

# IPR Proceedings Are Well Designed To Weather COVID-19

By **Christopher Scharff and Eligio Pimentel** (March 31, 2020)

The COVID-19 pandemic has forced many state, local and federal agencies to either suspend operations or close facilities to the public.

Numerous federal district courts, for example, have enacted emergency rules extending all pending deadlines (e.g., the U.S. District Court for the Northern District of Illinois) or provided individual judges with the discretion to stay civil cases (e.g., the U.S. District Court for the Southern District of New York).

In addition, the government has recommended that individuals avoid nonessential travel and adopt social distancing practices. Attorneys across the country are rightfully concerned with risking their own health and safety and that of their loved ones.

As a result, one might ask: How it could possibly be business as usual in the intellectual property field? But inter partes review proceedings in the U.S. Patent and Trademark Office are one area that, with some planning and minor inconvenience, can and should continue in a largely normal manner during the COVID-19 crisis. In fact, IPR proceedings are uniquely well-suited, both in terms of rules and procedures, for the current environment.



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## How will IPR proceedings be affected by the COVID-19 shutdowns?

IPR proceedings are well designed for weathering a COVID-19 shutdown. For example, the initial IPR petition, direct testimony (e.g., expert declarations), institution decision and subsequent responses and replies are all submitted in writing.

Early disputes were already handled via a teleconference with the Patent Trial and Appeal Board. The only person-to-person activities in an IPR proceeding, therefore, are (1) any cross-examination depositions and (2) the oral hearing before the PTAB judges.

With respect to depositions, although it may be a minor inconvenience, parties will not be significantly impacted by having to conduct them via telephone or videoconferencing. The board's rules provide that video deposition testimony is not normally allowed to be submitted, so most depositions are only recorded stenographically.[1]

A telephone or videoconference deposition, therefore, can be easily accomplished in an IPR. Numerous court reporter companies have recently issued releases or notifications regarding their video conferencing capabilities, touting their ability to coordinate exhibits and offer a seamless deposition.

The main impact that the shutdown will have on IPR proceedings will be to the oral hearing. On March 13, the USPTO ordered that all of its offices be closed indefinitely.[2] The order provides, however, that:

Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB) oral hearings, and other similar in-person meetings with parties and stakeholders scheduled to

take place at USPTO offices on or after Friday, March 13, 2020 will be conducted remotely by video or telephone.

The order provides that “[p]arties will receive further instructions on how to participate by video or telephone in advance of the interview, hearing, or meeting.” For board judges, this will not cause much, if any, disruption to their normal procedures. All judges are equipped with video conferencing equipment, and many judges already participate in IPR oral hearings remotely. Anecdotally, half or more of IPR oral hearings have had at least one judge participating remotely.

For the parties, the primary impact will be on how they utilize their demonstrative exhibits. Parties are already required to submit their demonstratives to the board prior to the hearing. While the parties may have to be more patient and careful to point the judges to specific pages, this should not result in a significant disruption.

### **What happens if an expert witness, attorney or judge becomes indisposed due to the COVID-19 virus?**

The human participants in an IPR proceeding can certainly be impacted due to the COVID-19 pandemic. A witness, attorney or judge could become unavailable or indisposed at some point during the proceeding.

With respect to witnesses, this is something that the board already has addressed at least once in *Corning Gilbert Inc. v. PPC Broadband Inc.*[3] In that IPR, the petitioner’s expert submitted a declaration in support of the IPR petition. After institution, the petitioner informed the board that the expert had been diagnosed with cancer and was unavailable for deposition due to his treatments.

Recognizing that it would be unfair to the patent owner to allow the petitioner to submit any new arguments or evidence, particularly since the petitioner now had the benefit of the board’s institution decision, the board instead indicated that it would allow the petitioner to retain a new expert that would be willing to repeat, word-for-word, the earlier expert’s declaration.[4]

Ultimately, the parties appear to have been able to take the deposition of the original expert despite his cancer, but the Corning panel’s order illustrates one way that the board could address an issue like this in the future.

Another option for accommodating an indisposed witness or attorney is an extension of time. Some early deadlines can already be adjusted up to several months by agreement of the parties, e.g., deadlines for a patent owner response and petitioner reply.

However, if more time is needed, there is a mechanism for seeking it. Specifically, although there is a statutory one-year time frame for completing an IPR, the statute nevertheless permits the USPTO to grant extensions for good cause.[5]

The board has invoked that exception rarely. In fact, based on a search of IPR orders it has only invoked the good cause exception once.[6] However, it is very likely that a serious, extended illness or incapacitation of an expert or key attorney would constitute good cause for an extension if there is no other solution.

Finally, if one of the judges on the IPR panel becomes unavailable, that also can be

addressed by the board's existing rules and procedures. For example, the PTAB's standard operating procedure anticipates that:

Judges may be unavailable for reasons that include: an approved agency leave request (for example, maternity leave, paternity leave, [Family and Medical Leave Act] leave, sick leave, or annual leave); death or serious illness of the judge or a family member; detail assignment within or outside of the USPTO; reassignment; or the retirement or permanent departure of the judge from the agency.[7]

If the panel has not yet made an appearance (e.g., in an institution decision or at a hearing), substituting a new judge is straightforward. But even if a judge has already appeared in the proceeding, panel changes are possible even though disfavored. If that were to occur after the oral hearing, it is possible that the new judge may ask to reopen the hearing to raise any additional questions he or she may have.

And if necessary, the board may extend the deadline for issuing a final written decision.[8] But absent either of those situations, substituting one of the panel judges should not disrupt the proceedings.

In conclusion, we all hope for a speedy end to the current COVID-19 crisis. In the meantime, however, practitioners, patent owners and potential IPR petitioners should know that the IPR process is unlikely to be greatly disrupted.

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[1] 37 CFR § 42.53.

[2] [www.uspto.gov/coronavirus](http://www.uspto.gov/coronavirus).

[3] See *Corning Gilbert Inc. v. PPC Broadband, Inc.*, IPR2013-00347.

[4] See *Id.* at Paper 20 at 2-3.

[5] See 35 U.S.C. 316(a)(11).

[6] See *Minerva Surgical, Inc., v. Hologic Inc.*, IPR2016-00868, Paper 56 (P.T.A.B. Oct. 5, 2017) (granting extension of time for good cause due to an intervening change in the law).

[7] PTAB's Standard Operating Procedure 1 (Rev. 15), Assignment of Judges to Panels at p. 13 (Sept. 15, 2018).

[8] 35 U.S.C. 316(a)(11).