

Ted Baroody

From: USPTO News <noreply@enews.uspto.gov>
Sent: Monday, March 30, 2015 5:29 PM
To: Ted Baroody
Subject: PTAB'S Quick-Fixes for AIA Rules Are to Be Implemented Immediately

Blog by Under Secretary of Commerce for Intellectual Property and Director of the USPTO Michelle K. Lee

In recent appearances before the Technology Policy Institute and the IPO Education Foundation's PTO Day, I highlighted the popularity (at least based upon number of filings) of our Patent Trial and Appeal Board (PTAB) America Invents Act (AIA) trials over the last three years. I also promised a series of rulemakings later this year so we could seek public input on how we could make these proceedings even better. We are well along in the process of issuing our first set of rules and I want to give you a hint now of what is to come.

The USPTO issued rules and guidance for the new AIA proceedings in 2012.

Despite best efforts, we never envisioned that our rules or guidance would be perfect at the outset, but instead anticipated making refinements along the way. In June 2014 we asked for your input on how these proceedings were working. I am pleased to tell you about the feedback we collected and how that feedback is shaping the direction of our AIA trials going forward.

In response to our request for input, we received 37 written comments.

Members of the Board have carefully reviewed your thoughtful comments about ways that we can improve the AIA proceedings. To implement some of the changes spurred by your input we have devised a three-part roll-out plan.

This spring we plan to issue a first rule package containing what we call "quick fixes"—changes of simple scope that will immediately improve the trial proceedings. Later this summer, we will issue a second proposed-rule package containing more involved changes to our Patent Trial and Appeal Board Trial Rules that govern the conduct of the AIA trial proceedings. We also plan to modify our Trial Practice Guide that provides guidance to the public concerning various aspects of PTAB practices in AIA trial proceedings. The Trial Practice Guide advises the public on the general framework of the rules, including the structure and times for taking action in AIA trial proceedings. These modifications will clarify our trial operations and by implementing the roll-out in stages, we aim to bring improvements to our proceedings as quickly as possible.

As to our first "quick fix" rule package, I wish to highlight some of the improvements you can expect to see. Many of you advised us that fifteen pages for a motion to amend that includes a claim listing is not sufficient to explain adequately why the amended claims are patentable. Similarly, others noted that fifteen pages for a petitioner's reply brief is not a commensurate number of pages to respond to a patent owner's response. We have heard you, and we agree. One of our quick-fix changes will nearly double the number of pages for a motion to amend, granting up to twenty-five pages for the motion along with the addition of a claims appendix (with a commensurate amount of additional pages for the opposition and reply briefing). Another change will nearly double the number of pages for a petitioner's reply brief, granting up to twenty-five pages.

Notably, even before these two changes appear in the first rule package, judges will begin implementing them through scheduling orders effective immediately.

As to our second rule package of more involved changes, we are considering proposing a number of other revisions to rules including: further modifications to the motion to amend process; adjustments to the evidence that can be provided in the patent owner preliminary response; and clarification of the claim construction standard as applied to expired patents in AIA proceedings. We also are considering several other changes, including adjustments to the scope of additional discovery, how to handle multiple proceedings before the Office involving the same patent, use of live testimony at oral hearings, and whether the parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation.

Additionally, regarding motions to amend, we are contemplating proposed changes to emphasize that a motion for a substitutionary amendment will always be allowed to come before the Board for consideration (i.e., be "entered"), and for the amendment to result in the issuance ("patenting") of amended claims, a patent owner will not be required to make a prior art representation as to the patentability of the narrowed amended claims beyond the art of record before the Office. Of course, the duty of candor and good faith requires the patent owner to make of record any additional prior art material to patentability known by the patent owner. These contemplated changes would be intended to more noticeably limit the burden on the patent owner, even though the patent owner is the party moving for the change in the patent.

As with the revisions we are making via the first rule package, the changes being considered in our second rule package are the direct results of your feedback. And because we plan to issue the changes in the second rule package in the form of a proposed rule, you will have an additional opportunity to give your feedback before we finalize them.

As to our Trial Practice Guide, we are contemplating proposing even more updates and refinements. Although we are not

prepared to change the scheduling order to specify that live testimony will automatically be allowed at a hearing, we will address the subject of live testimony to bring greater clarity to its usage. Specifically, because there has not yet been a current practice of denying motions for live testimony and we do not want to diminish the possibility of live testimony, we plan to emphasize the availability of live testimony upon the grant of any such motion for live testimony, except where not suitable.

Further, we understand that the existence of ample discovery to establish the real-party-in-interest (RPI) of the petitioner has been a concern. And we want to be sure that the availability of appropriate RPI evidence does not pose a problem for patent owners. While the Board increasingly has been granting motions for such discovery, we plan to update the Trial Practice Guide to emphasize the importance of RPI discovery as to determinations of standing and as to possible later estoppel consequences.

Lastly, to the extent that there has been concern that the judges participating in a decision to institute a trial may not be completely objective in the trial phase, we are considering developing a single-judge pilot program for institution. Under this pilot, a single judge would make the decision on whether to institute a trial. Two new judges would be added to the panel only when and if a trial is instituted. In the interest of efficiency, the first judge would remain on the panel; but in the interest of having "fresh eyes," the two additional judges would not have participated in the matter prior to institution. After running this pilot for a select number of cases, we would study the results to determine the approach to follow in the future.

In closing, we appreciate your input on our AIA trial proceedings thus far.

Our intention is to continue this iterative approach of seeking your input after this round of changes has been in effect for some time. We are committed to fulfilling our Congressional mandate to provide a quick, inexpensive alternative to district court litigation and improve patent quality and to ensuring that the AIA trials are as effective and fair as possible. And we can do so only by regularly monitoring and correcting our course as usage of our AIA trials evolves in time.

The link to the blog - www.uspto.gov/blog/director/entry/ptab_s_quick_fixes_for

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