to support its invalidity positions.
- The petitioner's expert declaration did not provide additional reasoning or evidence and was entitled to little weight.

(*Xerox Corp. v. Bytemark, Inc.*, 2022 WL 18699466, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022).)

Practitioners should therefore avoid submitting "copy/paste" style expert declarations and instead view the declaration as a vehicle to discuss the expert's reasoning.

The Board specifically looks for additional information that supports the assertions made in the petition (and responsive papers).

For example, if a petitioner's expert asserts that an element was "well-known" in the art at the relevant time, the expert should find and include in the declaration one or more prior art references that corroborate that assertion.

Similarly, if a patent owner's expert asserts that "a POSITA would not have known or understood" a purported prior art teaching, the expert should consider whether adding another reference to the declaration would help that expert's testimony carry more weight.

Supplemental Information

Supplemental information is a post-institution mechanism for getting additional evidence into the IPR record (37 C.F.R. § 42.123). Supplemental information is evidence that is relevant to the merits of a party's case, though it may or may not be relevant to a claim on which trial has been instituted. There are three ways to get supplemental information into the record, two of which are time-based and one of which is subject matter-based, depending on whether the information is:

- Submitted within one month of institution (see Submission Within One Month of Institution).
- Submitted more than one month after institution (see Submission More Than One Month After Institution).
- Not relevant to a claim for which the Board has instituted trial (see Supplemental Information Not Relevant to a Claim for Which the Board Has Instituted Trial).

Submission Within One Month of Institution

Once the PTAB has instituted trial, a party may file a motion to submit supplemental information if both:

- The request for authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.
- The supplemental information is relevant to a claim for which trial has been instituted.

(37 C.F.R. § 42.123(a).)

In addition to the threshold requirements of 37 C.F.R. § 42.123(a), however, practitioners should strongly consider arguing additional matters to support their submission. For example, counsel should also argue that the supplemental information does not change

the asserted invalidity grounds, or that the petitioner reasonably could not have submitted the information with the petition.

In *Apple Inc. v. Telefonaktiebolaget LM Ericsson*, the Board instituted IPR and noted a reasonable likelihood of prevailing for a first set of challenged claims, but not for a second set of challenged claims. For the second set of claims, the Board expressed confusion about a particular claim term in the petition and encouraged the parties to submit additional evidence and arguments regarding the term at issue.

The Board granted the petitioner's motion to supplement the record, noting that its request for the supplemental information was timely and that the requested submission of an expert declaration relating to the term at issue in the second set of claims was relevant to an asserted ground of unpatentability. (IPR2022-00343, Paper 14 (PTAB Nov. 10, 2022).)

In a similar situation then, petitioners should request authorization to submit a motion for supplemental information within 30 days of institution. They should then seek submission of evidence (for example, an expert declaration clarifying the claim term) and further note that no invalidity ground or evidence for the same is being changed.

Submission More Than One Month After Institution

The submitting party faces a higher burden to get supplementary information into the record more than one month after institution. A party seeking to submit supplemental information more than one month after institution 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 (see Foreseeability).
- That consideration of the supplemental information would be in the interests of justice (see Interests of Justice).

(37 C.F.R. § 42.123(b).)

Foreseeability

When considering the merits of a party's argument that the supplemental information reasonably could not have been obtained earlier, some panels focus on the foreseeability of the need for the evidence. For example, a patent owner may assert that exhibits introduced during cross-examination of the petitioner's expert in connection with their reply

declaration are proper where such evidence reasonably could not have been obtained earlier. In particular, where new exhibits relate to arguments that first appeared in the petitioner's expert's reply declaration, the Board has found that the patent owner reasonably could not have been expected to foresee the argument (*Group III Int'l Inc. et al. v. Targus Int'l LLC*, IPR2021-00371, Paper 76 (PTAB Mar. 28, 2022) (finding that entry of the new exhibits was in the interests of justice because the evidence allegedly contradicted the petitioner's expert's testimony and would allow the Board to weigh the credibility of the expert's testimony and provide for a more complete record)).

Interests of Justice

When weighing the interests of justice, the Board may consider whether:

- The supplemental information did not change the authorized grounds or add additional grounds of unpatentability.
- The supplemental information merely constituted additional evidence related to a relevant exhibit, such as admissibility of the evidence based on public accessibility of prior art.
- The supplemental information was not withheld intentionally.
- The submitting party appears to have made continuous attempts to obtain the supplemental information.
- Submission of the supplemental information would not appear to limit the Board's ability to complete the proceedings in a timely manner.
- The opposing party will suffer undue prejudice from introduction of the evidence.

(*Biomarin Pharm., Inc. v. Genzyme Therapeutics Prods., LP*, IPR2013-00534, Paper 80 (PTAB Jan. 7, 2015); *Shire Development, LLC v. Lucerne Biosciences, LLC*, IPR2014-00739, Paper 23 (PTAB Mar. 12, 2015)).

Typically, the Board's decision on the interests of justice factors will depend on whether:

- The party was diligent in trying to get the information into the record.
- Entry of the information will obstruct the Board's ability to conclude the proceeding on time.

For example, in *Group III Int'l*, the petitioner filed its reply supported by a reply declaration from its expert. During deposition of the petitioner's expert in connection with the expert's reply declaration, the patent owner cross-examined the expert with two exhibits, a patent and a web

page, to challenge an argument raised for the first time in the reply declaration. The new exhibits likely contradicted testimony in the reply declaration.

The Board granted the patent owner's motion to supplement the record. Because the motion was made more than 30 days after institution, the patent owner had to explain why the exhibits reasonably could not have been entered earlier and why the interests of justice favored admission. The Board held that a new unforeseeable argument and the interests of justice favored entry because the evidence contradicted the petitioner's expert testimony, would allow the Board to weigh the expert's testimony, and would provide a more complete record. (IPR2021-00371, Paper 76 (PTAB Mar. 28, 2022).)

Supplemental Information Not Relevant to a Claim for Which the Board Has Instituted Trial

A party seeking to submit supplemental information not relevant to an instituted claim 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.
- That consideration of the supplemental information would be in the interests of justice.

(37 C.F.R. § 42.123(c).) A party may wish to submit this type of supplemental information, for example, to resolve real-party-in-interest or privity issues that linger after institution.

Supplemental Information That Modifies Grounds

The Board may deny a request to submit supplemental information if it modifies the originally presented grounds, even if the request otherwise meets the requirements for submission of supplemental information under 37 C.F.R. § 42.123(a).

For example, in *Nanobebe US Inc. v. Mayborn (UK) Ltd.*, the petitioner's motion to submit supplemental information was both timely and relevant to a claim instituted at trial under section 42.123(a). However, the Board denied the petitioner's request to submit a supplemental petition and declaration because it determined that the "Petitioner seeks to bolster its Petition by including further analysis and arguments" regarding the prior art and an omitted claim.

The petitioner argued that it had intended to include discussion of the omitted claim, as evidenced by an

erroneous reference in the initial declaration's table of contents. The Board concluded, however, that neither the initial petition nor initial declaration disclosed this subject matter and the petitioner had not "identified any precedent or rule that suggests [it] can simply correct errors and omissions in a petition using supplemental information that results in the addition of a new analysis." The petitioner additionally did not sufficiently explain why the supplemental information could not have been presented earlier (that is, before the Board or the patent owner identified the errors and omissions). (IPR2023-00465, Paper 21 (PTAB August 17, 2023).)

Discovery

Discovery in IPR proceedings is limited to:

- Depositions of declarants.
- What is otherwise necessary in the interest of justice.

(35 U.S.C. § 316(a)(5).)

Under 37 C.F.R. § 42.51(b)(2), however, the parties may agree to additional discovery, or a party may move for additional discovery, on a showing that the additional discovery is in the interests of justice.

When determining whether admission of evidence is in the interest of justice, the Board considers the following factors set out in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, specifically whether:

- There is more than a possibility and mere allegation that something useful will be discovered.
- The requests do not seek the other party's litigation positions and the underlying basis for those positions.
- The requesting party can generate equivalent information by other means.
- The requests include easily understandable instructions.
- The requests are not overly burdensome to answer.

(2013 WL 11311697, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).)

Generally, additional discovery outside of routine expert declarations typically involves less-common fact patterns. For instance, parties have requested discovery relating to real-parties-in-interest, privity, and objective indicia of non-obviousness. (*Arris Grp., Inc. v. C-Cation Techs, LLC*, IPR2015-00635, Paper 10 (PTAB May 1, 2015) (granting patent owner request for additional discovery of indemnification agreements between petitioner and Comcast to show privity); *Atlas Copco Tools and Assembly Sys., LLC*,

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et al. v. Wildcat Licensing WI, LLC, IPR2020-00891, Paper 37 (PTAB Mar. 18, 2021) (denying patent owner request for additional discovery of documents that support statements made by petitioner to show non-obviousness).)

Applying the *Garmin* Factors

Requests Not Narrowly Tailored

In *Samsung Elecs. Co., Ltd. v. Netlist, Inc.* (Vidal), Netlist requested discovery on Samsung's relationship with

Google after institution to argue that the petition would otherwise be time-barred if Google were a real-party-in-interest or privy of Netlist. The USPTO Director granted review *sua sponte* and found that the discovery requests were timely because Netlist attempted to meet and confer with Samsung and that the rules permitted the request. (IPR2022-00615, Paper 40 (PTAB February 3, 2023).)

Netlist made seven requests. After applying the *Garmin* factors for all seven requests, Director Vidal granted six.

Requests	Outcome
Requests 1 and 7: Non-public deposition testimony from Samsung's corporate representatives in a District Court case between the parties.	Granted. Director Vidal found that the patent owner had tended to show reasoning that something would be uncovered that would be useful to the Board's analysis of Google's interest and any benefit it would have from the proceeding. It had also shown that it could not generate the information from other means because the testimony was under a protective order.
Request 2: Agreements between Samsung and Google related to products accused of infringing.	Granted. The Director found that this request was narrowly tailored and there was evidence that showed whether the petitioner had an exclusive agreement to supply Google that would be useful to the Board to determine whether there was a specially structured, preexisting, and well-established relationship between Google and Samsung.
Request 3: Agreements between Samsung and Google related to the terms of any supplier agreements between the parties.	Denied. The Director found that the patent owner's request for "any" supplier agreements, without specifying the products at issue, leaves the request as mere speculation that something useful might be found.
Requests 4-6: Indemnification agreements and communications between Samsung and Google related to the corresponding patent litigation and IPR.	Granted. The Director found that the indemnification agreements and related communications between the parties likely would help clarify whether Samsung is representing Google's interest or filed the petition on Google's behalf.

Netlist was therefore generally successful in its requests for additional discovery that it narrowly tailored, while being denied on the requests that it did not narrowly tailor. (IPR2022-00615, Paper 40 (PTAB February 3, 2023).)

Accordingly, practitioners should ensure that their discovery requests are specific and are not casting too wide of a net. Practitioners should not be seeking something that merely might be there. They should instead be able to explain what they seek, why they are seeking it, how it relates to the case, and why they do not have access to it through other means.

Draft Expert Declarations

In *Twitter, Inc. v. Palo Alto Research Center Inc.*, during a video deposition, the petitioner's expert testified regarding a sentence in a draft reply declaration that was based on a paragraph from the originally filed declaration. The expert had inadvertently used the draft reply declaration instead of the filed declaration after he mistakenly downloaded the draft version during the video deposition. As a result, the patent owner sought discovery of the entire unfiled draft declaration, arguing that this was "routine discovery" and that the declarant had waived privilege by using the draft version for deposition preparation. The

petitioner argued that the declarant inadvertently relied on one sentence from the draft declaration relating to claim construction and that such limited disclosure did not waive privilege.

The Board determined that Federal Rule of Civil Procedure (FRCP) 26 allows for discovery of “facts and data,” but not mental impressions of attorneys or expert opinion evidence based on facts and data. Here, the patent owner had not shown how the claim construction theory at issue represented “facts and data.” The Board held that a draft declaration exposes a lawyer’s mental processes and is protected work product until it is filed. If there had been any waiver of privilege, it was due to inadvertent and limited disclosure that pertained only to the paragraph of the draft declaration disclosed. (IPR2021-01398, Paper 33 (PTAB November 18, 2022).)

Accordingly, counsel may assert that draft declarations are protected from discovery unless and until they have been filed and served.

Timeliness

In *Walmart Inc. v. Power Concepts, LLC.*, after its request for oral argument, the patent owner moved for additional discovery relating to the petitioner’s product sales data and documents relating to the petitioner’s copying of the patent owner’s products or features of those products. The patent owner argued that the additional discovery was relevant to the commercial success of the petitioner’s product and the petitioner’s copying of the patented design elements into the product.

Discussing the *Garmin* factors, the Board stated that the “fifth Garmin factor and the issue of timeliness inform our design here,” noting that a party seeking discovery should do so “promptly after the need for relief is identified,” and “[d]elay in seeking relief may justify a denial of relief sought.” On the issue of timeliness, the Board found, as it relates to factor five’s requirement, that the request not be “overly burdensome to answer, given the expedited nature” of IPR. That burden includes “meeting the time schedule” of IPR. In its motion for additional discovery, the patent owner did not “identify any factors or issues ... that did not already exist at the time of institution.” The PTAB determined that the patent owner’s request could have been made any time between institution and the filing of the patent owner response. Instead, at a late stage in the proceedings, the patent owner did not “identify any sufficient reason as to why it did not request this discovery sooner.”

The Board further stated that parties “may not now remedy [their] perceived defects” in earlier filings “by

requesting additional discovery which could have been requested several months earlier.” Rather, “the Federal Circuit has held that “[r]ebuttal evidence is supposed to be limited to that which is responsive to the adversary’s evidence: the traditional principle [is] that evidence offered to rebut must accomplish the function of rebuttal; to explain, repel, counteract, or disprove the evidence of the adverse party.” (Quoting *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081-82 (Fed. Cir. 2015)). To “promote procedural fairness and prevent sandbagging,” the late request was denied, with the Board noting that “[a]uthorizing additional discovery related to objective indicia of non-obviousness at this late juncture would impair and unfairly prejudice Petitioner’s ability to respond to such indicia in the short period (mere weeks) before the scheduled hearing in this case.” (IPR2022-00534, Paper 43 (PTAB June 2, 2023).)

Parties seeking additional discovery should therefore submit these requests as soon as the need for discovery is identified. Discovery requests cannot be used to remedy perceived defects in earlier arguments or filings.

Motions to Exclude

Parties may move to exclude evidence submitted by another party in a proceeding. A party may not, however, use a motion to exclude to challenge the sufficiency of the proffered evidence or the weight that should be given to the evidence.

Pre-Motion Objections Required

To bring a motion to exclude, the moving party must have timely served objections to the relevant evidence during the course of the proceedings. A party must object to the admissibility of deposition evidence during the deposition (37 C.F.R. § 42.64(a)). The adverse party must provide any evidence to cure the objection during the deposition, unless counsel at the deposition stipulate otherwise on the record (37 C.F.R. § 42.64(a)). A party must file objections to other evidence submitted during a preliminary proceeding within ten business days of the institution of trial (37 C.F.R. § 42.64(b)). Once trial has been instituted, a party must file objections within five business days of service of the evidence to which the objection is directed (37 C.F.R. § 42.64(b)).

The objection must identify the grounds for the objection with “sufficient particularity” to allow correction in the form of supplemental evidence (37 C.F.R. § 42.64(b)(1)). 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 (37 C.F.R. § 42.64(b)(2)).

Oppositions to Motions to Exclude

When a motion to exclude is filed, the non-moving party can file an opposition to the motion. The Board typically will not rule on a motion to exclude prior to an oral hearing unless the evidence is central to the parties' dispute. Most rulings on motions to exclude are provided in the final written decision.

Motion to Exclude Success Rate

The success rate of motions to exclude is low, averaging about a 90+% denial rate. Given the low success rate of these motions, parties receiving objections to evidence may perceive low value in addressing them (such as through supplemental evidence). However, it is still important to thoughtfully consider the objections and assess the relative importance of the objected-to evidence to determine how to address the objection.

For example, in *Vudu, LLC v. Ideahub, Inc.*, the Board granted a motion to exclude a third-party declaration where that declarant was unavailable for deposition. The Board held that admissibility of this declaration was "no tangential matter" and instead went "to the heart of" whether a reference-at-issue was prior art. Therefore, the PTAB reasoned that allowing the declaration to remain in evidence would significantly prejudice the moving party. (IPR2020-01688, Paper 47 at 11 (PTAB Mar. 16, 2022).)

Some example issues on which motions to exclude have been successful include:

- Authenticity of the identified document (see *TRW Automotive U.S. LLC v. Magna Electronics Inc.*, 2016 WL 212791, IPR2014-01348, Paper 25 at 7-12 (PTAB Jan 15, 2016) (granting motion to exclude a reference relied on as prior art for lack of authentication)).
- Inadmissible hearsay (see *Asetek Danmark A/S v. CoolIT Sys., Inc.*, 2021 WL 4868406, IPR2020-00825, Paper 50 at 43-46 (PTAB Oct. 12, 2021) (granting motion to exclude deposition testimony in litigation from an inventor of a reference relied on in the IPR; reasoning that the testimony was inadmissible hearsay)).

Motions to Exclude Based on Expert Qualifications

Motions to exclude have generally been unsuccessful when attacking the admissibility of expert testimony on grounds that the expert is not qualified (see, for example, *Apple Inc. v. Zipit Wireless, Inc.*, 2022 WL 17823758, IPR2021-01130, Paper 30 at 39-42 (PTAB Dec. 20, 2022) (denying

motion seeking to exclude expert testimony on ground that the expert was not a POSITA as of the critical date)).

While overall success rates remain low, a 2022 Federal Circuit decision is giving renewed vigor to motions to exclude experts as qualified witnesses. In *Kyocera Senco Indus. Tools Inc. v. ITC*, the Federal Circuit held that if an expert does not meet the qualifications of a POSITA, the expert is not qualified to opine on what a POSITA would or would not have done in the context of an obviousness/non-obviousness analysis. *Kyocera*, however, does not stand for the proposition that an expert must have the relevant experience by the critical date. (22 F. 4th 1369 (Fed. Cir. 2022).)

Multiple panels have refused to exclude testimony where the expert was a qualified witness even if they did not meet a POSITA's skill level as of the critical date but acquired that skill level after the critical date (see, for example, *Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC*, 2022 WL 320786, IPR2020-01386, Paper 37 at 73-74 (PTAB Jan. 31, 2022); *Apple Inc.*, 2022 WL 17823758, IPR2021-01130, Paper 30 at 39-42 (PTAB Dec. 20, 2022)).

Given these recent cases, petitioners and patent owners should consider their expert's qualifications, as well as the qualifications of the opposing expert, to assess whether the respective experts can be considered POSITAs. To that end, the parties may also want to scrutinize the proposed definitions of a POSITA and, if there are competing definitions being proposed, the parties should ensure the experts meet the POSITA skill level under each competing definition.

Finally, while most motions to exclude are unsuccessful, there may be strategic reasons to advance these motions. For example, a party may file a motion to exclude certain evidence that, even if denied, may influence a panel to accord little or no weight to that evidence. As another example, a motion to exclude can preserve an issue for appeal to the Federal Circuit.

Motions to Strike

Motions to strike may be used to strike portions of an opposing party's briefing that:

- Raise new issues.
- Are accompanied by belatedly presented evidence.
- Exceed the proper scope of a reply/sur-reply.

They may not be used to challenge the admissibility of evidence, as that is the province of motions to exclude.

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A party intending to file a motion to strike should request the Board's authorization to file the motion, and that request must be made quickly, generally within one week of the allegedly improper submission. Failure to do so may lead to the motion filing not being authorized. The moving party should therefore immediately identify issues and evidence that may be the subject of a motion to strike, initiate a meet-and-confer with the other party, and raise the request with the Board after the meet-and-confer.

If the Board grants a motion to strike, the moving party should ensure that the motion and the requested relief are specific and limited to the portion of the opposing party's paper or exhibits that are deemed strike-worthy. Wholesale striking of briefs is considered an exceptional remedy that the Board is unlikely to grant. (See [PTAB Consolidated Trial Practice Guide 2019](#), at 80-81.)

Motion to Strike Success Rate

The success rate of motions to strike depends on the obviousness of the violation. For example, motions to strike new evidence submitted with a sur-reply are more likely to be successful (see, for example, *Satco Prods., Inc. v. Seoul Semiconductor Co., LTD.*, 2021 WL 5197168, IPR2020-00836, Paper 45 at 75-77 (PTAB Oct. 22, 2021) (striking new evidence cited with sur-reply)). On the other hand, motions to strike evidence that are premised on a paper exceeding the proper scope are less likely to be successful (see *Amphenol Corp. v. PPC Broadband, Inc.*, IPR2022-00720, Paper 26 at 2 (PTAB May 17, 2023) (denying request to file motion to strike because the Board could determine whether the petitioner's reply was proper when it weighed evidence at the close of trial); *Streck, Inc. et al v. Ravgen, Inc.* IPR2021-01577, Paper 67 (PTAB Apr. 18, 2023) (denying motion to strike portions of sur-reply that used an already-filed exhibit to respond to an argument in the petitioner's reply)).

Given the limited success rate of motions to strike, parties should carefully consider whether to raise these motions in the first instance. A motion to strike can spotlight a potential deficiency in the moving party's case, and if the request

to file a motion to strike is denied, the non-moving party may be able to leverage that deficiency to challenge any subsequent attempt by the moving party to respond to the portion of the paper or exhibit deemed to be strike-worthy.

When considering whether to file a motion to strike, a moving party should consider how clear the violation is. Clear violations, such as new evidence or belatedly presented evidence, tip in favor of seeking a motion to strike. Additionally, the moving party should assess whether there is already evidence in the record that rebuts the argument or issue for which the motion to strike is sought, or whether evidence can still be submitted to address that argument or issue (for example, in a petitioner reply). If so, the party has a defensible fallback position to address the new argument or evidence even if it loses the motion, in which case a motion to strike may be a worthwhile strategy.

On the other hand, if the record does not include evidence that rebuts the strike-worthy argument or issue and there is no opportunity to respond to address that argument or issue (such as when petitioners are confronted with new arguments or theories in a sur-reply and when patent owners when confronted with a new ground and evidence raised for the first time in a petitioner reply), a motion to strike may be warranted.

However, given that motions to strike are considered exceptional remedies, a moving party should consider requesting alternative relief (such as additional briefing or a request for observations) to increase its likelihood of success. In this scenario, if the Board refuses to strike the identified portions of a particular paper or exhibit, there remains a risk that the moving party has now highlighted a vulnerability in its case. Nevertheless, the moving party benefits from seeking a motion to strike in this scenario because at oral hearing (or at an earlier stage in the proceeding, as appropriate), it may be given more latitude to address this new argument, issue, or exhibit.

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