

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **Pilot Program for Motions to Amend in AIA Trials**

Presenters: Deputy Chief Judge Jackie Bonilla and  
Lead Judge Jessica Kaiser

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# Question/Comment Submission

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

[PTABBoardsideChat@uspto.gov](mailto: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**

# MTA pilot program

- 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



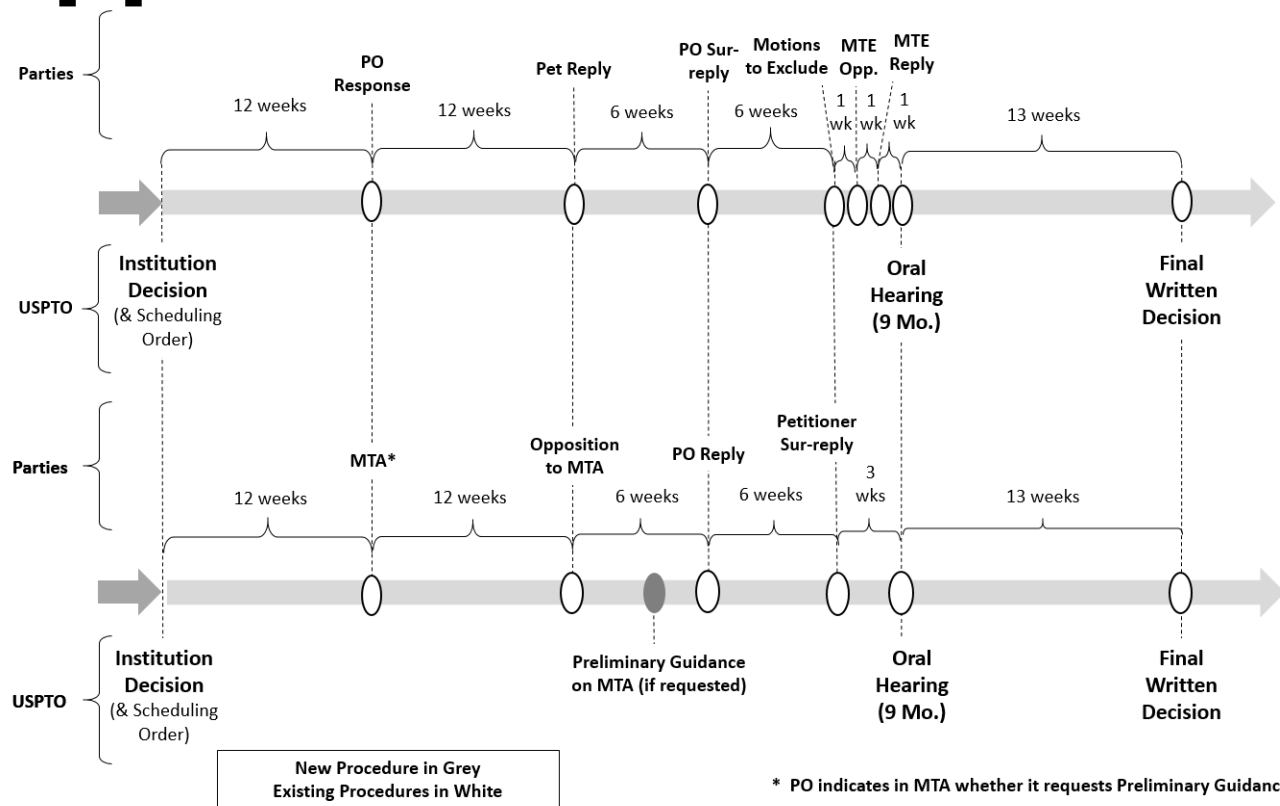
# Highlights of MTA pilot program

- 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

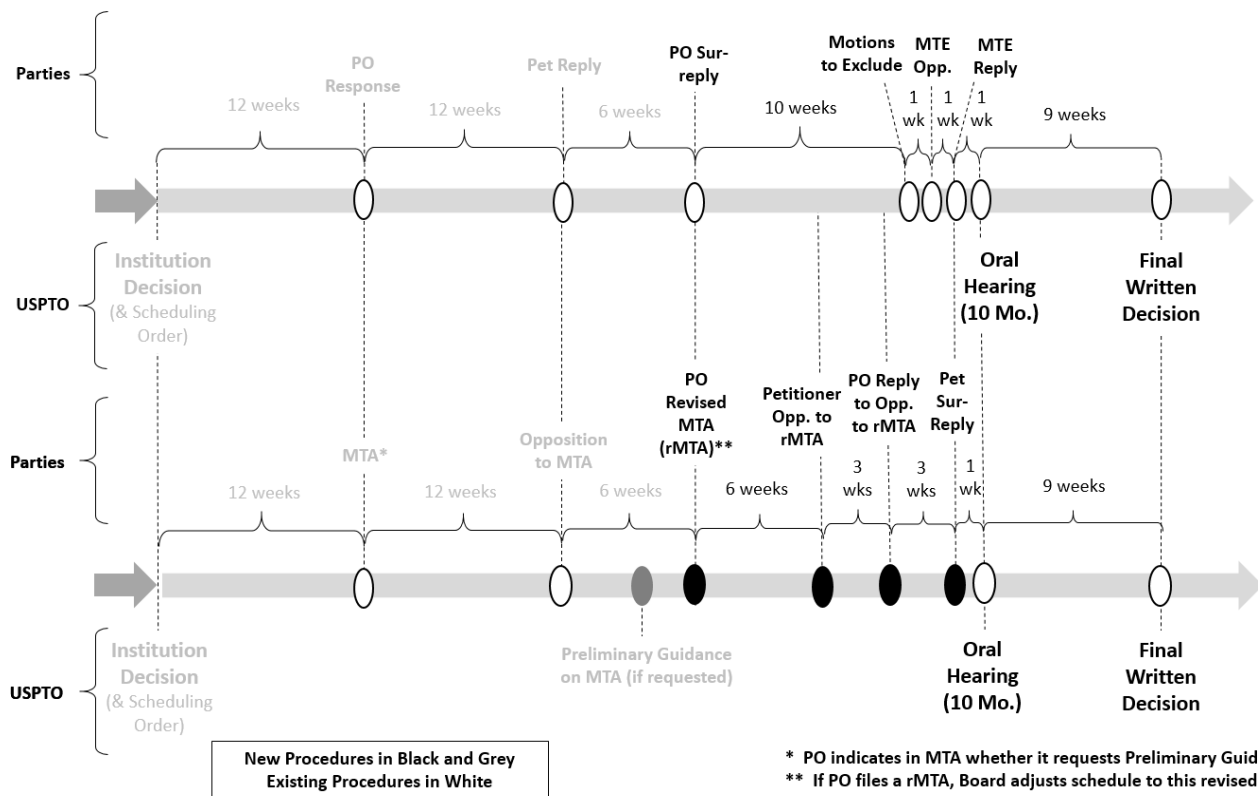
# Highlights of MTA pilot program

- 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)



# Revised schedule if revised MTA (Appendix 1B)



# 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

PO Reply	Revised MTA	No PO filing
No change to SO	Revised SO for due dates after reply to MTA	No change to SO
1 additional brief after PO reply (Pet. sur-reply at 6 weeks after reply)	3 additional briefs after revised MTA (Opp., reply, and sur-reply at 6-3-3 weeks)	2 additional briefs (if PG) (Pet reply and PO sur-reply at 3-3 weeks)
Briefing on MTA complete 3 weeks before oral hearing	Briefing on revised MTA complete 1 week before oral hearing	Briefing on MTA complete 3 weeks before oral hearing



# Comparison of PO options

PO Reply	Revised MTA	No PO filing
New evidence permitted with briefing other than sur-reply	New evidence permitted with briefing other than sur-reply	No new evidence permitted with reply or sur-reply
Oral hearing at ~ 9 months	Oral hearing at ~ 10 months	Oral hearing at ~ 9 months
(13 weeks from oral hearing to FWD deadline)	(9 weeks from oral hearing to FWD deadline)	(13 weeks from oral hearing to FWD deadline)

# 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

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# Thank You



