

§ 42.1

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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, including:

(1) For petition decisions and interlocutory decisions, a Board member or employee acting with the authority of the Board.

(2) For final written decisions under 35 U.S.C. 135(d), 318(a), and 328(a), a panel 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 to the extent available. 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, or a termination of a proceeding.

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 or assignee of the involved application.

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 consistent

with any time period required by statute.

§ 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 × 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: