

Insights: Alerts

Final Rule Amendments for PTAB Practice

May 22, 2015

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On May 19, 2015, the U.S. Patent and Trademark Office published amendments to the Rules of Practice before the Patent Trial and Appeal Board ("PTAB").

<https://www.federalregister.gov/articles/2015/05/19/2015-12117/amendments-to-the-rules-of-practice-for-trials-before-the-patent-trial-and-appeal-board>

The highlights are:

Format of papers

- Motion to Amend page limit is increased from 15 to 25 pages, claim listing as appendix. Oppositions to motions to amend page limit is increased from 15 pages to 25 pages. Replies to oppositions to motions to amend page limit is increased from 5 pages to 12 pages.
- 14-point, Times New Roman proportional font, with normal spacing (between letters) is now required (still double spacing).

Discovery & Procedure

- "Routine discovery," not requiring permission, includes only expert affidavit cross-examination.
- Uncompelled direct testimony must be submitted in the form of an affidavit.
- Testimony can be filed as an exhibit.
- More than one back-up counsel may be designated.
- Evidence objections must be filed, not just served.
- Excess claim fees required for unchallenged claims from which a challenged claim depends.
- A statement of material fact by a party is optional.
- A party may file only a single rehearing request as a matter of right.

CBMs (Covered Business Methods)

- No CBM institution is allowed when the petitioner previously filed a civil action challenging the validity of a claim. This codifies the PTAB decision in *SecureBuy, LLC v. CardinalCommerce Corp.*, CBM2014–00035 (Paper 12).
- CBM proceedings can be extended beyond the statutory one-year timeframe in the case of joinder.

Related People



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