



THINK FORWARD

USPTO Announces Rules Changes: "Quick-Fixes" to AIA Rules Effective Immediately; Previews Additional Potential Rule Changes

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On March 27, 2015, the U.S. Patent and Trademark Office (PTO) announced a three-part roll-out plan. The first rule package of "quick fixes" will be released in full later this spring, but part of the first package is effective immediately: [increased page limits for motions to amend and reply briefs by petitioners](#). The PTO will issue a second, proposed-rule package later this summer. Finally, the PTO will modify the Trial Practice Guide as the third part of the roll-out plan.

First Rule Package: Later this spring, the PTO plans to issue a first rule package of "quick fixes." As part of this package, the page limit for a motion to amend has been increased, "granting up to twenty-five pages for the motion along with the addition of a claims appendix (with a commensurate amount of additional pages for the opposition and reply briefing)." The page limit for a petitioner's reply brief has also been increased to twenty-five pages. "Notably, even before these two changes appear in the first rule package, judges will begin implementing them through scheduling orders effective immediately."

Second, Proposed-Rule Package: Later this summer, the PTO will issue a second proposed-rule package containing more involved changes to the Patent Trial and Appeal Board (PTAB) Trial Rules that govern the conduct of the AIA trial proceedings. According to the PTO,

[W]e are considering proposing a number of other revisions to rules including: further modifications to the motion to amend process; adjustments to the evidence that can be provided in the patent owner preliminary response; and clarification of the claim construction standard as applied to expired patents in AIA proceedings. We also are considering several other changes, including adjustments to the scope of additional discovery, how to handle multiple proceedings before the Office involving the same patent, use of live testimony at oral hearings, and whether the parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation.

Additionally, regarding motions to amend, we are contemplating proposed changes to emphasize that a motion for a substitutionary amendment will always be allowed to come before the Board for consideration (i.e., be "entered"), and for the amendment to result in the issuance ("patenting") of amended claims, a patent owner will not be required to make a prior art representation as to the patentability of the narrowed amended claims beyond the art of record before the Office. Of course, the duty of candor and good faith requires the patent owner to make of record any additional prior art material to patentability known by the patent owner. These contemplated changes would be intended to more noticeably limit the burden on the patent owner, even though the patent owner is the party moving for the change in the patent.

The second rule package will be in the form of a proposed rule, so interested parties will have an opportunity to provide feedback.

Amendments to Trial Practice Guide: The third part of the roll-out plan will involve modifications to the Trial Practice Guide that “advises the public on the general framework of the rules, including the structure and times for taking action in AIA trial proceedings.” The PTO plans to emphasize “the availability of live testimony upon the grant of any such motion for live testimony, except where not suitable” and “the importance of RPI discovery as to determinations of standing and as to possible later estoppel consequences.” Lastly, according to the PTO,

[W]e are considering developing a single-judge pilot program for institution. Under this pilot, a single judge would make the decision on whether to institute a trial. Two new judges would be added to the panel only when and if a trial is instituted. In the interest of efficiency, the first judge would remain on the panel; but in the interest of having “fresh eyes,” the two additional judges would not have participated in the matter prior to institution. After running this pilot for a select number of cases, we would study the results to determine the approach to follow in the future.

The immediate rule changes raise several questions that will need to be addressed by the PTAB for pending proceedings: How will the page limit increases apply to already-instituted cases? If a motion to amend has been filed under the fifteen-page limit, will the opposition and reply briefs be subject to fifteen- or twenty-five-page limits? How will the page limit increase affect the grant rate for motions to amend, which has been relatively low?

If you have any questions or wish to discuss how this decision may impact your company, please contact a member of the [Post-Grant Patent Practice group](#).