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Quick Tips for Navigating PTAB Remote Procedures

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As the COVID-19 epidemic drives the United States Patent and Trademark Office (USPTO) to an institution-wide remote work requirement, all involved in USPTO Patent Trial and Appeals Board (PTAB) proceedings are scrambling to use electronic communication to meet filing deadlines, conduct depositions, and attend Board hearings. Here, we explore this new reality with suggestions for effectively operating in this virtual PTAB world.

USPTO Remote Capabilities

It was inevitable that the USPTO would ask all non-essential employees to work remotely as the epidemic took hold in the US. [Effective March 23](#), all USPTO offices were closed to the public, and only employees whose physical presence is mission-critical are able to enter the physical offices. All other employees have been instructed to telework, and the [USPTO's news page](#) is full of updates about how the Office is adapting to the current situation. It parallels a similar work plan now in effect at the EPO after Germany and the Netherlands saw their epidemic numbers rise. As far as we know, no such remote work plans have been instituted at the other IP-5 member offices in China, Japan, and Korea.

Unlike other IP-5 offices, the USPTO has a long tradition of telework. This work model was driven by recruitment and retention objectives, due to the high cost of Washington, DC living. When this crisis hit, 50% of the Office's employees were already working remotely. Even with this head start, fulfilling the related hardware, software, and connectivity demands would be challenging for any organization the size of the USPTO, which had more than 12,000 employees at last count. The USPTO recently [recruited a new Chief Information Officer](#), and spends a significant amount of its budget on IT. This crisis will certainly test their system and leadership in a major way.

PTAB Electronic Filings

Post-grant proceedings at the USPTO require the electronic filing of documents. Recently, there have been some computer-system failures at the USPTO that have prevented filings due to system outages and other problems. But by and large, the electronic filing system has proven reliable and secure.

Although most actions in a post-grant proceeding play out through electronic filing or electronic communication with the Board, there are typically face-to-face interactions that will need to be modified. Normally, experts relied upon by both parties to a proceeding are cross-examined in person. Clearly, this cannot be continued for the time being.

Potential Workarounds

Because time waits for no one, parties need to explore workarounds that exploit the communication tools available during this fourth industrial revolution. Those that quickly master these tools will have a leg up on their competition, as everyone around the world is affected by the novel coronavirus and will need to adapt.

For depositions, conducting a remote, video deposition is a viable workaround. Remote depositions typically proceed with each person involved (examining counsel, defending counsel, the witness, and the reporter) in a secure remote location, connected by voice and video. The deposition is transcribed, and may even be video recorded, over the network.

Video Depositions

While video deposition platforms existed before this pandemic, they were seldom used. One reason was tradition – a belief that face-to-face cross-examination produced evidence more accurate and less biased than what was in the expert report. Additionally, a physical deposition created an opportunity for each party to caucus to prepare and exclude outside distractions. And, the logistics of conducting the examination allowed for the witness to be handed exhibits and to review and perhaps annotate them.

The court reporting industry has developed a wide array of video deposition platforms. While this publication does not endorse any particular reporter, a representative platform is provided by [Planetdepos.com](https://www.planetdepos.com). This platform is robust and flexible in that it permits electronically the physical features and functions of a physical deposition with an enhanced electronic record. Specifically, many physical depositions did not include video – only a written transcript was produced. With electronic depositions, not only is the deponent video recorded, but the attorneys can be as well. Exhibits can be presented to the deponent, marked, and annotated electronically with a full video record. Of course, as with any new technology, there is a learning curve for the attorneys. David Andre, from Planet Depos, recently provided some [Helpful Tips for a Great Mobile Videoconference Deposition](#).

Many attorneys have legitimate concerns about video depositions. For example, people are concerned about what happens if one (or more) of the parties have computer problems or issues with the network connections during the deposition. Does the examining attorney lose valuable time? Another concern is that it is difficult to observe the witness's body language, mannerisms, and visual cues while on a video call. Typically, only the face and part of a person's torso are visible. Another common concern is how to introduce exhibits for the witness to review. During a typical, in-person deposition, hard copy exhibits are often presented to and examined by the witnesses. Unless the examining attorney sends the witness a banker's box full of exhibits and can trust the witness not to study the exhibits beforehand, the examining witness will have to become familiar with the procedures for introducing and using electronic exhibits.

Oral Hearings

Oral hearings at the PTAB, which occur at the end of each proceeding, raise similar concerns. In typical, in-person hearings, the attorneys for each party argue their case to a panel of three Administrative Patent Judges. The hearing is in one of the four hearing rooms at the Madison Building at USPTO HQ in Alexandria, Virginia, or in a hearing room at one of the satellite offices in Detroit, Dallas, Denver, or Silicon Valley. Often, one or two of the APJs is brought in by video from a remote location. Having an APJ remote adds some complexity to the oral argument if demonstratives are being displayed to the APJs physically located in the hearing room. Depending on the size of the hearing room, visitors from the parties, the press, and others can attend since seldom is any part of the record under seal.

Now, these [oral hearings will have to be conducted by video](#). We do not know how the Office will set up these video hearings, if the video file of the hearing will be made part of administrative record open to the public, or whether third parties will be allowed access to the video feed during the hearing. Clients often attend the hearings, and for high profile proceedings, it is not uncommon to have the press, competitors, investors, and others in attendance.

The USPTO has not extended any of the deadlines in these proceedings because of the epidemic. By statute, the PTAB trial must be completed within 12 months of institution unless there is "good cause" (35 U.S.C. § 316(a)(11)), which can extend the proceeding by up to six months. Whether the Office will now utilize the additional 6 months under the AIA remains to

be seen.

Navigating the New PTAB Environment

Here are a few suggestions we offer about this new electronic PTAB world: First, embrace the new technology and communication tools that are available—again, those that adapt will have a leg up on their competition. Second, take a little extra time when noticing a deposition or reviewing the PTAB’s order for an oral hearing. It is important to think through some of the unique issues that may come up during a remote deposition or hearing, and address these with opposing counsel or the PTAB prior to the event. Third, when possible, conduct a test run before going live. This includes determining what tools you’ll use to communicate privately with your team (such as a messaging service) and practicing with your team. And finally, it is important for everyone involved to be patient and cooperative—everyone is under additional stress as we grapple with the current situation and face the unknown together.

The COVID-19 pandemic has forced PTAB proceedings into an electronic remote world and everyone must adapt to this world, since deadlines are not being extended. This transformation was likely inevitable, but not at such an abrupt pace. It is likely that much of the change will be retained when we settle into a “new normal” after the pandemic is over.

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