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5 KEY TAKEAWAYS

A New Day at the PTAB? Using the New Pilot Program for Motions to Amend and the Clarification on Reissue and Reexam

On February 6, Kilpatrick Townsend's **Justin Krieger** spoke on the **IPO Chat Channel** on the USPTO's new Motion to Amend (MTA) Pilot Program and on prosecution-related options for amending claims outside of IPR proceedings.

Here are some key takeaways:

1 MTAs are trending upward: In view of the burden shift created by the Federal Circuit's *Aqua Products* decision, the MTA grant rate is now hovering a little above 20%--up from the 8% grant rate before *Aqua Products*. Look for Patent Owners to increasingly fight for MTAs, especially when there is a co-pending litigation.

MTA Pilot Program Guidance: The PTAB recently issued its first guidance under the MTA Pilot Program. The guidance appears to provide more insight than anticipated. In one recent proceeding, for example, the PTAB issued 8 pages of detailed guidance addressing the statutory requirements, new matter, indefiniteness and patentability. *Ely Holdings Ltd. v. O'Keeffe's Inc.*, IPR2019-00025, Paper 34 (PTAB Jan. 28, 2020). This information should be very helpful for patent owners in revising their MTA strategy to maximize likelihood of success. **2**

3 Don't forget about pending continuations! As a petitioner, beware of filing an IPR when the patent owner still has continuations pending before the Office. Unless there is a co-pending litigation, there may be limited upside to filing an IPR since the patent owner may simply drop the challenged claims and pursue slightly narrower claims ex parte through continuation practice.

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Reissue may be a great option. The USPTO issued a notice in April 2019 clarifying how reissue and reexamination will be treated when there is a co-pending IPR/PGR proceeding. Notably, the patent owner is free to file for reissue at any time before, during or even after a PTAB trail has concluded, so long as the reissue application is filed before trial certificate issues or the Federal Circuit issues a mandate. This means a patent owner may hedge its bets and fight for the challenged claims in the IPR/PGR, but if all of the challenged claims are invalidated in a final written decision (FWD), the patent owner can pivot and file for reissue to pursue more narrow claims. Benefits to this process are that it is ex parte and the odds of success are much greater (>60% vs. ~23% for MTA).

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Beware Reexamination. To file for reexamination, the patent owner must present a substantial new question of patentability. Once the PTAB has issued a FWD, however, the prior art has already been considered by the Office. As a result, a reexamination request is unlikely to be accepted by the Office unless it is filed *before* the FWD issues. Additionally, although examination may be extended for reissue applications via RCE and continuation practice, the same does not hold true for reexamination, in which the patent owner has one shot to get the amended claims through the Office.

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