Insights: Alerts

USPTO Proposes Amendments to PTAB Rules

AUGUST 24, 2015 Written by Allison W. Dobson, Ph.D.

Proposed changes to rules for proceedings conducted by the Patent Trial and Appeal Board (PTAB) were published August 20, 2015 in the Federal Register[1]. The Proposed Rule may be found here.

Perhaps the most significant proposed change is the allowance of "new testimonial evidence" to accompany a Patent Owner Preliminary Response. PTAB has previously defined "new" testimony evidence as testimony evidence that was taken specifically for the purposes of the proceeding at issue, but PTAB also typically considers whether the evidence is dated before or after the petition was filed.[2,3]

Another proposed amendment provides that if the patent owner submits supporting evidence with its preliminary response, the petitioner may seek leave to file a reply to the preliminary response. For purposes of deciding whether to institute review, supporting evidence concerning disputed material will be viewed in the light most favorable to the petitioner.

For specific documents, word count limits are proposed to replace page limits. For example, the proposed word limits for a Petition requesting IPR, a Patent Owner Preliminary Response to a petition, and a Patent Owner Response to a petition are each 14,000 words. The rationale is to prevent "improper" use of claim charts to present additional arguments while circumventing page limits. The new rules would allow arguments in claim charts and thereby obviate preliminary review of claim charts for argument content, such that fewer petitions would be found noncompliant.

A new certification requirement, similar to Rule 11 for Federal district court litigation related to the duty of candor, is also proposed. This amendment would revise 37 CFR §42.11 to include a requirement for representations to the Board, and would provide for sanctions for violating this requirement.

The U.S. Patent and Trademark Office invites comment on the proposed revisions.

[1] 80 Fed. Reg. 50720 (Aug. 20, 2015).

[2] *Anova Food LLC v. Leo Sandau et al*, IPR2013-00114, Paper 11 (June 25, 2013).

[3] *Amneal Pharma., LLC v. Endo Pharma., Inc.*, IPR2014-01365, Paper 11 (Nov. 14, 2014).

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