



# USPTO announces Advance Notice of Proposed Rulemaking for potential PTAB reforms

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WASHINGTON — To ensure robust and transparent engagement throughout the rulemaking process, the U.S. Patent and Trademark Office (USPTO) today announced an [Advance Notice of Proposed Rulemaking \(ANPRM\)](#) seeking public input regarding proposed changes to discretionary institution practices, petition word limits, and settlement practices for America Invents Act (AIA) proceedings before the Patent Trial and Appeal Board (PTAB). The ANPRM allows the public to provide initial feedback on proposals from both the USPTO and the public before the USPTO shapes potential rules in a Notice of Proposed Rulemaking (NPRM).

“We thank our stakeholders and the public for the many comments they submitted, including in response to the Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board,” remarked Under Secretary of Commerce for Intellectual Property and USPTO Director Kathi Vidal. “Our goal is to better ensure our practices align with the USPTO’s mission to promote and protect innovation and investment, and with the congressional intent behind the AIA to provide a less expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment.”

In the proposals included in the ANPRM, the USPTO has considered the comments received from stakeholders and the public as well as “the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the USPTO, and the ability of the USPTO to timely complete proceedings instituted under” 35 U.S.C. 316(b).

The USPTO is soliciting comments regarding a range of proposals that relate to the rules the Director, and by delegation, the PTAB, will use in exercising discretion to institute inter partes reviews and post-grant reviews under 35 U.S.C. §§ 314(a), 324(a), and 325(d). The USPTO is also soliciting comments regarding proposals that would allow petitioners to pay additional fees for higher petition word count limits, provide a separate briefing process for discretionary institution arguments, and clarify that parties that settle prior to institution must file copies of any settlement agreements with the PTAB.

The USPTO welcomes feedback on:

- The proposals listed including any proposed modifications.
- Additional specific proposals not listed in the ANPRM and input as to why those proposals would:
  - Serve the USPTO’s mission to promote and protect innovation and investment, and
  - Align USPTO practices with the congressional intent behind the AIA to provide a less expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment.

Comments are important to inform the targeted changes the USPTO will make as well as any changes the USPTO will not move forward with.

## Key Areas of the Specific Proposals

**Key Area 1:** Better ensure our practices align with the USPTO’s mission to promote and protect innovation and investment, and with the congressional intent behind the AIA to provide a less expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment

**Key Area 2:** Enhance and build on existing precedent and guidance regarding exercise of Director’s discretion to determine whether to institute an AIA proceeding

**Key Area 3:** Provide threshold definitions that apply to one or more categories of petitions subject to discretionary denials, setting forth criteria used to determine “substantial relationship,” “substantial overlap,” and “compelling merits”

**Key Area 4:** Provide procedural enhancements

**Key Area 5:** Clarify filing requirements for Settlement Agreements

Comments on the ANPRM will be accepted for 60-days through June 20, 2023. Absent extenuating circumstances, the USPTO does not anticipate extending the deadline. Those who miss the deadline will have an additional opportunity to submit comments during the next stage of rulemaking. All comments must be submitted in writing through the Federal eRulemaking Portal at [www.regulations.gov](http://www.regulations.gov).

The USPTO will hold an [information session](#) with Under Secretary of Commerce for Intellectual Property and Director of the USPTO Kathi Vidal on the ANPRM on May 9, 2023 from noon to 1 p.m. ET.



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