

Summary of "Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board," Final Rule, 80 FR 28561 (2015)

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## **I. Introduction**

On May 19, 2015, the USPTO had published in the Federal Register its anticipated Quick Fixes, to the PTO rules governing AIA Trials before the PTAB. See the citation in the title. The rules package provides an effective date of today, May 19, 2015. This short paper specifies that changes made by this rule package.

## **II. Specification of Rule Changes**

We show below the rule changes.

### **II.1 Document Formatting**

42.6(a)(2)(ii) 14-point, Times New Roman proportional font, with normal spacing, must be used.

### **II.2 Counsel**

42.10(a) - Now allows for multiple backup counsels ("at least one").

### **II.3 Petition Fees**

42.15(a)(3); (a)(4); (b)(3); and (b)(4) are all amended to add a per claim fee for each "unchallenged claim from which a challenged claim depends." This changes increases the claim counts for claims in excess of the 20/15 limits for request/institution, respectively, when calculating petition fees.

### **II.4 Relaxed Pleading Requirements**

42.23(a) - Now only requires a *responsive* paper to include a listing of admitted, denied, or cannot be admitted or denied, responses, if a statement of material fact appears in the paper to which the *responsive* paper is responding.

42.24(a)(1) is amended to exclude claims listings from the page limit (for petitions, motions, oppositions, and replies).

42.24(a)(vi) is added authorizing 25 pages for motions to amend.

42.24(c) is amended to clarify that a statement of material facts is not required.

42.24 (c)(1) is amended to allow 25 pages to replies to patent owner responses to petitions.

42.24 (c)(3) is added to provide 12 pages for replies to oppositions to motions to amend.

### **II.5 Discovery**

42.51(b)(1)(ii) is clarified to be limited to routine discovery of "testimony prepared for the proceeding." The comments to the rules state that this rule is changed to "To clarify that routine discovery includes only the cross-examination of affidavit testimony prepared for the proceeding,"

42.53(c)(2) is corrected by removing the word "deposition" so that it is clear that uncompelled direct testimony refers to affidavits and declarations.

42.53(f)(7) is amended to make it clear that either party can file deposition testimony (but

someone has to file it!)

42.64(b)(1) is amended to require the *filing* of objections to pre-institution evidence within 10 days of institution; and *filing* of post-institution objections within 5 business days of service of the evidence objected to.

42.71(d) is amended to clarify that a party can only file a single request for rehearing.

42.121(b) and 221(b) are amended to authorize the claim listing for a motion to amend to be in an appendix to the motion.

42.300(c) revised to provide that the one year pendency can be "adjusted by the Board in the case of joinder."

42.302(c) is added and reads "(c) A petitioner may not file a petition to institute a covered business method patent review of the patent where, before the date on which the petition is filed, the petitioner or real party-in interest filed a civil action challenging the validity of a claim of the patent."

### **III. Conclusion**

These rule changes tweak the PTAB AIA trial process. There are no major changes to the structure of the proceedings.

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