

Memo

To: MTABurden2019@uspto.gov

From: Kristy J. Downing

Date: 11/4/2019

Re: Comments on the Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the PTAB (Dkt No.: PTO-P-2019-0011)

The following is submitted in response to the US Patent Office's Request for Comments on the Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, issued October 22, 2019. 84 Fed. Reg. 56,401-406.

As an initial matter, it is very reassuring to see the Office proposing rules to clarify the burden structure on motions to amend after *Aqua Products*. This should decrease ambiguity and increase customer confidence in arguing such motions. I just have two questions.

First, as to proposed 37 CFR 42.121(d)(2) & 42.221(d)(2), is it desirable to enumerate the sections of the Code that relate to the "unpatentability" burden petitioners have on motions to amend? It is helpful that Section (d)(1) lists the (procedural) portions of the Code for which a patent owner continues to bear the burden of persuasion. Perhaps that can be reciprocated for the petitioner *via* listing §§102, 103, 112 and 101 (for section 42.221).

Additionally, and further to that point, I have seen a good number of priority arguments accompanying unpatentability petitions in *inter partes* reviews. On motions to amend, should priority be an issue, is it clear who bears the burden of proof? I would expect it to be the petitioner but I am not sure we are all clear on that. Perhaps the Board can address this issue in the comments after the proposed rules are adopted or add §§119 & 120 to the enumerated list of "unpatentability" grounds petitioner will bear the burden of proving.

I hope this is helpful. I am commenting on my own behalf and for the Just Intellectuals eNewsletter – an intellectual property law commentary.

Sincerely,

s/ Kristy J. Downing /