

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Motion to amend developments

Deputy Chief Judge Jacqueline Bonilla

Lead Administrative Patent Judge Jessica Kaiser

December 3, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Notice of Proposed Rulemaking on the Burden
- MTA pilot program
- Other amendment options

Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Burdens for motion to amend

Notice of Proposed Rulemaking

Notice of proposed rulemaking on allocation of the burden of persuasion on motions to amend

- Published in Federal Register at 84 Fed. Reg. 56401 (October 22, 2019)
- The office proposes changes to the rules of practice governing motions to amend
 - to assign to the patent owner the burden of showing that a motion to amend complies with certain statutory and regulatory requirements
 - to assign to the petitioner the burden of showing the unpatentability of substitute claims proposed in a motion to amend
 - to provide that the Board itself may, in the interests of justice, exercise its discretion to grant or deny a motion to amend for any reason supported by the evidence of record
- The proposed rule is consistent with the burdens as described in the precedential Board decision *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 (PTAB Feb. 25, 2019).
- Comment period closes on December 23, 2019.



Board discretion – statutory and regulatory requirements

- The Board may determine that the motion complies with the statutory and regulatory requirements for a motion to amend, even if a patent owner does not expressly address or establish every requirement in its motion.
- The office expects that the Board will do so only in circumstances where:
 - there is easily identified and persuasive evidence that the motion complies with the statutory and regulatory requirements, and
 - only where the petitioner has been afforded the opportunity to respond to that evidence

Board discretion - unpatentability

- Similarly, when in the interests of justice, the Board may deny a motion to amend, even in instances where the petitioner does not oppose the motion or does not meet its burden of showing unpatentability.
- Such instances include, for example:
 - petitioner has ceased to participate in the proceeding altogether (for example, as a result of settlement)
 - petitioner remains in the proceeding but does not oppose the motion to amend
 - petitioner opposes the motion to amend and has failed to meet the burden of persuasion, but there is easily identified and persuasive evidence of unpatentability in the record

Board discretion - unpatentability

- Ordinarily, in cases where the petitioner has participated fully and opposed the motion to amend, the Office expects that:
 - the petitioner will bear the burden of persuasion and there will be no need for the Board to independently justify a determination of unpatentability
 - the Board will do so only in rare circumstances, and only where the patent owner has been afforded the opportunity to respond to the evidence and related grounds of unpatentability

Notice and comment

- Written comments must be received on or before December 23, 2019
 - Comments may be submitted by e-mail to: MTABurden2019@uspto.gov. Include the docket number (PTO-P-2019-0011).
 - Comments may also be sent via the Federal eRulemaking Portal at www.regulations.gov. Include the docket number (PTO-P-2019-0011).
 - Comments may also be submitted by postal mail addressed to:
 - Mail Stop Patent Board, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of “Lead Administrative Patent Judge Christopher L. Crumbley or Lead Administrative Patent Judge Susan L. C. Mitchell, PTAB Notice of Proposed Rulemaking 2019.”



MTA pilot program

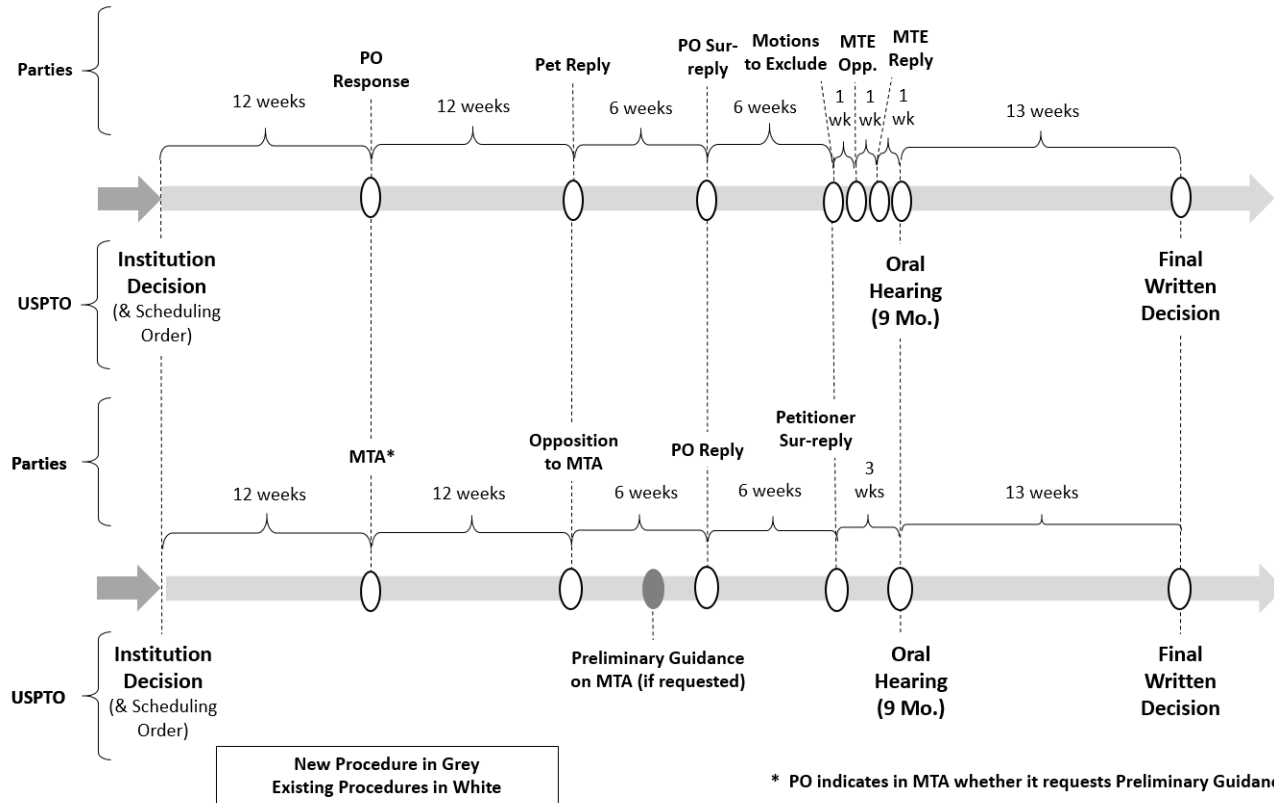
Highlights of MTA pilot program

- Provides patent owner (PO) with two options not previously available:
 - Option 1: PO may choose to receive preliminary guidance (PG) from Board on its motion to amend (MTA).
 - Option 2: PO may choose to file a revised MTA after receiving petitioner's opposition to initial MTA and/or after receiving Board's PG (if requested).
- Option 1 is not a predicate for Option 2.
- Applies to all AIA trials instituted on or after publication date of the notice (i.e., March 15, 2019).

Highlights of MTA pilot program

- If PO does not elect either option:
 - AIA trial practice, including MTA procedure, is essentially unchanged from prior practice, especially regarding timing of due dates for already existing papers in an AIA trial

Schedule entered at institution (Appendix 1A)



All cases

- Scheduling order entered at institution sets due dates similar to prior practice
 - Schedule is changed only if/after PO files revised MTA
 - Parties can stipulate to move dates, but must leave time for PG

All cases with an MTA

- In initial MTA, PO may request PG
 - If PO does not request PG, no PG
 - If PO requests it, Board will provide PG within 4 weeks of due date for Opp. to MTA
 - No rehearing request from PG

All cases with an MTA

- Content of PG

- Preliminary, non-binding initial assessment of MTA based on record so far
 - Typically short paper (although may be oral guidance in a conference call, at Board's discretion)
 - Focuses on limitations added in MTA
 - Does not address patentability of original claims
 - Does not provide dispositive conclusions

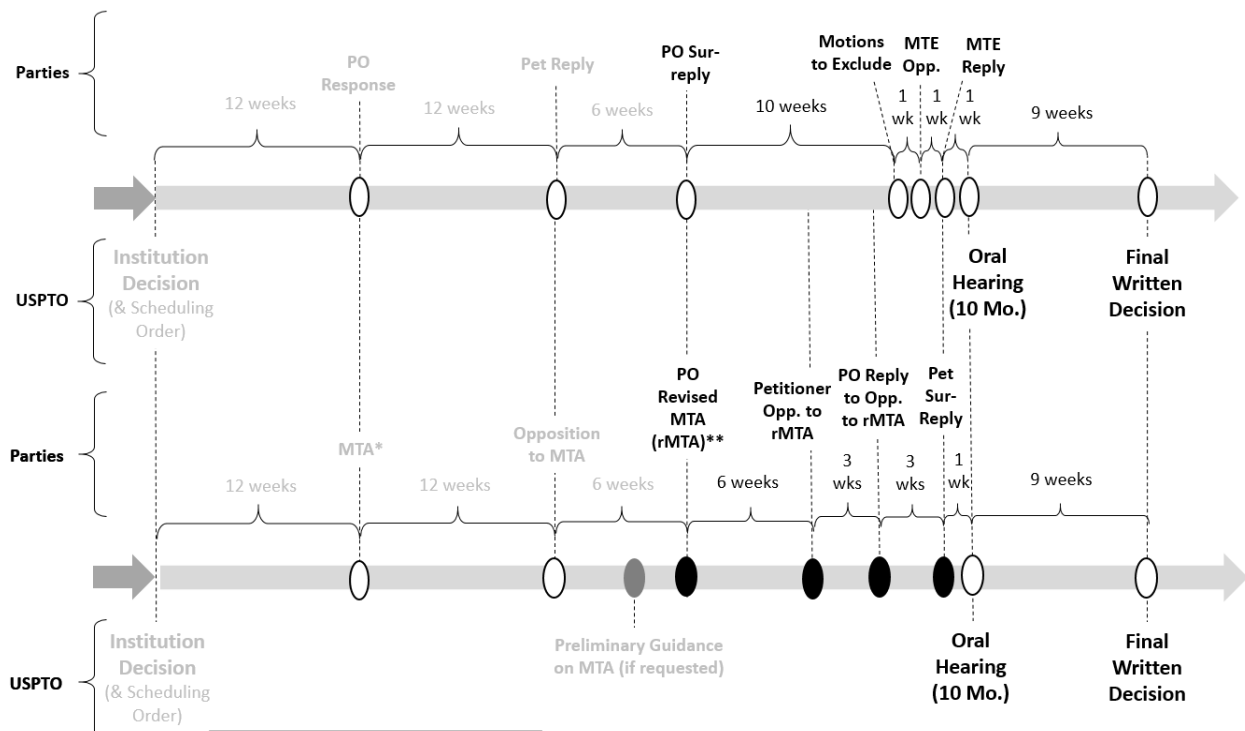
PO choices

- Based on Opp. to MTA and/or PG, PO may file:
 - Reply to opposition to MTA and PG (if requested); or
 - Revised MTA; or
 - Nothing

PO files reply

- Appendix 1A of pilot notice
- PO files reply to MTA opposition and/or PG
 - No change to scheduling order
 - Petitioner may file sur-reply six weeks after PO reply (on same day as MTE)
 - Oral hearing at ~nine months (similar to prior practice)

Revised schedule if revised MTA (Appendix 1B)



* PO indicates in MTA whether it requests Preliminary Guidance
 ** If PO files a rMTA, Board adjusts schedule to this revised timeline

PO files revised MTA

- Appendix 1B of pilot notice
- PO files revised MTA
 - Includes one or more new proposed substitute claims in place of previously presented substitute claims
 - May provide new arguments and/or evidence as to why revised MTA meets statutory and regulatory requirements
 - May keep some proposed substitute claims from original MTA and reply to PG and/or Opp. on those claims
 - Must provide amendments, arguments, and/or evidence that are responsive to issues raised in PG or Opp.

PO files revised MTA

- Board issues revised scheduling order shortly after PO files revised MTA
 - Sets dates for briefing on revised MTA
 - Revises dates for MTE and associated briefing
 - Revises oral hearing date to ~10 months
- Final written decision addresses only substitute claims at issue in revised MTA (if necessary)

If PO files no paper after opposition and/or PG

- If no PG, no further briefing on MTA
- If PG:
 - Petitioner may file reply to PG (three weeks after due date for PO reply)
 - May only respond to PG
 - PO may file sur-reply in response (three weeks thereafter)
 - May only respond to reply
 - No new evidence with either paper

Current MTA pilot status

- MTA pilot has been effective since March 15, 2019 for cases instituted on or after that date.
- First opportunity to file an MTA was June 7, 2019
 - First MTA requesting PG was filed June 25
- First opportunity to file a revised MTA was mid-October
 - First revised MTA was filed October 30

Other amendment options

Notice regarding options for reissue or reexamination during pending AIA proceeding

- Published in Federal Register at 84 Fed. Reg. 16654 (April 22, 2019).
- Notice provides:
 - A summary of current practice regarding existing USPTO procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of same patent, after Board institutes a trial, and after Board issues a final written decision (FWD).
 - Summary information about factors currently considered when determining:
 - Whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding; and
 - When and whether to lift such a stay or suspension.



Options for amendments on PTAB webpage

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/notice-regarding-options-amendments>

The screenshot shows the USPTO Patent and Trademark Office website. The top navigation bar includes links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO', along with a search bar. Below this is a secondary navigation bar with 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', plus a 'Find It Fast' button. The main content area is titled 'Patent Trial and Appeal Board' and includes a breadcrumb trail: 'Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board'. The main heading is 'Patent Trial and Appeal Board', followed by a brief description of the PTAB's functions. Below this are several columns of links and information:

- Trials**: Manage or review pending inter partes review, post-grant review, covered business method, derivation, and interference proceedings.
- Appeals**: Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.
- Decisions**: Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.
- Hearings**: Review guidance, schedules, and inclement weather advisories for oral arguments for appeals, interferences, and trials.
- Resources and guidance**: Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.
- Statistics**: View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.
- PTAB Data Tools and IT Systems**: Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.
- PTAB Events**: Find where our judges are speaking and learn more about events sponsored by PTAB.
- About PTAB**: Discover the history of the PTAB and map out its modern structure and mission.

On the right side of the page, there are several news items, each with a 'NEW' tag:

- Trial Practice Guide July 2019 Update**
- Notice regarding options for amendments through reissues or reexaminations** (highlighted with a red box)
- New Pilot Program Concerning Motions to Amend**
- Claim Construction Final Rule**
- SOP 1 (rev. 15): Assignment of judges to panels**
- SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure**

Notice regarding options for amendments through reissue or reexamination

The United States Patent and Trademark Office (USPTO) has published a notice of information regarding existing office practice available to a patent owner during the pendency of a trial proceeding under the America Invents Act (AIA), pertaining to reissue and reexamination procedures available for amending claims involved in the trial.

This notice provides a summary of current practice regarding reissue and reexamination options in which patent owners may amend claims before and after the Patent Trial and Appeal Board (PTAB) issues a final written decision in an AIA trial proceeding. This notice also provides summary information about factors the USPTO currently considers when determining whether to stay or suspend a reissue proceeding, or stay a reexamination, that involves a patent involved in an AIA proceeding, and also when and whether to lift such a stay or suspension.

The full text of the notice is [published in the Federal Register](#).

On October 29, 2018, the USPTO published a notice requesting comments on proposed modifications to current motion to amend practice and procedures in AIA trial proceedings. In response to that notice, the USPTO received a number of comments and questions requesting clarification regarding existing reissue and reexamination procedures at the USPTO. The USPTO carefully considered those comments and questions and issued this notice of information in response.

Question/comment submission

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Appendix

Amendments through reissue or reexamination

- The office will consider a reissue application or a request for reexamination any time before, but not after, either:
 - Office issues a certificate that cancels all claims of a patent, or
 - Federal Circuit issues a mandate in relation to a decision that finds all claims of a patent are invalid or unpatentable

Amendments through reissue or reexamination

- The office will not issue a trial certificate (e.g., canceling all claims) relating to a patent at issue in an AIA proceeding until after either:
 - Deadline for filing a notice of appeal to Federal Circuit has passed without a party filing an appeal, which is:
 - 63 days after the date of a FWD, or
 - 63 days after the date of a decision on a request for rehearing regarding the FWD
 - All decisions or determinations in relation to an appeal to the Federal Circuit regarding the patent are finally resolved

Amendments through reissue or reexamination

- Thus, patent owners (POs) may avail themselves of a reissue application or a request for reexamination before, during, or after an AIA trial concludes with a FWD, as long as application or request is timely filed

Stays of reissue or reexamination

- The Board ordinarily will stay a parallel office proceeding where good cause exists
 - Good cause may exist if, for example, an on-going AIA proceeding is addressing the same or overlapping claims of a patent at issue in a parallel office proceeding
- The Board typically will consider motions to stay (or may impose a stay *sua sponte*):
 - After institution of an AIA trial proceeding, and
 - Before the filing of a notice of appeal or the deadline for filing a notice of an appeal to Federal Circuit has passed

Notice regarding options for reissue or reexamination during pending AIA trial proceeding

- See notice for information regarding non-limiting factors
 - considered by Board when deciding whether to grant a stay of a reissue or reexamination
 - considered by Patents when deciding whether to suspend a reissue application
 - considered by Board when deciding whether to lift a stay
 - considered by Patents when deciding whether to lift a reissue suspension

Motion to lift a stay of a parallel proceeding

- If PO files a motion to lift a stay after a FWD:
 - Board typically will lift stay, absent reasons not to do so, e.g., in view of factors discussed above
 - Board typically will lift a stay if PO proposes amendments in a reissue or reexamination in a meaningful way not previously considered by the office
 - Meaningful amendments include those that narrow the scope of claims considered in an AIA proceeding or otherwise attempt to resolve issues identified in a FWD

During appeal to the Federal Circuit

- Under certain circumstances, the office will proceed with a reissue application or request for ex parte reexamination after the Board issues a FWD relating to the same patent, including during an appeal of FWD at the Federal Circuit

Reissue proceedings and Federal Circuit appeals

- After a FWD issues, as long as PO files in a timely manner, and raises issues different than those already considered in the AIA proceeding (e.g., amendments meaningfully different than those in a previously presented motion to amend), the office typically will consider a reissue application (subject to possible suspension considerations)
- If a Federal Circuit appeal remains ongoing when an examiner identifies allowable subject matter, the office typically will not pass a reissue application to allowance until Federal Circuit appeal concludes
- The examiner may need to reevaluate status of allowable subject matter in view of a decision by Federal Circuit

Reissue options after Federal Circuit appeal

- After Federal Circuit appeal concludes, PO may confer with examiner and decide how to proceed with reissue:
 - For example:
 - Proceed to issuance,
 - File a request for continued examination (RCE) for further amendments/prosecution, or
 - Abandon reissue application

Reexamination options after Federal Circuit appeal

- Unlike reissue applications, POs do not have the option to abandon ex parte reexamination proceedings
- Once started, reexaminations proceed with special dispatch to completion (see 35 U.S.C. § 305)
- Thus, after the office determines that it is appropriate to lift a stay, or that a stay is not appropriate, reexamination typically will continue to completion, notwithstanding a Federal Circuit appeal of a FWD on the same patent

Reexamination options after Federal Circuit appeal

- If the office identifies allowable subject matter, or determines that some or all claims are unpatentable, the office typically will issue a NIRC and reexamination certificate, even if a relevant Federal Circuit appeal is ongoing, unless PO timely files a notice of appeal in the reexamination (for Board review)
- PO may appeal a final rejection of any claim to Board by filing a notice of appeal within required time
- Thus, to ensure a reexamination certificate does not cancel original patent claims that are separately on appeal at the Federal Circuit, PO must timely file an appeal of any final rejection of those original claims