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Motions to Amend in AIA Trial Proceedings

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What is a Motion to Amend?

Under the America Invents Act (“AIA”), a patent owner may file a motion to amend (“MTA”) claims challenged in an instituted IPR or PGR

- IPR rules governed by 37 C.F.R. § 42.121
- PGR rules governed by 37 C.F.R. § 42.221

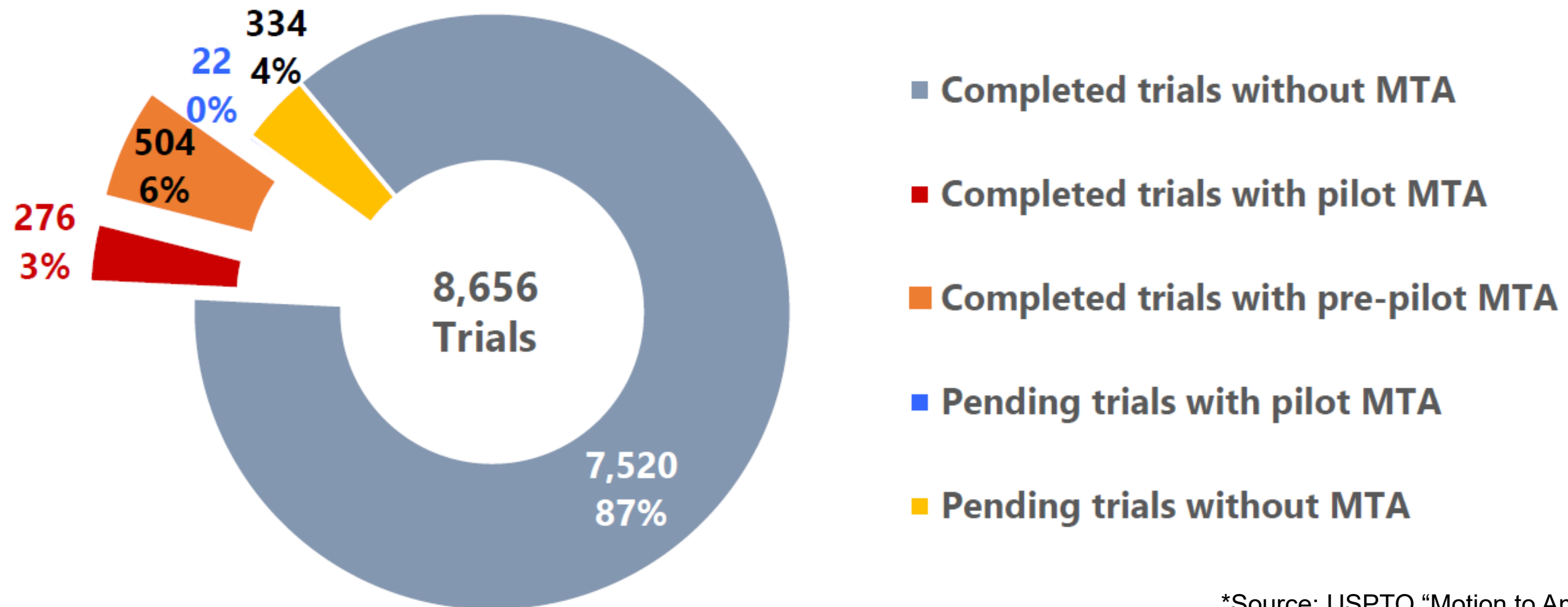
Since 2019, MTAs have been handled in accordance with procedures defined by the PTO’s MTA pilot program

- Much of the pilot program procedures were recently codified, with some changes, in a final rule that became effective on October 18, 2024

MTA Filings

Oct. 1, 2012 to Mar. 31, 2024*

In how many trials are MTAs filed?



*Source: USPTO "Motion to Amend Studies"

(d) AMENDMENT OF THE PATENT

(1) IN GENERAL—During an *inter partes* review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

(2) ADDITIONAL MOTIONS—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.

(3) SCOPE OF CLAIMS—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

Key Cases Fill in Legal Gaps

- **Does the petitioner or patent owner have the burden to prove patentability?**
 - *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)
 - Federal Circuit held that PTO may not place the burden of persuasion regarding the patentability of amended claims on the patent owner
- **Can the Board raise issues of unpatentability *sua sponte*?**
 - *Hunting Titan, Inc., v. DynaEnergetics Europe GmbH*, 28 F.4th 1371 (Fed. Cir. 2022)*
 - Federal Circuit held that Board may raise grounds of unpatentability against amended claims in an IPR or PGR proceeding even if those grounds were not raised by the petitioner
 - Under the new final rules, the Board is given discretion to raise new grounds of unpatentability not raised by the petitioner (e.g., if the petitioner does not oppose or presents deficient prior art grounds)

*Board's precedential *Hunting Titan* "is de-designated from precedential status"

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Motion to Amend - §42.121(a)/221(a)

- A patent owner may file one original motion to amend a patent, but only after conferring with the Board §(a)(1)(i)
 - MTA can be filed no later than the filing of a patent owner response, absent a Board due date §(a)(1)(i)
- Patent owner can request preliminary guidance from the Board if a request is included in the original motion to amend §(a)(1)(ii)
- Board can deny motion where:
 - (i) amendment does not respond to a ground of unpatentability §(a)(2)(i)
 - (ii) amendment enlarges the scope of the claims of the patent or introduces new matter §(a)(2)(ii)
- Rules allow a “reasonable number” of substitute claims §(a)(3)
 - rebuttable presumption that only one substitute claim will be needed to replace each challenged claim

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Content - §42.121(b)/221(b)

Any motion to amend claims must:

- Include a claim listing,
- Show the changes clearly, and
- Set forth:
 - the support in the original disclosure of the patent for each proposed substitute claim §(b)(1)
 - the support in an earlier-filed disclosure for each claim for which the benefit of the filing date of the earlier-filed disclosure is sought §(b)(2)

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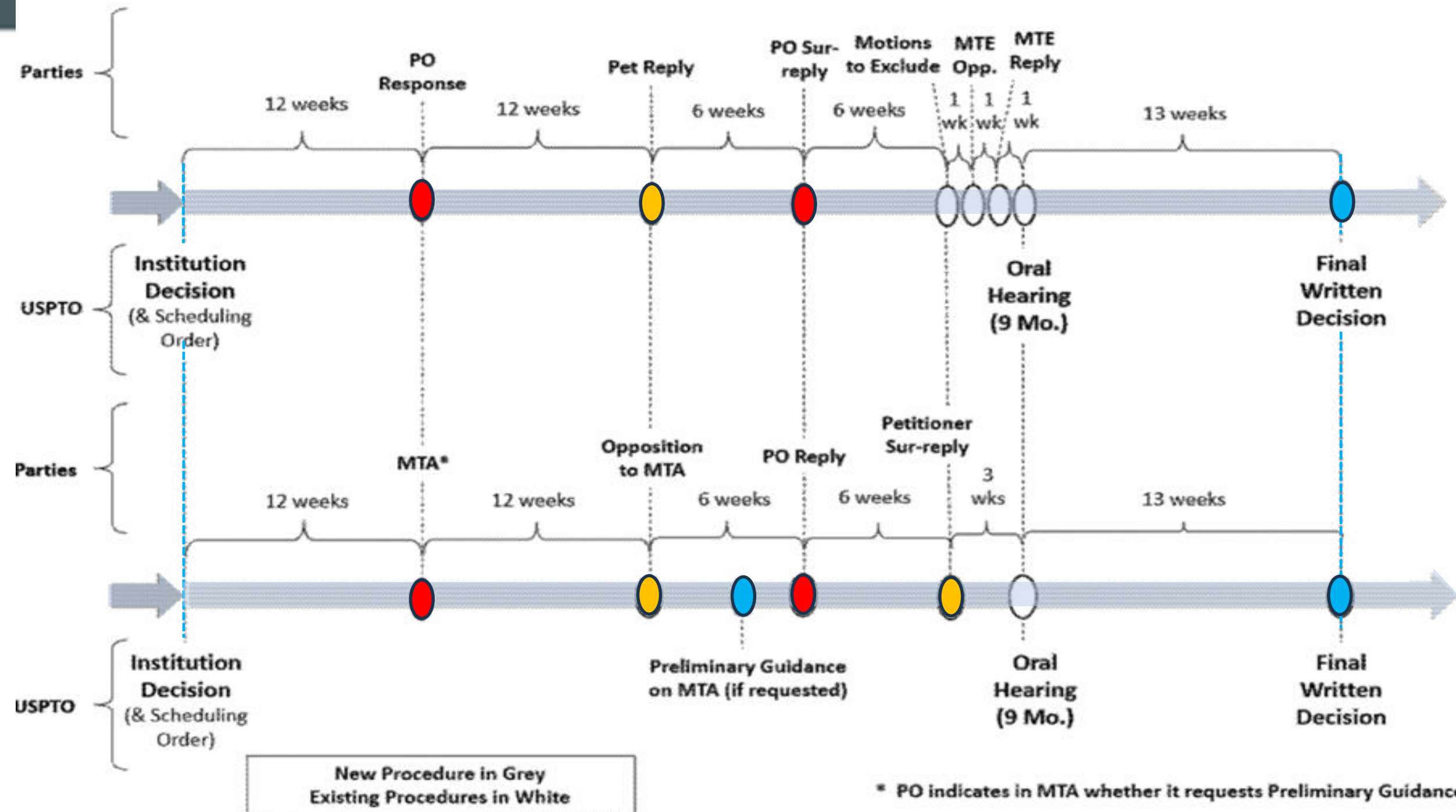
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Additional Motion to Amend - §42.121(c)/221(c)

- With limited exceptions (*e.g.*, § (f)), any additional motion to amend may not be filed without Board authorization
- Additional MTA may be authorized upon a showing of “good cause” or a joint request of the petitioner and the patent owner to advance a settlement
- Where authorizing an additional MTA, the Board “will consider” whether a petitioner has submitted supplemental information after the time period set for filing an MTA (see *e.g.*, § (a)(1)(i))

“Typical” MTA Timeline*

- -Patent Owner
- -Petitioner
- -Board



*Source: Fed. Reg. – “Notice Regarding a New Pilot Program Concerning Motion To Amend Practice”

Burdens of Persuasion

- PO must show that the motion to amend complies with requirements of 35 U.S.C. 316(d); § (d)(1)
- Petitioner must show that substitute claims are unpatentable § (d)(2)
- Board has discretion to grant or deny an MTA or raise a new ground of unpatentability
 - where the Board raises a new ground of unpatentability, parties have an opportunity to respond
- The Board may consider “all evidence of record” in the proceeding, including:
 - any evidence in a related proceeding before the PTO
 - evidence that a district court can judicially notice § (d)(3)(i)
 - information identified in response to a Board-initiated examination assistance
 - results of Board's request for examination assistance § (d)(3)(ii)
- Board must determine unpatentability based on a preponderance of the evidence of record § (d)(3)(4)

- PO may request preliminary guidance (PG) from the Board setting forth the Board's initial views on the MTA, and whether the parties have shown a reasonable likelihood of:
 - meeting their respective burdens of persuasion
 - notice of any new ground of unpatentability raised by the Board §(e)(1)
- The Board may request that the Chief Administrative Patent Judge (“APJ”) extend:
 - the final written decision deadline more than one year from the date of institution and
 - any remaining deadlines in appropriate cases to accommodate complexities and additional procedures implicated by MTA practice §(e)(1)
- PG of an original MTA is not binding on the Board’s subsequent decisions
 - PG is not a final agency action, and not eligible for rehearing or Director Review §(e)(2)

Upon receiving preliminary guidance (PG):

- PO may file a reply that responds to the petitioner's opposition to MTA, a reply to the Board's preliminary guidance, or file a revised MTA (rMTA)
- The PO's reply or rMTA can include new evidence
- Petitioner may file a sur-reply, limited to the preliminary guidance, or arguments in PO's reply
 - no new evidence in petitioner's sur-reply
 - sur-reply can comment on any new evidence filed with PO's reply, or point to cross-examination testimony of a reply witness (if relevant PO's reply arguments) §(e)(3)

Where PO files no reply or an rMTA after receiving Board's PG:

- Petitioner may file a reply to the preliminary guidance
 - reply may only respond to the preliminary guidance
 - no new evidence for Petitioner
 - PO may file a sur-reply to respond to petitioner's reply
 - no new evidence for PO §(e)(4)

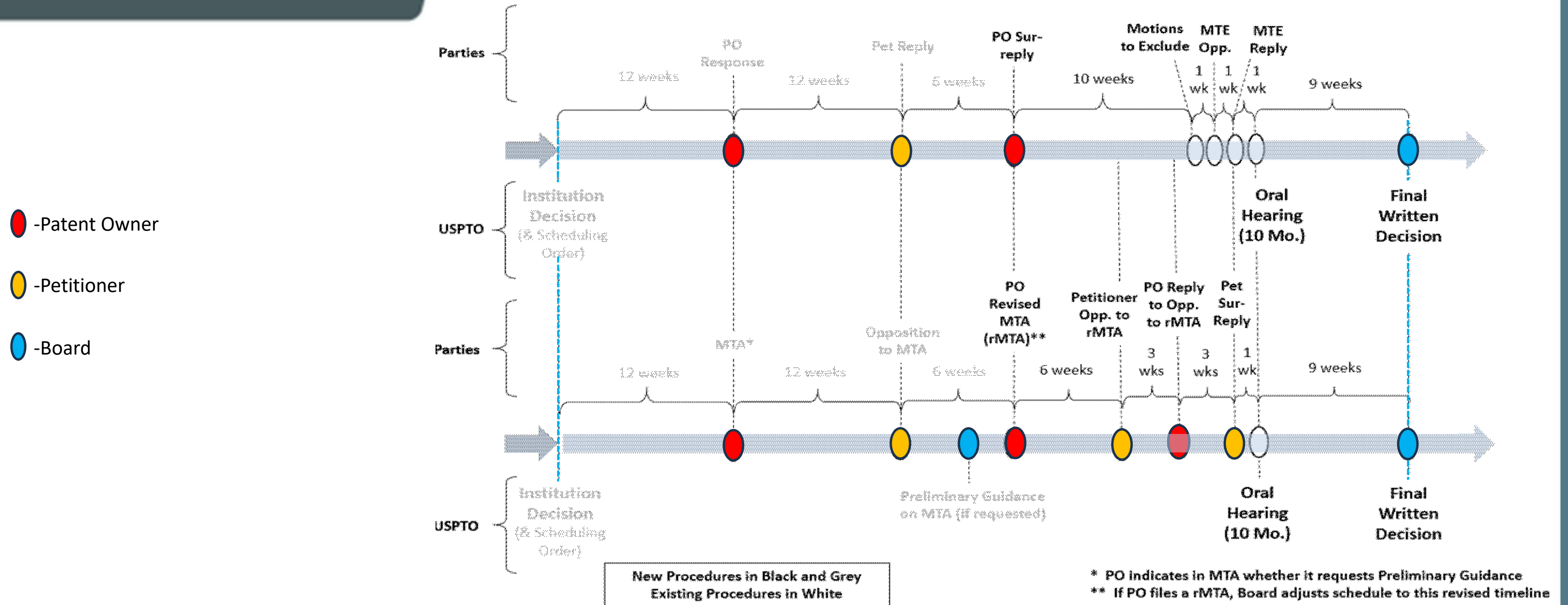
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Revised Motion to Amend §42.121(f)/221(f)

- PO may file one revised motion to amend (rMTA) after receiving:
 - an opposition to the original motion to amend
 - the Board's preliminary guidance
- The Board may request the Chief APJ to extend the final written decision deadline more than one year from the date a trial is instituted and whether to extend any remaining deadlines
- An rMTA must:
 - be responsive to issues raised in the preliminary guidance or in the petitioner's opposition to the MTA
 - include one or more new proposed substitute claims in place of the previously presented substitute claims §(f)(2)
- rMTA replaces the original MTA in the proceeding §(f)(3)

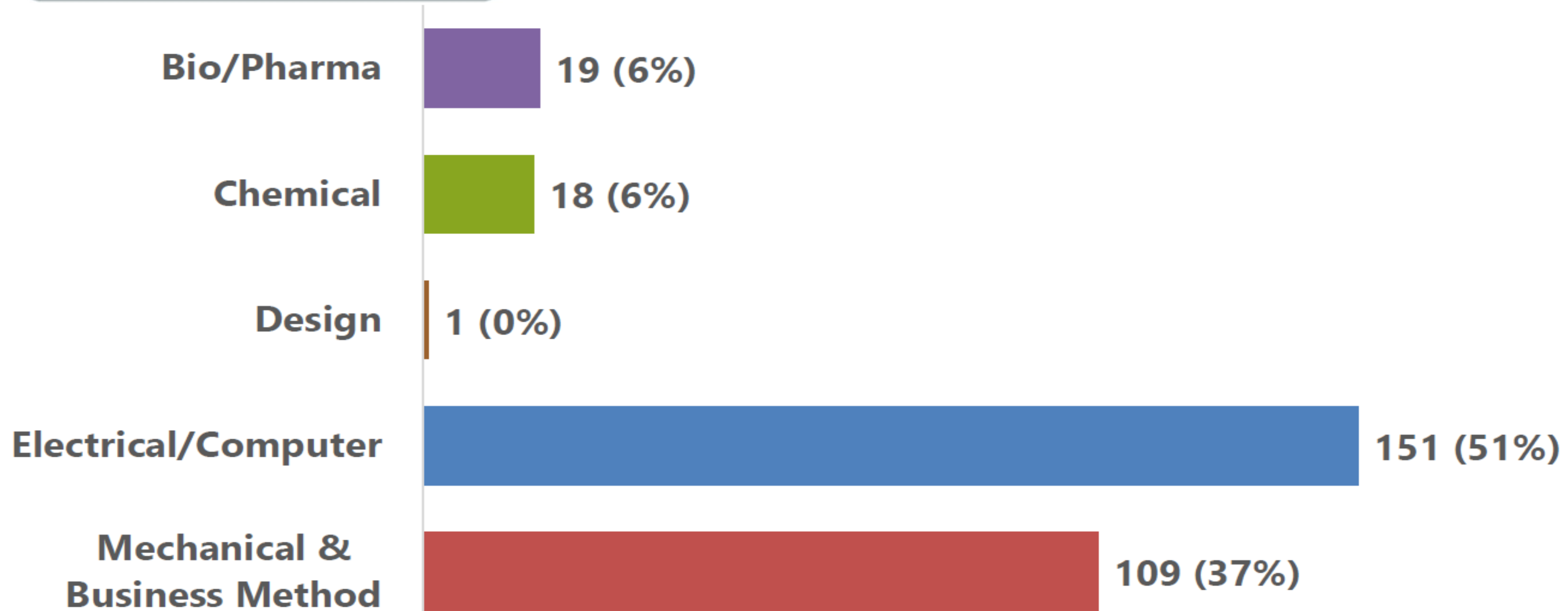
Timeline for Revised MTA*



*Source: Fed. Reg. – “Notice Regarding a New Pilot Program Concerning Motion To Amend Practice”

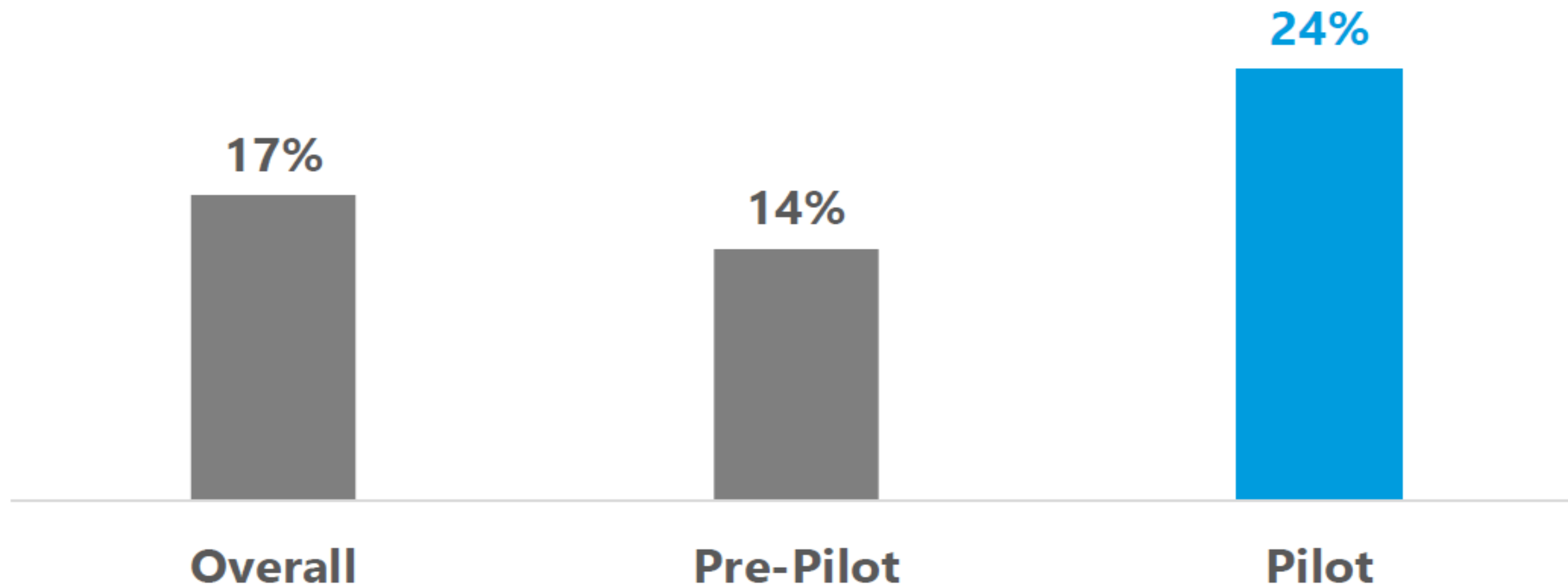
MTA Filings by Technology

Mar. 15, 2019 to Mar. 31, 2024*



*Source: USPTO "Motion to Amend Studies"

MTA Grant Rates*



- Pre-Pilot: Oct. 1, 2012 to Mar. 14, 2019
- MTA Pilot: Mar. 15, 2019 to Mar. 31, 2024

*Source: USPTO "Motion to Amend Studies"

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