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Quick Fixes Implemented, New Rules on the Way, for PTAB Trial Practice

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On Friday, March 27, the U.S. Patent and Trademark Office (USPTO) announced two upcoming rule packages aimed at improving Patent Trial and Appeal Board (PTAB) trial practice, the first to be issued this spring and the second this summer. As part of this initiative, the USPTO also announced that judges would immediately begin to increase the pages limits for motions to amend and petitioners' reply briefs to be up to 25 pages (excluding a claims appendix for motions to amend) in an informal change to be implemented through judges' scheduling orders. Current practice limits both types of papers to be up to 15 pages in length (including a claims appendix for motions to amend).

The first rule package will be directed to what the USPTO refers to as "changes of simple scope that will immediately improve the trial proceedings." The package will, among other likely changes, formalize the increased page limits for motions to amend and petitioners' reply briefs. The USPTO explained that it agreed with comments that "fifteen pages for a motion to amend that includes a claim listing is not sufficient to explain adequately why the amended claims are patentable," and comments that "fifteen pages for a petitioner's reply brief is not a commensurate number of pages to respond to a patent owner's response."

The second rule package will contain "more involved changes." Changes being contemplated by the USPTO include:

- "Further modifications to the motion to amend process," including "changes to emphasize that a motion for a substitutionary amendment will always be allowed to come before the Board for consideration (i.e., be 'entered'), and for the amendment to result in the issuance ('patenting') of amended claims, a patent owner will not be required to make a prior art representation as to the patentability of the narrowed amended claims beyond the art of record before the Office."
- "Adjustments to the evidence that can be provided in the patent owner preliminary response."
- "Clarification of the claim construction standard as applied to expired patents in AIA proceedings."
- "Adjustments to the scope of additional discovery."
- "How to handle multiple proceedings before the Office involving the same patent."

- "Use of live testimony at oral hearings."
- "Whether the parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation."

To address the "concern that the [three] judges participating in a decision to institute a trial may not be completely objective in the trial phase," the USPTO noted that it is also considering a pilot program in which institution decisions would be made by a single judge. Two judges would then be added to the panel after institution, with the original judge remaining. Based on the results of the pilot program, to be implemented for only a limited number of cases, the USPTO will determine which approach to follow in the future.

Finally, the USPTO also noted likely changes coming to its Trial Practice Guide. Planned changes include a new emphasis on "the availability of live testimony" at hearings and "the importance of RPI discovery as to determinations of standing and as to possible later estoppel consequences."

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