
**PTAB Bar Association
Webinar Series**

**Notice of Proposed Rulemaking
Motions to Amend**

Wednesday, April 3, 2024



FEDERAL REGISTER

The Daily Journal of the United States Government



 Proposed Rule

Request for Comments Regarding the Motion To Amend Pilot Program and Rules of Practice To Allocate the Burdens of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board

A Proposed Rule by the [Patent and Trademark Office](#) on [05/23/2023](#)

Comment Deadline Date: To ensure consideration, commenters must submit written comments on or before July 24, 2023.

DISCLAIMER

The views expressed today are our individual views, and are not intended to represent views of our firms, our clients, or the PTAB Bar Association.

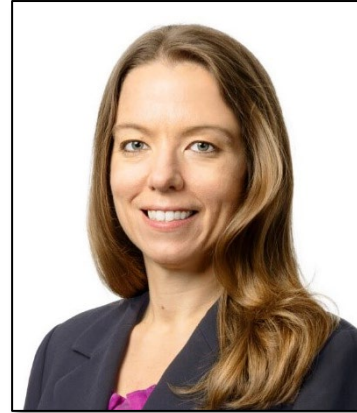
YOUR PRESENTERS



**Tamara
Fraizer,**
Panel Moderator
Squire Patton Boggs



**Jennifer
Bush**
Fenwick
& West



**Megan
Raymond**
Groombridge, Wu,
Baughman & Stone



**Stephanie
Schonewald**
Choate, Hall
& Stewart

OVERVIEW

Last summer, the PTAB Bar Association presented webinars examining the **Advanced Notice of Proposed Rulemaking (ANPRM)** and the USPTO's proposed sweeping rule changes for PTAB practice.

Today's webinar will address the recent **Notice of Proposed Rulemaking (NPRM) re Motion to Amend Practice**, including:

- ❖ Options for preliminary guidance and revised motions to amend
- ❖ Use of discretion by the Board
- ❖ Burdens for Petitioner, Patent Owner, Board
- ❖ Interplay with *ex parte* post-grant proceedings

Proposed Revisions to 37 CFR § 42.121 and 42.221

Stephanie Schonewald

Proposed New § 42.121

Original Motion to Amend

- One motion allowed by right, after conferring with Board; must be filed with or before Patent Owner response
- Must respond to unpatentability ground in the trial, and cannot enlarge claim scope or introduce new matter
- Can cancel a challenged claim or propose reasonable number of substitute claims (presumptively equal to number of challenged claims)
- Must identify support in original disclosure of the patent and any priority application

§ Amendment of the patent.

(a) *Motion to amend*—(1) *Original motion to amend*. A patent owner may file one original motion to amend a patent, but only after conferring with the Board.

(i) *Due date*. Unless a due date is provided in a Board order, an original motion to amend must be filed no later than the filing of a patent owner response.

(2) *Scope*. Any motion to amend may be denied where:

(i) The amendment does not respond to a ground of unpatentability involved in the trial; or

(ii) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

(3) *A reasonable number of substitute claims*. Any motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute claim will be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.

(b) *Content*. Any motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

(1) The support in the original disclosure of the patent for each proposed substitute claim; and

(2) 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.

Proposed New § 42.121

Request for Preliminary Guidance

- Is optional; must be requested in motion
- Board will provide non-binding views on likelihood that parties meet their burdens
- Board may extend FWD past statutory deadline
- Petitioner may oppose; Patent Owner may reply to Petitioner or Board; sur-reply possible

(ii) *Request for preliminary guidance.* If a patent owner wishes to receive preliminary guidance from the Board as discussed in paragraph (e) of this section, the original motion to amend must include the patent owner's request for that preliminary guidance.

(e) *Preliminary guidance.* (1) In its original motion to amend, a patent owner may request that the Board provide preliminary guidance setting forth the Board's initial, preliminary views on the original motion to amend, including whether the parties have shown a reasonable likelihood of meeting their respective burdens of persuasion as set forth under paragraphs (d)(1) and (2) of this section and notice of any new ground of unpatentability discretionarily raised by the Board under paragraph (d)(3) of this section. The Board may, upon issuing the preliminary guidance, determine whether to extend the final written decision more than one year from the date a trial is instituted in accordance with § 42.100(c) and whether to extend any remaining deadlines under § 42.5(c)(2).

(2) Any preliminary guidance provided by the Board on an original motion to amend will not be binding on the Board in any subsequent decision in the proceeding, is not a "decision" under § 42.71(d) that may be the subject of a request for rehearing and is not a final agency action.

(3) In response to the Board's preliminary guidance, a patent owner may file a reply to the petitioner's opposition to the motion to amend, the preliminary guidance (if no opposition is filed), or a revised motion to amend as discussed in paragraph (f) of this section. The reply or revised motion to amend may be accompanied by new evidence. If a patent owner does not file either a reply or a revised motion to amend after receiving preliminary guidance from the Board, the petitioner may file a reply to the preliminary guidance, but such a reply may only respond to the preliminary guidance and may not be accompanied by new evidence. If the petitioner files a reply in this context, a patent owner may file a sur-reply, but that sur-reply may only respond to the petitioner's reply and may not be accompanied by new evidence.

Proposed New § 42.121

Revised Motion to Amend

- Is optional
- Requires Board authorization or joint request of Petitioner and Patent Owner, **except...**
- Can be filed without authorization after receiving opposition or preliminary guidance
- Replaces original motion
- Board may extend FWD past statutory deadline

(c) *Additional motion to amend.*
Except as provided in paragraph (f) of this section, any additional motion to amend may not be filed without Board authorization. An additional motion to amend may be authorized when there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement. In determining whether to authorize such an additional motion to amend, the Board will consider whether a petitioner has submitted supplemental information after the time period set for filing a motion to amend in paragraph (a)(1)(i) of this section.

(f) *Revised motion to amend.* (1) Irrespective of paragraph (c) of this section, a patent owner may, without prior authorization from the Board, file one revised motion to amend after receiving an opposition to the original motion to amend or after receiving the Board's preliminary guidance. The Board may, upon receiving the revised motion to amend, determine whether to extend the final written decision more than one year from the date a trial is instituted in accordance with § 42.100(c) and whether to extend any remaining deadlines under § 42.5(c)(2).
(2) A revised motion to amend must be responsive to issues raised in the preliminary guidance or in the petitioner's opposition to the motion to amend and must include one or more new proposed substitute claims in place of the previously presented substitute claims, where each new proposed substitute claim presents a new claim amendment.
(3) If a patent owner files a revised motion to amend, that revised motion to amend replaces the original motion to amend in the proceeding.

Proposed New § 42.121

(d) *Burden of persuasion.* On any motion to amend:

(1) *Patent owner's burden.* A patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2) and (3) and (b)(1) and (2) of this section:

(2) *Petitioner's burden.* A petitioner bears the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable: and

(4) *Determination of unpatentability.* Where the Board exercises its discretion under paragraph (d)(3) of this section, the Board must determine unpatentability based on a preponderance of the evidence of record or made of record.

Burdens

- **Patent Owner:** burden to show compliance with rules by preponderance of the evidence
- **Petitioner:** burden to show unpatentability by a preponderance of the evidence
- **Board:** If exercising discretion to grant/deny a motion or raise a new ground of patentability, must determine unpatentability “based on a preponderance of the evidence of record or made of record”

Proposed New § 42.121

(3) Exercise of Board discretion.

Irrespective of paragraphs (d)(1) and (2) of this section, the Board may exercise its discretion to grant or deny a motion to amend or raise a new ground of unpatentability in connection with a proposed substitute claim. Where the Board exercises its discretion to raise a new ground of unpatentability in connection with a proposed substitute claim, the parties will have notice and an opportunity to respond. In the exercise of this discretion under this paragraph (d)(3) the Board may consider all evidence of record in the proceeding.

The Board also may consider and make of record:

(i) Any evidence in a related proceeding before the Office and evidence that a district court can judicially notice; and

(ii) When no petitioner opposes or all petitioners cease to oppose a motion to amend, prior art identified through a prior art search conducted by the Office at the Board's request. The request for and the results of a prior art search conducted by the Office at the Board's request will be made of record.

Discretion of the Board

- May raise a new ground of unpatentability, so long as parties are given opportunity to respond
- May rely on evidence in any related proceeding before the Patent Office
- May rely on evidence that a district court can judicially notice
- If no opposition by petitioner, can rely on prior art search by the Patent Office at the Board's request

Historical Context: The Original, Existing and Proposed New Programs

Megan Raymond

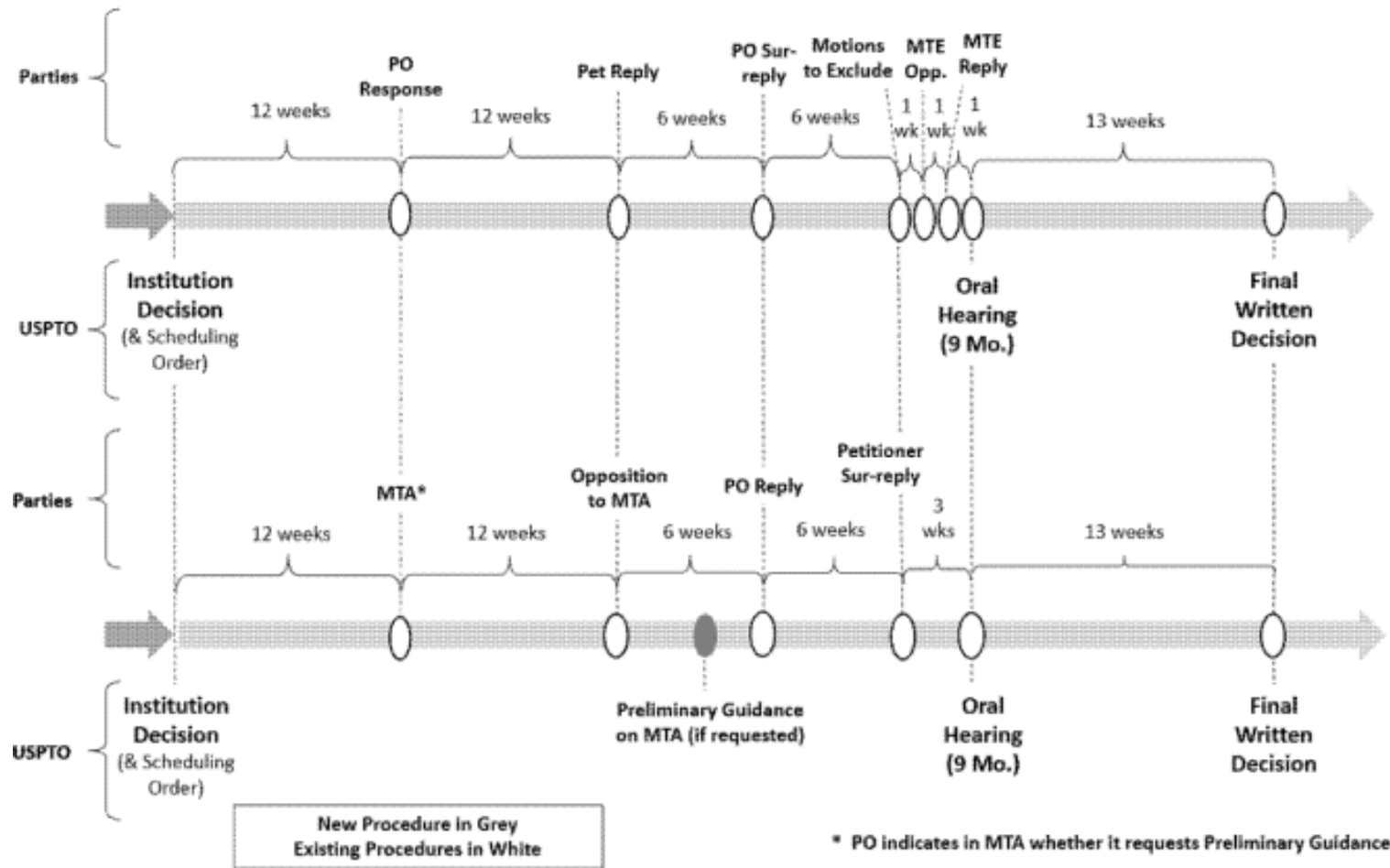
The Current MTA Program

- In 2019, the Office implemented an MTA Pilot Program based on public feedback. The PTO stated “[t]he goal of the proposed amendment process and pilot program is to provide an improved amendment practice in AIA trials in a manner that is fair and balanced for all parties and stakeholders.”

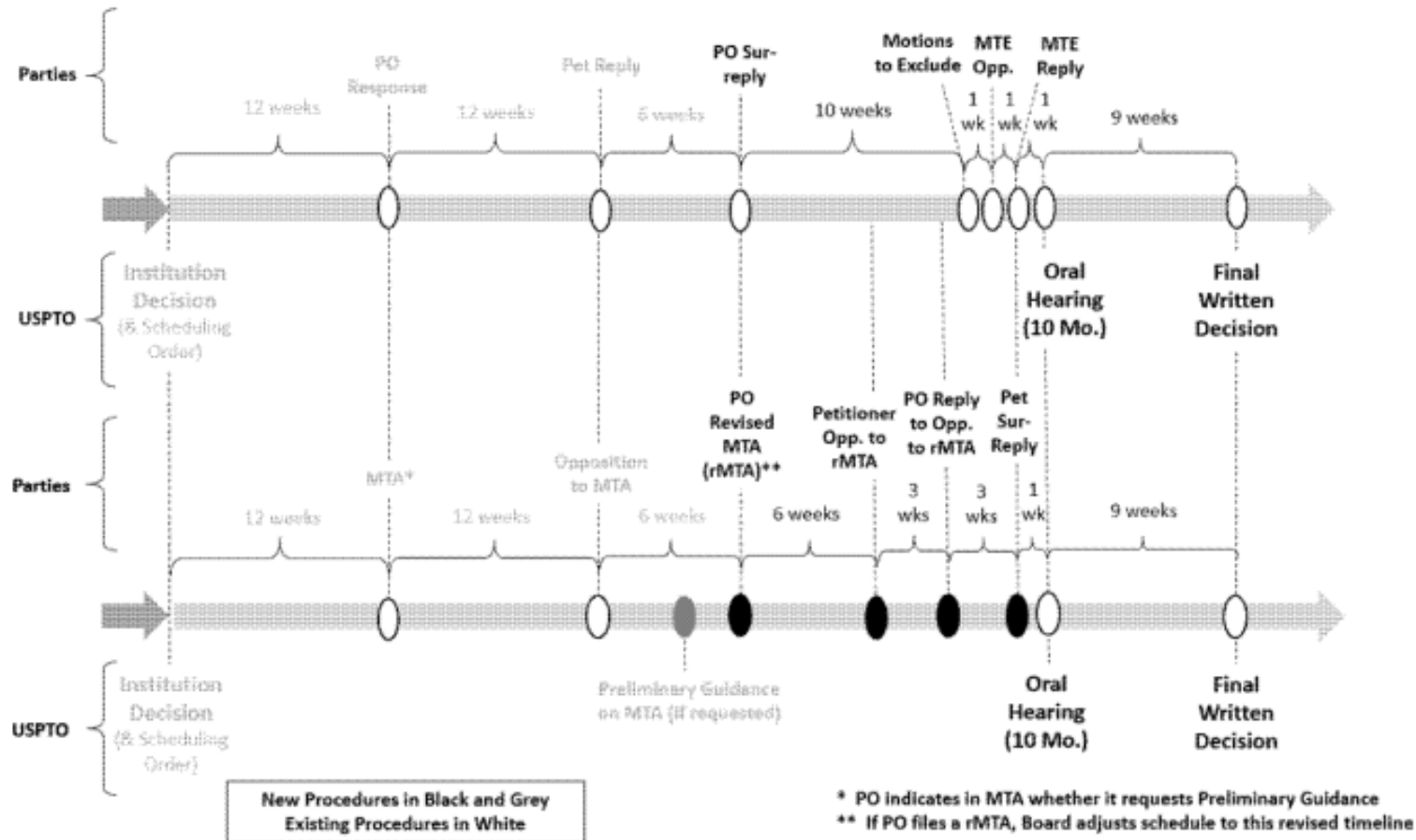
The Current MTA Pilot Program

- The pilot program provided two options to patent owners for amending, which had not previously been available: (1) the ability to receive preliminary guidance and (2) the ability to file a revised motion to amend.
- The pilot program assigned to patent owner the burden of showing the motion complies with certain statutory and regular requirements.
- The pilot program assigned the burden of showing unpatentability of the substitute claims to petitioner

The Current MTA Pilot Program



The Current MTA Pilot Program



Purpose of the Proposed Rules

- Goal is “to formalize certain provisions of the Motion to Amend (MTA) Pilot Program and to revise the rules that allocate burdens in connection with MTAs in trial proceedings....”
- PTO stated it “heard from patent owners that [the MTA Pilot Program] is an efficient and effective way to receive feedback on their amended claims....”

Proposed Rules: The Same or Different?

- Gives the Board more authority to use its discretion to raise grounds of unpatentability and consider more prior art.
- When the PTAB raises a new ground *sua sponte*, the Board determines patentability “based on a preponderance of the evidence” despite being a “neutral tribunal.”
- Explicitly allow the PTAB to consider and make of record art in any related proceeding in the PTAB and any art a court could judicially notice, and that Board will consider all evidence of record. Not limited to “only readily identifiable and persuasive art.”

Proposed Rules: The Same or Different?

- Retains ability of patent owner to request preliminary guidance and file a revised motion to amend Scope of Prior Art.
- Continues to apply preponderance of the evidence standard to new grounds.
- Allows PTAB to request examination assistance and seek a prior art search.
- Reaffirms PTAB's discretion to extend the FWD deadline for good cause.

Historical Context: Usage of the Program, including Statistics

Jennifer Bush

Studies on Motions to Amend

The PTAB has been studying Motions to Amend since 2016

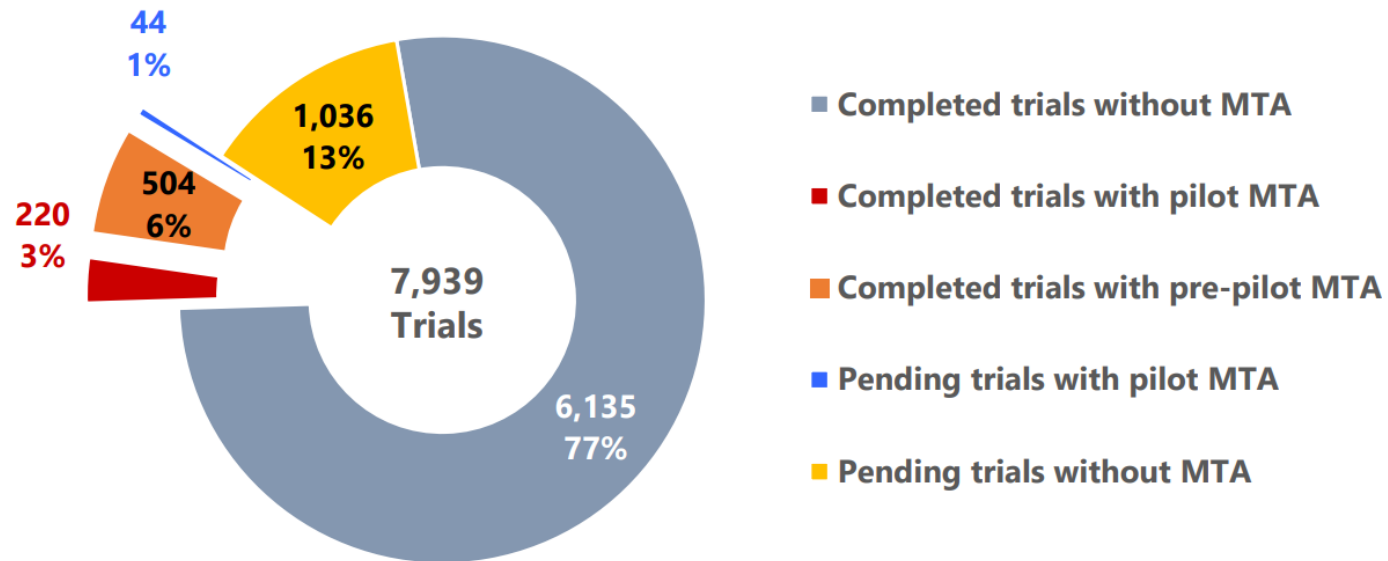
<https://www.uspto.gov/patents/ptab/motions-amend-study>

- **Motion to Amend Study** (updated March 2023)
- **Data for Completed Trials** (March 2023)
- **Motion to Amend Study** (updated March 2022)
- **Data for 155 Completed Trials** (March 2022)
- **Motion to Amend Study** (July 2020)
- **Data for 504 Completed Trials with a Pre-Pilot MTA** (July 2020)
- **Motion to Amend Study** (March 2019)
- **Data for 326 Completed Trials** (March 2019)
- **Motion to Amend Study** (July 2018)
- **Data for 305 Completed Trials** (July 2018)
- **Motion to Amend Study** (September 2017)
- **Data for 275 Completed Trials** (September 2017)
- **Motion to Amend Study** (May 2017)
- **Data for 254 Completed Trials** (May 2017)
- **Motion to Amend Study** (April 2016)
- **Data for 192 Completed Trials** (April 2016)

Studies on Motions to Amend

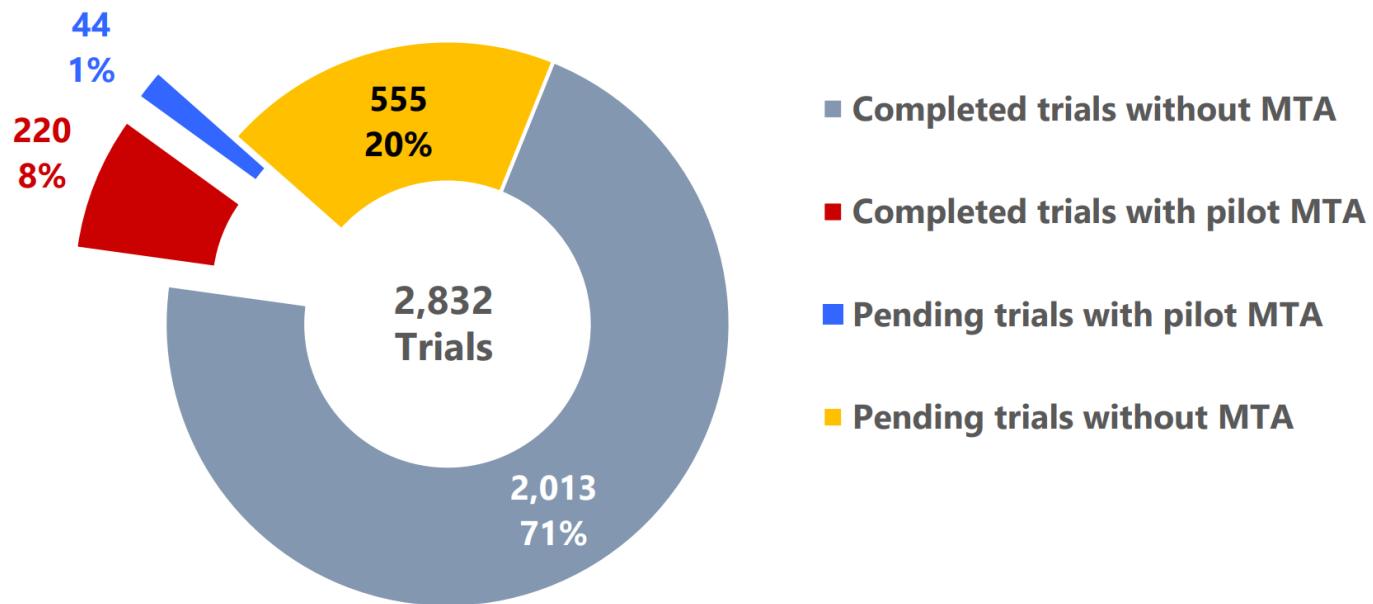
Usage of MTAs FY13-FY22

In how many trials are MTAs filed?



Studies on Motions to Amend

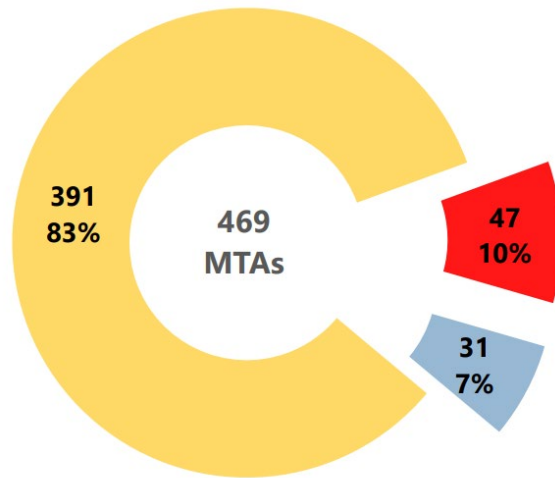
Usage of MTAs Pilot Program March 2019 to March 2023



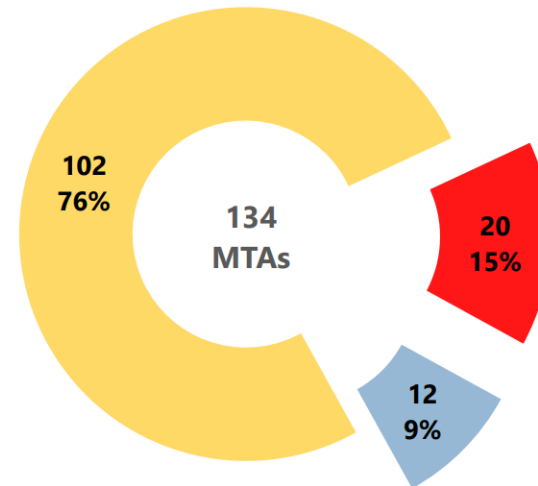
Studies on Motions to Amend

Comparative Use of MTAs

Disposition of all MTAs

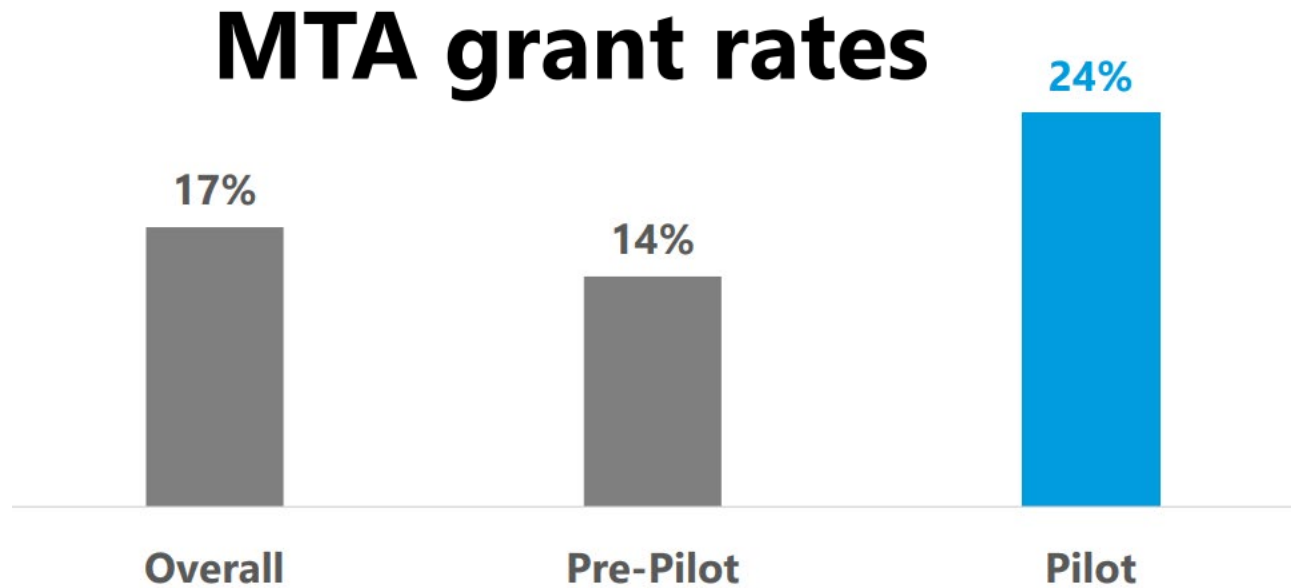


Disposition of pilot MTAs



Studies on Motions to Amend

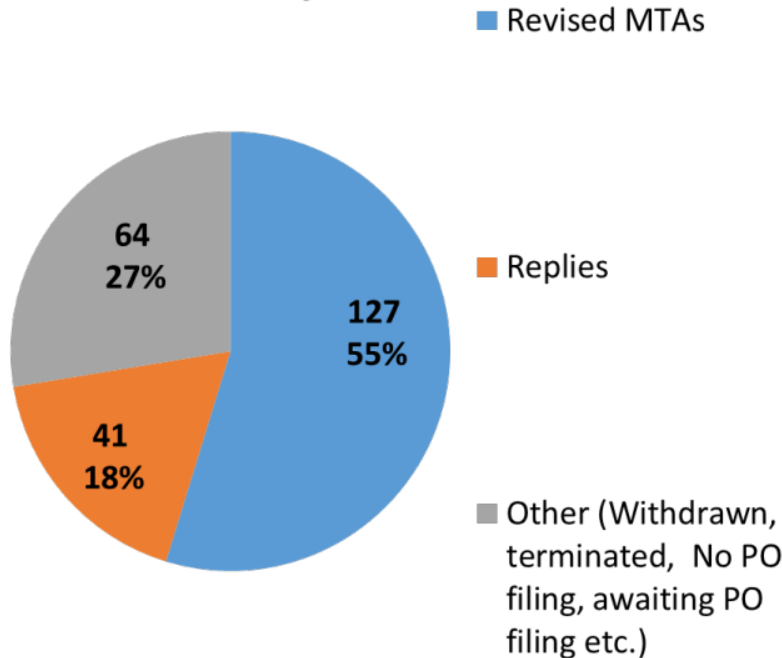
MTA Grant Rates Before/After Pilot Program



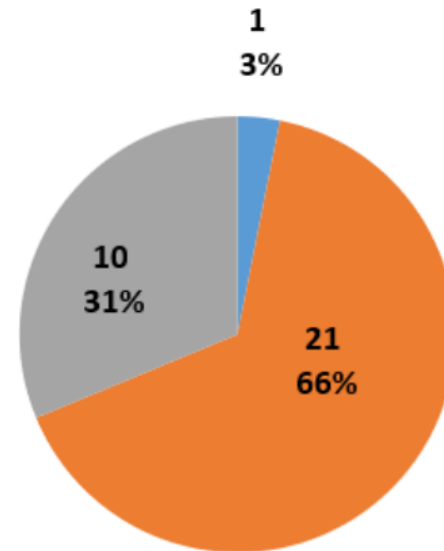
Studies on Motions to Amend

Usage of Revised MTAs in Pilot March 2019 to March 2023

With Preliminary Guidance



Without Preliminary Guidance



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Questions Presented by the Office

- (1) Has the MTA Pilot Program positively or negatively impacted a patent owner's ability to successfully amend claims in an AIA proceeding? Has it made it more likely that a patent owner will avail itself of the MTA process?
- (2) Are there circumstances in which reexamination and/or reissue proceedings are better options for patent owners seeking to amend claims challenged in an AIA proceeding, as compared to the MTA Pilot Program? Is there anything more the Office can do to make the MTA process more useful to patent owners?
- (3) Should the Office modify any aspect of the MTA Pilot Program? Should the Office continue to provide the options of receiving preliminary guidance and being able to revise an MTA, as currently implemented?
- (4) Assuming the MTA Pilot Program should remain, should any aspect of preliminary guidance, as currently provided by the Board, be changed?
- (5) What barriers, if any, exist that the Office can address to increase the effectiveness of the MTA procedure?

Questions Presented by the Office

- (6) Should the Office modify its practice of when the Board can or should raise a new ground of unpatentability, and if so, how? For example, should the PTAB's decision in the *Hunting Titan* case continue to guide when and how the Board can and should raise a new ground of unpatentability? If so, why and how?
- (7) Should the Office involve patent examiner assistance in relation to MTAs? Should the Office conduct a prior art search in relation to proposed substitute claims in certain situations? If so, under what circumstances? And should examiner assistance or prior art searches be limited in any way?
- (8) Should the Office clarify in its rules where the burden of persuasion for Board-raised grounds lies? Who should bear that burden?
- (9) Should any other aspects of the MTA rules ([37 CFR 42.121](#), [42.221](#)), including as they relate to the Board's discretion to grant or deny an MTA, be changed, and if so, how?

CLE CREDIT

- For those of you who require CLE credits please note the following states are pending CLE: AZ, CA, NJ and NY
- Please write down the following affirmation code:

PTAB4324

- After today's session you will receive a Uniform Certificate of Attendance to submit to our colleague, robin.hallagan@squirepb.com. Please add the code to your form.

THANK YOU & REMINDER

Thank you for attending our webinar.

Comments responsive to the ANPRM must be submitted on or before July 24, 2024.

The PTAB Bar Association will be submitting comments and welcomes your input!