



October 20, 2015

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, Virginia 22313

Via Electronic Mail to TrialsRFC2015@uspto.gov

Dear Director Lee:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments to the U.S. Patent & Trademark Office (USPTO or Office) in response to its Request for Comments on Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, published in the *Federal Register* on August 20, 2015. 80 Fed. Reg. 161, 50720 (Notice).

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association through their companies or as inventor, author, law firm, or attorney members.

IPO supports rules that will streamline and simplify AIA trials, allowing owners of intellectual property to avoid unnecessary cost and delay in defending their rights. The following comments are organized in the order of the proposed rules in the *Federal Register* notice.

We thank the USPTO for considering these comments and would welcome any further dialogue or opportunity to support the USPTO in implementing the proposed rule changes.

Sincerely,

Philip S. Johnson
President

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Rule Specific Comments

- **Claim Construction Standard**

- Under what circumstances, if any, should the Board decline to construe a claim in an unexpired patent in accordance with its broadest reasonable construction?

Establishing a just, speedy, and inexpensive proceeding requires applying the *Phillips* construction, including construing each claim of the patent in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art, the prosecution history pertaining to the patent, and prior judicial determinations and stipulations relating to the patent. IPO summarized its views as part of its response to the USPTO's initial request for comments.¹ While the Notice of Proposed Rulemaking suggests that those comments were not entirely persuasive with the USPTO, IPO wishes to reemphasize its views that:

1. The importance of establishing proceedings that are not only speedy and inexpensive, **but also just**, requires applying the claim construction standard set forth in *Phillips* in all AIA trials.
2. Board rules of practice do not consider the impact of the Broadest Reasonable Interpretation (BRI) claim construction standard on the overall balance of rights between patentees and accused infringers, as required by the “integrity of the patent system” prong of Patent Act §§ 316(b) and 326(b). Nor do they consider the standard of justice in adjudicating existing patent rights that will best promote the overall progress of science and the useful arts.

While a divided panel of the Federal Circuit held, in *In re Cuozzo Speed Techs., LLC*,² that the USPTO's adoption of BRI in 37 C.F.R. § 42.100(b) was either implicitly approved by Congress³ or properly adopted and entitled to *Chevron* deference,⁴ the BRI standard stands on somewhat shaky ground. In July, the *Cuozzo* panel decision escaped *en banc* review by a scant 6:5 vote⁵ but was revised and reissued⁶ without substantive

¹ IPO Response to PTAB Request for comments (2014 September 16) (http://www.uspto.gov/sites/default/files/ip/boards/bpai/ipo_20140916.pdf).

² 778 F.3d 1271 (Fed. Cir. 2015).

³ 778 F.3d at 1281; *but cf. In re Cuozzo Speed Techs., LLC*, 2015 WL _____, *__, slip op. at 16 (Fed. Cir. July 8, 2015) (opinion revised and reissued without comment coincident with decision denying *en banc* review).

⁴ 778 F.3d at 1282; *but cf. In re Cuozzo Speed Techs., LLC*, 2015 WL _____, *__, slip op. at 18-19 (Fed. Cir. July 8, 2015).

⁵ *See In re Cuozzo Speed Techs., LLC*, 2015 WL _____, *3, slip op. at 3 (Fed. Cir. July 8, 2015) (decision denying petition for rehearing *en banc*); *see also Id.*, 2015 WL _____ at *__, slip op. at 7 (Prost, CJ dissenting, joined by Newman, Moore, O'Malley and Reyna); *see also Id.*, 2015 WL _____ at *__, slip op. at 16 (Newman, J dissenting).

⁶ *In re Cuozzo Speed Techs., LLC*, 2015 WL _____ (Fed. Cir. July 8, 2015) (revised panel decision).

comment. In *Microsoft v. Proxyconn*, the very next panel decision (i.e., after the original *Cuozzo* panel decision, but before the revised *Cuozzo* panel decision), a different panel ostensibly bound by the original *Cuozzo* panel's decision, nonetheless held that notwithstanding BRI, the Board may not construe "claims during IPR so broadly that its constructions are unreasonable under general claim construction principles."⁷ The *Microsoft* panel emphasized:

[t]he protocol of giving claims their broadest reasonable interpretation ... does not include giving claims a legally incorrect interpretation. ... Rather 'claims should always be read in light of the specification and teachings in the underlying patent.' ... The PTO should also consult the patent's prosecution history in proceedings in which the patent has been brought back to the agency for a second review. ... Even under the broadest reasonable interpretation, the Board's construction 'cannot be divorced from the specification and the record evidence[]' ... and 'must be consistent with the one that those skilled in the art would reach[.]' ... A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster.⁸

Suffice it to say that whatever the shorthand notation, proper standards for construction of claims in AIA trials remain very much in issue. IPO remains committed in its advocacy for Board practices (whether expressed in properly adopted rules, espoused in forthcoming revisions to the Office Trial Practice Guide, or applied in Board decisional law made informative or precedential) that result in a *legally correct* construction for contested claim limitations in all AIA trials.

It should be noted that a primary rationale for the Office's BRI construction standard, whether expressed (i) in responses to public comments published in the Notice,⁹ (ii) in the Trial Practice Guide,¹⁰ or (iii) in briefing as intervenor before the Federal Circuit, has been the patent owner's statutorily provided opportunity to amend. However, it remains IPO's observation that, given the Board's non-rule-denominated procedures and case-by-case adjudications to date, patent owner's *actual* ability to amend is quite limited and, in practice, has proved nearly illusory. As a result, the Office's BRI construction standard cannot be justified on this ground.

⁷ *Microsoft Corp. v. Proxyconn, Inc. v. Lee, Director, U.S. Patent & Trademark Office, Intervenor*, Appeal Nos. 2014-1542, 2014-1543, slip op. at 6 (Fed. Cir. June 16, 2015) (emphasis in original).

⁸ *Id.* at 6-7 (internal citations to pre-*Cuozzo* precedent omitted).

⁹ See Notice at 50722 (Aug. 20, 2015).

¹⁰ See Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012).

- **Patent Owner's Motions to Amend**
 - What modifications, if any, should be made to the Board's practice regarding motions to amend?

During AIA trials, a patent owner has the statutory right to file one motion to amend the patent by cancelling any challenged patent claim, and for each challenged claim, proposing a reasonable number of substitute claims.¹¹ Notwithstanding the statutory right, a patent owner's actual ability to amend claims in AIA trials has been, in practice, severely restricted by the Office.¹² Perhaps most notable in *Idle Free* was the Office's imposition of a requirement under 37 C.F.R. § 42.20(c) that "[patent owner] persuade the Board that [a] proposed substitute claim is patentable over the prior art of record, **and over prior art not of record but known to the patent owner.**"¹³

While the Federal Circuit, in *Proxycorr*, could not say the Office's interpretation of § 42.20(c) was plainly erroneous or inconsistent with the regulation or governing statutes,¹⁴ the court did intimate its concern with extending the § 42.20(c)-based burden to prior art not of record.¹⁵ The Office has since recognized the import of *Proxycorr* and has at least partially clarified its *Idle Free* requirement as to prior art not of record.¹⁶ However, the Office has at the same time retooled its definition of "prior art of record" to redefine the record in such a way that the term "prior art of record" ... everywhere ... in *Idle Free*[] should be understood as referring to:

1. any material art in the prosecution history of the patent;
2. any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and
3. any material art of record in any other proceedings before the Office involving the patent.¹⁷

In doing so, the Office adopts a non-*adjudicative* posture that extends the § 42.20(c)-based burden to prior art **not actually of record** in the AIA trial proceeding in which the

¹¹ See 35 USC §§ 316(d)(1), 326(d)(1).

¹² See generally, *Idle Free Inc. v. Bergstrom, Inc.*, No. IPR2012-00027, Paper No. 26, at 7-8 (PTAB June 11, 2013) (informative).

¹³ See *Id.* at 7 (interpreting 37 C.F.R. § 42.20(c), emphasis added).

¹⁴ *Microsoft v. Proxycorr*, slip op. at 25-26 (Fed. Cir. June 16, 2015).

¹⁵ See *Id.*, note 4.

¹⁶ See *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, paper 42, at 2 (PTAB July 15, 2015) (clarifying that "prior art known to the patent owner" ... everywhere ... in *Idle Free*[] should be understood as no more than the material prior art that Patent Owner makes of record in the current proceeding pursuant to its duty of candor and good faith to the Office under 37 C.F.R. § 42.11, in light of a Motion to Amend."); see also Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, Proposed Rule, 80 Fed. Reg. at 50723.

¹⁷ *MasterImage 3D*, paper 42, at 2.

“petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”¹⁸ Prior art may become of record in the AIA trial either by actions of the patent owner consistent with its duty of candor and good faith or through rebuttal, by the petitioner in its opposition, of patent owner’s *prima facie* case of patentability over prior art actually of record in the AIA trial proceeding.¹⁹ In this regard, *Proxycorn* made clear that the adjudicative scope of an AIA trial proceeding is not limited solely to the prior art grounds on which trial was instituted for an original claim.²⁰ Rather, the patent owner’s § 42.20(c) burden extends to prior art that is “front and center throughout the course of the proceedings.”²¹

The Office should further clarify, consistent with the reasoning and circumstances of *Proxycorn*,²² that absent rebuttal evidence actually advanced by petitioner in the AIA trial proceeding, patentee’s § 42.20(c) burden as movant is satisfied by setting forth a *prima facie* case of patentability of narrower substitute claims over the prior art actually of record. For avoidance of doubt, IPO does not take the position that material art in the prosecution history of the patent or material art of record in any other proceedings before the Office involving the patent, or other material art, may not be considered if properly raised by petitioner in opposition to a motion to amend. But the Office should repudiate statements in *MasterImage 3D* that purport to extend the patent owner’s burden in these AIA trial proceedings to invalidity positions that fall outside the actual record of the adjudicative proceeding.

IPO recognizes and appreciates the Office’s recent adoption of somewhat less restrictive page limits on motions to amend.²³ Nonetheless, given the reference counts that can be typical of many file histories, a requirement, as proposed in *MasterImage 3D* and referenced with approval in the Notice, that patent owner establish a *prima facie* case of patentability over prior art ***not actually of record*** in the AIA trial proceeding remains impracticable given these page limits. For this reason as well, the Office should repudiate statements that purport to extend the patent owner’s *prima facie* patentability burden to invalidity positions outside the actual record of the adjudicative AIA trial proceeding.

¹⁸ See 35 U.S.C. § 316(e) (2011).

¹⁹ See Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, Proposed Rule, 80 Fed. Reg. at 50722, 50723 (noting that *MasterImage 3D* clarified that burden of production shifts to petitioner “once Patent Owner has set forth a *prima facie* case of patentability of narrower substitute claims over the prior art of record.”)

²⁰ See *Microsoft v. Proxycorn*, slip op. at 27-28.

²¹ See *Id.* at 28.

²² See *Id.* at 26.

²³ See 80 Fed. Reg. 28561, 28565-66, Final Rule, Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board; 37 C.F.R. § 42.24(a)(1)(vi) (amended to raise page limit for Motion to Amend to 25 pages from 15); and *Id.* §§ 42.121(b), 42.221(b) (allowing claim listing to appear in appendix not subject to the page limit).

- **Patent Owner Preliminary Response**
 - New testimonial evidence to be permitted in a Patent Owner Preliminary Response

IPO applauds the change that allows patent owners to file a preliminary response that includes all evidence the patent owner chooses to rely upon to rebut the petition, including testimonial evidence (by affidavit or declaration). The Office should encourage a full disclosure of rebuttal evidence by the patent owner in the preliminary response so that the Board may decide whether to institute an AIA trial on the basis of the best available information.

However, IPO is concerned with the following two aspects of the proposed rule changes related to the pre-institution stage of the AIA trials:

1. Resolving material factual disputes in favor of petitioner when deciding whether to institute an AIA trial; and
2. The availability to a petitioner of filing a reply to a preliminary response that includes new testimonial evidence.

Evidence presented by the patent owner, including new testimonial evidence, should be weighed in the same manner as like evidence presented by the petitioner. Congress has spoken directly on the standard for institution decisions, and did not provide for any presumption or weighing of evidence against the patent owner. Indeed, the evidentiary burden at institution, as well as during an AIA trial, is on the petitioner. A rule that in essence weights evidence in favor of the petitioner is inconsistent with this burden and with the statutory requirements for institution decisions.

The proposed rule construing evidence at the institution stage in the light most favorable to the petitioner is not needed to counterbalance the petitioner's lack of ability to cross-examine a declarant prior to institution or to file a reply as of right.

The lack of cross-examination of a patent owner's declarant until after a decision on institution places a petitioner at an equal evidentiary position as the patent owner, because a patent owner also does not have the ability to cross-examine a petitioner's declarant prior to institution.

Further, the issue of not being provided the right to file a reply can be remedied by the Board's readiness to grant leave to file replies to address arguments that a petitioner could not have reasonably anticipated. In many cases, new testimonial evidence provided by a patent owner with a preliminary response may raise reasonably unanticipated issues that would merit granting a reply. As many previous commenters stated, the petition itself is limited because the petitioner cannot anticipate all arguments

or testimonial evidence that a patent owner may present. Accordingly, where a patent owner presents new testimonial evidence in a patent owner preliminary response relating to issues that could not have been anticipated, the Board should grant leave to file a reply that includes additional testimonial evidence directed at those issues. Such a reply can provide the best available information to the Board for weighing against the reasonable likelihood of prevailing standard where a patent owner has submitted evidence that was reasonably unanticipated by a petitioner.

Accordingly, the Board readily granting leave to file a reply where evidence has been provided that could not have been reasonably anticipated by the petitioner provides the petitioner with the ability to contradict new issues raised by the new testimonial evidence and provides both parties fair ability to present their evidence and arguments prior to the decision on institution. Thus, the evidence from both parties can continue to be weighed in the same manner.

- **Additional Discovery/Obviousness**

As is described in more detail in the proposal below, IPO reiterates its suggestion that the Board relax the first *Garmin* factor (i.e., rewriting the first factor to be “a reasonable basis that the non-moving party has evidence relevant to [the issue]”) in view of the fifth factor (i.e., requests not overly burdensome to answer). By taking such a step, the Board can allow for the limited exchange of information about a particular topic while likewise limiting the scope of discovery to still fit within the statutory timeline.

In making determinations regarding discovery, the Board uses the following factors outlined in *Garmin*:

1. More Than A Possibility And Mere Allegation
2. Litigation Positions And Underlying Basis
3. Ability To Generate Equivalent Information By Other Means
4. Easily Understandable Instructions
5. Requests Not Overly Burdensome To Answer

By adapting this first factor, the moving party will still be required to demonstrate some reasonable basis for the request. For example, in connection with discovery to request financial documents relating to sales data (to show non-obviousness), the moving party would need to demonstrate that the claims at issue could reasonably be read to cover a particular product to ensure the requested sales data is reasonably related to claims at issue. If such a mapping was reasonable, then the Board would approve reasonable discovery requests that were not overly burdensome to answer. These types of requests would not necessarily be burdensome if correctly written as it is likely that this type of financial data is already in existence, is under the control of the non-moving party, and would not be burdensome to produce or access.

The same test would also apply to the other additional discovery. For example, should a moving party request discovery on copying a claimed invention, the moving party would need to demonstrate a reasonable basis for such a request. Even if the moving party were able to show such a request was reasonable, the Board can balance such a reasonable request by ensuring it is not overly burdensome to answer. The same would apply to requests for discovery concerning real parties-in-interest, etc.

This proposal balances the more permissive first factor with the already existing fifth factor (i.e., requests are not overly burdensome to answer). The fifth factor will be used by the Board to ensure any requests are limited to, for example, documents already in existence, short time windows, limited number of products, etc. By altering the language of the first factor and enforcing the fifth factor, the interests of justice are met as the moving party will obtain necessary documents to determine whether secondary factors of non-obviousness are present, and the non-moving party will not be forced to respond to overly burdensome requests. IPO looks forward to seeing the promised changes associated with discovery in the Trial Practice Guide.

- **Real Party-in-Interest (RPI)**

IPO agrees with the Board that the patent owner may raise a real-party-in-interest issue at any time during the proceeding. The Board's requirement of explaining a belated RPI challenge in the proceeding is reasonable. However, a rational explanation such as new facts coming to light should be sufficient for patent owners to have the Board consider whether the petition properly identified all real parties in interest.

- **Multiple proceedings**

IPO appreciates and understands the Office's need to conserve resources, and appreciates that the Board is attempting to avoid patent owner harassment by denying institution when the petitioners recycle arguments that the Board has found deficient. Such petitions are a waste of the Board resources, and it is appropriate for the Board to not institute. However, petitioners may have reasonable bases for filing second petitions after receiving a first denial of institution, provided that the new petition does not revisit evidence or arguments already considered, such as the following:

1. A material change in claim construction standard or substantive law occurred since the filing of the previously denied petition.
2. Petitioner need to address additional claims not previously asserted by patent owner against petitioner/RPI/privy in litigation, even if some of the grounds under which the additional claims are challenged involve the same or substantially the same prior art or arguments denied as to other claims in a petition filed by the petitioner/RPI/privy.

IPO supports the Board limiting the filing of serial petitions in an effort to prevent harassment and incentivize the petitioner to include its best and complete arguments in its initial petition. However, the petitioner may seek to file a second petition after denial of a first petition where the patent owner preliminary response or decision on institution contains information that could not have been reasonably anticipated when filing the first petition. The filing of a second petition in this circumstance causes additional expense for all parties, including the Board. The Board may be able to reduce the number of second petitions if it were more frequently to authorize replies to preliminary responses when the petitioner demonstrate that it reasonably could not have anticipated the patent owner's arguments in the first proceeding. Furthermore, if the Board raises a new issue, such as denying a petition on the basis of a claim construction issue not identified by either party, the Board should give the petitioner an opportunity to address that issue in a request for rehearing, rather than dismiss such a request as raising new issues. If the Board is typically only going to allow the petitioner one opportunity to present its arguments, the Board should ensure that the petitioners has the opportunity to address reasonably unanticipated arguments before issuing a final and non-appealable decision.

- **Extension of 1-Year Period to Issue Final Determination**

IPO agrees with the Office that it should continue to strive to meet the one-year statutory time period for AIA Trials. IPO looks forward to receiving the updated Trial Practice Guide, which will provide examples of instances in which an extension may be warranted, which IPO hopes will include instances where an extension is needed to ensure a full and fair AIA trial for patent owners.

- **Oral Hearing**

IPO agrees that the Office should continue to have discretion as to whether to permit live testimony, but reiterates that the Office should grant live testimony more frequently. The Office's rationale for limiting the evidence of record is important, but so is the parties' right to a full and fair hearing. The Board can limit live testimony to a limited number of issues, agreed to by the parties well before the final hearing. The Board frequently states its ability to distinguish new arguments and ignore them; thus, there should be limited additional work for the Board, and the parties will get the full and fair hearing they deserve.

General

IPO thanks the Office for updating the AIA trial rules, and encourages the Office to consider and respond to the items discussed above. The discussion below addresses comments on the proposed rules.

- ***Comment 2: Filing an opponent's confidential information***

IPO is encouraged by the Office's intent to update the Practice Guide to handle filing an opponent's confidential information. AIA trials are very fast-paced and do not allow for much time to consider arguments and evidence, and to negotiate with opposing parties over which information should remain confidential.

For instance, a deposition might be scheduled late during a discovery period or the parties may have stipulated to shortened schedules, which exacerbates the problem of too little time to prepare. In these instances, the Office should permit a party to file provisionally an opposing party's apparent confidential information under seal, and allow the opposing party to explain which information, if any, should remain under seal.

- ***Comments 3, 4 (excess claims), and 5 (arguments in claim chart): Word Count***

A cursory count of several filed IPR petitions demonstrates that the proposed word count is too low. Petitions exceeding the proposed word counts are not "exceptional;" they are common. If the Office intends to apply a word count to "exceptional" petitions, it must disclose its underlying data demonstrating why it believes petitions exceeding these word counts are "exceptional." *Hanover Potato Prods. v. Shalala*, 989 F.2d 123 (3d Cir. 1993).

The Office places many regulatory and judicially-made requirements on petitioners when filing petitions, including presenting a full rationale to combine, claim constructions of all important terms, and no incorporation by reference. Even when petitioners make a good faith effort to provide several claim constructions, the Board may deny a petition for failing to construe another term. IPR2014-00937, Paper 22. Placing these burdens on petitioners to present their entire case-in-chief, while not giving enough space to make their cases places too much burden on petitioners. IPO recommends that the Office increase the word counts by at least 2,000 words.

The Board has offered that petitioners may request additional pages or file multiple petitions if they need more space. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 157, 48612, 48635–6. However, in practice, the Board usually does not grant such requests or institute on second petitions. *See* IPR2015-00767, Paper 14 (denying petition under 35 U.S.C. § 325(d) despite it challenging claims for the first time); IPR2015-00327, Paper 15 (denying second petition under 35 U.S.C. § 325(d) filed on same day); IPR2012-00005, Paper 42 (granting only one additional page); IPR2012-00027, Paper 27, (denied ten pages for motion to amend); IPR2014-00949, Paper 16, (denied additional pages); IPR2013-00011, Paper 11, (denied eight additional pages for petition). Therefore, IPO asks that the Board increase the word count limit because the Board does not usually grant additional pages or multiple petitions.

- ***Comment 6: Petitioner reply to preliminary response***

It is unclear whether the change to the rules to allow petitioners to request replies to preliminary responses simply codifies current practice or is a practical change that would allow petitioners to file pre-institution replies as of right in every case. Petitioners may already request replies to preliminary responses, though the Board denies them frequently. The Board should make clear that a petitioner may file replies to address arguments that it could not have reasonably anticipated. This should be a relatively rare event. This balances petitioner's desire to have a full and fair hearing in the decision on institution with the patent owner's right to respond and the Board's need to provide a just, speedy, and inexpensive proceeding.

This is a particularly important issue for patent owners, though, since this new practice provides petitioners with one paper more than patent owners. And, of course, every additional paper permitted in the proceeding will increase the overall cost of the proceeding for both parties. It may be possible that this disparity could be remedied by authorizing patent owner sur-replies to petitioner replies to the patent owner response, if the patent owner can demonstrate that the reply raises issues that could not have been reasonably anticipated, particularly new expert testimony.

- ***Comment 10: Updating PRPS and coordination with PAIR***

The Office has suggested on several occasions that it is seeking to improve PRPS. IPO is unaware of any updates to PRPS since its release, and the same limitations remain from the first day it was made available. For instance, the search options only allow searching based on petitioner, not patent owner in the "party name" field. In addition, PRPS frequently goes down, causing problems when parties try to file papers.

Other problems with PRPS include, first, the inability of PRPS to store more than about ten documents without significant degrading of responsiveness. Second, PRPS frequently does not accurately post the status of cases. *See, e.g.*, IPR2013-00073 shows "Pending" when it is terminated; and IPR2013-00261 shows "Not Instituted" when it is terminated.

Third, when PRPS is down, parties must file via email with a motion to accept filing. However, the email system will only accept files up to 7 MB, while PRPS accepts files up to 25 MB. This requires splitting large files up even further. IPO requests that the Office improve PRPS to address these problems and make it more reliable.

- ***Comment 12: Redundancy***

Petitioners cannot reasonably anticipate all patent owner's arguments, and therefore petitioners frequently propose multiple grounds. The Board has provided guidance to petitioners on how to demonstrate that a ground is not redundant of other grounds, *i.e.*,

an explanation of how the grounds are better or worse than one another. However, the Board has denied petitions even when petitioners followed this guidance. *See, e.g.*, IPR2014-00638, Papers 1 and 9. This practice places the petitioner at a disadvantage if the patent owner overcomes one ground while ignoring disclosure in a “redundant” ground. The Board may institute on a faulty ground while a “redundant” ground would have succeeded. If the Board provides guidance as to how to show non-redundancy, and the petitioner follows it, the Board should institute on all grounds expressly shown to be non-redundant.

Petitioners take on great risk and expense when preparing petitions, and in exchange they should have an opportunity to present a full and fair case, with the patent owner receiving a corresponding right to respond. The Board should more frequently consider petitioner’s multiple grounds when the petitioner shows these grounds are not redundant, the necessity of which may not be apparent until after the patent owner response.

- ***Comment 19: Deposition rules***

The Office should make clear whether parties may confer with their declarants during depositions. Currently panels are inconsistent regarding whether they permit counsel to confer with their declarants, particularly between cross examination and redirect. The Board should make a rule and apply it consistently, else parties cannot be certain what to do and may gain an unfair advantage if they are willing to test the rules’ boundaries. The USPTO might wish to consider a rule that is consistent with the Federal Rules of Civil Procedure and practices in federal district court litigation or with prior practices of the Board of Patent Appeals and Interferences in conducting patent interference and *inter partes* reexamination proceedings.

The Office invited further comment on 37 C.F.R. § 42.53(d)(4), concerning filing of notices of depositions. Sometimes parties cannot agree on a time and location of a deposition to give enough time for a timely notice of deposition. Therefore, parties will sometimes file a late notice of deposition without ill effect. The notices are primarily for the Board’s benefit. Therefore, if the Board is not burdened by a later notice of deposition, IPO would prefer a shorter timing requirement for filing such notices.

- ***Comment 20: Patent owner should submit evidence challenging publication or authenticity with objections***

The Office is incorrect that the rule requiring service of evidence inconsistent with a position requires service of evidence concerning authenticity and publication. The evidence discussed in this comment concerns evidence consistent with an objection. The Office should require service of evidence consistent with an objection. Then, absent good cause, the objecting party should not be able to rely on previously served evidence in a motion to exclude. If there is good cause for a delay in serving evidence, the party

receiving the objection should have appropriate time to serve supplemental evidence in response to the objection.

- ***Comment 36: Supplemental evidence***

The rules are not clear on whether a party may file previously served supplemental evidence with an opposition to a motion to exclude. The rules state that a party may file “supplemental information” within thirty days of institution or afterwards if it is in the interest of justice. Parties often file the supplemental evidence, if appropriate, with oppositions to motions to exclude. However, Board decisions are inconsistent on whether this is the appropriate course of action. Therefore, the rules should make clear that a party may file previously served supplemental evidence with oppositions to motions to exclude.