

# Proposed Rules for Practice Before the PTAB

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## Subpart A—Trial Practice and Procedure

### General

#### § 42.1 Policy.

- (a) *Scope.* Part 42 governs proceedings before the Patent Trial and Appeal Board. Sections 1.4, 1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of part 1 of this chapter that are incorporated by reference into this part.
- (b) *Construction.* This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.
- (c) *Decorum.* Every party must act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.
- (d) *Evidentiary standard.* The default evidentiary standard is a preponderance of the evidence.

#### § 42.2 Definitions.

The following definitions apply to this part:

*Affidavit* means affidavit or declaration under § 1.68 of this chapter. A transcript of an *ex parte* deposition or a declaration under 28 U.S.C. 1746 may be used as an affidavit.

*Board* means the Patent Trial and Appeal Board. *Board* means a panel of the Board or a member or employee acting with the authority of the Board.

*Business day* means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

*Confidential information* means trade secret or other confidential research, development or commercial information.

*Final* means final for the purpose of judicial review. A decision is final only if it disposes of all necessary issues with regard to the party seeking judicial review, and does not indicate that further action is required.

*Hearing* means consideration of the trial.

*Involved* means an application, patent, or claim that is the subject of the proceeding.

*Judgment* means a final written decision by the Board.

*Motion* means a request for relief other than by petition.

*Office* means the United States Patent and Trademark Office.

*Panel* means at least three members of the Board.

*Party* means at least the petitioner and the patent owner and, in a derivation proceeding, any applicant.

*Petition* is a request that a trial be instituted.

*Petitioner* means the party filing a petition requesting that a trial be instituted.

*Preliminary Proceeding* begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted.

*Proceeding* means a trial or preliminary proceeding.

*Rehearing* means reconsideration.

*Trial* means a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial. The term trial specifically includes a derivation proceeding under 35 U.S.C. 135; an *inter partes* review under Chapter 31 of title 35, United States Code; a post-grant review under Chapter 32 of title 35, United States Code; and a transitional business-method review under section 18 of the Leahy-Smith America Invents Act. Patent interferences are administered under part 41 and not under part 42 of this title, and therefore are not trials.

#### § 42.3 Jurisdiction.

- (a) The Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order.
- (b) A petition to institute a trial must be filed with the Board in a timely manner.

#### §42.4 Notice of trial.

- (a) Institution of trial. The Board institutes the trial on behalf of the Director.
- (b) Notice of a trial will be sent to every party to the proceeding. The entry of the notice institutes the trial.
- (c) The Board may authorize additional modes of notice, including:
  - (1) Sending notice to another address associated with the party, or
  - (2) Publishing the notice in the Official Gazette of the United States Patent and Trademark Office or the **Federal Register**.

#### § 42.5 Conduct of the proceeding.

- (a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.
- (b) The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.
- (c) *Times*—
  - (1) *Setting times*. The Board may set times by order. Times set by rule are default and may be modified by order. Any modification of times will take any applicable statutory pendency goal into account.
  - (2) *Extension of time*. A request for an extension of time must be supported by a showing of good cause.
  - (3) *Late action*. A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.
- (d) *Ex parte communications*. Communication regarding a specific proceeding with a Board member defined in 35 U.S.C. 6(a) is not permitted unless both parties have an opportunity to be involved in the communication.

#### § 42.6 Filing of documents, including exhibits; service.

- (a) *General format requirements*.
  - (1) Page size must be 8½ inch x 11 inch except in the case of exhibits that require a larger size in order to preserve details of the original.
  - (2) In documents, including affidavits, created for the proceeding:
    - (i) Markings must be in black or must otherwise provide an equivalent dark, high-contrast image;
    - (ii) Either a proportional or monospaced font may be used:
      - (A) The proportional font must be 14- point or larger, and
      - (B) The monospaced font must not contain more than 4 characters per centimeter (10 characters per inch);
    - (iii) Double spacing must be used except in 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; and
    - (iv) Margins must be at least 2.5 centimeters (1 inch) on all sides.
  - (3) *Incorporation by reference; combined documents*. Arguments must not be incorporated by reference from one document into another document. Combined motions, oppositions, replies, or other combined documents are not permitted.
  - (4) *Signature; identification*. Documents must be signed in accordance with §§ 1.33 and 11.18(a) of this title, and should be identified by the trial number (where known).
- (b) *Modes of filing*—
  - (1) *Electronic filing*. Unless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the Web site of the Office.
  - (2) (i) *Filing by means other than electronic filing*. A document filed by means other than electronic filing must:
    - (A) Be accompanied by a motion requesting acceptance of the submission; and
    - (B) Identify a date of transmission where a party seeks a filing date other than the date of receipt at the Board.
  - (ii) Mailed correspondence shall be sent to: Mail Stop PATENT BOARD, Patent Trial and Appeal Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.
- (c) *Exhibits*. Each exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.

- (d) *Previously filed paper.* A document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.
- (e) *Service*—
  - (1) *Simultaneous with filing.* Each document filed with the Board, if not previously served, must be served simultaneously on each opposing party.
  - (2) *Counsel of record.* If a party is represented by counsel of record in the proceeding, service must be on counsel.
  - (3) *Certificate of service.*
    - (i) Each document, other than an exhibit, must include a certificate of service at the end of that document. Any exhibit filed with the document may be included in the certification for the document.
    - (ii) For an exhibit filed separately, a transmittal letter incorporating the certificate of service must be filed. If more than one exhibit is filed at one time, a single letter should be used for all of the exhibits filed together. The letter must state the name and exhibit number for every exhibit filed with the letter.
    - (iii) The certificate of service must state:
      - (A) The date and manner of service; and
      - (B) The name and address of every person served.

**§ 42.7 Management of the record.**

- (a) The Board may expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized under this part or in a Board order or that is filed contrary to a Board order.
- (b) The Board may vacate or hold in abeyance any non-Board action directed to a proceeding while an application or patent is under the jurisdiction of the Board unless the action was authorized by the Board.

**§ 42.8 Mandatory notices.**

- (a) Each notice listed in paragraph (b) of this section must be filed with the Board:
  - (1) By the petitioner, as part of the petition;
  - (2) By the patent owner, or applicant in the case of derivation, within 21 days of service of the petition; or
  - (3) By either party, within 21 days of a change of the information listed in paragraph (b) of this section stated in an earlier paper.
- (b) Each of the following notices must be filed as a separate paper with a caption identical to the title of the paragraph:
  - (1) *Real party-in-interest.* Identify each real party-in-interest for the party.
  - (2) *Related matters.* Identify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.
  - (3) *Lead and back-up counsel.* If the party is represented by counsel, then counsel must be identified.
  - (4) *Service information.* Identify (if applicable):
    - (i) An electronic mail address;
    - (ii) A postal mailing address;
    - (iii) A hand-delivery address, if different than the postal mailing address;
    - (iv) A telephone number; and
    - (v) A facsimile number.

**§ 42.9 Action by patent owner.**

- (a) *Entire interest.* An owner of the entire interest in an involved application or patent may act to the exclusion of the inventor (*see* § 3.73(b) of this title).
- (b) *Part interest.* An owner of a part interest in the subject patent may move to act to the exclusion of an inventor or a co-owner. The motion must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interests of justice to permit the owner of a part interest to act in the trial. In granting the motion, the Board may set conditions on the actions of the parties.

**§42.10 Counsel.**

- (a) If a party is represented by counsel, the party should designate a lead counsel and a back-up counsel who can conduct business on behalf of the lead counsel.
- (b) A power of attorney must be filed with the designation of counsel, except the patent owner should not file an additional power of attorney if the designated counsel is already counsel of record in the subject patent or application.
- (c) The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to such conditions as the Board may impose.
- (d) A panel of the Board may disqualify counsel for cause after notice and opportunity for hearing. A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.
- (e) Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.

**§ 42.11 Duty of candor.**

Parties and individuals associated with the parties have a duty of candor and good faith to the Office during the course of a proceeding.

**§ 42.12 Sanctions.**

- (a) The Board may impose a sanction against a party for misconduct, including:
  - (1) Failure to comply with an applicable rule or order in the proceeding;
  - (2) Advancing a misleading or frivolous argument or request for relief;
  - (3) Misrepresentation of a fact;
  - (4) Engaging in dilatory tactics;
  - (5) Abuse of discovery;
  - (6) Abuse of process; or
  - (7) Any other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.
- (b) Sanctions include entry of:
  - (1) An order holding facts to have been established in the proceeding;
  - (2) An order expunging, or precluding a party from filing a paper;
  - (3) An order precluding a party from presenting or contesting a particular issue;
  - (4) An order precluding a party from requesting, obtaining, or opposing discovery;
  - (5) An order excluding evidence;
  - (6) An order providing for compensatory expenses, including attorney fees;
  - (7) An order requiring terminal disclaimer of patent term; or
  - (8) Judgment in the trial or dismissal of the petition.

**§ 42.13 Citation of authority.**

- (a) For any United States Supreme Court decision, citation must be to the United States Reports.
- (b) For any decision other than a United States Supreme Court decision, citation must be to the West Reporter System.
- (c) Citations to authority must include pinpoint citations whenever a specific holding or portion of an authority is invoked.
- (d) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in the United States Reports or the West Reporter System, a copy of the authority should be provided.

**§ 42.14 Public availability.**

The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered. A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.

## Fees

### §42.15 Fees.

- (a) On filing a petition for *inter partes* review of a patent, payment of the following fee is due based upon the number of challenged claims:
  - (1) 1 to 20 claims — \$27,200.00.
  - (2) 21 to 30 claims — \$34,000.00.
  - (3) 31 to 40 claims — \$40,800.00.
  - (4) 41 to 50 claims — \$54,400.00.
  - (5) 51 to 60 claims — \$68,000.00.
  - (6) Additional fee for each additional 10 claims or portion thereof — \$27,200.00.
- (b) On filing a petition for post-grant review or covered business method patent review of a patent, payment of the following fee is due based upon the number of challenged claims:
  - (1) 1 to 20 claims — \$35,800.00.
  - (2) 21 to 30 claims — \$44,750.00.
  - (3) 31 to 40 claims — \$53,700.00.
  - (4) 41 to 50 claims — \$71,600.00.
  - (5) 51 to 60 claims — \$89,500.00.
  - (6) Additional fee for each additional 10 claims or portion thereof — \$35,800.00.
- (c) On the filing of a petition for a derivation proceeding a fee of:— \$400.00.
- (d) Any request requiring payment of a fee under this part, including a written request to make a settlement agreement available:— \$400.00.

## Petition and Motion Practice

### § 42.20 Generally.

- (a) *Relief*. Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion.
- (b) *Prior authorization*. A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding.
- (c) *Burden of proof*. The moving party has the burden of proof to establish that it is entitled to the requested relief.
- (d) *Briefing*. The Board may order briefing on any issue involved in the trial.

### § 42.21 Notice of basis for relief.

- (a) *Notice of request for relief*. The Board may require a party to file a notice stating the relief it requests and the basis for its entitlement to relief. A notice must include sufficient detail to place the Board and each opponent on notice of the precise relief requested. A notice is not evidence except as an admission by a party-opponent.
- (b) *Filing and service*. The Board may set the times and conditions for filing and serving notices required under this section. The Board may provide for the notice filed with the Board to be maintained in confidence for a limited time.
- (c) *Effect*. If a notice under paragraph (a) of this section is required:
  - (1) A failure to state a sufficient basis for relief may result in a denial of the relief requested;
  - (2) A party will be limited to filing motions consistent with the notice; and
  - (3) Ambiguities in the notice will be construed against the party.
- (d) *Correction*. A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices will only be entered if entry would serve the interests of justice.

### § 42.22 Content of petitions and motions.

- (a) Each petition or motion must be filed as a separate paper and must include:
  - (1) A statement of the precise relief requested;
  - (2) A statement of material facts (*see* paragraph (c) of this section); and
  - (3) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.
- (b) *Relief requested.* Where a rule in part 1 of this title ordinarily governs the relief sought, the petition or motion must make any showings required under that rule in addition to any showings required in this part.
- (c) *Statement of material facts.* Each material fact shall be set forth as a separately numbered sentence with specific citations to the portions of the record that support the fact.
- (d) The Board may order additional showings or explanations as a condition for authorizing a motion (*see* § 42.20(b)).

**§ 42.23 Oppositions and replies.**

- (a) Oppositions and replies must comply with the content requirements for motions and must include a statement identifying material facts in dispute. Any material fact not specifically denied may be considered admitted.
- (b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition.

**§42.24 Page limits for petitions, motions, oppositions, and replies.**

- (a) *Petitions and motions.*
  - (1) The following page limits for petitions and motions apply and include the required statement of facts in support of the petition or motion. The page limit does not include a table of contents, a table of authorities, a certificate of service, or appendix of exhibits.
    - (i) Petition requesting *inter partes* review: 50 pages
    - (ii) Petition requesting post-grant review: 70 pages
    - (iii) Petition requesting covered business method patent review: 70 pages
    - (iv) Petition requesting derivation proceeding: 50 pages
    - (v) Motions: 15 pages.
  - (2) Petitions to institute a trial must comply with the stated page limits but may be accompanied by a motion to waive the page limits. The petitioner must show in the motion how a waiver of the page limits is in the interests of justice and must append a copy of proposed petition exceeding the page limit to the motion. If the motion is not granted, the proposed petition exceeding the page limit may be expunged or returned. Any other motion to waive page limits must be granted in advance of filing a motion, opposition or reply for which the waiver is necessary.
- (b) *Oppositions.* The page limits for oppositions are the same as those for corresponding petitions or motions. The page limits do not include a listing of facts which are admitted, denied, or cannot be admitted or denied.
- (c) *Replies.* The following page limits for replies apply and include the required statement of facts in support of the reply. The page limits do not include a table of contents, a table of authorities, a listing of facts which are admitted, denied, or cannot be admitted or denied, a certificate of service, or appendix of exhibits.
  - (1) Replies to patent owner responses to petitions: 15 pages
  - (2) Replies to motions: 5 pages.

**§ 42.25 Default filing times.**

- (a) A motion may only be filed according to a schedule set by the Board. The default times for acting are:
  - (1) An opposition is due one month after service of the motion; and
  - (2) A reply is due one month after service of the opposition.
- (b) A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.

**Testimony and Production § 42.51 Discovery.**

- (a) *Limited discovery.* A party is not entitled to discovery except as authorized in this subpart. The parties may agree to discovery between themselves at any time.
- (b) *Routine discovery.* Except as the Board may otherwise order:
  - (1) Unless previously served, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.
  - (2) Cross examination of affidavit testimony is authorized within such time period as the Board may set.
  - (3) Unless previously served, noncumulative information that is inconsistent with a position advanced by the patent owner or petitioner during the proceeding. The information is to be filed as soon as practicable in a motion identifying supplemental information or as part of a petition, motion, opposition, reply, preliminary patent owner response to petition, or patent owner response to petition. The party submitting the information must specify the relevance of the information, including where the information is presented in a document and, where applicable, how the information is pertinent to the claims.
- (c) *Additional discovery.*
  - (1) A party may move for additional discovery. Except in post-grant reviews, the moving party must show that such additional discovery is in the interests of justice. The Board may specify conditions for such additional discovery.
  - (2) When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during authorized compelled testimony under § 42.52.

**§ 42.52 Compelling testimony and production.**

- (a) *Authorization required.* A party seeking to compel testimony or production of documents or things must file a motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:
  - (1) In the case of testimony, identify the witness by name or title; and
  - (2) In the case of a document or thing, the general nature of the document or thing.
- (b) *Outside the United States.* For testimony or production sought outside the United States, the motion must also:
  - (1) *In the case of testimony.*
    - (i) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and
    - (ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the travel expenses of the witness to testify in the United States.
  - (2) *In the case of production of a document or thing.*
    - (i) Identify the foreign country and explain why the party believes production of the document or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and
    - (ii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document or thing to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

**§ 42.53 Taking testimony.**

- (a) *Form.* Uncompelled direct testimony must be submitted in the form of an affidavit. All other testimony, including testimony compelled under 35 U.S.C. 24, must be in the form of a deposition transcript. In addition, the Board may authorize or require live or video-recorded testimony.
- (b) *Time and location.*
  - (1) Uncompelled direct testimony may be taken at any time to support a petition, motion, opposition, or reply; otherwise, testimony may only be taken during a testimony period set by the Board.
  - (2) Except as the Board otherwise orders, during the testimony period, deposition testimony may be taken at any reasonable time and location within the United States before any disinterested official authorized to administer oaths at that location.
  - (3) Deposition testimony outside the United States may only be taken as the Board specifically directs.
- (c) *Notice of deposition.*

- (1) Prior to the taking of deposition testimony, all parties to the proceeding must agree on the time and place for taking testimony. If the parties cannot agree, the party seeking the testimony must initiate a conference with the Board to set a time and place.
  - (2) Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. A party requesting cross-examination testimony of more than one witness may choose the order in which the witnesses are to be cross-examined.
  - (3) In the case of direct deposition testimony, at least 3 business days prior to the conference in paragraph (c)(1) of this section, the party seeking the direct testimony must serve:
    - (i) A list and copy of each document under the party's control and on which the party intends to rely; and
    - (ii) A list of, and proffer of reasonable access to, anything other than a document under the party's control and on which the party intends to rely.
  - (4) The party seeking the deposition must file a notice of the deposition at least 2 business days before a deposition.
  - (5) Scope and content—
    - (i) For direct deposition testimony, the notice limits the scope of the testimony and must list:
      - (A) The time and place of the deposition;
      - (B) The name and address of the witness;
      - (C) A list of the exhibits to be relied upon during the deposition; and
      - (D) A general description of the scope and nature of the testimony to be elicited.
    - (ii) For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.
    - (iii) The notice must list the time and place of the deposition.
  - (6) Motion to quash—Objection to a defect in the notice is waived unless the objecting party promptly seeks authorization to file a motion to quash.
- (d) *Deposition in a foreign language.* If an interpreter will be used during the deposition, the party calling the witness must initiate a conference with the Board at least 5 business days before the deposition.
- (e) *Manner of taking deposition testimony.*
- (1) Before giving deposition testimony, each witness shall be duly sworn according to law by the officer before whom the deposition is to be taken. The officer must be authorized to take testimony under 35 U.S.C. 23.
  - (2) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer, or by some other disinterested person in the presence of the officer, unless the presence of the officer is waived on the record by agreement of all parties.
  - (3) Any exhibits used during the deposition must be numbered as required by § 42.63(b), and must, if not previously served, be served at the deposition. Exhibits objected to shall be accepted pending a decision on the objection.
  - (4) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the deposition shall be noted on the record by the officer.
  - (5) When the testimony has been transcribed, the witness shall read and sign (in the form of an affidavit) a transcript of the deposition unless:
    - (i) The parties otherwise agree in writing;
    - (ii) The parties waive reading and signature by the witness on the record at the deposition; or
    - (iii) The witness refuses to read or sign the transcript of the deposition.
  - (6) The officer shall prepare a certified transcript by attaching a certificate in the form of an affidavit signed and sealed by the officer to the transcript of the deposition. Unless the parties waive any of the following requirements, in which case the certificate shall so state, the certificate must state:
    - (i) The witness was duly sworn by the officer before commencement of testimony by the witness;
    - (ii) The transcript is a true record of the testimony given by the witness;
    - (iii) The name of the person who recorded the testimony and, if the officer did not record it, whether the testimony was recorded in the presence of the officer;

- (iv) The presence or absence of any opponent;
  - (v) The place where the deposition was taken and the day and hour when the deposition began and ended;
  - (vi) The officer has no disqualifying interest, personal or financial, in a party; and
  - (vii) If a witness refuses to read or sign the transcript, the circumstances under which the witness refused.
- (7) The officer must promptly provide a copy of the transcript to all parties. The testimony must be filed by proponent as an exhibit.
- (8) Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed motion to exclude.
- (f) *Costs.* Except as the Board may order or the parties may agree in writing, the proponent of the direct testimony shall bear all costs associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination.

**§ 42.54 Protective order.**

- (a) A party or any person from whom discovery of confidential information is sought may file a motion to seal where the motion to seal contains a proposed protective order. The motion must include a certification that the moving party has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute. The Board may, for good cause, issue an order to protect a party or person from disclosing confidential information, including, but not limited to, one or more of the following:
- (1) Forbidding the disclosure or discovery;
  - (2) Specifying terms, including time and place, for the disclosure or discovery;
  - (3) Prescribing a discovery method other than the one selected by the party seeking discovery;
  - (4) Forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;
  - (5) Designating the persons who may be present while the discovery is conducted;
  - (6) Requiring that a deposition be sealed and opened only by order of the Board;
  - (7) Requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and
  - (8) Requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the Board directs.
- (b) [Reserved].

**§ 42.55 Confidential information in a petition.**

A petitioner filing confidential information with a petition may, concurrent with the filing of the petition, file a motion to seal with a proposed protective order as to the confidential information. The petitioner may serve the confidential information under seal. The patent owner may only access the sealed confidential information prior to the institution of the trial by agreeing to the terms of the proposed protective order. The institution of the requested trial will constitute a grant of the motion to seal unless otherwise ordered by the Board.

**§ 42.56 Expungement of confidential information.**

After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.

**§ 42.61 Admissibility.**

- (a) Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible.
- (a) *Records of the Office.* Certification is not necessary as a condition to admissibility when the evidence to be submitted is a record of the Office to which all parties have access.
- (b) *Specification and drawings.* A specification or drawing of a United States patent application or patent is admissible as evidence only to prove what the specification or drawing describes. If there is data in the specification or a drawing upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated must be filed.

**§42.62 Applicability of the Federal Rules of Evidence.**

- (a) *Generally*. Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.
- (b) *Exclusions*. Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.
- (c) *Modifications in terminology*. Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated:

*Appellate court* means United States Court of Appeals for the Federal Circuit.

*Civil action, civil proceeding, and action* mean trial.

*Courts of the United States, U.S. Magistrate, court, trial court, trier of fact, and judge* mean Board.

*Hearing* means as defined in Federal Rule of Evidence 804(a)(5), the time for taking testimony.

*Judicial notice* means official notice.

*Trial or hearing* in Federal Rule of Evidence 807 means the time for taking testimony.

- (a) In determining foreign law, the Board may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

**§ 42.63 Form of evidence.**

- (a) *Exhibits required*. Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.
- (b) *Translation required*. When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.
- (c) *Exhibit numbering*. Each party's exhibits must be uniquely numbered sequentially in a range the Board specifies. For the petitioner, the range is 1001–1999, and for the patent owner, the range is 2000–2999.
- (d) *Exhibit format*. An exhibit must conform with the requirements for papers in § 42.6 and the requirements of this paragraph.
  - (1) Each exhibit must have an exhibit label.
    - (i) An exhibit filed with the petition must include the petitioner's name followed by a unique exhibit number.
    - (ii) For exhibits not filed with the petition, the exhibit label must include the party's name followed by a unique exhibit number, the names of the parties, and the trial number.
  - (2) When the exhibit is a paper:
    - (i) Each page must be uniquely numbered in sequence; and
    - (ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.
- (e) *Exhibit list*. Each party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact.

**§ 42.64 Objection; motion to exclude; motion in limine.**

- (a) *Cross-examination deposition*. An objection to the admissibility of deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition, unless the parties to the deposition stipulate otherwise on the deposition record.
- (b) *Other than cross-examination deposition*. For evidence other than cross-examination deposition evidence:
  - (1) *Objection*. Any objection to evidence submitted during a preliminary proceeding must be served within 10 business days of the institution of the trial. Once a trial has been instituted, any objection must be served within 5 business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.
  - (2) *Supplemental evidence*. The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.
- (c) *Motion to exclude*. A motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections.
- (d) *Motion in limine*. A party may file a motion in limine for a decision on the admissibility of evidence.

**§ 42.65 Expert testimony; tests and data.**

- (a) Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. Testimony on United States patent law or patent examination practice will not be admitted.
- (b) If a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:
  - (1) Why the test or data is being used;
  - (2) How the test was performed and the data was generated;
  - (3) How the data is used to determine a value;
  - (4) How the test is regarded in the relevant art; and
  - (5) Any other information necessary for the Board to evaluate the test and data.

**Oral Argument, Decision, and Settlement**

**§ 42.70 Oral argument.**

- (a) *Request for oral argument.* A party may request oral argument on an issue raised in a paper at a time set by the Board. The request must be filed as a separate paper and must specify the issues to be argued.
- (b) Demonstrative exhibits must be served at least 5 business days before the oral argument and filed no later than the time of the oral argument.

**§ 42.71 Decision on petitions or motions.**

- (a) *Order of consideration.* The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.
- (b) *Interlocutory decisions.* A decision on a motion without a judgment is not final for the purposes of judicial review. A panel decision on an issue will govern the trial. If a decision is not a panel decision, the party may request that a panel rehear the decision. When rehearing a non-panel decision, a panel will review the decision for an abuse of discretion.
- (c) *Rehearing.* A party dissatisfied with a decision may file a request for rehearing. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. A request for rehearing does not toll times for taking action. Any request must be filed:
  - (1) Within 14 days of the entry of non- final decision; or
  - (2) Within 30 days of the entry of a final decision.

**§ 42.72 Termination of trial.**

The Board may terminate a trial without rendering judgment, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).

**§ 42.73 Judgment.**

- (a) A judgment disposes of all issues that were, or by motion could have properly been, raised and decided.
- (b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:
  - (1) Disclaimer of the involved application or patent;
  - (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
  - (3) Concession of unpatentability or derivation of the contested subject matter; and
  - (4) Abandonment of the contest.
- (c) *Recommendation.* The judgment may include a recommendation for further action by an examiner or by the Director.
- (d) *Estoppel*—
  - (1) *Petitioner other than in derivation proceeding.* A petitioner, or the real party in interest or privy of the petitioner, is estopped in the Office from taking an action that is inconsistent with a judgment as to any ground that the petitioner raised or reasonably could have raised during the trial, except that estoppel shall not apply to a petitioner, or to the real party in interest or privy of the petitioner who has settled under 35 U.S.C. 317 or 327.

- (2) *In a derivation*, the losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.
- (3) *Patent applicant or owner*. A patent applicant or owner whose claim is canceled is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:
  - (i) A claim to substantially the same invention as the finally refused or cancelled claim;
  - (ii) A claim that could have been filed in response to any properly raised ground of unpatentability for a finally refused or cancelled claim; or
  - (iii) An amendment of a specification or of a drawing that was denied during the trial proceeding.

#### **§ 42.74 Settlement.**

- (a) *Board role*. The parties may agree to settle any issue in a proceeding, but the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice.
- (b) *Agreements in writing*. Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.
- (c) *Request to keep separate*. A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:
  - (1) To a Government agency on written request to the Board; or
  - (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

#### **Certificate**

##### **§ 42.80 Certificate.**

After the Board issues a final written decision in an *inter partes* review, post-grant review, or covered business method patent review and the time for appeal has expired or any appeal has terminated, the Office will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any new or amended claim determined to be patentable by operation of the certificate.