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Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board

A Rule by the [Patent and Trademark Office](#) on 05/19/2015

 This document was corrected by a document published on 06/16/2015.

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PUBLISHED DOCUMENT**AGENCY:**

Patent Trial and Appeal Board, United States Patent and Trademark Office, U.S. Department of Commerce.

ACTION:

Final rule.

SUMMARY:

This final rule amends the existing consolidated set of rules relating to the United States Patent and Trademark Office (Office or USPTO) trial practice for *inter partes* review, post-grant review, the transitional program for covered business method patents, and derivation proceedings that implemented provisions of the Leahy-Smith America Invents Act (“AIA”) providing for trials before the Office.

DATES:

Effective Date: This rule is effective May 19, 2015.

FOR FURTHER INFORMATION CONTACT:

Susan L. C. Mitchell, Lead Administrative Patent Judge by telephone at (571) 272-9797.

SUPPLEMENTARY INFORMATION:

Executive Summary: Purpose: This final rule increases the page limitations for briefing for Patent Owner's motion to amend and for Petitioner's reply brief in response to comments from the public. This final rule also addresses clarifying changes to the rules so that they conform to Office practice in conducting AIA proceedings.

Summary of Major Provisions: In an effort to gauge the effectiveness of the rules governing AIA trials, the Office conducted a nationwide listening tour in April and May of 2014, and in June 2014, published a **Federal Register** Notice asking for public feedback about the AIA trial proceedings. The Office has carefully reviewed the comments and, in response to public input, will issue two rules packages; a first, final rule package with more ministerial changes to the rules, and a second, proposed rule package that will issue later to address more involved changes to the rules and the Office Patent Trial Practice Guide. The Office presents the following final rules to address issues concerning Patent Owner's motion to amend and

Petitioner's reply brief that involve ministerial changes, and will address public comments relating to those specific issues only, in this first, final rule package. For instance, the following final rules provide ten additional pages for a Patent Owner motion to amend, allow a claims appendix for a motion to amend, and provide ten additional pages for Petitioner's reply brief.

These final rules also provide changes to conform the rules to the Office's established practices in handling AIA proceedings. For instance, the final rules require a specific font to ensure readability of briefs, clarify that more than one back-up counsel can be named, and clarify how to count challenged claims to calculate fees. The final rules also clarify that providing a statement of material fact by a party is optional and that routine discovery contemplates only cross-examination of affidavit testimony prepared for the proceeding. The final rules further provide that uncompelled direct testimony must be in the form of an affidavit, not a deposition; that motions in limine are not used in AIA practice; that objections to evidence should be made part of the record by filing them; and that only a single request for rehearing may be filed as of right. Finally, with regard to covered business method patent reviews, the final rules clarify, consistent with the AIA, that such reviews may be extended in the case of joinder and that no petition for a covered business method patent review may be filed if the petitioner or real party-in-interest filed a civil action challenging the validity of a claim of the covered business method patent.


Costs and Benefits: This rulemaking is not economically significant, and is not significant, under Executive Order 12866 (Sept. 30, 1993), as amended by Executive Order 13258 (/executive-order/13258) (Feb. 26, 2002) and Executive Order 13422 (/executive-order/13422) (Jan. 18, 2007).

Background

Development of the Final Rule

On September 16, 2011, the AIA was enacted into law (Pub. L. 112–29 (<https://www.govinfo.gov/link/plaw/112/public/29>), 125 Stat. 284 (2011)), and shortly thereafter in 2012, the Office implemented rules to govern Office trial practice for AIA proceedings, including *inter partes* review, post-grant review, the transitional program for covered business method patents, and derivation proceedings pursuant to 35 U.S.C. 135 (<https://www.govinfo.gov/link/uscode/35/135>), 316 (<https://www.govinfo.gov/link/uscode/35/316>) and 326 (<https://www.govinfo.gov/link/uscode/35/326>) and AIA 18(d)(2). See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 FR 48 (/citation/77-FR-48), 612 (/citation/77-FR-612) (Aug. 14, 2012); Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 FR 48 (/citation/77-FR-48), 680 (/citation/77-FR-680) (Aug. 14, 2012); Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 FR 48 (/citation/77-FR-48), 734 (/citation/77-FR-734) (Aug. 14, 2014). Additionally, the Office published a Patent Trial Practice Guide for the rules to advise the public on the general framework of the regulations, including the structure and times for taking action in each of the new proceedings. See Office Patent Trial Practice Guide, 77 FR 48 (/citation/77-FR-48), 756 (/citation/77-FR-756) (Aug. 14, 2012).

In an effort to gauge the effectiveness of the rules governing AIA trials, the Office conducted a nationwide listening tour in April and May of 2014. During the listening tour, the Office focused particularly on transparency and public involvement in making trial proceedings more effective going forward by adjusting the rules and guidance where necessary. As a result, in June of 2014, the Office published a Request for Comments in the **Federal Register** and, at stakeholder request, extended the period for receiving

comments to October 16, 2014. See Request for Comments on Trial Proceedings Under  the America Invents Act Before the Patent Trial and Appeal Board, 79 FR 36 (/citation/79-FR-36),474 (/citation/79-FR-474) (June 27, 2014).

The Request for Comments asked seventeen questions on ten broad topics, including a general catchall question, to elicit any proposed changes to the AIA post-grant program that stakeholders suggest would be beneficial. See Request for Comments, 79 FR at 36,476–77. The Office received thirty-seven comments from bar associations, corporations, law firms, and individuals, encompassing a wide range of issues. The Office expresses its gratitude for the thoughtful and comprehensive comments provided by the public, which are available on the USPTO Web site: <http://www.uspto.gov/page/comments-trial-proceedings-under-america-invents-act-patent-trial-and-appeal-board> (<http://www.uspto.gov/page/comments-trial-proceedings-under-america-invents-act-patent-trial-and-appeal-board>).

Several commenters expressed satisfaction with the current AIA post-grant programs, and several commenters offered suggestions on how to strengthen the AIA post-grant programs. For example, some suggestions concerned the claim construction standard used by the PTAB, motions to amend, discovery procedures, and handling of multiple proceedings. The Office will address all public comments that do not involve changes to the page limitations for Patent Owner's motion to amend or Petitioner's reply brief in the second, proposed rule package.

Discussion of Specific Final Rules

Subpart A—Trial Practice and Procedure

PATENT OWNER'S MOTION TO AMEND

A. AMENDMENTS TO THE RULES

In response to comments received from the public concerning amendment practice in AIA proceedings, the Office is increasing the page limitation for Patent Owner's motion to amend by ten pages and allowing a claims appendix that is not included in the page limitation. To implement this increase in the page limitation for a motion to amend from fifteen to twenty-five pages, exclusive of any claims appendix, with a commensurate increase in the number of pages for an opposition to a motion to amend, the Office amends 37 CFR 42.24(a) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(a\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(a))) and (c) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c))), 42.121(b) ([https://www.ecfr.gov/current/title-37/section-42.121#p-42.121\(b\)](https://www.ecfr.gov/current/title-37/section-42.121#p-42.121(b))), and 42.221(b) ([https://www.ecfr.gov/current/title-37/section-42.221#p-42.221\(b\)](https://www.ecfr.gov/current/title-37/section-42.221#p-42.221(b))) as follows:

- Amend 37 CFR 42.24(a)(1) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(a\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(a)(1))) to add the phrase “or claim listing” after “or appendix of exhibits.”
 - Amend 37 CFR 42.24(a)(1)(v) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(a\)\(1\)\(v\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(a)(1)(v))) to read “Motions (excluding Motions to Amend): 15 pages”; and add (vi) to read “Motions to Amend: 25 pages.”
 - Amend 37 CFR 42.24(c)(2) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)\(2\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c)(2))) to read “Replies to oppositions (excluding replies to oppositions to Motions to Amend): 5 pages”; and add (3) to read “Replies to oppositions to Motions to Amend: 12 pages.”
- Amend 37 CFR 42.121(b) ([https://www.ecfr.gov/current/title-37/section-42.121#p-42.121\(b\)](https://www.ecfr.gov/current/title-37/section-42.121#p-42.121(b))) to read “*Content.* A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth . . .”

- Amend 37 CFR 42.221(b) to read “ *Content.* A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth”

B. RESPONSE TO COMMENTS

Comments: Although some comments advocated no change to the Office's motion to amend practice in AIA proceedings, numerous comments suggested relaxing the page limitation on Patent Owner's motion to amend. Several comments proposed a specific number of additional pages, and/or permitting the listing of claims in an appendix not counted toward the page limit. One comment suggested a flexible page limit based on the number of substitute claims proposed, and one comment suggested that the Board more freely grant requests for additional pages. Another comment suggested permitting the patent owner to allocate unutilized pages from the patent owner's response to the motion to amend.

Response: The overall request to relax the page limitation on Patent Owner's motion to amend is adopted. As set forth above, the Office amends 37 CFR 42.24(a) to increase the page limit for motions to amend from 15 pages to 25 pages. Applying the provision of 37 CFR 42.24(b)(3) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(b\)\(3\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(b)(3))) mandating an equal page limitation for oppositions, the page limit for oppositions to motions to amend also increases from 15 pages to 25 pages. The Office also amends 37 CFR 42.24(c) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c))) to increase the page limit for replies to oppositions to motions to amend from 5 pages to 12 pages. Also, the Office amends 37 CFR 42.121(b) ([https://www.ecfr.gov/current/title-37/section-42.121#p-42.121\(b\)](https://www.ecfr.gov/current/title-37/section-42.121#p-42.121(b))) and 37 CFR 42.221(b) ([https://www.ecfr.gov/current/title-37/section-42.221#p-42.221\(b\)](https://www.ecfr.gov/current/title-37/section-42.221#p-42.221(b))) to permit an appendix for the claim listing accompanying a motion to amend that is not counted toward the 25-page limitation.

The specific request for a flexible page limit based on the number of substitute claims is not adopted. This procedure is not warranted in light of the above amendments relaxing the page limitation on Patent Owner's motion to amend. In addition, this approach may encourage parties to increase unnecessarily the number of substitute claims presented solely to procure additional pages for the motion. In accord with the specific request that the Board more freely grant requests for additional pages, however, the Board will continue to consider requests for additional pages on a case-by-case basis.

The specific request that a patent owner be able to allocate pages from the patent owner's response to a motion to amend is not adopted. This procedure is not warranted in light of the above amendments relaxing the page limitation on Patent Owner's motion to amend. In addition, this procedure would be difficult to administer in light of the above amendments, placing an undue administrative burden on the Office to determine and monitor the total number of pages allocated to the patent owner, to the petitioner's opposition to the motion to amend, and to any reply.

PETITIONER'S REPLY

A. AMENDMENTS TO THE RULES

In response to comments received from the public, the Office is increasing the page limitation for Petitioner's reply brief to Patent Owner's response to petition by 10 pages. To implement this increase in the page limitation for Petitioner's reply brief from fifteen to twenty-five pages, the Office amends 37 CFR 42.24(c)(1) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c)(1))) to read: “Replies to patent owner responses to petitions: 25 pages.”

B. RESPONSE TO COMMENTS

Comments: Although at least one commenter wanted no change, several commenters suggested that the fifteen pages afforded for a Petitioner's reply brief is not commensurate with the number of pages afforded to Patent Owner, especially if Patent Owner raises new issues. Commenters suggested that increasing the page limitation for Petitioner's reply brief would allow a more complete record before the Office. One comment suggested that to provide Petitioner with a fair opportunity to respond, the number of pages afforded for Petitioner's reply brief may correspond to the number of pages in Patent Owner's post-institution response that is devoted to new issues.

Response: The overall request to relax page limitations on Petitioner's reply brief to Patent Owner's response is adopted. As set forth above, the Office amends 37 CFR 42.24(c)(1) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c)(1))) to increase the page limit for Petitioner's reply brief from 15 to 25 pages.

The specific request for a flexible page limit based on new issues raised in Patent Owner's response is not adopted. This procedure is not warranted in light of the above amendment relaxing the page limitation on Petitioner's reply brief. In addition, this procedure would be difficult to administer, placing an undue administrative burden on the Office to determine the total number of pages allocated by Patent Owner to new issues.

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REQUIRED FONT

In AIA post-grant proceeding filings, the Office has required either a proportional or monospaced font that is 14-point or larger, with an additional requirement that any monospaced font must not contain more than four characters per centimeter or ten characters per inch. See 37 CFR 42.6(a)(2)(ii) ([https://www.ecfr.gov/current/title-37/section-42.6#p-42.6\(a\)\(2\)\(ii\)](https://www.ecfr.gov/current/title-37/section-42.6#p-42.6(a)(2)(ii))). The Office has received briefs from parties that utilize narrow fonts that may be compliant with these requirements, but nevertheless, have proved difficult to read. To address this concern, the Office is amending 37 CFR 42.6(a)(2) ([https://www.ecfr.gov/current/title-37/section-42.6#p-42.6\(a\)\(2\)](https://www.ecfr.gov/current/title-37/section-42.6#p-42.6(a)(2))) to require 14-point, Times New Roman proportional font, with normal spacing, to ensure readability of all briefs.

COUNSEL

To clarify the rule regarding designation of counsel for an AIA proceeding that more than one back-up counsel may be designated, the Office amends 37 CFR 42.10 (<https://www.ecfr.gov/current/title-37/section-42.10>) as follows:

- Replace the article “a” before “back-up counsel” with “at least one” in 37 CFR 42.10(a) ([https://www.ecfr.gov/current/title-37/section-42.10#p-42.10\(a\)](https://www.ecfr.gov/current/title-37/section-42.10#p-42.10(a))).

FEES

The Office has explained in the Office Patent Trial Practice Guide that to understand the scope of a dependent claim, the claim(s) from which the dependent claim depends must be construed along with the dependent claim. Therefore, to calculate any fee due under 37 CFR 42.15 (<https://www.ecfr.gov/current/title-37/section-42.15>) that is based on the number of claims, each claim challenged will be counted as well as any claim from which a challenged claim depends, unless the parent claim is also separately challenged. See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 FR 48 (/citation/77-FR-48), 612 (/citation/77-FR-612), 48 (/citation/77-FR-48), 619 (/citation/77-FR-619) (Aug. 14, 2012).

To clarify the fees rule to reflect explicitly this requirement to include unchallenged claims from which a challenged claim depends in the claim count for fee calculating purposes, the Office is amending 37 CFR 42.15 (<https://www.ecfr.gov/current/title-37/section-42.15>) as follows:

- Add the content “, including unchallenged claims from which a challenged claim depends” after the text “each claim in excess of 20” in 37 CFR 42.15(a)(3) ([https://www.ecfr.gov/current/title-37/section-42.15#p-42.15\(a\)\(3\)](https://www.ecfr.gov/current/title-37/section-42.15#p-42.15(a)(3))) and 42.15(b)(3) ([https://www.ecfr.gov/current/title-37/section-42.15#p-42.15\(b\)\(3\)](https://www.ecfr.gov/current/title-37/section-42.15#p-42.15(b)(3))).
- Delete the first instance of the phrase “request fee” in the following phrase “Post-Grant or Covered Business Method Patent Review request fee Post-Institution request fee” in 42.15(b)(4).
- Add the content “, including unchallenged claims from which a challenged claim depends” after the text “each claim in excess of 15” in 37 CFR 42.15(a)(4) ([https://www.ecfr.gov/current/title-37/section-42.15#p-42.15\(a\)\(4\)](https://www.ecfr.gov/current/title-37/section-42.15#p-42.15(a)(4))) and 42.15(b)(4) ([https://www.ecfr.gov/current/title-37/section-42.15#p-42.15\(b\)\(4\)](https://www.ecfr.gov/current/title-37/section-42.15#p-42.15(b)(4))).

OPPOSITIONS AND REPLIES AND PAGE LIMITS FOR PETITIONS, MOTIONS, OPPOSITIONS, AND REPLIES

To clarify that supplying a statement of material fact by a party is optional, the Office amends 37 CFR 42.23 (<https://www.ecfr.gov/current/title-37/section-42.23>) and 42.24 (<https://www.ecfr.gov/current/title-37/section-42.24>) as follows:

- Replace the phrase “and must include a statement identifying material facts in dispute” from the first sentence of 37 CFR 42.23(a) ([https://www.ecfr.gov/current/title-37/section-42.23#p-42.23\(a\)](https://www.ecfr.gov/current/title-37/section-42.23#p-42.23(a))) with “and, if the paper to which the opposition or reply is responding contains a statement of material fact, must include a listing of facts that are admitted, denied, or cannot be admitted or denied.”
- Replace the phrase “the required” with “any” in the first sentence of 37 CFR 42.24(c) ([https://www.ecfr.gov/current/title-37/section-42.24#p-42.24\(c\)](https://www.ecfr.gov/current/title-37/section-42.24#p-42.24(c))).

DISCOVERY

To clarify that routine discovery includes only the cross-examination of affidavit testimony prepared for the proceeding, the Office amends 37 CFR 42.51(b)(1)(ii) ([https://www.ecfr.gov/current/title-37/section-42.51#p-42.51\(b\)\(1\)\(ii\)](https://www.ecfr.gov/current/title-37/section-42.51#p-42.51(b)(1)(ii))) to add the phrase “prepared for the proceeding” after “affidavit testimony.”

TAKING TESTIMONY

Because uncompelled direct testimony must be submitted in the form of an affidavit, the Office is amending 37 CFR 42.53(c)(2) ([https://www.ecfr.gov/current/title-37/section-42.53#p-42.53\(c\)\(2\)](https://www.ecfr.gov/current/title-37/section-42.53#p-42.53(c)(2))) as follows:

- Delete the word “deposition” from the phrase “uncompelled direct deposition testimony.”

To clarify that either party is permitted to file testimony as an exhibit, the Office amends 37 CFR 42.53(f)(7) ([https://www.ecfr.gov/current/title-37/section-42.53#p-42.53\(f\)\(7\)](https://www.ecfr.gov/current/title-37/section-42.53#p-42.53(f)(7))) to delete the phrase “by proponent” in the second sentence.

MOTION IN LIMINE

The term motion in limine is included in the title for 37 CFR 42.64 (<https://www.ecfr.gov/current/title-37/section-42.64>), but the rule does not provide for a motion in limine. To clarify the rule, the Office amends 37 CFR 42.64 (<https://www.ecfr.gov/current/title-37/section-42.64>) to delete “motion in limine” from the title of the rule.

OBJECTION

The Office amends 37 CFR 42.64(b)(1) ([https://www.ecfr.gov/current/title-37/section-42.64#p-42.64\(b\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.64#p-42.64(b)(1))) for consistency with the Office Patent Trial Practice Guide. The Office Patent Trial Practice Guide requires that a party wishing to challenge admissibility of evidence must object timely to the evidence. Therefore, the Office Patent Trial Practice Guide states that a motion to exclude evidence requires a party to identify where in the record the objection originally was made, but 37 CFR 42.64(b)(1) ([https://www.ecfr.gov/current/title-37/section-42.64#p-42.64\(b\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.64#p-42.64(b)(1))) merely requires service of objections to evidence, which does not make such objections part of the record. Therefore, the Office amends the first and second sentences of 37 CFR 42.64(b)(1) ([https://www.ecfr.gov/current/title-37/section-42.64#p-42.64\(b\)\(1\)](https://www.ecfr.gov/current/title-37/section-42.64#p-42.64(b)(1))) to replace “served” with “filed” so as to require filing of objections, which also requires service under 37 CFR 42.6(e)(2) ([https://www.ecfr.gov/current/title-37/section-42.6#p-42.6\(e\)\(2\)](https://www.ecfr.gov/current/title-37/section-42.6#p-42.6(e)(2))).

DECISION ON PETITION OR MOTIONS

To clarify that a party may file only a single request for rehearing as of right, the Office amends 37 CFR 42.71(d) ([https://www.ecfr.gov/current/title-37/section-42.71#p-42.71\(d\)](https://www.ecfr.gov/current/title-37/section-42.71#p-42.71(d))) to add “single” before “request for rehearing” in the first sentence.

Subpart D—Transitional Program for Covered Business Method Patents

PROCEDURE AND PENDENCY

To clarify that the pendency of a covered business method patent review proceeding can be extended in the case of joinder and to harmonize the rule with similar rules in other post grant proceedings, the Office amends 37 CFR 42.300(c) ([https://www.ecfr.gov/current/title-37/section-42.300#p-42.300\(c\)](https://www.ecfr.gov/current/title-37/section-42.300#p-42.300(c))) to add “, or adjusted by the Board in the case of joinder” at the end of the second sentence after “Chief Administrative Patent Judge.”

WHO MAY PETITION FOR A COVERED BUSINESS METHOD PATENT REVIEW

The Office may not institute a covered business method patent review of a challenged patent when the petitioner filed a civil action challenging the validity of a claim of the patent before filing the petition. *See* AIA section 18(a)(1); 35 U.S.C. 325(a)(1) (<https://www.govinfo.gov/link/uscode/35/325>); *SecureBuy, LLC v. CardinalCommerce Corp.*, Case CBM2014–00035 (PTAB Apr. 25, 2014) (Paper 12) (precedential). To state this prohibition explicitly, the Office amends 37 CFR 42.302 (<https://www.ecfr.gov/current/title-37/section-42.302>) to add a section (c) as set forth in the regulatory text of this rule.

Rulemaking Considerations

A. Administrative Procedure Act (APA): This final rule revises the consolidated set of rules relating to Office trial practice for *inter partes* review, post-grant review, the transitional program for covered business method patents, and derivation proceedings. The changes being adopted in this rule do not change the substantive criteria of patentability. These changes involve rules of agency practice. *See, e.g.*, 35 U.S.C. 316(a)(5) (<https://www.govinfo.gov/link/uscode/35/316>), as amended. http://www.cruiseamerica_.com/rent/our_vehicles/ (http://www.cruiseamerica_.com/rent/our_vehicles/) These rules are procedural and/or interpretive rules. *See Bachow Commc'ns Inc. v. F.C.C.*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive requirements for reviewing claims); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive); *JEM Broad. Co. v. F.C.C.*, 22 F.3d 320, 328 (D.C. Cir. 1994) (rules are not legislative because they do not “foreclose effective opportunity to make one's case on the merits”).

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Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) (<https://www.govinfo.gov/link/uscode/5/553>) or (c) (<https://www.govinfo.gov/link/uscode/5/553>) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (<https://www.govinfo.gov/link/uscode/5/553>) (or any other law). See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553 (<https://www.govinfo.gov/link/uscode/5/553>), and thus 35 U.S.C. 2(b)(2)(B) (<https://www.govinfo.gov/link/uscode/35/2>), do not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A) (<https://www.govinfo.gov/link/uscode/5/553>)); *U.S. v. Gould*, 568 F.3d 459, 476 (4th Cir. 2009) (“The APA also requires publication of any substantive rule at least 30 days before its effective date, 5 U.S.C. 553(d) (<https://www.govinfo.gov/link/uscode/5/553>), except where the rule is interpretive . . .”).

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (<https://www.govinfo.gov/link/uscode/5/553>) or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601–612 (<https://www.govinfo.gov/link/uscode/5/601>)) is required. See 5 U.S.C. 603 (<https://www.govinfo.gov/link/uscode/5/603>).

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (/executive-order/13563) (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563 (/executive-order/13563). Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (/executive-order/13132) (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (/executive-order/13132) (Aug. 4, 1999).

F. Executive Order 13175 (/executive-order/13175) (Tribal Consultation): This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (/executive-order/13175) (Nov. 6, 2000).

G. Executive Order 13211 (/executive-order/13211) (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 (/executive-order/13211) because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (/executive-order/13211) (May 18, 2001).

H. Executive Order 12988 (/executive-order/12988) (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (/executive-order/12988) (Feb. 5, 1996).

I. Executive Order 13045 (/executive-order/13045) (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (/executive-order/13045) (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 (<https://www.govinfo.gov/link/uscode/5/801>) *et seq.*), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this final rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this final rule is not a “major rule” as defined in 5 U.S.C. 804(2) (<https://www.govinfo.gov/link/uscode/5/804>).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See* 2 U.S.C. 1501 (<https://www.govinfo.gov/link/uscode/2/1501>) *et seq.*

M. National Environmental Policy Act: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See* 42 U.S.C. 4321 (<https://www.govinfo.gov/link/uscode/42/4321>) *et seq.*

N. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note (<https://www.govinfo.gov/link/uscode/15/272>)) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549 (<https://www.govinfo.gov/link/uscode/44/3501>)) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549 (<https://www.govinfo.gov/link/uscode/44/3501>)). This rulemaking does not add any additional information requirements or fees for parties before the Board. Therefore, the Office is not resubmitting information collection packages to OMB for its review and approval because the revisions in this rulemaking do not materially change the □ information collections approved under OMB control number 0651–0069.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to, a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 42 (<https://www.ecfr.gov/current/title-37/part-42>)

- Administrative practice and procedure, inventions and patents

For the reasons set forth in the preamble, 37 CFR part 42 (<https://www.ecfr.gov/current/title-37/part-42>) is amended as follows.

PART 42—TRIAL PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

1. The authority citation for 37 CFR part 42 (<https://www.ecfr.gov/current/title-37/part-42>) continues to read as follows:

Authority: 35 U.S.C. 2(b)(2) (<https://www.govinfo.gov/link/uscode/35/2>), 6 (<https://www.govinfo.gov/link/uscode/35/6>), 21 (<https://www.govinfo.gov/link/uscode/35/21>), 23 (<https://www.govinfo.gov/link/uscode/35/23>), 41 (<https://www.govinfo.gov/link/uscode/35/41>), 135 (<https://www.govinfo.gov/link/uscode/35/135>), 311 (<https://www.govinfo.gov/link/uscode/35/311>), 312 (<https://www.govinfo.gov/link/uscode/35/312>), 316 (<https://www.govinfo.gov/link/uscode/35/316>), 321–326 (<https://www.govinfo.gov/link/uscode/35/321>) and Public Law 112–29 (<https://www.govinfo.gov/link/plaw/112/public/29>).

Subpart A—Trial Practice and Procedure

2. Section 42.6 is amended by revising paragraph (a)(2)(ii) to read as follows:

§ 42.6 Filing of documents, including exhibits; service.

(a) * * *

(2) * * *

(ii) 14-point, Times New Roman proportional font, with normal spacing, must be used;

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3. Section 42.10 is amended by revising paragraph (a) to read as follows:

§ 42.10 Counsel.

(a) If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.

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4. Section 42.15 is amended by revising paragraphs (a)(3), (a)(4), (b)(3), and (b)(4) to read as follows:

§ 42.15 Fees.

(a) * * *

(3) In addition to the *Inter Partes* Review request fee, for requesting review of each claim in excess of 20, including unchallenged claims from which a challenged claim depends: \$200.00.

(4) In addition to the *Inter Partes* Post-Institution request fee, for requesting review of each claim in excess of 15, including unchallenged claims from which a challenged claim depends: \$400.00.

(b) * * *

(3) In addition to the Post-Grant or Covered Business Method Patent Review request fee, for requesting review of each claim in excess of 20, including unchallenged claims from which a challenged claim depends: \$250.00.

(4) In addition to the Post-Grant or Covered Business Method Patent Review Post-Institution request fee, for requesting review of each claim in excess of 15, including unchallenged claims from which a challenged claim depends: \$550.00.

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5. Section 42.23 is amended by revising the first sentence of paragraph (a) to read as follows:

§ 42.23 Oppositions and replies.

(a) Oppositions and replies must comply with the content requirements for motions and, if the paper to which the opposition or reply is responding contains a statement of material fact, must include a listing of facts that are admitted, denied, or cannot be admitted or denied. * * *

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6. Section 42.24 is amended by revising paragraphs (a)(1) introductory text and (a)(1)(v), the first sentence of paragraph (c) introductory text, and paragraphs (c)(1) and (c)(2), and adding paragraphs (a)(1)(vi) and (c)(3) to read as follows:

§ 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 any statement of material facts to be admitted or denied 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 or claim listing.

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(v) Motions (excluding Motions to Amend): 15 pages.

(vi) Motions to Amend: 25 pages.

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(c) *Replies.* The following page limits for replies apply and include any statement of facts in support of the reply. * * *

(1) Replies to patent owner responses to petitions: 25 pages.

(2) Replies to oppositions (excluding replies to oppositions to Motions to Amend): 5 pages.

(3) Replies to oppositions to Motions to Amend: 12 pages.

7. Section 42.51 is amended by revising paragraph (b)(1)(ii) to read as follows.

§ 42.51 Discovery.

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(b) * * *

(1) * * *

(ii) Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.

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8. Section 42.53 is amended by revising paragraphs (c)(2) and (f)(7) to read as follows:

§ 42.53 Taking testimony.

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(c) * * *

(2) Unless stipulated by the parties or ordered by the Board, cross-examination, redirect examination, and re-cross examination for uncompelled direct testimony shall be subject to the follow time limits: Seven hours for cross-examination, four hours for redirect examination, and two hours for re-cross examination.

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(f) * * *

(7) Except where the parties agree otherwise, the proponent of the testimony must arrange for providing a copy of the transcript to all other parties. The testimony must be filed as an exhibit.

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9. Section 42.64 is amended by revising the section heading and the first two sentences of paragraph (b)(1) to read as follows.

§ 42.64 Objection; motion to exclude.

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(b) * * *

(1) *Objection.* Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be filed within five business days of service of evidence to which the objection is directed. * * *

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10. Section 42.71 is amended by revising the first sentence of paragraph (d) to read as follows:

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

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(d) *Rehearing.* A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. * * *

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Subpart B—Inter Partes Review

11. Section 42.121 is amended by revising paragraph (b) introductory text to read as follows:

§ 42.121 **Amendment of the patent.**

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(b) *Content.* A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

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Subpart C—Post-Grant Review

12. Section 42.221 is amended by revising paragraph (b) introductory text to read as follows:

§ 42.221 **Amendment of the patent.**

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(b) *Content.* A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

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Subpart D—Transitional Program for Covered Business Method Patents

13. Section 42.300 is amended by revising paragraph (c) to read as follows:

§ 42.300 **Procedure; pendency.**

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(c) A covered business method patent review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

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14. Section 42.302 is amended by adding paragraph (c) to read as follows:

§ 42.302 Who may petition for a covered business method patent review.

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(c) A petitioner may not file a petition to institute a covered business method patent review of the patent where, before the date on which the petition is filed, the petitioner or real party-in-interest filed a civil action challenging the validity of a claim of the patent.

Dated: May 14, 2015.

Michelle K. Lee,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 2015-12117 (/d/2015-12117) Filed 5-18-15; 8:45 am]

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