

UNITED STATES
PATENT AND TRADEMARK OFFICE



Proposed AIA Trial Rule Changes and Guidance

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Patent Trial and Appeal Board
Webinar Series (5 of 5)
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AIA Trial Rulemaking

- In response to stakeholder requests, the Office published two rule packages in the Federal Register:
 1. A first final rule package that encompassed less difficult “quick-fixes,” including more pages for briefing for motions to amend and for petitioner’s reply brief; and
 2. A second proposed rule package that addressed the remaining issues raised in comments received from the public, as well as providing more guidance concerning our growing experience with AIA proceedings
- The public has sixty days to provide the Office with comments on the proposed rules
- The Office will issue a final rule, responding to these comments, and also issue a revised Office Patent Trial Practice Guide reflecting guidance concerning our current practice in handling AIA proceedings

Proposed Rule Changes

- Allow patent owners to include, with their opposition to a petition to institute a proceeding, new testimonial evidence such as expert declaration
- New requirement on practitioners before the PTAB, akin to the Rule 11 requirements in federal courts, that would give the USPTO a more robust means with which to police misconduct
- Clarifies that the PTAB will use the claim construction standard used by district courts for patents that will expire during proceedings and therefore cannot be amended, while confirms the use of broadest reasonable interpretation (BRI) for all other cases
 - Notes the PTAB's development of motions-to-amend practice through its own body of decisions
- Uses a word count for major briefing

Motions-to-Amend

- *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (representative)
 - Clarified earlier *Idle Free* decision
 - Patent Owner must show patentable distinction over prior art of record (in the proceeding; in the prosecution history; in any other proceeding involving the same patent)
 - Duty of candor and good faith in the Office may lead to additional prior art made of record by the Patent Owner when moving to amend

Possible Pilot Program for Institution Decisions

- The Office is considering a pilot program to increase the efficiency for handling AIA post grant proceedings, specifically, a potential alternative to the current three-judge institution model
- The Office is seeking input on whether to conduct a pilot program under which a single APJ would decide whether to institute an IPR trial, with two additional APJs being assigned to conduct the IPR trial, if instituted
- The public has sixty days to provide the Office with comments on the proposed pilot

Questions?



Public Feedback on Proposed Rules and Pilot

- Proposed AIA Trial Rules
 - Comments due by October 19, 2015
 - trialrules2015@uspto.gov
- Proposed Single Judge Institution Pilot
 - Comments due by October 26, 2015
 - ptabtrialpilot@uspto.gov

Thank You



