

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **Patent Trial and Appeal Board Boardside Chat: Discussion on current motion to amend practice and on the Request for Comments regarding motion to amend practice**

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June 15, 2023



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# Agenda

- Current Motion to Amend (MTA) practice
  - MTA Pilot Program
  - MTA Burdens in 37 CFR §§ 42.121(d), 42.221(d)
  - MTA data study
- Panel discussion with practitioners on their experience with the MTA Pilot Program
- Request for Comments regarding Motion To Amend practice

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

**Current motion to amend practice**

# Original MTA practice

- **Motions to Amend due with PO response**
  - Responsive briefing limited to response, reply, sur-reply to the MTA
  - No preliminary review of the MTA by the Board
  - No opportunity to further revise amendments
  - Initially, MTAs filed in less than 10% of cases
- **Request for Comment in October 2018**

# Current MTA practice

- MTA Pilot Program
  - Implemented March 15, 2019
  - Applies to all AIA trials post-implementation date
  - Extended through September 16, 2024
  - <https://www.federalregister.gov/documents/2019/03/15/2019-04897/notice-regarding-a-new-pilot-program-concerning-motion-to-amend-practice-and-procedures-in-trial>

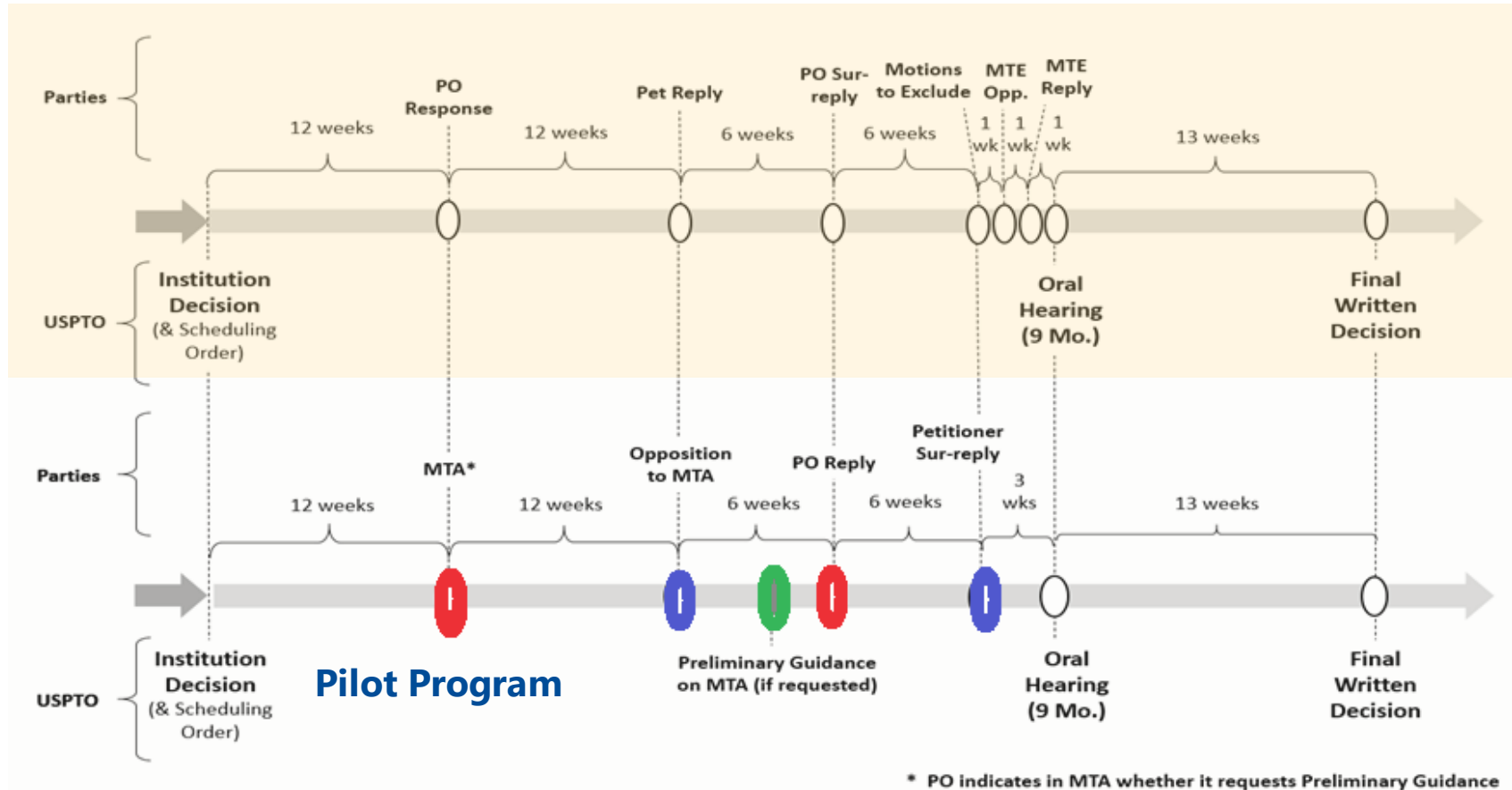
# MTA Pilot Program recap

- 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
  - 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)
- PO may elect either or both options
- MTAs may be contingent or non-contingent





# Schedule entered at institution (Appendix 1A)



# Preliminary guidance

- Patent Owner may request preliminary guidance in its motion to amend
- If requested, Board will provide preliminary guidance within 4 weeks of due date for opposition to the motion to amend

# Preliminary guidance content

- Preliminary, non-binding initial assessment
- Typically short paper
- Does not address patentability of original claims
- Focuses on limitations added in MTA
- Based on the current record
- Does not provide any dispositive conclusions

# Preliminary guidance assessments

- **Statutory and regulatory requirements**
  - Reasonable number of proposed substitute claims
  - Must respond to a ground of unpatentability
  - May not enlarge scope of claims
  - May not introduce new matter
- **Unpatentability**
  - Based on prior art under §§ 102/103
  - Grounds that a panel would not address in relation to the original claims in an IPR, such as subject matter eligibility (§ 101), indefiniteness (§ 112), enablement (§ 112)



# Preliminary guidance example: Number of proposed substitute claims and responsiveness

## 1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims?  
(35 U.S.C. § 316(d)(1)(B))

**Yes.** Petitioner challenges six original claims of the [REDACTED] patent (claims [REDACTED]), and Patent Owner proposes three substitute claims (claims [REDACTED]). Mot. 1. Patent Owner proposes no more than one substitute claim for each challenged claim, and each substitute claim appears to be traceable to an original challenged claim. *Id.* Petitioner does not argue otherwise. *See generally* Opp.

## 2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

**Yes.** Patent Owner responds to the grounds of unpatentability from the Institution Decision, arguing that the additional limitation distinguishes proposed substitute claims [REDACTED] as patentable over the cited prior art references. Mot. 9, 11–12. Petitioner does not argue otherwise. *See generally* Opp.



# Preliminary guidance example: Scope enlargement

## 3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**Yes.** At this stage in the proceedings, on the record before us, it does not appear that Patent Owner has shown a reasonable likelihood that proposed substitute claims [REDACTED] do not enlarge the scope of the claims.

**Proposed substitute claims [REDACTED].** Proposed substitute claims [REDACTED] newly, and similarly, recite “cast[ing] a ray from the augmented location of the subject,” where the augmented location is generated depending on . . . The original claims to be substituted (claims [REDACTED]) recite “cast[ing] a ray from the position of the subject.”

Petitioner points out, the proposed substitute claims appear to encompass “casting a ray from a different (and previously non-infringing) starting point.” . . . Upon review of the supporting description, additional scope appears to be captured . . . the description indicates that an “augmented location” would, at times, provide a different location than the originally claimed “position.”

Consequently, the proposed substitute claims capture the original scope . . . and newly capture additional scope[.]



# Preliminary guidance example: Unpatentability

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

## *35 U.S.C. § 103 – Obviousness*

**No.** On the current record, it appears that Petitioner (or the record) does not show a reasonable likelihood that proposed substitute claims [REDACTED] are unpatentable as obvious over the combination of [REDACTED] (Ex. 1012) and [REDACTED] (Ex. 1016). . .

We focus only on the limitation added to challenged claim [REDACTED] in proposed substitute claim [REDACTED] presented in Patent Owner’s Motion to Amend.

For proposed substitute claim [REDACTED], Petitioner does not appear to have shown a reasonable likelihood that the teachings of [REDACTED] and [REDACTED] alone or in combination, render obvious the. . . limitation labeled [REDACTED] by Petitioner[.]

Petitioner asserts “the newly added element [REDACTED]. . . is disclosed by any art that would disclose the second communication system having shorter symbol period[.]”

Petitioner’s reliance on the disclosure of [REDACTED] and particularly, on [REDACTED] Figure 5 showing symbols with a shorter symbol period for faster moving remote units, i.e., a second communication system) and on [REDACTED] associated testimony does not appear to show a reasonable likelihood that the teachings of [REDACTED] (in combination with [REDACTED]) render obvious limitation [REDACTED]. . . [REDACTED] does not disclose that the shortened period symbols are pilot symbols, as required by limitation [REDACTED]. In fact, [REDACTED] does not mention pilot symbols at all with respect to Figure 5. . . The other figure relied upon by Petitioner in its Opposition is the figure presented in [REDACTED] supporting testimony. See Ex. 1039 ¶¶ 61–62 (presenting a figure with data and pilot symbols in “a second communication system having a symbol period that is one half of the original symbol period”); Opp. 8, 12 (reproducing [REDACTED] figure). The figure presented in [REDACTED] supporting testimony does not establish the obviousness of limitation [REDACTED] because the figure is merely unsupported declaration testimony.



# Preliminary guidance example: Unpatentability

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

*35 U.S.C. § 112 ¶ 2 – Definiteness*

Petitioner further contends proposed substitute claims [REDACTED] fail to comply with the definiteness requirement because a person of ordinary skill in the art (“POSITA”) would not have understood the meaning of the term “analyzing . . . the plurality of input signals comprises more than identifying a location of each of the plurality of input signals,” recited in proposed substitute claim 15. Opp. 4. . .

On this record, Petitioner has established a reasonable likelihood that the term “more than,” recited in substitute claim 15, renders the claim indefinite because one having ordinary skill in the art would not, in light of the Specification, have understood whether a given technique for analyzing an input signal is *more than* identifying a location of an input signal. For example, it is unclear whether a technique for analyzing a signal is required to either: (1) identify a location of a signal *and also* analyze some other additional property (or properties) of the signal; or (2) merely analyze a specific property of the signal that is “more than” a location of the signal to be “more than identifying a location of . . . input signals.”





# Patent Owner choices following guidance

- Patent Owner does nothing
  - Petitioner may file a reply to the preliminary guidance
  - Patent Owner may file sur-reply to preliminary guidance
  - No change to scheduling order
- Patent Owner files reply to preliminary guidance
  - No change to scheduling order
- Patent Owner files revised MTA
  - Requires a change to the scheduling order
  - Appendix 1B of pilot program





# Revised MTA

- Includes one or more new proposed substitute claims in place of previously presented substitute claims
- Must provide amendments, arguments, and/or evidence that are responsive to issues raised in preliminary guidance or Petitioner's opposition
- May provide new arguments and/or evidence as why revised MTA meets the statutory and regulatory requirements
- May keep some proposed claims from original MTA
- Final written decision addresses only substitute claims at issue in revised MTA (if necessary).

# MTA Burdens of Persuasion

- December 2020 revisions to rules to allocate MTA burdens
- 37 CFR §§ 42.121(d)(1), 42.221(d)(1)
  - Burden on Patent Owner: statutory and regulatory requirements
  - (1) reasonable number of proposed substitute claims; (2) must respond to a ground of unpatentability; (3) may not enlarge scope of claims; (4) may not introduce new matter
- 37 CFR §§ 42.121(d)(2), 42.221(d)(2)
  - Burden on Petitioner: Unpatentability
  - Prior art which anticipates or renders obvious
  - Issues come up that a panel would not address on the original claims in an IPR, such as subject matter eligibility, indefiniteness, or enablement
- *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

# Board-raised grounds

- 37 CFR § 42.121(d)(3)

...the Board may, *in the interests of justice*, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record. The rule notice explains that Board-raised grounds should be rare

- The rule notice explains that Board-raised grounds occur in “rare circumstances”

- *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, IPR2018–00600, 12-13, 25-26 (PTAB July 6, 2020) (Paper 67)

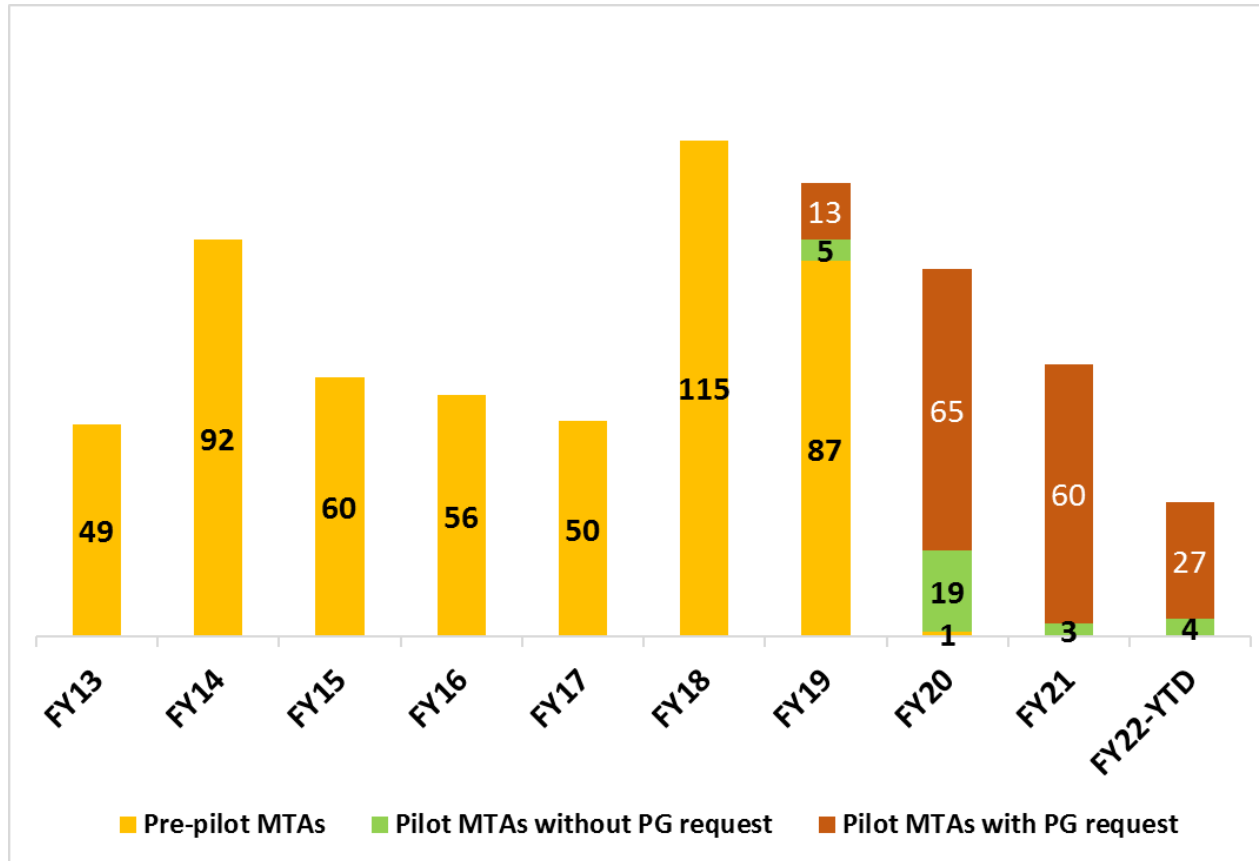
- Board raises grounds “the interest of supporting the integrity of the patent system” but where evidence is “readily identifiable and persuasive”



# **Motion to Amend Data Study**

# MTAs filed by fiscal year

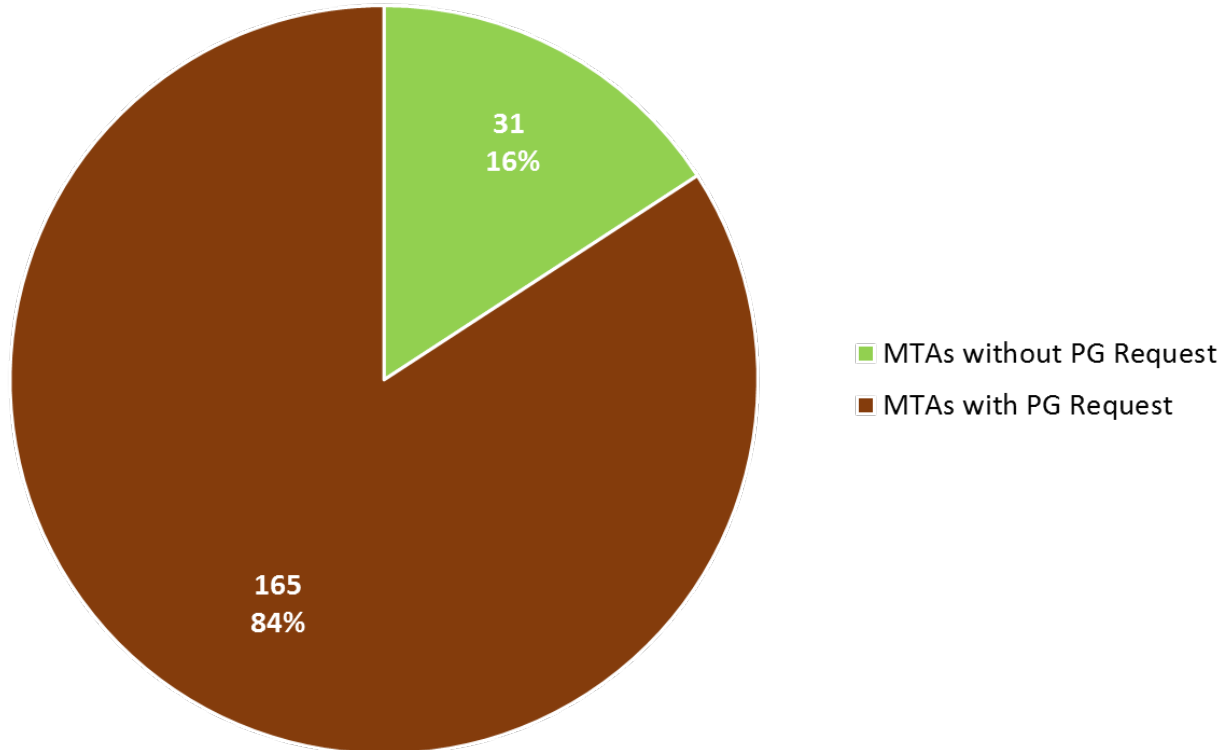
(Pre-pilot and pilot: Oct. 1, 2012 to Mar. 31, 2022)



\* The one pre-pilot MTA filed in FY20 is a corrected MTA of an MTA originally filed in FY19.

# Preliminary guidance (PG) requests during pilot program

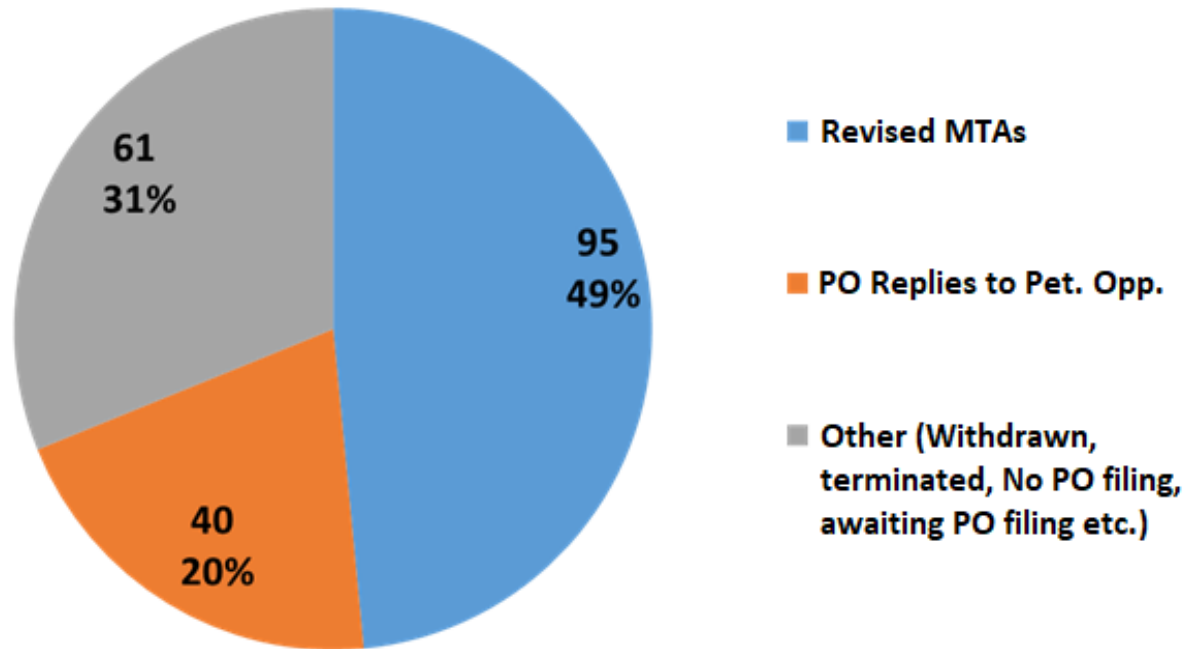
(Mar. 15, 2019 to Mar. 31, 2022)





# Patent owner filings after original MTA

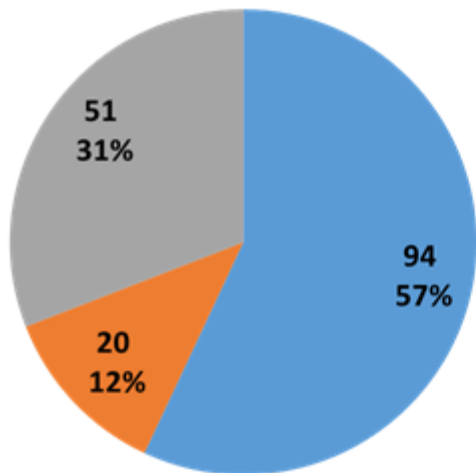
(Pilot: Mar. 15, 2019 to Mar. 31, 2022)



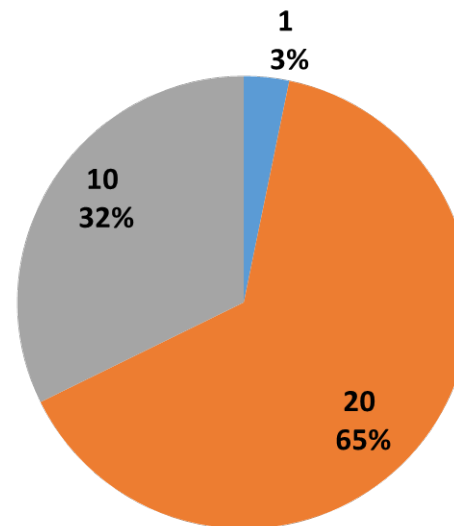
# Patent owner filings after original MTA

(Pilot: Mar. 15, 2019 to Mar. 31, 2022)

### With preliminary guidance



### Without preliminary guidance

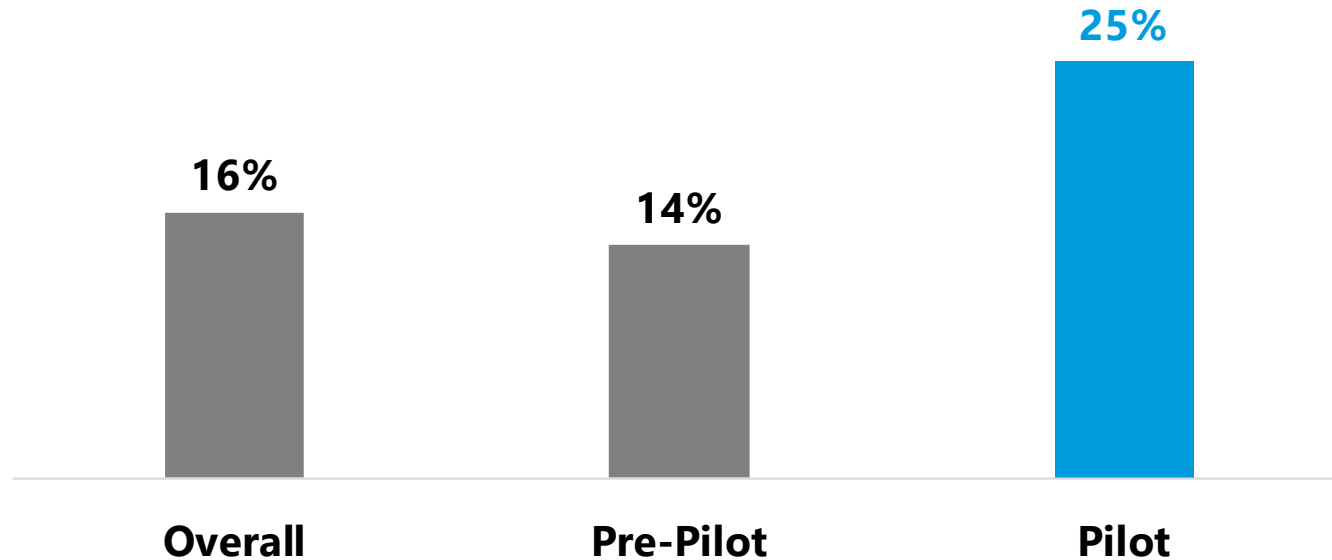


- Revised MTAs
- PO Replies to Pet. Opp.
- Other (Withdrawn, terminated, No PO filing, awaiting PO filing etc.)



# MTA grant rates

(Pre-pilot: Oct. 1, 2012 to Mar. 14, 2019; and  
Pilot: Mar. 15, 2019 to Mar. 31, 2022)



Grant rate calculated as the percentage of MTA dispositions granted or granted-in-part.



# Question/comment submission

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**Panel discussion with practitioners**

# Question/comment submission

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**Request for Comments (RFC) on the  
Motion to Amend Pilot Program  
and motion to amend burdens**

# RFC on motions to amend practice

- Published in Federal Register at 88 FR 33063 on May 26, 2023
- Nine questions directed to two main topics:
  - MTA Pilot Program experiences and making permanent
  - Board-raised grounds practices and burdens
- Comment period ends July 24, 2023

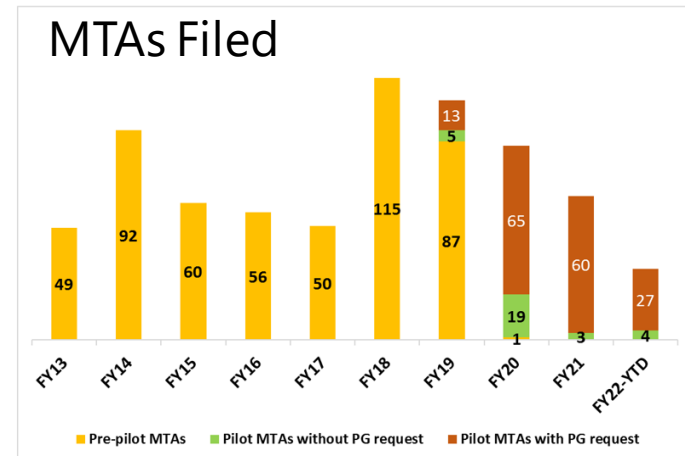
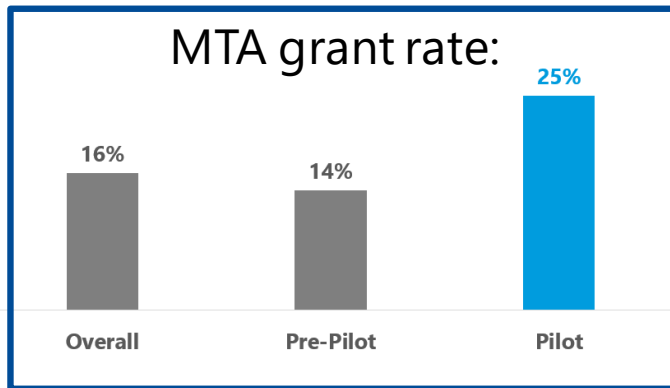
\* "Request for Comments Regarding the Motion To Amend Pilot Program and Rules of Practice To Allocate the Burdens of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board," 88 FR 33063 (<https://www.govinfo.gov/content/pkg/FR-2023-05-23/pdf/2023-10565.pdf>).





# RFC – MTA Pilot Program questions

1. Has the MTA Pilot Program positively or negatively impacted a patent owner's ability to successfully amend claims in an AIA proceeding? Has it made it more likely that a patent owner will avail itself of the MTA process?



# RFC – MTA Pilot Program questions

2. Are there circumstances in which reexamination and/or reissue proceedings are better options for patent owners seeking to amend claims challenged in an AIA proceeding, as compared to the MTA Pilot Program?

Is there anything more the Office can do to make the MTA process more useful to patent owners?

# RFC – MTA Pilot Program questions

3. Should the Office modify any aspect of the MTA Pilot Program? Should the Office continue to provide the options of receiving preliminary guidance and being able to revise an MTA, as currently implemented?
4. Assuming the MTA Pilot Program should remain, should any aspect of preliminary guidance, as currently provided by the Board, be changed?
5. What barriers, if any, exist that the Office can address to increase the effectiveness of the MTA procedure?

# RFC – Board-raised grounds questions

7. Should the Office involve patent examiner assistance in relation to MTAs?

Should the Office conduct a prior art search in relation to proposed substitute claims in certain situations? If so, under what circumstances?

Should examiner assistance or prior art searches be limited in any way?

# RFC – Board-raised grounds questions

6. Should the Office modify its practice of when the Board can or should raise a new ground of unpatentability, and if so, how? For example, should the PTAB's decision in the *Hunting Titan* case continue to guide when and how the Board can and should raise a new ground of unpatentability? If so, why and how?
8. Should the Office clarify in its rules where the burden of persuasion for Board-raised grounds lies? Who should bear that burden?
9. Should any other aspects of the MTA rules ([37 CFR 42.121](#), [42.221](#)), including as they relate to the Board's discretion to grant or deny an MTA, be changed, and if so, how?

# Board-raised grounds: Two requirements

- 37 CFR § 42.121(d)(3)

. . . the Board may,

- in the interests of justice, exercise its discretion to grant or deny a motion to amend
- only for reasons supported by readily identifiable and persuasive evidence of record.

# Board-raised grounds: Requirements

- Interests of justice
  - situations in which the adversarial process fails to provide the Board with potential arguments relevant to granting or denying a motion to amend
  - For example,
    - Petitioner has ceased to participate or chooses not to oppose the MTA
    - Patent Owner does not expressly address each requirement for the MTA in its briefing
  - The rule “applies the same standards articulated in” *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, IPR2018–00600, 12-13, 25-26 (PTAB July 6, 2020) (Paper 67) (precedential)

85 FR 82923, 82927 (Notice implementing 37 CFR 42.121(d))



# Board-raised grounds: Requirements

- **Readily identifiable and persuasive evidence** of record
  - For example,
    - where the record readily and persuasively establishes that substitute claims are unpatentable for the same reasons that corresponding original claims are unpatentable. (*Hunting Titan*, Paper 67 at 13)
    - *Hunting Titan* characterizes such instances as “rare circumstances”
    - potential collateral estoppel - to consider prior art raised in a related IPR in determining the patentability of dependent claims not addressed in that IPR. 85 FR at 82927 (citing *MaxLinear v. CF CRESPE*, 880 F.3d 1373 (Fed. Cir. 2018))



# Board-raised grounds: Requirements

- Readily identifiable and persuasive evidence **of record**
  - Board may make of record only readily identifiable and persuasive evidence in a related proceeding before the Office, or evidence that a district court can judicially notice

37 CFR 42.121(d)(3)

# Board-raised grounds: Federal Circuit view

- *Hunting Titan, Inc., v. DynaEnergetics Europe GmbH*, 28 F.4th 1371 (Fed. Cir. 2022)
  - Board does not have “an affirmative duty, without limitation or exception, to *sua sponte* raise patentability challenges to a proposed substitute claim”
  - But, Fed. Cir. found “problematic” that the USPTO confined the Board's discretion to only rare circumstances

# Board-raised grounds: burdens

- § 42.121(d)(3)
  - Provides Board’s discretion to raise its own grounds
  - Does not specifically state where the burdens of persuasion lie for Board-raised grounds
- *Nike, Inc. v. Adidas AG*, No. 2021–1903, 2022 WL 4002668, at \*4–10 (Fed. Cir. Sept. 1, 2022)
  - Federal Circuit does not clarify the burdens on Board-raised grounds
  - “unnecessary to determine here whether, in an *inter partes* review, the petitioner or Board bears the burden of persuasion for an unpatentability ground raised *sua sponte* by the Board against proposed substitute claims”

# Submit a formal comment

<https://www.regulations.gov/search?filter=PTO-P-2023-0024>

SEARCH RESULTS

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PROPOSED RULE

Motion to Amend Pilot Program and Rules of Practice to Allocate the Burdens of Persuasion on Motions to Amend in Trial Proceedings before the Patent Trial and Appeal Board

∴ [PTO-P-2023-0024](#)] Request for Comments Regarding the Motion To Amend Pilot Program and Rules of... To submit comments via the portal, enter docket number [PTO-P-2023-0024](#) on the homepage and click ``Search

Agency Patent and Trademark Office | Posted May 22, 2023 | ID PTO-P-2023-0024-0001

Comment

Comments Due Jul 24, 2023

Displaying 1 - 1 of 1 results



# Submit a formal comment

<https://www.federalregister.gov/documents/2023/05/23/2023-10565/request-for-comments-regarding-the-motion-to-amend-pilot-program-and-rules-of-practice-to-allocate>



**FEDERAL REGISTER**

The Daily Journal of the United States Government



**PR** Proposed Rule

## Request for Comments Regarding the Motion To Amend Pilot Program and Rules of Practice To Allocate the Burdens of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board

A Proposed Rule by the [Patent and Trademark Office](#) on 05/23/2023



This document has a comment period that ends in 46 days. (07/24/2023)

**SUBMIT A FORMAL COMMENT**

# Questions



# Next Boardside Chat



- Thursday, July 20, 2023, at 12-1 pm ET
- Topic: AIA Trial Practice
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:  
<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>

