

Insights: Alerts

Amendments to Rules of Practice before the Patent Trials and Appeals Board (PTAB)

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The amendments are in the April 1, 2016 Federal Register [here](#). The amendments are effective May 2, 2016, and apply not only to new petitions, but to ongoing ones. Thus, for example, if the deadline for a preliminary response, or the new reply to a preliminary response falls on May 2 or later, it would behoove practitioners to start preparing those under the newly amended rules. Below are the highlights of the new rules:

1. Declarations in Preliminary Response. A preliminary response to an inter partes review ("IPR") or post-grant review ("PGR") petition (not covered business method ("CBM")) can now include testimonial evidence (declarations).
2. Petitioner Reply with Good Cause. A petitioner can now file a reply to a preliminary response in an IPR or PGR petition (not CBM), not previously permitted, upon request with a showing of good cause. The response to comments suggest that countering declarations in the Patent Owner preliminary response may be good cause. Replies are limited to responding to arguments raised in the response.
3. Issue of Fact. Where there is a genuine issue of material fact created by the testimonial evidence, it shall be viewed in the light most favorable to the petitioner for the institution decision (IPR and PGR).
4. Expiring Patents. The claims subject to the broadest reasonable interpretation are extended to those in patents that do not expire before a final written decision. A party may request a "district court-type claim construction" if the patent "will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition." Such a request must be a motion made within 30 days of filing the petition. This changes the old rule of applying the district court standard if the patent expires before the institution decision. This applies to IPRs and PGRs, not CBMs.
5. Word Counts. Word counts will be used instead of the old 14 point Times New Roman font and double spacing for arguments and single spacing for claim charts. Some filings still have page counts. A certification as to the word count is required, and can rely on a word processor word count. A motion to waive the word count "in the interests of justice" can be included in a petition, but if not granted, the petition will be expunged or returned. Other motions to waive word count must be granted in advance. The word counts do not include a "listing of facts which are admitted, denied, or cannot be admitted or denied," a table of contents, grounds for standing, mandatory notices, certificate of service or word count, appendix of exhibits or claim listing.

1. IPR Petition; Derivation Proceeding Petition; IPR Preliminary Response, IPR Response: 14,000 words
2. PGR, CBM Petition; PGR Preliminary Response; PGR Response: 18,700 words
3. Motions to amend: 25 pages
4. Other motions, oppositions: 15 pages
5. Replies to Patent Owner responses (preliminary and final) to Petitions: 5600 words
6. Replies to oppositions to motions to amend: 12 pages
7. Replies to all other oppositions: 5 pages

6. Sanctions for Rule 11-Type Certification. Provisions are made for sanctions for violations of the certification requirements [under 11.18(b)(2)], with the proposed motion served on the other party at least 21 days before seeking Board authorization for the motion. The proposed sanction "must not be filed or presented to the Board if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service" or other time the Board sets.

7. Oral Hearing Exhibits. The rules now require exhibits be served 7 days before oral argument, instead of 5.

Proposals not adopted. The PTAB decided not to adopt institution decisions by a single judge. The ability to amend the Real Parties in Interest was said to be under review. The comments address a number of proposals not adopted, including ones relating to claim amendment procedure and additional discovery.

Related People



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