

USPTO ANNOUNCES SECOND ROUND OF AIA RULE CHANGES

Date: 20 August 2015

IP Procurement and Portfolio Management Alert

By: Jason A. Engel, Philip A. Kunz, Benjamin E. Weed

SUMMARY

On August 20, 2015, the Patent and Trademark Office published, in the Federal Register, a set of "Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board" that would amend 37 CFR Part 42. Among the ten topics encompassed by the proposed amendments, two noteworthy changes include: (1) new evidence allowed in Patent Owner's preliminary response; and (2) briefing length limited by word count rather than page limits. Each topic is discussed in turn below, with our initial practical **TAKEAWAYS** for each respective section.

The period for public comment on the proposed amendments is open until October 19, 2015.

Practical ramifications of new proposed rule changes:

1. PATENT OWNER PRELIMINARY RESPONSES

TAKEAWAYS:

Patent Owners will start submitting declarations with preliminary responses, which means Petitioners will start to request leave to file preliminary replies and additional evidence. Budgets for work prior to institution will need to increase accordingly.

2. WORD COUNT DICTATING SUBMISSION LENGTHS

TAKEAWAYS:

Claim charts have become a more viable way to present arguments, although the loss of word count from repeating claim language may not make them worthwhile. In addition, the Office's comments make it clear that similar claims are likely appropriately treated with brevity to save words, focusing instead on combinations and the first application of art to claims. This change will also allow the parties to focus on making arguments that fit the new word count limit rather than arbitrarily having to pare back arguments because they spill over onto a new page. This should allow the parties to be more efficient in the preparation of briefs.

3. NEW RULE 11-TYPE CERTIFICATION

TAKEAWAYS:

For practitioners admitted to AIA proceedings *pro hac vice*, the Rule 11-type certification requirement presumably would impact subsequent requests for *pro hac vice* admission.

4. CLAIM CONSTRUCTION STANDARD

TAKEAWAYS:

Petitioners will need to determine, prior to the Petition, the expiration date of the patent. If expiration is imminent, Petitioners should perform a full *Phillips*-type claim construction analysis in the Petition. If the expiration date is in dispute, Petitioners should consider arguing under both a Broadest Reasonable Interpretation ("BRI") and a *Phillips*-type construction.

5. MOTIONS TO AMEND

TAKEAWAYS:

It is possible that the duty of candor may be usable to curtail amendments by submitting art to the Patent Owner even after institution, based on preliminary response arguments and evidence. Petitioners should consider sending communications to Patent Owners enclosing art that addresses arguments raised in the preliminary response.

6. ADDITIONAL DISCOVERY

TAKEAWAYS:

It is still of paramount importance that the requested discovery be narrow and very likely to result in relevant, important information, particularly when it pertains to confidential information about the Petitioner's (accused infringer's) success.

7. REAL PARTY IN INTEREST

TAKEAWAYS:

Real party in interest issues should be fleshed out prior to filing the Petition. As always, make sure to take as conservative an approach as possible with regard to the one-year limit to file.

8. MULTIPLE PROCEEDINGS

TAKEAWAYS:

Petitions filed about patents already the subject of AIA review should explain, in as much detail as possible, the circumstances that warrant instituting an additional review.

9. ORAL HEARING

TAKEAWAYS:

The Board will entertain requests for oral hearing that deviate from the norm in terms of technology requests or oral testimony. These requests should be made in the request for oral hearing. Also, the date for exchange of demonstratives has been moved back to seven (7) business days before oral hearing, giving the parties more time to resolve objections. Objectionable slides will thus likely be more difficult to present in oral hearings.

10. OTHER GENERAL TOPICS (OFFICE-STATED "CATCHALL")

TAKEAWAYS:

It appears likely that the Office will implement a single judge-institution pilot program. While preliminary responses remain optional, the Office is apparently encouraging parties to use them to flesh out issues as early as possible. The Office appears comfortable with the way it is currently managing its docket. Finally, practitioners should be aware that the Office intends to use the Office Patent Trial Practice Guide as a tool for implementing changes to AIA trials, and that any updates to the Office Patent Trial Practice Guide are forthcoming.

To read the full alert, [click here](#).

KEY CONTACTS



JASON A. ENGEL
PARTNER

CHICAGO
+1.312.807.4236
JASON.ENGEL@KLGATES.COM



PHILIP A. KUNZ
PARTNER

CHICAGO
+1.312.807.4294
PHILIP.KUNZ@KLGATES.COM

This publication/newsletter is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer. Any views expressed herein are those of the author(s) and not necessarily those of the law firm's clients.