

USPTO Makes Changes to American Invents Act Post Grant Proceedings

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The ***U.S. Patent and Trademark Office*** will be making a series of rule changes to ***America Invents Act*** reviews. Some will be effective immediately, others will be implemented in phases. The rule changes are a direct response to the public comments the USPTO received last year about how to improve the AIA review process. Most practitioners will welcome the changes, which Director Michelle Lee described in a blog post on the agency's website on March 27, 2015.

Specific topics for change, according to Director Lee, include:

1. Further modification to the motion to amend process;
2. Adjustments to the evidence that can be provided in a patent owner preliminary response;
3. Clarification of the claim construction standard as applied to expired patents;
4. Adjustments to the scope of additional discovery;
5. How to handle multiple proceedings involving the same patent;
6. Providing guidelines for the use of live testimony at oral hearings; and
7. Whether the parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation.

We discuss a few of these proposed changes below.

Quick fixes

The Office will soon issue a "quick fix" rule package. The most notable changes, which the Judges will implement immediately, are to the page limits for motions to amend and for petitioner's reply briefs. The USPTO agreed with public comments that 15 pages were not sufficient for either paper.

The new page limit for both papers is 25 pages.

Patent owners will welcome the change. The immediate modification to the page limits for motions to amend is more in line with reality, given the high burdens placed on patent owners. Even when patent owners sought additional pages, the norm was a three to five page extension. So, getting ten extra pages is a welcome change. Changing the page limits alone is unlikely to impact the calculus underlying the strategic choice to amend. But, when the choice is made to amend, patent owners will be better able to meet their burden.

Petitioners will also welcome the change. Patent owner responses may be 60 pages, and they often include multiple declarations and much evidence. The previous 15 page limit for replies unduly restricted a petitioner's ability to respond to patent owner arguments and evidence. Again, 25 pages is more in line with reality.

Second rule package

A second phase of proposed rule changes will be more substantive. Perhaps most significant are the proposed changes to the motion to amend process. One change under consideration is the current high burden imposed on patent owners. Specifically, patent owners "will not be required to make a prior art representation as to the patentability of the narrowed claims beyond the art of record before the Office." Unlike the page limit changes, this change will positively impact a patent owner's strategic decision to amend. The affirmative burden to show patentability over the entire state of the art at the time of invention was perhaps the biggest hurdle patent owners faced in moving to amend claims. With this burden lessened, more motions to amend are likely.

For the remaining proposed changes, we will need to see the specific changes. But generally, each of the listed changes is the result of direct feedback from the patent bar and will likely provide welcome clarification to the current rules.

Trial Practice Guide

Finally, Director Lee also foreshadowed coming changes to the Trial Practice Guide. Three changes are particularly noteworthy.

1. *Single-Judge Institution Pilot Program*: One proposal is a pilot program to have a single judge make the decision on whether to institute a trial. This judge would remain on the panel, but two new judges would be added only when and if a trial is instituted. This would provide "fresh eyes" on the subsequent trial. From the patent owner's perspective, this is a positive development.

There is certainly a perceived unwillingness from three-judge panels to go against what they put in a trial institution decision, especially with respect to claim construction. The patent owner bar will appreciate what the pilot program is trying to accomplish – to relieve some of the bias that may persist from a panel's initial view of the case, on an incomplete record.

2. *Real Party In Interest Discovery*: Another proposal recognizes the importance of RPI discovery in the pre-trial phase of an AIA review. The Office wants to ensure that "the availability of appropriate RPI evidence does not pose a problem for patent owners." Again, this is a positive development for patent owners considering the Federal Circuit's ruling in *In re Cuozzo Speed Technologies, LLC* that institution decisions lie beyond the scope of appellate review.

3. *Live Testimony*: Another change under consideration is a provision for live testimony at oral

hearings. The ability to present live testimony may be a double-edged sword. It may benefit cases where the technology is complicated and the panel could benefit from hearing from the experts directly. But subjecting a legally untrained expert to the panel also comes with some risk.

In sum, it should be approached carefully. It will be interesting to see how the Board intends to actually work live testimony into the oral hearings.

Overall, the PTO litigation bar should welcome the proposed changes. It is good to see the Office's positive response to the public comments it received last year.

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