

December 11, 2018

Via Electronic Mail  
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Attention: Michael Tierney, Vice Chief Administrative Patent Judge  
Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent  
Judge

IBM Corporation Comments in Response to "Request for Comments on Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board," 83 Fed. Reg. 54319 (October 29, 2018)("Notice")

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IBM thanks the United States Patent and Trademark Office ("Office" or "USPTO") for the opportunity to provide comments on proposed changes from the USPTO Patent Trial and Appeal Board ("PTAB" or "Board") to certain practices and procedures regarding motions to amend patent claims filed in inter partes reviews ("IPRs"), post-grant reviews ("PGRs"), and covered business method patent reviews ("CBMs"). As an innovator and patentee in the field of information technology, IBM supports the availability of robust challenge proceedings to effectively and efficiently resolve patent validity disputes while ensuring fairness to both patentees and petitioners. We commend the Office's continued efforts to improve the Leahy-Smith America Invents Act (AIA) trial proceedings.

IBM advocates for greater predictability and certainty in every aspect of the patent system, including PTAB trial proceedings. IBM supports an improved patent claim amendment practice in AIA trials in a manner that is fair and balanced for all parties and stakeholders and enhances the likelihood of successful claim amendments.

The reasonable opportunity for patentees to amend patent claims in AIA trials is critical for ensuring a balanced and fair proceeding. Petitioners in AIA trial proceedings enjoy a low burden for proving invalidity—by a mere preponderance of the evidence, in contrast to the clear and convincing burden which must be met by parties challenging validity in district court. To balance this and other features of AIA trials favoring Petitioners, the patentee should be allowed reasonable opportunity to make adjustments to the patent claims.

A new process for considering patent claim amendments is a significant step forward to enable the intent of the AIA and create a more balanced post issuance review system at the USPTO. Given the importance of the patent claims amendment process to the balance of the post issuance proceedings created by the AIA, we welcome the USPTO's proposal to enhance the patent claim amendment process.

In particular, IBM supports a proposed patent claim amendment process in IPRs, PGRs, and CBMs before the PTAB that includes a preliminary non-binding decision

by the Board (which provides information to the parties regarding the merits of the motion to amend) and an opportunity for a patent owner to revise its motion to amend thereafter. We do have some suggested changes, as noted below, that we believe will enhance the effectiveness of the proposed process.

IBM generally supports modification of the Office's current practice to implement a proposal similar to the one described in the Notice, because these types of modifications should create more meaningful opportunities for patent claims to be amended in AIA trial proceedings before the Board. However, requiring motions to amend be filed only 1.5 months after the institution decision (as shown in Appendix A1 of the Notice), without the benefit of further proceedings, may diminish meaningful opportunities for patent claims to be amended in AIA trial proceedings, because the patent owner may have insufficient guidance from the institution decision to propose claim amendments that would be commercially beneficial and/or lead to expeditious resolution of the AIA trial proceeding. With insufficient guidance, the patent owner may choose not to file a motion to amend, and any meaningful opportunity for patent claims to be amended in AIA trial proceedings may be lost.

IBM advocates for an ability to file a motion to amend patent claims at various points in AIA trial proceedings, including before and after the oral hearing, but in advance of the Board's final written decision. In order to accommodate this variable timing for filing a motion to amend the patent claims, IBM supports the notion that filing of a motion to amend be sufficient cause under 35 USC Sections 316 and 326 and 37 CFR Section 42.5 to extend an AIA trial proceeding for up to an additional six (6) months.

IBM supports the Office preparing a preliminary decision in every proceeding where a patent owner files a motion to amend that proposes substitute claims. As proposed in the Notice, a preliminary decision by the Board should include whether there is a reasonable likelihood that: (1) the patent owner would prevail in establishing that the motion to amend meets statutory and regulatory requirements, and/or (2) the petitioner would prevail in establishing the unpatentability of any proposed substitute claims. In addition, the preliminary decision by the Board should be based upon and include evidentiary support for the decision from the record.

Any patent claim amendments arising out of a motion to amend should be fully supported by the patent specification and should not extend the patent protection as granted. If a petitioner ceases to participate in an AIA trial proceeding, then the Board may request assistance from an Examiner to search for prior art for patent claims that were not previously presented to the Office and that arise out of a motion to amend. Because the parties to an AIA trial proceeding have an ongoing duty to disclose prior art, we maintain that the Board generally should not solicit patent examiner assistance when the petitioner remains in the AIA trial proceeding. However, patent claim amendments arising out of a motion to amend should be properly vetted prior to issuance.

We support the opportunity for multiple motions to amend and for multiple preliminary decisions on such motions by the Board. Motions to amend filed under the proposed new process should be contingent, so the Board will provide a final decision on the patentability of substitute claims only if it determines that a corresponding original claim is unpatentable.

The Office should consider not proceeding with the pilot program in AIA trial proceedings in which both parties agree to opt-out of the program. In anticipation of this opt-out option, the Office should continue to support the current motion to amend practice and procedures.

IBM supports the rule that in a motion to amend the burden of persuasion lies with the petitioner to show that the proposed substitute claims are unpatentable.

#### Conclusion

IBM appreciates the opportunity to comment on the Office's request for comments on motion to amend practice and procedures in AIA trial proceedings before the Board. We thank the Office for working with the patent community to improve the fairness and effectiveness of challenge proceedings and thereby promote patent quality and provide certainty for the public and patent owners.

Respectfully submitted,

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