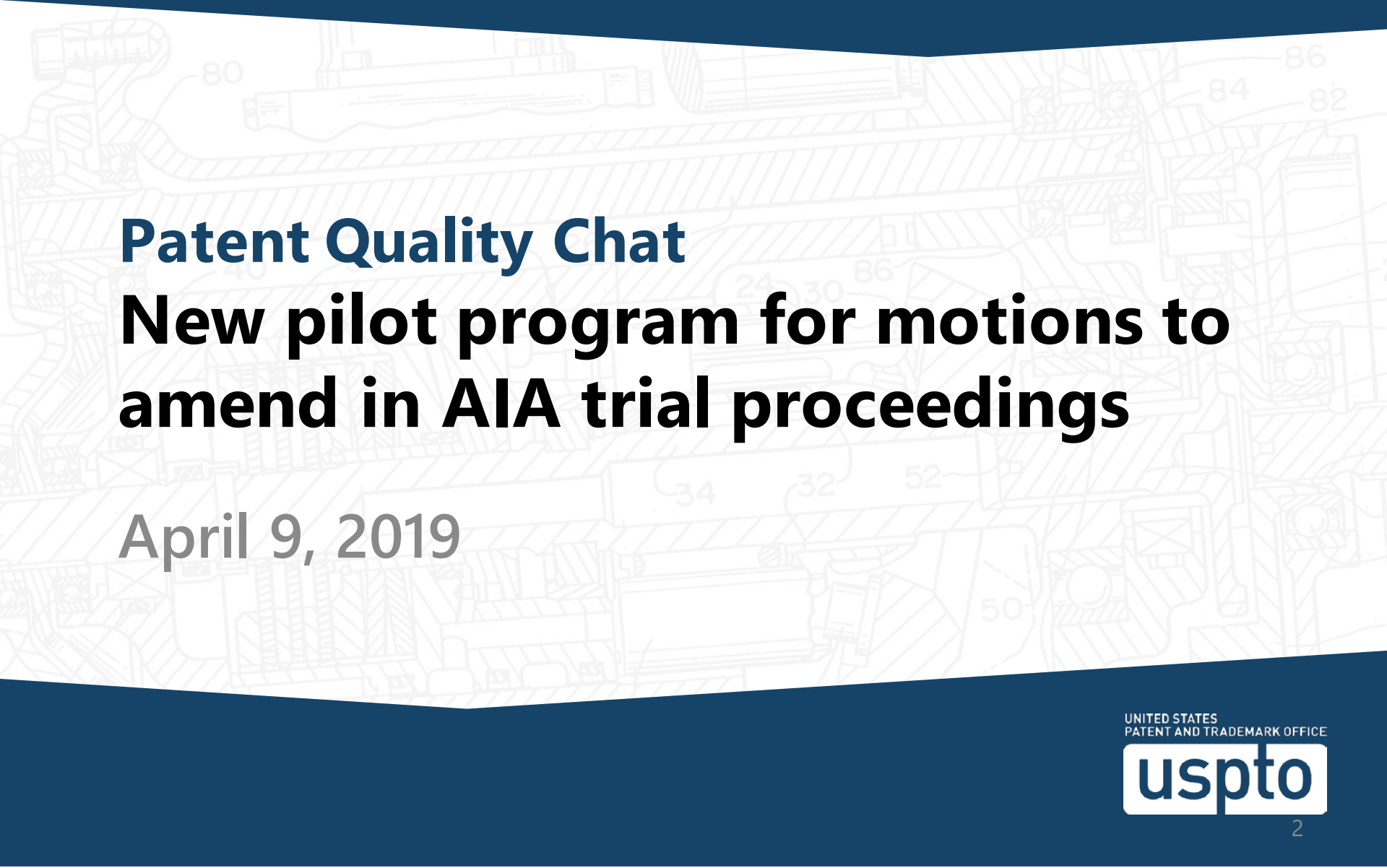


UNITED STATES  
PATENT AND TRADEMARK OFFICE





**Patent Quality Chat**  
**New pilot program for motions to  
amend in AIA trial proceedings**

April 9, 2019

UNITED STATES  
PATENT AND TRADEMARK OFFICE



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

**[PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)**

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### Highlights



#### [Patent Quality Chat](#)

Our next Patent Quality Chat will be on April 9th discussing "New Pilot Program for Motions to Amend in AIA Trial Proceedings".

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# <http://www.uspto.gov/patent/initiatives/patent-quality-chat>

- 1 Patent Quality Chat
- 2 Join the Webinar
- 3 2019 Chat Series**
- 4 Previous Events
- 5 General Information

## 2019 Chat Series

Date	Topic	Speaker
Thursday April 9 12 p.m. - 1 p.m. ET	New Pilot Program for Motions to Amend in AIA Trial Proceedings <ul style="list-style-type: none"><li>• Presentation slides (coming soon)</li><li>• Video (coming soon)</li></ul>	<b>Jackie Bonilla</b> Deputy Chief Judge Patent Trial and Appeal Board  <b>Jessica Kaiser</b> Lead Judge Patent Trial and Appeal Board
Thursday January 10 2 p.m. - 3 p.m. ET	Revised Subject Matter Eligibility Guidance <ul style="list-style-type: none"><li>• <a href="#">Slides</a></li><li>• <a href="#">Video</a></li></ul>	<b>Robert Bahr</b> Deputy Commissioner for Patent Examination Policy  <b>Matthew Sked</b> Senior Legal Advisor, Office of Patent Legal Administration

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)

# Patent Quality Chat

## New pilot program for motions to amend in AIA trial proceedings

Jackie Bonilla  
Deputy Chief Judge, Patent Trial and Appeal Board

Jessica Kaiser  
Lead Judge, Patent Trial and Appeal Board

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)

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# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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**

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)





# 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>

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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).

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



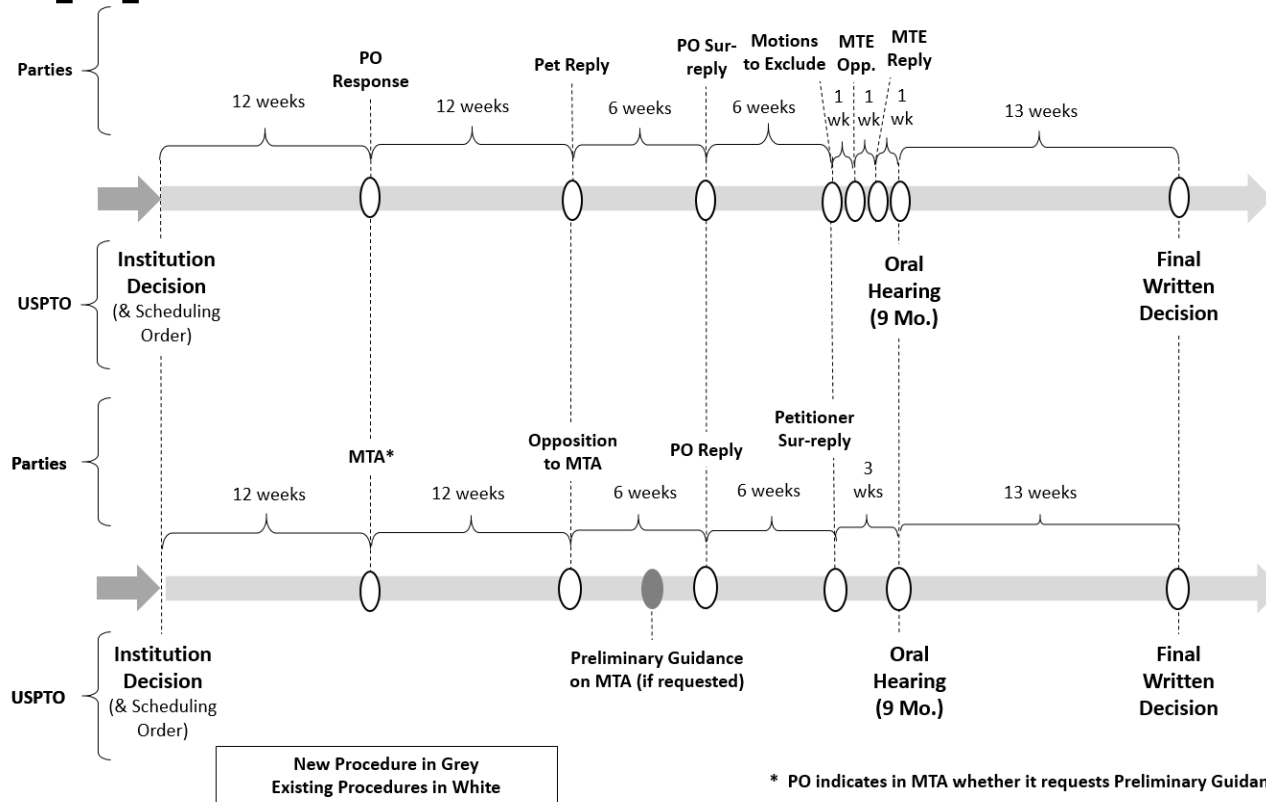
# Highlights of MTA pilot program

- 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

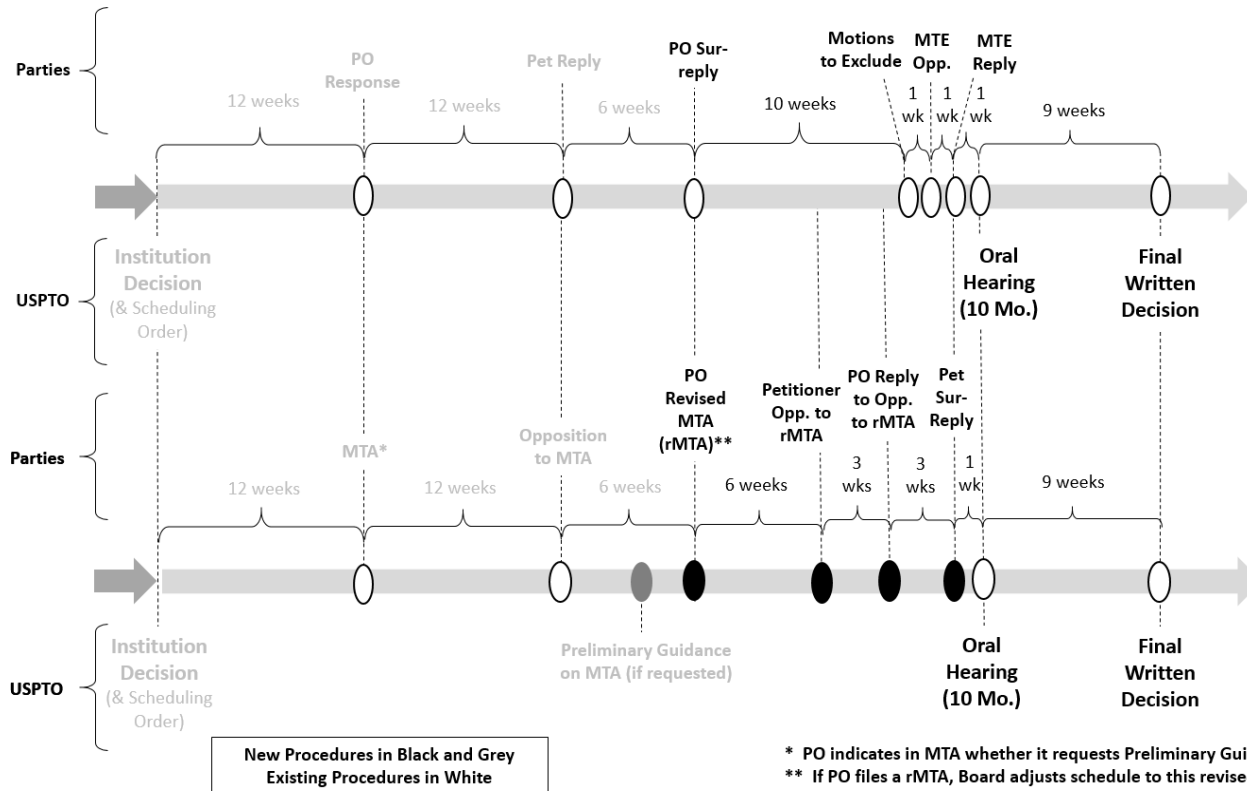
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# Schedule entered at institution (Appendix 1A)



# 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)

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# 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

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# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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)

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# 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.

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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)**

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

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# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# 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

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# 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)

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)

# 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# Pilot program implementation

- Effective date is publication date of 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

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# Let's Chat about New pilot program for motions to amend in AIA trial proceedings

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Deputy Chief Judge, Patent Trial and Appeal Board

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Lead Judge, Patent Trial and Appeal Board

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# Other patent quality-related events

<https://www.uspto.gov/about-us/events>

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**April 18**

**USPTO Chicago Regional Seminar**

*At Northwestern Pritzker School of Law in Chicago, IL*

**April 25**

**13<sup>th</sup> Annual Design Day**

*At Headquarters and in Dallas, Denver, and San Jose Regional Offices*

**April 30**

**TC 3600 and TC 3700 Customer Partnership Meeting**

*At Headquarters in Alexandria*

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# Thank you for joining us today!

Patent Quality Chat  
Webinar Series 2019  
April 9, 2019

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