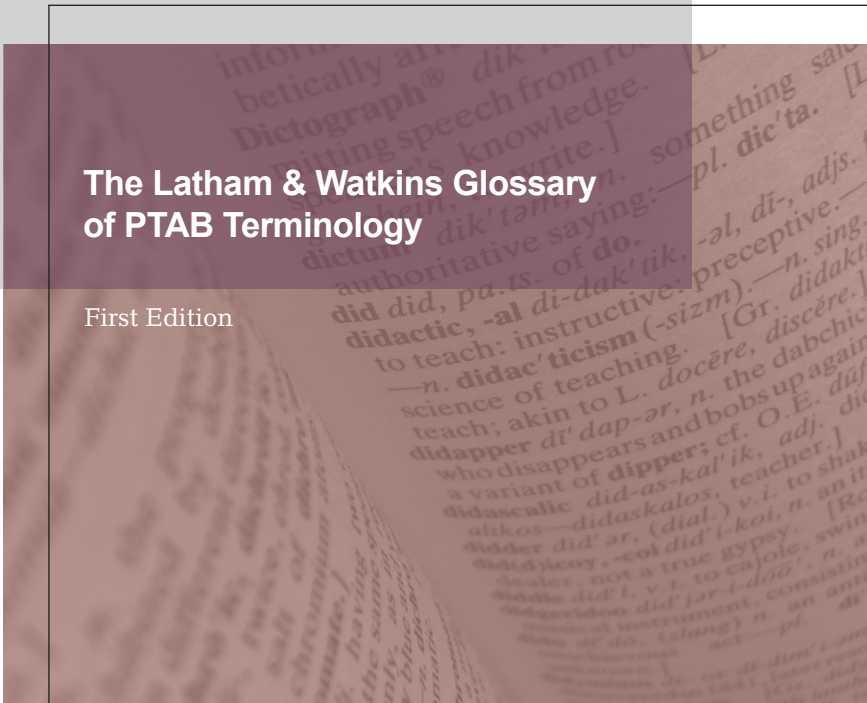


LATHAM & WATKINS LLP

The
BOOK
of
JARGON[®]
**Patent Trial &
Appeal Board**

**The Latham & Watkins Glossary
of PTAB Terminology**

First Edition



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The Book of Jargon® Patent Trial & Appeal Board is one of a series of practice area-specific glossaries published by Latham & Watkins.

The definitions contained herein are designed to provide an introduction to the applicable terms often encountered in Patent Trial & Appeal Board (PTAB) proceedings. These terms raise complex legal issues on which specific legal advice will be required. The terms are also subject to change as applicable laws and customary practice evolve. As a general matter, The Book of Jargon® - Patent Trial & Appeal Board (PTAB) is drafted from a US practice perspective.

The information contained herein should not be construed as legal advice.

Additional Discovery: any Discovery beyond Routine Discovery. The PTAB will consider the Garmin Factors when determining whether a Motion for Additional Discovery should be granted.

In IPR and CBM review, Additional Discovery may be granted in the interest of justice, considering the totality of the circumstances. 37 C.F.R. § 42.51(b)(2)(i).

In PGR, Additional Discovery may be granted upon a showing of good cause. This is a slightly lower standard than the interest of justice standard for IPR and CBM review and requires the requesting party to establish a specific factual reason for the Additional Discovery. 37 C.F.R. § 42.224.

Administrative Patent Judge (APJ): an administrative law judge sitting on the PTAB. Each APJ is a lawyer, typically with a technical background and many years of experience in patent law, such as in Examination, Patent Prosecution or litigation.

Amendment(s): see Claim Amendment(s)

America Invents Act/Leahy-Smith America Invents Act (AIA): a federal statute signed into law on September 16, 2011 that changed US patent law, including creating the PTAB and establishing the new PTAB Proceedings of IPR, PGR and CBM review. The AIA changed the US patent system from a First to Invent system to a First to File system. Pub. L. No. 112-29, 125 Stat. 284-341.

Anticipation: a Ground of Invalidity or ground for rejecting a patent claim based on the prior invention or disclosure of the claimed invention by another, or the inventor's own disclosure of the claimed invention by publication, Prior Sale or Prior Use. Anticipation requires that all claim elements appear in a single prior art reference.

Anticipation also means a lack of Novelty.

Appeal, Right of: both parties to a PTAB Proceeding, the Petitioner and the Patent Owner, may appeal a Final Written Decision of the PTAB. All appeals from PTAB Proceedings are made directly to the Federal Circuit. Notice of appeal to the Federal Circuit is due within 63 days of a Final Written Decision. 35 U.S.C. §§ 141-142; 37 C.F.R. § 90.3.

The PTAB's decision to not Institute Trial is final and non-appealable. But a party can file a Request for Rehearing, due within 30 days of the Institution Decision. 37 C.F.R. § 42.71(d).

Both parties to PTAB Proceeding also have a statutory right to seek a Stay of Litigation of pending district court litigation. For CBM review, parties have the right to seek immediate, interlocutory, de novo review of a district court's decision to grant or deny a Stay of Litigation. Pub. L. No. 112-29 § 18(b)(2), 125 Stat. 284-341.

In *Ex Parte* Reexaminations, only a Patent Owner may appeal a decision of the CRU — first to the PTAB and then to the Federal Circuit.

Asserted Patent: a patent that a Patent Owner enforces, typically by filing suit or threatening to do so.

Board of Patent Appeals and Interferences (BPAI): before September 16, 2012, the BPAI was the adjudicative body within the PTO that focused on patent disputes. The AIA replaced the BPAI with the newly formed PTAB. 35 U.S.C. § 6.

Broadest Reasonable Interpretation (BRI): the Claim Construction standard which applies in PTAB Proceedings. Claim terms are given their BRI in light of the specification to one having ordinary skill in the art at the time of the invention. In contrast in federal district court, however, claims are construed under the Ordinary and Customary Meaning Standard (Phillips Standard). 37 C.F.R. § 42.100(b).

Burden of Proof: the evidentiary standard to legally establish a fact. In PTAB Proceedings, the Petitioner must prove Invalidity of the challenged claims by a Preponderance of the Evidence. 37 C.F.R. § 42.1(d). In contrast, in federal district court the accused infringer must prove Invalidity by Clear and Convincing Evidence.

Central Reexamination Unit (CRU): a dedicated unit within the PTO that administers *Ex Parte* Reexaminations. The CRU was formed in 2005 and remains largely unchanged by the AIA.

Certificate: after the PTAB issues a Final Written Decision in a PTAB Proceeding and the time for appeal has ended, the PTO issues and publishes a Certificate that (1) cancels any patent claim determined to be unpatentable, (2) confirms any patent claim determined to be patentable, and (3) incorporates any new or Amended Claim determined to be patentable. 35 U.S.C. § 318(b).

Charged with Infringement: a requirement for CBM review. A Petition for CBM review may only be filed if the Petitioner, Real Party-in-Interest or Privy has been Charged with Infringement, *i.e.*, there is a real and substantial controversy of the patent such that the party would have standing to bring a Declaratory Judgment action in federal court. This includes being served with a patent infringement complaint. 37 C.F.R. § 42.302(a).

Claim Amendment(s): after Institution of a PTAB Proceeding and conferring with the PTAB, a Patent Owner may file a Motion to Amend patent claims. The Patent Owner may generally propose one Substitute Claim for each original claim it wishes to amend, which will only be considered if the original claim it replaces is canceled by the Patent Owner.

A Claim Amendment will not be allowed if it does not respond to all Grounds of Invalidity asserted against the original claim. Nor will it be allowed if it seeks to enlarge the scope of the claims or introduce new subject matter. The Patent Owner must also show patentability of a Substitute Claim over the prior art generally, and not just over the references the Petitioner asserted against the original patent claims. 37 C.F.R. §§ 42.121, 42.221.

Claim Chart: typically a two-column chart providing an element-by-element breakdown of a patent's claims. Invalidity claim charts are useful for visualizing which claim elements exist in the prior art (Invalidity claim chart).

Claim Charts may be single-spaced under the Line Spacing requirements, but placing arguments and claim construction in a claim chart to circumvent the double-spacing requirement or Page Limits is prohibited. The PTAB will not consider such arguments and double-spaced Claim Constructions. 37 C.F.R. § 42.6(a)(2)(iii).

Claim Construction: refers to the process an adjudicative body undergoes to determine the legal meaning of a patent claim term, or the actual meaning ascribed to the claim term after the Claim Construction process. PTAB gives claim terms their Broadest Reasonable Interpretation, whereas district courts give claim terms their Ordinary and Customary Meaning. 37 C.F.R. §§ 42.100(b), 42.200(b), 42.300(b). On August 20, 2015, the PTAB published a proposed rule change that would apply Ordinary and Customary Meaning as the claim construction standard for patents that will expire before the issuance of a final decision, but apply the Broadest Reasonable Interpretation to all other unexpired patents.

Clear and Convincing Evidence/Clear and Convincing Standard: the Standard of Proof required to establish the Invalidity of a patent in district court litigation. To prove Invalidity by Clear and Convincing Evidence, a party must prove that it is substantially more likely than not that the patent is invalid. The Clear and Convincing Evidence standard is higher than the Preponderance of the Evidence standard required to establish Invalidity in PTAB Proceedings.

Consolidation: if multiple matters before the PTAB involve the same patent (Related Matters), a party may request that the PTAB Consolidate the matters into a single proceeding (Unified Case). To obtain a Consolidation, a party seeks PTAB authorization to file a Motion for Joinder. If the Motion is granted, the parties must appoint a Lead Counsel and Speak with a Single Voice in all matters in the Unified Case. 37 C.F.R. § 42.122.

Counsel, Back-up: each party in a PTAB Proceeding must be represented by an attorney who is designated as Lead Counsel and by at least one other attorney who is designated as Back-up Counsel. The Back-up

Counsel must be able to represent the party before the PTAB on behalf of Lead Counsel, and if not admitted to practice before the PTAB may be admitted *Pro Hac Vice*.

Each party must file a Power of Attorney when designating counsel, except a Patent Owner need not file an additional Power of Attorney if the designated counsel is already counsel of record in the subject patent or application. 37 C.F.R. § 42.10.

Counsel, Lead: each party in a review proceeding must be represented by one attorney who is designated as Lead Counsel and by at least one other attorney who is designated as Back-up Counsel. The Lead Counsel must be a registered patent attorney.

Each party must file a Power of Attorney when designating counsel, except a Patent Owner need not file an additional Power of Attorney if the designated counsel is already counsel of record in the subject patent or application. 37 C.F.R. § 42.10.

Covered Business Method (CBM): CBM review is a PTAB Proceeding to challenge any patent that includes at least one claim directed to a method or apparatus used in the practice, administration or management of a Financial Product or Service. CBM review is not available for patents for Technological Inventions. 37 C.F.R. § 42.301(a).

CBM review may be requested on the basis of Novelty, Obviousness, Written Description, Enablement, Indefiniteness and Patentable Subject Matter. All prior art is available when challenging FTF patents, whereas the PTAB will only consider patents and Printed Publications as prior art when reviewing challenging FTI patents. 37 C.F.R. § 42.304.

Only a person who is sued or Charged with Infringement of a CBM patent may Petition for CBM review of the patent. 37 C.F.R. § 42.302.

CBM review may be requested at any time for FTI patents. But for FTF patents, CBM review may only be requested nine months after issuance (the period in which a Petition for PGR could be filed). 37 C.F.R. § 42.303.

Declaration: a written statement submitted to the PTAB, often providing factual or expert testimony (an Expert Declaration). The declarant must attest that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. 37 C.F.R. § 1.68. Such statements are made under the warning that willful false statements are punishable by fine or imprisonment and may jeopardize the Validity of any related patents.

Uncompelled direct testimony (e.g. *ex parte* deposition transcripts) must be submitted in the form of a Declaration. All other testimony must be in the form of a deposition transcript. 37 C.F.R. § 42.53(a).

Declaratory Judgment: a legal determination by a court resolving an issue affecting the rights of the parties to a dispute. Declaratory Judgments are common in patent litigation because they allow alleged infringers to seek judicial determination of, for example, Validity, non-infringement, or enforceability of an Asserted Patent before the Patent Owner brings suit. A Declaratory Judgment action may allow the alleged infringer to determine the forum of the lawsuit.

Default Protective Order: a form Protective Order provided in the Office Patent Trial Practice Guide that is automatically entered if the parties to a PTAB Proceeding do not agree on a Protective Order. 37 C.F.R. § 42.55. On August 20, 2015, the PTAB published a rule change that it will revise the form Protective Order to place the burden on the designating party to show good cause to seal "confidential" information.

Demonstrative/Demonstrative Exhibit: materials, typically visual, used during oral argument before the PTAB. While Demonstrative Exhibits are allowed during oral argument, the PTAB strictly limits their use. Testimony not previously developed in papers may not be discussed for the first time in a Demonstrative Exhibit at oral hearing. And the party presenting a Demonstrative Exhibit bears the burden of showing the material does not present new argument or Evidence.

Demonstrative Exhibits must be served at least five business days before the oral argument and filed no later than the time of the oral argument. 37 C.F.R. § 42.70(b). On August 20, 2015, the PTAB published a proposed rule change that extends the exchange of demonstratives before the oral argument from five business days to seven business days.

Derivation Proceeding (DER): a new form of inter partes proceeding designed to resolve inventorship disputes for FTF patents. In a DER, a Petitioner with a pending patent application seeks to establish that an earlier filed application on the same invention was derived from Petitioner's application and is not entitled to Priority.

FTI patent applications are still subject to Interference Proceedings.

Disclaimer: a Patent Owner's voluntary cancellation of a claim in a patent. Disclaimer is a statutory right and does not invalidate any remaining claims that do not depend on the disclaimed claim. 35 U.S.C. § 253(a). A Petition for PTAB Proceedings will not be Instituted based on disclaimed claims. 37 C.F.R. §§ 42.107(e), 42.207(e).

Discovery: while Discovery in PTAB Proceedings is generally limited, parties are entitled to Mandatory Initial Disclosures and Routine Discovery. Any Discovery beyond Routine Discovery is considered Additional Discovery. Parties may agree to Additional Discovery, or a party may file a Motion for Additional Discovery. 37 C.F.R. § 42.51.

Enablement: a requirement for patentability and distinct from the Written Description requirement. To satisfy Enablement, a patent specification must contain sufficient information such that a person of ordinary skill in the art could make or use the invention from the disclosures in the patent together with information known in the art without undue experimentation. 35 U.S.C. § 112(a).

Enablement may be raised as a Ground of Invalidity in PGR and CBM review, but not in IPR. 37 C.F.R. §§ 42.104(b)(2), 42.204(b)(2), 42.304(b)(2).

Estoppel: a doctrine prohibiting a party, Real Party-in-Interest, or Privy to a district court litigation or PTAB Proceeding from asserting certain Grounds of Invalidity in a later proceeding. For PTAB Proceedings, Estoppel only applies after the PTAB has issued a Final Written Decision. 37 C.F.R. § 42.73(d). In district court litigation, Estoppel applies after the court has entered a final judgment.

The Scope of Estoppel depends on the type of PTAB Proceeding.

Estoppel, Scope of: the Grounds of Invalidity a party is prohibited from raising in a later proceeding. The Scope of Estoppel depends on the party and type of proceeding.

Statutory Estoppel applies to IPR, PGR and CBM review under the AIA. For IPR or PGR, the Petitioner, Real Party-in-Interest or Privy, is estopped from asserting in any later proceeding, before the PTAB or a district court, any Ground of Invalidity that Petitioner raised or reasonably could have raised during the PTAB Proceeding. 35 U.S.C. §§ 315(e), 325(e).

For CBM review, Estoppel applies differently depending on the type of later proceeding. For a later PTAB Proceeding, a CBM Petitioner, Real Party-in-Interest or Privy is estopped from asserting any Ground of Invalidity that Petitioner raised or reasonably could have raised. 37 C.F.R. § 42.73(d)(1). For a later district court litigation, Estoppel only applies to those Grounds of Invalidity actually asserted by the CBM Petitioner.

Limited statutory Estoppel applies to district court litigation under the AIA. A defendant in a district court litigation is prohibited from petitioning for a later PTAB Proceeding only when defendant previously sought a Declaratory Judgment of Invalidity regarding the patent. 35 U.S.C. §§ 315(a)(1), 325(a)(1). A district court finding that patent claims are not Invalid by Clear and Convincing Evidence does not preclude a finding by the PTAB that the same claims are Invalid by a Preponderance of the Evidence.

Two further points about the Scope of Estoppel are noteworthy. First, a PTAB finding of Invalidity will supersede a district court judgment if the Federal Circuit affirms the PTAB Proceeding before the district court judgment becomes Sufficiently Final. *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013). Second, Estoppel only

applies to the party seeking to invalidate the patent: a Patent Owner in a PTAB Proceeding or Plaintiff in a district court litigation is not subject to Estoppel.

Evidence: includes Declarations, transcripts of depositions and other documents. All Evidence submitted in PTAB Proceedings must be filed in the form of an Exhibit. 37 C.F.R. § 42.63.

Except as otherwise provided, the Federal Rules of Evidence apply to PTAB Proceedings. 37 C.F.R. § 42.62(a).

Ex Parte Reexamination: a proceeding conducted between the Patent Owner and the PTO to review the patentability of a patent. The Patent Owner or a third party may request an *Ex Parte* Reexamination of an issued patent based on other patents and Printed Publications. The requesting party must submit prior art establishing a “substantial new question of patentability” based on Novelty or Obviousness. If the request for reexamination is granted, the PTO will begin reexamination proceedings before the CRU and third-party requesters are excluded from the proceedings.

Examination: the procedure by which the PTO reviews a patent application, interacts with applicants and their representatives and determines whether the claims are patentable over the prior art.

Exhibit: all Evidence submitted in PTAB Proceedings must be filed in the form of an Exhibit. 37 C.F.R. § 42.63(a).

Exhibit List: in PTAB Proceedings, each party is required to maintain an Exhibit List with the Exhibit Number and a brief description of each Exhibit. If an Exhibit is not filed, the Exhibit List should note that. A current Exhibit List must be served when Evidence is served, and the current Exhibit List must be filed when Exhibits are filed. 37 C.F.R. § 42.63(e).

Exhibit Number: in PTAB Proceedings, each party's Exhibits must be uniquely numbered sequentially. For the Petitioner, the range is 1001-1999, and for the Patent Owner, the range is 2001-2999. 37 C.F.R. § 42.63(c).

Expert Declaration/Report: a written statement by an expert setting forth his or her analysis and conclusions. An Expert Declaration is a permissible and often a helpful attachment to a Petition, especially for complex technologies. The PTAB discourages the practice of incorporating Expert Declarations by reference. Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. And testimony on US patent law or Patent Examination will not be admitted. 37 C.F.R. § 42.65. Analysis of Grounds of Invalidity must appear in the body of a Petition and may contain pin point citations to an Expert Declaration where appropriate.

Expert Declarations may be any length but generally should be limited to less than 100 pages. Expert Declarations cannot be used to extend the length of the Petition or circumvent the Page Limits. See, e.g., *Cisco Systems, Inc. v. C-Catation Technologies, LLC*, IPR2014-00454, Paper 12 (P.T.A.B. Aug. 29, 2014).

Federal Circuit/Court of Appeals for the Federal Circuit Final: Written Decisions are appealable directly to the Court of Appeals for the Federal Circuit, which has exclusive jurisdiction over appeals for PTAB Proceedings and patent litigations in federal district court. 35 U.S.C. § 141.

Federal Rules of Civil Procedure: rules governing the conduct of all civil actions brought in federal district courts, including patent litigation. The Federal Rules of Civil Procedure do not govern PTAB Proceedings.

Federal Rules of Evidence: rules governing Evidence in federal district courts, including patent litigation, as well as in PTAB Proceedings. 37 C.F.R. § 42.62.

Filing Date (for a Petition): the date officially accorded to a filed Petition. A Filing Date is assigned on the date the Petitioner: (1) satisfies the requirement for Content of the Petition, (2) effects service on the Patent Owner and (3) submits the appropriate Filing Fee for that particular PTAB Proceeding. 37 C.F.R. § 42.106.

If the Petition complies with all the statutory requirements, then the original submission date of the Petition is the Filing Date. Conversely, no Filing Date will be assigned if Petitioner has not satisfied a statutory requirement.

Filing Fee: on filing a Petition for IPR, payment of the following fees in US dollars are due: (1) an IPR request fee of \$9,000 plus \$200 for each claim in excess of 20 and (2) an IPR post-Institution fee of \$14,000 plus \$400 for each claim in excess of 15.

On filing a Petition for PGR or CBM review, payment of the following fees are due: (1) a PGR or CBM review request fee of \$12,000 plus \$250 for each claim in excess of 20 and (2) a PGR or CBM review post-Institution fee of \$18,000 plus \$550 for each claim in excess of 15.

On filing a Petition for a DER, a fee of \$400 is due. 37 C.F.R. § 42.15.

Filing Times: a Motion may only be filed according to a schedule set by the PTAB. In the absence of a schedule, an Opposition filing is due one month after service of a Motion and a Reply filing is due one month after service of the Opposition. 37 C.F.R. § 42.25.

For PTAB Proceedings generally, the following filing times apply. After the Petition is filed, the Patent Owner Preliminary Response is due within

three months. Then the PTAB issues an Institution Decision within three months. 37 C.F.R. § 107(b). Along with the Institution Decision, the PTAB issues a scheduling order whereby the proceeding concludes within 12 months, which may be extended six more months for cause. 37 C.F.R. §§ 42.100, 42.200, 42.300.

Next, the Patent Owner Response and Motion to Amend Claims are due within three months of the Institution Decision. 37 C.F.R. §§ 42.120(b), 42.220(b). Next, the Petitioner's Reply and Opposition to Amendment are due three months later. Next, the Patent Owner's Reply to Opposition to Amendment is due one month later.

All submissions to the PTAB must be made electronically via the Patent Review Processing System (PRPS) before 12:00 am ET.

Final Written Decision: the written order issued by the PTAB after a Judgment in a PTAB Proceeding conducted on the merits. The PTAB will generally issue a Final Written Decision within 18-24 months of the Petition's Filing Date. The Final Written Decision creates Estoppel and the parties' Right of Appeal. PTAB Proceedings that settle or are never Instituted will not have a Final Written Decision, and no Estoppel or Right of Appeal will apply. 37 C.F.R. § 42.73.

Financial Product or Service: to be eligible for CBM review, the patent at issue must have at least one claim related to a Financial Product or Service. The PTAB broadly construes Financial Product or Service to include activities that are financial in nature, incidental to a financial activity or complementary to a financial activity. 37 C.F.R. § 42.301(b); *Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention*, 77 Fed. Reg. 48734, 48735 (Aug. 14, 2012).

When a patent's claims relate to money matters or can be performed by a financial institution, the patent likely relates to a Financial Product or Service even if the claims are not otherwise related to financial services. See, e.g., *LinkedIn Corp. v. AVMarkets Inc.*, CBM2013-00025, Paper 13 (P.T.A.B. Nov. 12, 2013); *Salesforce.com, Inc. v. Virtualagility, Inc.*, CBM2013-00024, Paper 16 (P.T.A.B. Nov. 19, 2013).

A patent need only have a single claim directed to a covered business method for the entire patent to be eligible for CBM review. 77 Fed. Reg. at 48736.

First to File (FTF): a system of granting patents where Priority is given to the first person to file a patent application. Effective March 16, 2013 with the AIA, the US patent system transitioned from an FTI system to an FTF system.

Priority disputes between inventors in an FTF system are often resolved through DERs.

First to Invent (FTI): a system of granting patents where Priority is given to the first person to invent the subject matter of the patent. The US patent system used an FTI system until March 16, 2013, when the FTF system under the AIA went into effect. Issued patents that claim Priority before March 16, 2013 are considered FTI patents. 35 U.S.C. § 100.

Priority disputes in an FTI between inventors are often resolved through Interference Proceedings.

Font: petitions and other documents created for a proceeding must be in either a proportional Font that is 14-point or larger or a monospaced Font that does not contain more than four characters per centimeter (10 characters per inch). Certain 14-point proportional Fonts are so narrow that they cannot be read easily. When using a 14-point proportional Font, parties should select a Font of sufficient width that the words can be read easily (e.g., Times New Roman). 37 C.F.R. § 42.6(a)(2)(ii). See Petition, Formatting of.

Garmin Factors: factors used by the PTAB to determine whether a Motion for Additional Discovery should be granted in a particular PTAB Proceeding as set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (P.T.A.B. Mar. 5, 2013). Garmin Factors include: (1) the requesting party must establish more than a possibility and mere allegation of finding something useful, (2) litigation positions and underlying bases are not discoverable, (3) the requesting party must not have the ability to generate equivalent information by other means, (4) the requests must be easily understandable and (5) the requests must not be overly burdensome.

Graham Factors: questions of fact used to resolve the issue of Obviousness as set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1965). Graham Factors include: (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art and (3) the level of ordinary skill in the prior art. Further objective Evidence may also be relevant to Obviousness and often referred to as Secondary Considerations.

Grounds of Invalidity: the grounds on which a Petitioner can challenge the Validity of patent claims in a PTAB Proceeding. For IPR, Grounds of Invalidity are limited to Novelty and Obviousness. For PGR and CBM review all patentability challenges are Novelty, Obviousness, Written Description, Enablement, Indefiniteness and Patentable Subject Matter. 37 C.F.R. §§ 42.104, 42.204(b), 42.304(b).

Horizontal Redundancy: assertion of multiple prior art references that separately and distinctly support the same Ground of Invalidity. When the PTAB denies Grounds of Invalidity for being redundant, the Petitioner is statutorily estopped from pursuing the grounds in subsequent litigation or further PTAB Proceedings. 35 U.S.C. §§ 315(e), 325(e).

Indefiniteness: Definiteness is a requirement for patentability. To satisfy Definiteness, a patent claim must particularly point out and distinctly claim the subject matter of the invention. 35 U.S.C. § 112(b). Indefiniteness is available as a Ground of Invalidity in PGR and CBM review, but not IPR. 37 C.F.R. §§ 42.104(b), 42.204(b), 42.304 (b).

Informative Decision: a Final Written Decision designated as particularly instructive by a majority of the APJs. Informative Decisions are not binding, but not meant to illustrate PTAB principles and reasoning for the public, the patent Examining corps and future PTAB panels.

Institution: granting of a Petition for a PTAB Proceeding after considering the Petition and Patent Owner Preliminary Response, if filed. 35 U.S.C. § 314(b). After Institution, the PTAB issues a Scheduling Order under which the proceeding concludes within 12 months, which can be extended for six more months for cause. *Practice Guide for Proposed Trial Rules*, 77 Fed. Reg. 6868, 6869 (Feb. 9, 2012). If a Trial is not Instituted, no Estoppel applies.

Institution Decision: the PTAB's decision on whether or not to Institute a Trial — generally issued within six months of the Filing Date of the Petition. 35 U.S.C. § 314(b). The Institution Standard depends on the particular PTAB Proceeding.

The PTAB's decision to not Institute Trial is final and non-appealable. 37 C.F.R. § 42.71(c). But a party may file a Request for Rehearing within 30 days of the Institution Decision. 37 C.F.R. § 42.71(d)(2).

Institution Standard: different Institution Standards apply depending on the type of PTAB Proceeding.

For IPR, the Petition must demonstrate a reasonable likelihood of prevailing on at least one claim. 35 U.S.C. § 314(a).

For PGR and CBM review, the Petition must demonstrate either that: more likely than not, at least one claim is patentable, or the Petition raises an unsettled or novel legal question. 35 U.S.C. § 324.

Inter Partes Reexamination: a proceeding at the PTO conducted among the Patent Owner, PTO and a third-party requester to review the patentability of a patent. A third party may request *Inter Partes* Reexamination of an issued patent based on other patents and Printed Publications. The requesting party must submit prior art establishing a reasonable likelihood that the requester will prevail on at least one of the patent claims based on Novelty or Obviousness. If the requesting party can establish a reasonable likelihood of success, the PTO will order a reexamination proceeding before the CRU, when the Patent Owner and third-party requester engage in comment.

Inter Partes Reexamination was replaced by IPR review on September 16, 2012 and no longer exists.

Inter Partes Review (IPR): a PTAB Proceeding for challenging the Validity of any issued patent. IPR may be requested on the basis of Novelty and Obviousness, and only patents and Printed Publications may be used as prior art. 37 C.F.R. § 42.104(b).

The PTAB will not Institute a Petition for IPR if the Petitioner previously filed a Declaratory Judgment action challenging the patent's Validity. However, a Declaratory Judgment action filed as a counterclaim to an infringement suit does not bar Instituting an IPR. 37 C.F.R. § 42.101.

IPR may be requested at any time for FTI patents. But for FTF patents, IPR may only be requested nine months after the issuance or later (the period when a Petition for PGR could be filed). 37 C.F.R. § 42.102. And if Petitioner has been served with a patent infringement complaint, then Petitioner must file its Petition in the PTAB within one year after service. 35 U.S.C. § 315(b).

Interference Proceeding: a proceeding conducted by the CRU to resolve which of several parties first invented an invention commonly claimed in two or more FTI patents or patent applications. As a form of *inter partes* proceeding, Interferences are conducted among the PTO and several parties.

Interpreter: an Interpreter may be used when one of the parties to a PTAB Proceeding uses foreign language deposition testimony. The party calling the witness must initiate a conference with the PTAB at least five days before the deposition. 37 C.F.R. § 42.53(e). The party offering the witness must provide an Interpreter and the Interpreter's name, address, telephone number, e-mail address and resume at least five days before the deposition. The opposing party may hire a second Interpreter. If the Interpreters disagree on the record, then the PTAB will determine which interpretation should be given more weight. Further guidelines can be found in *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 55 (P.T.A.B. Aug. 7, 2013).

Voir dire of the Interpreter is not required, but the parties must make any objections to the Interpreter's qualifications at the time of the testimony. The same Interpreter may be used for the deposition and to prepare the witness. The opposing party may only inquire into whether the Interpreter helped prepare the witness but not into the substance of the preparations. *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 67 (P.T.A.B. Aug. 29, 2013).

Intervening Rights: an accused infringer's rights to avoid infringement for previously lawful activity that later becomes unlawful when claims are substantively Amended during a PTAB Proceeding. The AIA

explicitly provides that Intervening Rights may exist for any amended or new claims determined to be patentable and incorporated into a patent during an IPR, PGR or CBM review proceeding. 35 U.S.C. § 318(c).

Invalidity: if a patent or any of its claims are found not to comply with any of the prerequisites for obtaining a patent as set forth in 35 U.S.C., the patent or its claims are said to be invalid. The PTAB does not presume a patent or its claims are valid, so a Petitioner bears a lower burden of proof for establishing Invalidity than in district court, where a patent and its claims are presumed valid.

In district court, each claim of a patent will be presumed valid independently of the Validity of other claims; and dependent claims will be presumed valid even if they depend upon on an invalid claim. 35 U.S.C. § 282. See Invalidity, Standard of Proof.

Invalidity, Standard of Proof: district courts observe a rebuttable presumption that an issued patent is valid. To invalidate a patent in district court litigation, a defendant must establish Invalidity of the Asserted Patent by Clear and Convincing Evidence.

The PTAB does not presume an issued patent is valid, and thus, a Petitioner bears a lower burden of proof for establishing Invalidity by only Preponderance of the Evidence. 37 C.F.R. §§ 42.1(d), 42.20(c).

Joinder: the combination of a second PTAB Proceeding with a first, already-Instituted PTAB Proceeding. Both the Patent Owner and Petitioner may request Joinder by a Motion, which must be filed no later than one month after Instituting the first PTAB Proceeding.

In order for a Motion for Joinder to be granted the PTAB must determine that the Petition for the second PTAB Proceeding warrants Institution, and the Patent Owner's Preliminary Response must have been submitted or the time for that response must have expired.

The One Year Bar does not apply to a Petition filed concurrently with a Motion for Joinder. In some cases, APJs have denied Motions for Joinder if the moving party is also a Petitioner in the first, already-Instituted PTAB Proceeding and the One Year Bar for that first proceeding has already passed. In other cases, APJs have granted Motions for Joinder in similar situations. 37 C.F.R. § 42.122.

Joint Petitioners: a group of distinct entities who together file a single Petition for a PTAB Proceeding. The PTAB considers Joint Petitioners a single party that must strictly Speak with a Single Voice both in writing and oral representation. Individual arguments, submissions or sections in consolidated filings are not allowed. The PTAB allows only one Lead Counsel for a group of Joint Petitioners.

Judgment: the PTAB's Final Written Decision disposing of all issues that were, or reasonably could have been, raised and decided during a PTAB Proceeding.

Line Spacing: the PTAB imposes specific formatting requirements filing documents. Double spacing must always be used except for Claim Charts, headings, tables of contents, tables of authorities, indices, signature blocks and certificates of service. Block quotations may be 1.5 spaced, but must be indented from both the left and the right margins. 37 C.F.R. § 42.6(a)(2).

Mandatory Initial Disclosures: parties may agree to Mandatory Initial Disclosures as set forth in the Office Patent Trial Practice Guide. The parties must submit any agreement reached on initial disclosures no later than the filing of the Patent Owner Preliminary Response or the expiration of the time period for filing such a response. Upon Institution of a PTAB Proceeding, parties may automatically take Discovery of the information identified in the Mandatory Initial Disclosures. If the parties fail to agree to provide Mandatory Initial Disclosures, a party may seek them by Motion. 37 C.F.R. § 42.51(a).

Mandatory Notices: both the Petitioner and the Patent Owner must file the following Mandatory Notices: (1) identification of each Real Party-in-Interest, (2) identification of related matters, (3) identification of Lead and Back-up Counsel and (4) identification of service information. The Petitioner must file such notices with the Petition. The Patent Owner must file such notices within 21 days of service of the Petition. In addition, both parties are required to file updated notices within 21 days of a change in the information in any of the notices. 37 C.F.R. § 42.8.

Margins: all documents filed in a PTAB Proceeding must include page Margins that measure at least 2.5 centimeters (1 inch) on all sides. 37 C.F.R. § 42.6(2)(iv). See Petition, Formatting of.

Motion: a request for relief other than by Petition. A Motion must include a statement of the precise relief requested and a full statement of the reasons for the relief requested. A Motion may also include a statement of material facts. 37 C.F.R. § 42.22.

Generally, the PTAB requires a moving party to request and receive authorization before filing any Motion. Motions will not be entered without Board authorization. 37 C.F.R. § 42.20(b). Most Motions must be approved by the PTAB in a conference call with all parties before filing, but no prior authorization is not required for Motions to Seal and Motions filed with Petitions. Further, Motions for Rehearing, Motions to Exclude Evidence and Motions for Observation on Cross-Examination require authorization, but they are automatically granted.

Motion Filing Schedule: parties may only file a Motion according to a schedule set by the PTAB. Otherwise, the default times for acting are: (1) an Opposition is due one month after service of a Motion; and (2) a Reply is due one month after service of the Opposition. 37 C.F.R. § 42.25.

Motion for Observation on Cross-Examination: a motion for the Petitioner to draw the PTAB's attention to relevant cross examination testimony of a reply witness since no further substantive paper is permitted after the Reply. See Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48769 (Aug. 14, 2012). The observation must be a concise statement of the relevance of the precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph. The Patent Owner may respond to the observation and any response must be equally concise and specific.

Motion to Amend: a Motion filed at the PTAB whereby the Patent Owner seeks a Claim Amendment. A Patent Owner may file a Motion to Amend only after Institution of a PTAB Proceeding and after conferring with the PTAB. Should the PTAB grant a Motion to Amend, the proposed Substitute Claims will be added to the patent without Examination. 37 C.F.R. § 42.121.

Motion to Exclude Evidence: a Motion challenging the admissibility — not the sufficiency — of Evidence to prove a particular fact. A Motion to Exclude Evidence must explain why the Evidence is not admissible and: (1) identify where the objection originally was made, (2) identify where in the record the Evidence sought to be excluded was relied upon by an opponent, (3) address objections to exhibits in numerical order and (4) explain each objection. A Motion to Exclude Evidence must be filed to preserve any objection to Evidence, and the PTAB need not resolve objections to Evidence until a party files a Motion to Exclude. A Motion to Exclude may be filed without prior PTAB authorization. 37 C.F.R. § 42.64(c).

Any objection preserved by a Motion to Exclude in a preliminary proceeding must be served within 10 business days of Institution. After Institution, any objection preserved by a Motion to Exclude must be made within five business days of service of the Evidence. 37 C.F.R. § 42.64(b)(1).

Motion to Expunge Confidential Information: a Motion filed after denial of a Petition or after entry of Final Written Decision to remove confidential information from the record. Notably, the PTAB is under no obligation to grant a Motion to Expunge Confidential Information. 37 C.F.R. § 42.56.

Motion to Seal: a Motion to prevent information from becoming a part of the public record. A party filing a Motion to Seal must establish good cause — specifically that the information sought to be sealed is truly confidential and that the confidentiality outweighs the strong public interest in an open record.

Potentially confidential information includes exhibits and copies of transcripts, papers, and decisions alleged to contain trade secrets or other confidential research, development or commercial information. 37 C.F.R. § 42.54.

Motion to Strike: a Motion to remove all or a portion of a piece of Evidence or submitted paper. A Motion to Exclude, however, is typically the proper procedure to remove Evidence. 37 C.F.R. § 42.64(c).

Motion to Terminate: the parties to a PTAB Proceeding may terminate the proceeding only through a joint request to the PTAB before a Final Written Decision. But the PTAB is not required to grant the request and terminate the PTAB Proceeding. The PTAB has sole discretion over whether it may proceed to a Final Written Decision without a Petitioner and has done so after receiving requests to terminate late in the proceedings. 35 U.S.C. §§ 317, 327; 37 C.F.R. § 42.72.

Motivation to Combine: for Obviousness, there needs to be a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine proffered prior art references and suggest a reasonable likelihood of success. The Motivation to Combine requirement guards against hindsight bias in Obviousness determinations.

Novelty: an invention cannot be patented if the claimed invention was patented, described in a Printed Publication, or in public use (see Prior Use), on sale (see Prior Sale) or otherwise available to the public before the effective Filing Date of the claimed invention. 35 U.S.C. § 102.

Objection(s), Timing of: any objection to Evidence submitted during a Preliminary Proceeding must be served within 10 business days of the Institution of the Trial, except that an objection to deposition Evidence must be made during the deposition. Once a Trial has been Instituted, any objection must be served within five business days of the Evidence's service. 37 C.F.R. § 42.64.

Obviousness: a patent for a claimed invention may not issue, even if the claimed invention is not identical to prior art, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been Obvious before the effective Filing Date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. A court considers the Graham Factors when determining whether an invention is Obvious. 35 U.S.C. § 103.

Offer for Sale: a definite offer, the acceptance of which would create a binding contract by simple acceptance (assuming consideration). See 35 U.S.C. § 102. See Sale.

Office Patent Trial Practice Guide: the guide published by the PTO regarding Trial practice in PTAB Proceedings. It can be found at 37 C.F.R. Part 42.

One Year Bar/Statutory Bar: an IPR may not be Instituted if the Petition is filed more than one year after the date on which the Petitioner, Real Party-in-Interest or Privy of the Petitioner is served with a patent infringement complaint. 35 U.S.C. § 315(b).

Opposition to a Motion: a response by a Patent Owner or Petitioner to any Motion the opposing party has filed. The Opposition to a Motion must include: (1) a statement of the precise relief requested, (2) a full statement of the reasons for the relief requested and (3) a statement identifying material facts in dispute. 37 C.F.R. § 42.23.

An Opposition to a Motion is due one month after service of the Motion and has the same Page Limit as the Motion. 37 C.F.R. § 42.25.

Ordinary and Customary Meaning: the Claim Construction standard applied in district court litigation. Under the Ordinary and Customary Meaning standard, claim terms are given the meaning they would have to a person of ordinary skill in the art in question at the time of the invention. This determination is based on the entire record, including both intrinsic Evidence (the patent claims, specification and Patent Prosecution history) and extrinsic Evidence (e.g., dictionary definitions and Expert Reports).

Page Limits: limits on the number of pages allowed for Petitions, Motions, responses and Oppositions, which do not include a table of contents, a table of authorities, a certificate of service or appendix of exhibits.

Petitions requesting IPR are limited to 60 pages. Petitions requesting PGR or CBM review are limited to 80 pages. Petitions requesting DERs are limited to 60 pages. Motions are limited to 15 pages. 37 C.F.R. § 42.24(a). Motions to Amend are limited to 25 pages, and can include a claim appendix that does not count against the page limit.

Patent Owner Preliminary Responses, Patent Owner Responses and Oppositions to a Motion are limited to the same number of pages as the corresponding Petitions and Motions. 37 C.F.R. § 42.24(b).

Replies to Patent Owner Responses are limited to 25 pages. Replies to Oppositions to a Motion are limited to 5 pages. 37 C.F.R. § 42.24.

On August 20, 2015, the PTAB published a proposed rule change that would use word counts (instead of Page Limits) for Petitions, Patent Owner Preliminary Responses, Patent Owner Responses, and Petitioner's Reply Briefs, as follows:

- Petition, Preliminary Response, Patent Owner's Response: 14,000 words for IPRs and 18,700 words for PGRs and CBMs
- Reply: 5,600 words

Patent and Trademark Office (USPTO or PTO): an administrative agency in the US Department of Commerce that examines patent application and issues patents to inventors and businesses for their inventions. The PTO also examines and issues trademark registrations.

The PTAB is an administrative law body of the PTO.

Patent Owner: an individual or entity with a legal right to exclude others from making, using, offering for sale, selling or importing into the US the invention claimed in the patent.

A patent or patent application is assignable by an instrument in writing. The assignment of the patent, or patent application transfers to the assignee an alienable (transferable) ownership interest in the patent or application. 35 U.S.C. § 261.

Patent Owner Preliminary Response: before Institution of a PTAB Proceeding, the Patent Owner may file an initial response to a Petition setting forth the reasons why Trial should not be Instituted. 37 C.F.R. § 42.107. On August 20, 2015, the PTAB published a proposed rule change that would allow the Patent Owner to submit testimonial evidence (in the form of a Declaration) with the Preliminary Response.

Patent Owner Response: a response to a Petition filed by the Patent Owner and addressing any Ground of Invalidity not already rejected by the PTAB in its Institution Decision. A Patent Owner Response is due three months from the date of Institution, unless the PTAB orders an alternative deadline. 37 C.F.R. § 42.120. The Opposition has the same Page Limit as the Petition. 37 C.F.R. § 42.24. The Patent Owner typically submits testimonial evidence (in the form of a Declaration) with the Response.

Patent Prosecution: the process of applying for a patent, including drafting and filing the application, communicating with the PTO examiner, and, if necessary, amending the claims to establish patentability.

Patent Prosecution is distinct from patent litigation and PTAB Proceedings, both of which occur only after prosecution and issuance of the patent.

Patent Trial and Appeal Board (PTAB): a statutorily created administrative board within the PTO, which includes the APJs that preside over all PTAB Proceedings. The PTAB renders decisions on appeals from adverse examiner decisions involving patent applications, PTAB Proceedings and Interferences. The PTAB replaced the BPAI after the AIA passed in 2012. 35 U.S.C. § 6(a).

Patentable Subject Matter: a Ground of Invalidity available in CBM review and PGR. To be patentable, a claimed invention must: (1) be directed to a process, machine, manufacture, or composition of matter and (2) not be wholly directed to laws of nature, physical phenomena,

abstract ideas, or any other judicially recognized exception. 35 U.S.C. § 101; see also 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74618 (Dec. 16, 2014).

Pendency: a PTAB Proceeding is administered such that after Institution, the proceeding is normally Pending for no more than one year. The time can be extended by up to six months for good cause by the Chief APJ or adjusted by the PTAB in the case of Joinder. 37 C.F.R. § 42.200(c).

Pending Civil Action: district court litigation involving the same patent pending in a PTAB Proceeding. Parties often seek a Stay of Litigation for a Pending Civil Action until the PTAB Proceedings conclude.

Petition: a request for the PTAB to Institute a PTAB Trial. 37 C.F.R. § 42.2.

Petition, Content of: petitions for IPR, PGR and CBM review must satisfy the following statutory and regulatory requirements for Institution:

Statutory: (1) identify all Real Parties-in-Interest, (2) identify all challenged claims and all Grounds of Invalidity, (3) provide copies of Evidence relied upon and (4) pay the required Filing Fee. 35 U.S.C. § 312.

Regulatory: (1) identify the grounds for standing, (2) propose a Claim Construction for each challenged claim, (3) specifically explain the Grounds of Invalidity and (4) specifically explain the relevance of the Evidence relied upon. 37 C.F.R. § 42.22(a)(2).

A Petition for IPR must additionally set forth: (1) the Grounds for Standing and (2) a precise identification of the relief requested for each challenged claim, including (a) the claim, (b) the Grounds of Invalidity, (c) proposed Claim Construction for the challenged claim, (d) how the construed claim is unpatentable under the Grounds of Invalidity and (e) the Exhibits Numbers of the supporting Evidence. 37 C.F.R. § 42.104.

A Petition is not required to include an Expert Declaration, but most Petitioners submit an Expert Declaration in support of their Petitions. An Expert Declaration is often helpful, especially for complex technologies.

A Petition must comply with applicable Petition Formatting and Page Limit requirements.

Petition, Formatting of: submissions to the PTAB must comply with several requirements. Page size must be 8.5 x 11 inches, except in the case of Exhibits that require a larger size in order to preserve details of the original. In addition, for documents created for the PTAB Proceeding: (1) markings must be in black or must otherwise provide an equivalent dark, high-contrast image, (2) Fonts must be either a proportional Font (14-point or larger) or monospaced Font containing no more than four characters per centimeter (i.e., 10 characters per inch), (3) double Spacing must be used except in Claim Charts, headings, tables of contents, tables

of authorities, indices, signature blocks and certificates of service and (4) Margins must be at least 2.5 centimeters (i.e., one inch) on all sides. 37 C.F.R. § 42.6.

Petitioner: the party filing a Petition requesting a Trial be Instituted. 37 C.F.R. § 42.2.

Phillips Standard: the Claim Construction standard used in federal district court and established in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-18 (Fed. Cir. 2005). Words of a claim are generally given their Ordinary and Customary Meaning as understood by a person of ordinary skill in the art at the time of the invention.

Plain Meaning: the Ordinary and Customary Meaning given to a term by those of ordinary skill in the art at the time of the invention.

Post Grant Review (PGR): a PTAB Proceeding available to request cancelling one or more patent claims on the following Grounds of Invalidity: Novelty, Obviousness, Written Description, Enablement, Indefiniteness and Patentable Subject Matter. All prior art is available, including Prior Sale and Prior Use. 35 U.S.C. § 321(b); 37 C.F.R. § 42.204(b).

The PTAB will not Institute a Petition for PGR if the Petitioner previously filed a Declaratory Judgment action challenging the patent's Validity. 37 C.F.R. § 42.201.

A Petitioner may only request PGR for FTF patents and only within the first nine months after issuance. 37 C.F.R. § 42.202.

Power of Attorney: parties to a PTAB Proceeding must file a written document authorizing one or more practitioners or joint inventors to act on their behalf. 37 C.F.R. § 1.32(a)(2). Parties must file Power of Attorney when designating counsel, except that the Patent Owner should not file an additional Power of Attorney if the designated counsel is already counsel of record in the PTAB Proceeding. 37 C.F.R. § 42.10(b).

Precedential Opinion: a Final Written Decision that is binding on the PTAB. For a decision to be designated as precedential, a majority of the APJs must vote to designate it as such.

The PTAB also designates some decisions as informative. Informative Decisions are not binding but illustrate norms of PTAB decision-making for the public, the patent Examining corps and future PTAB panels.

Preliminary Proceeding: the phase of the PTAB Proceeding that begins with filing a Petition and ends with an Institution Decision. 37 C.F.R. § 42.2.

Preponderance of the Evidence: the Standard of Proof required to establish a patent's Invalidity in PTAB Proceedings. 37 C.F.R. § 42.1(d). To prove Invalidity by a Preponderance of the Evidence, a party must prove that it is more likely than not that the patent is invalid. The Preponderance of the Evidence standard requires a lower burden of proof than the Clear and Convincing Evidence standard required to establish Invalidity in district court litigation.

Primary Reference: prior art references can be combined to show that a claimed invention is Obvious. A Primary Reference discloses many of the Claim Elements and may be combined with one or more Secondary Reference(s), which disclose other Claim Elements.

Printed Publication: a reference that has been publicly disseminated or otherwise made available to the extent that it can be located and accessed by persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence.

Prior Sale: a defense to infringement. A patent is invalid if a commercial embodiment of the patented invention was subject to Sale or an Offer for Sale more than one year before the patent application was filed.

Prior Sale may be raised as a Ground of Invalidity in PGR or CBM review, but not in IPR.

Prior Use: a defense to infringement. A patent is invalid if the patented invention was subject to a good faith, public use more than one year before the patent application was filed. Prior Use applies to commercial use as well as non-profit use, so long as the public is the intended beneficiary of any non-commercial use.

Prior Use may be raised as a Ground of Invalidity in PGR or CBM review, but not in IPR.

Priority: the date on which an inventor established a right to patent invention — generally the effective filing date of the patent.

When seeking patent protection in several countries, the World Intellectual Property Organization provides that once an application is filed in a member country, the applicant is entitled to claim Priority for a period of 12 months, and the filing date of that first application is considered the Priority date.

Privy: see Real Party-in-Interest.

Pro Hac Vice: counsel may be admitted in a PTAB Proceeding *Pro Hac Vice* even if counsel is not a registered practitioner before the PTAB. A Motion for admission *Pro Hac Vice* must be filed more than 21 days after the service of the Petition. An Opposition is due within one week

and no Reply should be filed. A Motion for admission *Pro Hac Vice* must contain: (1) a statement of facts showing good cause, and (2) a Declaration attesting that counsel (a) is a member in good standing of the Bar, (b) has no suspensions or disbarments, (c) has never had an admission to practice denied, (d) has never been sanctioned or held in contempt, (e) will read the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, (f) will be subject to the PTO's Code of Professional Responsibility and (g) has familiarity with the subject matter of the proceeding. The Declaration must also list all other proceedings before the PTO where the applicant has been admitted *Pro Hac Vice* in the last three years. 37 C.F.R. § 42.10; *Motorola Mobility LLC v. Michael Arrouse*, IPR2013-00013, Paper 6 (P.T.A.B. Oct. 15, 2012).

Proposed Protective Order: a Protective Order agreed upon by the parties that differs from the Default Protective Order. The parties to a PTAB Proceeding are free to submit a Proposed Protective Order to the PTAB but must explain how the Proposed Protective Order differs from the Default Protective Order and how it complies with the Office Patent Trial Practice Guide. 37 C.F.R. §§ 42.54, 42.55.

Often, a party submits the Proposed Protective Order to the PTAB along with a Motion to Seal confidential information. The opposing party may then access the filed information by agreeing to the terms of the Proposed Protective Order.

Protective Order: an agreement between or among the PTAB and the parties to a PTAB Proceeding, which provides details for identifying confidential information and rules governing its disclosure between the parties. 37 C.F.R. § 42.54.

PTAB Proceeding: a litigation-like process established under the AIA, effective Sept. 16, 2012 for challenging the Validity of issued patents. Common proceedings include CBM review, IPR and PGR. A PTAB Proceeding begins when a Petitioner files a Petition for a PTAB Proceeding, and the Trial period begins at Institution.

Real Party-in-Interest: the party who desires Institution of a PTAB Proceeding — generally the Petitioner or a party at its behest and control. Determination of the Real Party-in-Interest is a highly fact-dependent inquiry. Considerations may include whether a non-party exercises control over a Petitioner's participation in a proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012). Other factors may include whether a non-party is funding the proceeding or directing the proceeding. *Id.* at 48,759-60. *TRW Automotive US LLC v. Magna Electronics Inc.*, IPR2014-00293, Paper 18 (P.T.A.B. July 27, 2014).

A Petitioner must disclose all Real Parties-in-Interest as a part of the Mandatory Notices section of a Petition. 37 C.F.R. § 42.8(b)(1).

Reasonable Likelihood Standard: a discretionary standard for Instituting an IPR. Petitioner must establish it is more likely than not to prevail as to at least one Ground of Invalidity. 35 U.S.C. § 314(a).

Redundant Grounds of Invalidity: Grounds of Invalidity that are the same or substantially the same as those presented in a previous Petition. The PTAB will not consider Redundant Grounds of Invalidity and will only sustain more than one Ground of Invalidity per claim if the Petitioner explains in its Petition why multiple Grounds of Invalidity are not redundant. The PTAB has classified different types of redundancy as either Horizontally Redundant or Vertically Redundant.

Related Matters: any other judicial or administrative matter that would affect, or be affected by, a decision in a PTAB Proceeding. For example, Related Matters include a Pending Civil Action involving the same parties or patent, or a patent application that claims priority to the patent. A Petitioner must disclose all Related Matters as a part of the Mandatory Notices section of a Petition. 37 C.F.R. § 42.8(b)(2).

Reply: a party's response to any Petition, Motion or Opposition filed by the opposing party in a PTAB Proceeding. 37 C.F.R. §§ 42.23, 42.24(c).

Request for Adverse Judgment: a party's request for judgment against itself, including: (1) Disclaimer of the challenged patent, (2) cancellation or Disclaimer of a claim such that the party has no remaining claim at trial, (3) concession that the patent is unpatentable or that the contested subject matter is derived from another application and (4) abandonment of the PTAB Proceeding. 37 C.F.R. § 42.73(b). Generally, a party will only Request Adverse Judgment because of a recent acquisition, change in Privy, or if a PTAB Proceeding is only pending on a subset of claims and the Patent Owner does not wish to risk Joinder of any additional PTAB Proceedings.

Request for Reconsideration: see Request for Rehearing.

Request for Rehearing: a request to reconsider the PTAB's decision on a Petition or Motion. The party filing the Request for Rehearing need not obtain prior authorization from the PTAB but must specifically identify all matters the party believes the PTAB misapprehended or overlooked, and the place where each matter was previously addressed in a Motion, Opposition or Reply.

A party must file a Request to Rehear a Petition for Institution of a PTAB Proceeding within 30 days of an Institution Decision. 37 C.F.R. § 42.71(d).

Routine Discovery: Discovery to which parties to a PTAB Proceeding are automatically entitled, including: (1) any exhibit cited in a paper or testimony, (2) cross examination of affidavit testimony and (3) relevant information that is inconsistent with a position advanced by the party during the proceeding. 37 C.F.R. § 42.51(b)(1).

In IPR, a party may move for Additional Discovery provided the requesting party establishes the Additional Discovery is necessary in the interest of justice. 37 C.F.R. § 42.51(b)(2).

In PGR and CBM review, a Motion for Additional Discovery may be granted upon a showing of good cause. Additional Discovery is limited to Evidence directly related to factual assertions advanced by either party in the proceeding. 37 C.F.R. § 42.224(a).

Rule 11 Certification: On August 20, 2015, the PTAB published a proposed rule change that would use add a Rule 11-type certification for all papers filed with the Board, as well as a provision for sanctions for noncompliance that would apply to practitioners and the parties.

Sale: transfer of a commercial embodiment of a patented invention in return for consideration. See Prior Sale.

Scheduling Order: an order issued concurrently with an Institution Decision and setting due dates for an Instituted Trial. The Scheduling Order will take into account the complexity of the proceeding while ensuring that the Trial is completed within the one year statutory Pendency. *Practice Guide for Proposed Trial Rules*, 77 Fed. Reg. 6868, 6869 (Feb. 9, 2012).

Secondary Considerations: objective Evidence in IPR, PGR and CBM review proceedings tending to show that an invention was not Obvious over the asserted prior art, even in cases where the claimed invention does not seem particularly distinct from the prior art or is composed of elements found in the prior art. Secondary Considerations may include, for example, commercial success, industry recognition, long-felt but unsolved need, unexpected results and copying by competitors.

Secondary Reference: prior art references can be combined to show that a claimed invention is Obvious. A Primary Reference discloses most of the Claim Elements. Secondary References are one or more other reference(s), which disclose other Claim Elements that are combined with the Primary Reference.

Settlement: an agreement between the parties to a PTAB Proceeding that serves as the basis for a Motion to Terminate. But the PTAB is not required terminate the PTAB Proceedings based on a Settlement. In its discretion, the PTAB may proceed to a Final Written Decision regardless of a Settlement. 37 C.F.R. § 42.74.

Spacing: all documents filed in a PTAB Proceeding must use double Spacing for all text, not including Claims Charts, headings, tables of contents, tables of authorities, indices, signature blocks and certificates of service. Block quotations may be 1.5 spaced, but must be indented from both the left and right Margins. 37 C.F.R. 42.6(2)(iii). See Petition, Formatting of.

Speak with a Single Voice: in Unified Cases — cases involving Joint Petitioners and/or Consolidation — the PTAB considers multiple Petitioners a single party that must Speak with a Single Voice both in writing and oral representation. Individual arguments, submissions or sections in consolidated filings are not allowed. Each of the Petitioners must allow the Lead Counsel to speak on their behalf.

Standard of Proof: the level of Evidence required to establish a particular fact or legal issue. The Standard of Proof will depend on the particular issue, Motion and PTAB Proceeding. The two applicable Standards of Proof are Clear and Convincing Evidence and a Preponderance of the Evidence. 35 U.S.C. § 316(e).

Stay of Litigation: an order temporarily suspending a Pending Civil Action or concurrent proceeding before the PTO, often during the pendency of a PTAB Proceeding. 37 C.F.R. § 42.122(a).

Substitute Claim: a claim proposed by a Patent Owner to replace original claims through Claim Amendment in a Motion to Amend. The Patent Owner may propose one Substitute Claim for each original claim it wishes to amend, and each Substitute Claim must be traceable back to an original patent claim at issue. A proposed Substitute Claim will be considered by the PTAB only if the original claim it replaces is determined unpatentable by the PTAB or cancelled by the Patent Owner. In addition, a proposed Substitute Claim may only seek to narrow the scope of the challenged claim it replaces, and may not seek to broaden a challenged claim in any respect. The Patent Owner is required to show that the proposed new claims are patentable at least over the prior art that the Patent Owner is aware of. 37 C.F.R. §§ 42.121, 42.221.

Sufficiently Final: a district court judgment affirmed on appeal that ends the litigation on the merits and leaves nothing for the district court to do but execute the Judgment.

Supplemental Information: information submitted by a Petitioner after considering its Petition and Institution of a PTAB Proceeding. Petitioner must file a Motion for Supplemental Information within one month of the Institution Decision, and all Supplemental Information must be relevant to a claim for which the PTAB Proceeding has been Instituted. 37 C.F.R. § 42.123(a). A party seeking to file a Motion for Supplemental Information more than one month after the Institution Decision must establish that the Supplemental Information could not reasonably have been obtained earlier and that consideration of the Supplemental Information would be in the interest of justice. 37 C.F.R. § 42.123(b).

Technological Invention: a patent is not eligible for CBM review if it claims subject matter that as a whole recites a technological feature that is Novel and Unobvious over the prior art, and solves a technical problem using a technical solution. 37 C.F.R. § 42.301; see also *Transitional*

Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg. 48734, 48753 (Aug. 14, 2012).

Trial: an adversarial process during which parties to a PTAB Proceeding submit Evidence, depose witnesses, and advocate regarding Invalidity of a challenged patent. After Trial, the PTAB determines the Validity of a challenged patent. 37 C.F.R. § 42.100. The Trial period of a PTAB Proceeding begins at Institution and continues until the PTAB issues a Final Written Decision. 37 C.F.R. § 42.2. The Pendency of Trial is statutorily limited to one year after Institution, except that it may be extended up to six months for good cause. 37 C.F.R. § 42.200(c).

Unified Case: a single PTAB Proceeding consisting of Joint Petitioners or Petitions after a successful Motion for Joinder. In a Unified Case, multiple Joint Petitioners make up a single party that must strictly Speak with a Single Voice both in writing and oral representation. Individual arguments, submissions or sections in consolidated filings are not allowed. In addition, only one Lead Counsel may represent multiple Joint Petitioners.

Validity: see Invalidity.

Validity, Standard of Proof: see Invalidity, Standard of Proof.

Vertical Redundancy: Petitioner's assertion of multiple Grounds of Invalidity for a single claim based on different prior art references without explaining the relative strengths and weaknesses of each Ground of Invalidity. If a Ground of Invalidity is rejected for redundancy, the Petitioner is statutorily estopped from pursuing the grounds in a later litigation or PTAB Proceeding. So Petitioners should determine their strongest Grounds of Invalidity and proceed only with those grounds.

Written Description: a requirement for patentability. To satisfy Written Description, a patent specification must describe the claimed invention in sufficient detail to show one skilled in the art that the inventor possessed the claimed invention. 35 U.S.C. § 112(a). Written Description is available as a Ground of Invalidity in PGR and CBM review, but not IPR.

PTAB Contacts

If you have questions about Latham & Watkins' PTAB practice or this Book of Jargon, please contact one of the lawyers listed below or the Latham lawyer with whom you normally consult.

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