



THINK FORWARD

USPTO Seeking Potential Reforms to PTAB Proceedings

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On April 7, the U.S. Patent and Trademark Office (“USPTO”) announced its [PTAB Procedural Reform Initiative](#). Patent Trial and Appeal Board (“PTAB”) proceedings created under the America Invents Act (“AIA”) have been in existence for almost five years, and the proceedings have been constantly developing as decisions issued from the PTAB, the Federal Circuit, and even the Supreme Court. Now the PTAB intends “to use nearly five years of historical data and user experiences to further shape and improve” its proceedings, particularly inter partes review (“IPR”), post-grant review (“PGR”), and covered business method review (“CBMR”) proceedings (collectively, AIA proceedings). The USPTO has shown in the [past](#) that it is willing to listen to the concerns of petitioners and patent owners alike and implement changes to its proceedings.

The stated purpose of the new initiative is to ensure that the proceedings are “as effective and fair as possible.” While the USPTO is open to looking at all aspects of PTAB proceedings, the USPTO specifically identified the following: “procedures relating to multiple petitions, motions to amend, claim construction, and decisions to institute.”

This initiative will likely be utilized by both petitioners and patent owners. Because IPR rules restrict a petitioner’s ability to modify its arguments during the proceedings, petitioners will likely seek the continued allowance of multiple petitions. This gives a petitioner the option of filing a second, subsequent petition to add or modify its arguments as an AIA proceeding moves forward. By contrast, patent owners will likely seek to limit the number of bites at the apple that a petitioner may have via new petitions. Patent owners also will likely seek additional changes to increase the availability of motions to amend.

One issue complicating any changes that may come from this initiative is the January 30, 2017 executive order requiring each agency to repeal two existing regulations for each new one it issues: [Executive Order 13771](#). The USPTO may issue new regulations if it eliminates current obsolete regulations, or the USPTO could implement the changes by not issuing them as regulations. For example, the USPTO could issue a new Trial Practice Guide for IPRs that contains the changes. The PTAB would likely follow those changes, even if they are not formally promulgated and codified in the Code of Federal Regulations.

Ideas regarding PTAB procedural reform may be sent to the USPTO at PTABProceduralReformInitiative@uspto.gov. The USPTO will share news about the initiative as it progresses.

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