Pilot Program for Motions to Amend in AIA Trials

Presenters: Deputy Chief Judge Jackie Bonilla and Lead Judge Jessica Kaiser
April 10, 2019
Question/Comment Submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov
Introduction

• October 2018 motion to amend (MTA) request for comments (RFC)
  – Proposed a new MTA process and pilot program
  – Sought input regarding burden of persuasion when determining patentability of substitute claims, after *Aqua Products*
  – Included 17 questions of interest, but also solicited feedback regarding MTA practice generally
  – Comment period closed on December 21, 2018
Introduction

October 2018 MTA RFC

• 49 comments from stakeholders (as of Dec. 21, 2018)
  – 11 from companies
  – 9 from IP/bar associations
  – 11 from trade organizations
  – 4 from other organizations
  – 14 from individuals

• Office carefully considered all comments and revised pilot program in response
In response to the comments, the Office issued a notice regarding a new pilot program concerning MTA practice and procedures in AIA trials. This notice provides summary of 11 common comments and responses thereto.

- Topics include timelines, retroactivity of applying pilot, Board preliminary decision, opportunity to file a revised MTA, contingent MTAs, and opting-out of pilot.
- Stakeholder comments to October MTA RFC are available at https://go.usa.gov/xEXS2.
Highlights of MTA pilot program

• New program provides patent owner (PO) with two options not previously available:
  1. PO may choose to receive preliminary guidance (PG) from Board on its MTA.
  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).
Highlights of MTA pilot program

• If PO does not elect either option:

  AIA trial practice, including MTA procedure, is essentially unchanged from current practice, especially regarding timing of due dates for already existing papers in an AIA trial
  – One small exception: times between due dates for certain later-filed papers are extended slightly
Highlights of MTA pilot program

• Upon institution of an AIA trial, Board will issue the same scheduling order in every case
  – Due dates are similar to current practice
  – Due dates are calculated in weeks
• If PO chooses to file a revised MTA after receiving petitioner’s opposition and Board’s PG (if requested), Board will issue a revised scheduling order soon thereafter
Highlights of MTA pilot program

• Pilot program applies to all AIA trials instituted on or after March 15, 2019, the publication date of the notice
• MTA and revised MTA are contingent unless PO indicates otherwise or cancels original claims

• The full text of the notice can be found in the Federal Register at 84 Fed. Reg. 9497 (March 15, 2019)
Schedule entered at institution (Appendix 1A)

* PO indicates in MTA whether it requests Preliminary Guidance
Revised schedule if revised MTA (Appendix 1B)

New Procedures In Black and Grey
Existing Procedures in White

* PO indicates in MTA whether it requests Preliminary Guidance
** If PO files a rMTA, Board adjusts schedule to this revised timeline
All cases

• Scheduling order entered at institution sets due dates similar to current practice
  – Schedule is changed only if/after PO files revised MTA
  – Parties can stipulate to move dates, but must leave time for PG
  – Small changes:
    • 12 weeks for MTA and Opposition (Opp.) to MTA
      – Similar to current schedule
      – Same due dates as PO response and petitioner reply (petition)
    • 6 weeks for reply and sur-reply regarding MTA
      – Rather than 1 month under current practice
      – Same due dates as PO sur-reply and motion to exclude (MTE)
All cases with an MTA

• In initial MTA, PO may request PG
  – If PO does not request PG, no PG
  – If PO requests it, Board will provide PG within 4 weeks of due date for Opp. to MTA
  – No rehearing request from PG
All cases with an MTA

• Content of PG
  – Preliminary, non-binding initial assessment of MTA based on record so far
    • Typically short paper (although may be oral guidance in a conference call, at Board’s discretion)
    • Focuses on limitations added in MTA
    • Does not address patentability of original claims
    • Does not provide dispositive conclusions
All cases with an MTA

• Content of PG
  – Initially assesses whether:
    1. There is a reasonable likelihood that MTA meets statutory and regulatory requirements
       • 35 U.S.C. 316(d) or 326(d); 37 C.F.R. 42.121 or 42.221 and/or
    2. Petitioner (or record at that time) establishes a reasonable likelihood that proposed substitute claims are unpatentable
PO choices

• Based on Opp. to MTA and/or PG, PO may file:
  – Reply to opposition to MTA and PG (if requested); or
  – Revised MTA; or
  – Nothing
PO files reply

• Appendix 1A of pilot notice
• PO files reply to MTA opposition and/or PG
  – No change to scheduling order
  – Petitioner may file sur-reply 6 weeks after PO reply
    (on same day as MTE)
    • No new evidence other than deposition transcripts of cross-examination of any reply witness.
    • Limited to response to PG (if provided) and PO reply
  – Oral hearing at ~9 months (similar to current practice)
PO files revised MTA

• Appendix 1B of pilot notice
• PO files revised MTA
  – Includes one or more new proposed substitute claims in place of previously presented substitute claims
  – May provide new arguments and/or evidence as to why revised MTA meets statutory and regulatory requirements
  – May keep some proposed substitute claims from original MTA and reply to PG and/or Opp. on those claims
  – Must provide amendments, arguments, and/or evidence that are responsive to issues raised in PG or Opp.
PO files revised MTA

• Board issues revised scheduling order shortly after PO files revised MTA
  – Sets dates for briefing on revised MTA
  – Revises dates for MTE and associated briefing
  – Revises oral hearing date to ~10 months
    • If needed, PO may ask to file MTE regarding reply or sur-reply evidence at or after oral hearing

• Final written decision addresses only substitute claims at issue in revised MTA (if necessary)
If PO files no paper after opposition and/or PG

- If no PG, no further briefing on MTA
- If PG:
  - Petitioner may file reply to PG (3 weeks after due date for PO reply)
    - May only respond to PG
  - PO may file sur-reply in response (3 weeks thereafter)
    - May only respond to reply
  - No new evidence with either paper
All cases with an MTA

• **Opposition or reply**
  – May be accompanied by new evidence (e.g., declarations) that responds to new evidence or issues raised in PG, revised MTA, and/or opposition to MTA, as applicable
  – Exception for petitioner reply to PG, if PO files no reply or revised MTA—no new evidence

• **Sur-reply**
  – No new evidence other than deposition transcripts of cross-examination of a reply witness
  – May only respond to arguments made in reply, comment on reply declaration testimony, and/or point to cross-examination testimony
All cases with an MTA

• Cross-examinations/depositions pertaining to MTA and revised MTA
  – PG can take into account all evidence of record including cross-examination testimony
  – Parties should confer on deposition scheduling as soon as possible
    • Once declarants are known, parties should confer as to dates for scheduling all depositions—including before submitting declarations
    • Parties expected to make declarants reasonably available
    • If subsequent papers are due in 3 weeks, parties expected to make declarants available within 1 week
## Comparison of PO options

<table>
<thead>
<tr>
<th>PO Reply</th>
<th>Revised MTA</th>
<th>No PO filing</th>
</tr>
</thead>
<tbody>
<tr>
<td>No change to SO</td>
<td>Revised SO for due dates after reply to MTA</td>
<td>No change to SO</td>
</tr>
<tr>
<td>1 additional brief after PO reply (Pet. sur-reply at 6 weeks after reply)</td>
<td>3 additional briefs after revised MTA (Opp., reply, and sur-reply at 6-3-3 weeks)</td>
<td>2 additional briefs (if PG) (Pet reply and PO sur-reply at 3-3 weeks)</td>
</tr>
<tr>
<td>Briefing on MTA complete 3 weeks before oral hearing</td>
<td>Briefing on revised MTA complete 1 week before oral hearing</td>
<td>Briefing on MTA complete 3 weeks before oral hearing</td>
</tr>
</tbody>
</table>
## Comparison of PO options

<table>
<thead>
<tr>
<th>PO Reply</th>
<th>Revised MTA</th>
<th>No PO filing</th>
</tr>
</thead>
<tbody>
<tr>
<td>New evidence permitted with briefing other than sur-reply</td>
<td>New evidence permitted with briefing other than sur-reply</td>
<td>No new evidence permitted with reply or sur-reply</td>
</tr>
<tr>
<td>Oral hearing at ~ 9 months</td>
<td>Oral hearing at ~ 10 months</td>
<td>Oral hearing at ~ 9 months</td>
</tr>
<tr>
<td>(13 weeks from oral hearing to FWD deadline)</td>
<td>(9 weeks from oral hearing to FWD deadline)</td>
<td>(13 weeks from oral hearing to FWD deadline)</td>
</tr>
</tbody>
</table>
Examiner involvement

• If petitioner ceases to participate altogether and Board proceeds
  – Generally only if PO requests that Board address its MTA
  – Board may solicit patent examiner assistance
    • E.g., from Central Reexamination Unit examiner
  – Examiner advisory report, if solicited, may address:
    • Statutory and regulatory requirements for MTA
    • Patentability of proposed substitute claims in light of prior art provided by PO or found in searches by examiner
Pilot program implementation

- Effective date is March 15, 2019, the publication date of the notice
- Applies to all AIA trials instituted on or after that date
- USPTO anticipates it will reassess pilot program approximately 1 year from effective date
  - Potentially may terminate program at any time or continue program (with or without modifications) depending on stakeholder feedback and effectiveness of program
Question/Comment Submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov
Thank You