

USPTO Announces Significant Reforms in Three Rounds of AIA Rule Changes—Round One: Increased Page Limits for Motions to Amend and Reply Briefs



March 30, 2015

On March 27, 2015, the U.S. Patent and Trademark Office (USPTO) announced the first of three upcoming "rule packages" that will clarify and modify rules for proceedings under the America Invents Act (AIA). In a blog post on the agency's website, USPTO Director Michelle Lee outlined the first round of "quick fixes" planned for this spring and provided a glimpse of two additional rule packages that are expected later this summer.

Background

In 2012, the USPTO issued rules and guidance for AIA proceedings before the Patent Trial and Appeal Board (PTAB). The first AIA proceedings began in September 2012, and in 2014, the USPTO requested public comments on the proceedings. Following a review of these comments, the USPTO has announced a three-part rollout plan to implement various changes to the PTAB rules that govern the conduct of AIA proceedings and to the Trial Practice Guide that advises the public on the general framework of the proceedings.

First "Quick Fix" Rule Package

The first rule package will provide "changes of simple scope" and is expected to be issued this spring. While the full set of changes remains unknown, Director Lee did highlight two specific changes: page limits for motions to amend the claims and for subsequent reply briefs, previously limited to 15 pages, have been increased to 25 pages. While the rules will not be officially changed until the spring, judges will immediately begin implementing the increased page limits through scheduling orders.

Second and Third Rule Packages

The next rule package, which is expected this summer, will contain "more involved changes" to the PTAB rules and the Trial Practice Guide. While these changes are still under consideration, Director Lee highlighted several possible changes, some providing explicit modifications to the rules and others clarifying existing practices. The USPTO plans to issue the second rule package as a set of proposed rules, so the public will have an additional opportunity to provide feedback before the rules are finalized. Director Lee highlighted the following possible changes and clarifications to the rules and guidelines:

- *Easier claim amendment process.* Patent owners are currently required to demonstrate the patentability of substitute claims over: (1) prior art of record in the proceeding; and (2) relevant prior art known to them but not of record. The USPTO may eliminate the second requirement. Director Lee noted that even with such a change, the duty of candor and good faith would still require patent owners to disclose material prior art.
- *Live testimony at oral hearing.* At present, live testimony has been used at an oral hearing only once. Such testimony will continue to be allowed only upon the grant of a motion, but the USPTO plans to "emphasize" its availability, opening the door for increased usage.
- *Discovery to establish the real-party-in-interest (RPI).* Motions for such discovery are regularly granted, and the USPTO appears likely to bless this practice by "emphasiz[ing] the importance of RPI discovery as to determinations of standing and as to possible later estoppel consequences."
- *Single-judge institution decisions.* Under current practice, a three-judge panel issues the institution decision and the final written decision. Under a proposed pilot program, a single judge would decide whether to institute trial, and two new judges would be added to the panel if and when trial is instituted.

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Director Lee also mentioned several less specific changes, including:

- Adjusting the evidence that can be presented in the Patent Owner's Preliminary Response
- Clarifying the claim construction standard for expired patents
- Adjusting the scope of additional discovery
- Reforming treatment of multiple proceedings involving the same patent
- Changing whether parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation

The USPTO's response to the public's comments on the current rules demonstrates the work-in-progress nature of AIA proceedings. Of particular note is the USPTO's response to repeated criticism that the claim amendment process has been too onerous for patent owners, since at present the vast majority of motions to amend have been denied. The page limit increases and the possible relaxation of the prior art-showing requirements suggest that the USPTO is taking these concerns seriously.

For more information about the AIA rule changes or any related matters, please contact Michael Rosato, Richard Torczon, Steven Parmelee, or any member of the patent office litigation practice at Wilson Sonsini Goodrich & Rosati.

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