

# PTO Requests Comments on Revisions to AIA Trial Proceedings

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On April 21, 2023, the US Patent & Trademark Office (PTO) announced that it is seeking public input on proposed modifications to the rules of practice for *inter partes* reviews (IPRs) and post grant reviews (PGRs) before the Patent Trial & Appeal Board to better align the practices with the PTO's mission to promote and protect innovation and investment in the same and to provide a less expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment.

The PTO is considering promulgating rules that the Director—and, by delegation, the Board—will use to do the following:

- Exercise the Director's discretion to institute IPRs and PGRs
- Provide a procedure for separate briefing on discretionary denial that will allow parties to address relevant issues for discretionary denial without encroaching on the page limit to address the merits of a case
- Give petitioners the ability to pay additional fees for a higher word-count limit
- Clarify that all settlement agreements, including pre-institution settlement agreements, are required to be filed with the Board.

To create clear, predictable rules where possible, as opposed to balancing tests that decrease certainty, the PTO is considering changes that would provide for discretionary denials of petitions in the following categories, subject to certain conditions and circumstances as discussed further in the [Official Notice](#):

- Petitions filed by certain for-profit entities
- Petitions challenging under-resourced patent owner patents where the patentee has brought or is attempting to bring products to market

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- Petitions challenging patent claims previously subject to a final adjudication upholding the patent claims against patentability challenges in district court or in post-grant proceedings before the PTO
  - Serial petitions
  - Petitions raising previously addressed prior art or arguments
  - Parallel petitions
  - Petitions challenging patents subject to ongoing parallel litigation in district court.

The PTO also seeks comments on proposed threshold definitions that apply to one or more of these categories of petitions subject to discretionary denials. Those definitions set forth the criteria used to determine the following:

- What constitutes a “substantial relationship” between entities sufficient to trigger or avoid discretionary denial
- When claim sets are deemed to have “substantial overlap” with challenged claims
- What constitutes “compelling merits” sufficient to trigger an exception to discretionary denial.

For example, one proposal with respect to the “substantial relationship” is a requirement that a patent owner and petitioner disclose anyone with an ownership interest in the patent owner or petitioner, any government funding related to the patent, any third-party litigation funding support, and any stake any party has in the outcome of the America Invents Act (AIA) proceeding or any parallel proceedings on the challenged claims.

Additional changes being considered by the PTO include the following:

- Absent exceptional circumstances, requiring petitioners to file a stipulation that neither they nor their privy or real parties in interest have filed prior post-grant proceedings (PGRs, IPRs, covered business methods or *ex parte* reexaminations) on the challenged claims
- If petitioners’ post-grant proceeding is instituted, requiring that neither they nor their privy or real parties in interest will challenge any of the challenged claims in a subsequent post-grant proceeding
- Requiring petitioners to file a separate paper justifying multiple parallel petitions.

The PTO will hold an [information session](#) with Under Secretary of Commerce for Intellectual Property and PTO Director Kathi Vidal to discuss the proposed rule changes on May 9, 2023, from noon to 1:00 pm EDT.

For more details about the proposed rule modifications regarding which the PTO seeks comments, see the notice [here](#). Comments on the proposed rule changes must be received by June 20, 2023, to

ensure consideration. Comments must be submitted through the [Federal eRulemaking Portal](#). To submit comments via the portal, enter docket number PTO-P-2020-0022 on the homepage and click “search.”

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