

# USPTO Releases Major AIA Rule Changes to Take Effect Soon

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On March 31, 2016, the US Patent and Trademark Office (“USPTO”) filed a notice in the Federal Register<sup>1</sup> adopting the amendments to AIA Proceedings that it [proposed in August 2015](#) and subsequently opened for public comment.

These amendments introduce a number of changes affecting the proceedings before the Patent Trial and Appeal Board (“PTAB”), including *inter partes* review (“IPR”), post-grant review (“PGR”) and covered business methods (“CBM”). The major provisions of the amendments include confirmation that PTAB proceedings will continue to use the “broadest reasonable interpretation” standard for claim construction as well as allowing patent owners to submit testimonial evidence with their preliminary responses. These rule changes are final and will take effect on May 2, 2016. The major changes are summarized below.

## Major AIA rule changes

### Declarant Testimony in Patent Owner’s Preliminary Response

A patent owner may submit declarant testimony with its preliminary response. This change allows patent owners a chance to address the petitioner’s testimonial evidence—often, an expert declaration—before the PTAB decides whether trial should be instituted. With this change, the AIA strengthens patent owners’ preliminary responses in an effort to fix a perceived inequality in the parties’ pre-institution briefing.

Nonetheless, any genuine issue of material fact created by the patent owner’s testimonial evidence will be resolved in favor of the petitioner for purposes of deciding whether to institute proceedings. Because of this presumption, the petitioner does not have the right to cross-examine the patent owner’s declarant or to file a reply before institution.

### Rule 11-type Certification

Similar to the FRCP Rule 11, the PTAB’s new certification requirement acts as a deterrent against baseless and unfounded claims made by parties to AIA proceedings. This new Rule 11-type certification provides the PTAB with a vehicle for policing and reprimanding any misuse of PTAB proceedings, including meritless filings and lack of pre-filing investigation. The PTAB can impose sanctions for noncompliance and can also refer misconduct for further proceedings and/or investigation.

### District Court Claim Construction Standard Applies if Patent Expires During Proceeding

The PTAB will continue to apply the “broadest reasonable interpretation” (“BRI”) claim construction standard for AIA proceedings. This confirmation comes on the heels of a number of public comments asking that the PTAB use the narrower *Phillips* claim construction standard used in district court litigation. The only scenario where the PTAB applies the *Phillips* standard is when the challenged patent will expire prior to the issuance of

<sup>1</sup> Amended Rules are available at <https://www.federalregister.gov/articles/2016/04/01/2016-07381/rules-of-practice-for-trials-before-the-patent-trial-and-appeal-board>

a final decision. Despite its application of the broader BRI standard in AIA proceedings, the PTAB acknowledged that it has and will continue to consider prior district court constructions when making its own constructions. The PTAB acknowledged that this can result in both forums reaching the same constructions under different construction standards.<sup>2</sup>

The Supreme Court has granted *certiorari* in the *Cuozzo* case to decide whether the PTAB’s application of the BRI standard is allowed under the current statutory framework.<sup>3</sup> The Supreme Court will hold oral arguments in the *Cuozzo* case on April 25, 2016.

### Clarification of Patent Owner’s Motion to Amend

In response to numerous complaints that the patent amendment process is too narrow and convoluted, the PTAB clarified numerous facets regarding patent owners’ motions to amend. The PTAB confirmed that the patent owner does not have a new, additional duty to disclose imposed when seeking to amend its patent. Also, the PTAB confirmed that it will not wholly deny motions to amend based on minor defects such as failure to provide a construction for the new, proposed claims; instead, patent owners will be allowed to cure these defects before the PTAB decides the motions.

### Major Briefing Subject to Word Limit, Not Page Limit

The PTAB transitioned from page limits to word limits for the major briefs filed in AIA proceedings. Major briefs consist of the petition, preliminary response, patent owner response and petitioner reply. Parties can seek leave from the PTAB to extend these word limits if necessary. For all non-major briefs and motions, page limits remain in place. The new limits are summarized below.

Type of brief	Allowed length
Petition	IPR – 14,000 words PGR – 18,700 words CBM – 18,700 words
Preliminary Response	Same length as corresponding petition
Patent Owner Response	Same length as corresponding petition
Petitioner Reply to PO Response	5,600 words
Motion to Amend	25 pages
All Other Motions	15 pages
All Opp. to Motions	Same length as corresponding motion
Replies to Opp. to Motions to Amend	12 pages
All Other Replies to Opp.	5 pages

<sup>2</sup> See, e.g., *Google, Inc. v. Simpleair, Inc.*, CBM2014-00054, slip op. at 7 (PTAB May 13, 2014) (Paper 19); *Kyocera Corp. v. Softview, LLC*, IPR2013-0004, IPR2013-00257, slip op. at 5 (PTAB March 21, 2014) (Paper 53).

<sup>3</sup> See *Cuozzo Speed Technologies v. Lee*, Case No. 15-446 (Jan. 15, 2016).

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