



THE BOSTON PATENT LAW ASSOCIATION

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December 21, 2018

Via E-Mail: TrialRFC2018Amendments@uspto.gov

Attn: Acting Deputy Chief Administrative Patent Judge Jacqueline Wright
Bonilla or Vice Chief Administrative Patent Judge Michael Tierney,
PTAB Request for Comments 2018
Mail Stop Patent Board
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Comments on Motion to Amend Practice and Procedures in Trial
Proceedings under the America Invents Act before the Patent Trial
and Appeal Board, in response to requests for comments at 83 Fed.
Reg. 54319 (October 29, 2018)

Dear Honorable Judges Bonilla and Tierney:

The Boston Patent Law Association (“BPLA”) thanks the United States Patent and Trademark Office (“USPTO”) for the opportunity to respond to the USPTO’s request for comments on its proposal to implement changes to the Motion to Amend (“MTA”) practice used in trial proceedings before the Patent Trial and Appeal Board (“PTAB” or “Board”).¹ The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the exchange of ideas and information concerning patent, trademark, and copyright laws in the First Circuit, focusing on the greater Boston area. These comments were prepared with the assistance of the Patent Office Practice Committee of the BPLA. The BPLA submits these comments solely as its consensus view. They are not necessarily the views of any individual member, any firm, or any client.

¹ Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 Fed. Reg. 54319 (October 29, 2018) (“the Request”); *see also* U.S. Patent and Trademark Office Patent Trial and Appeal Board email dated December 12, 2018 (extending the time to submit comments in response to the same by seven days, until Friday, December 21).

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We appreciate the USPTO's efforts to provide an improved amendment practice in AIA trials in a manner that is fair and balanced for all parties and stakeholders. We offer these comments to assist the USPTO in implementing and considering modifications to the proposed changes to the MTA procedures in PTAB trial proceedings as outlined in the Request.

I. The USPTO Should Evaluate its Rulemaking Authority with Respect to the Proposed Opportunity for Patent Owners to Revise Previously Filed Motions to Amend

The Request for Comment introduces a proposal that would allow Patent Owners to revise a previously filed MTA in trial proceedings before the PTAB² after receiving the Petitioner's opposition and a preliminary decision from the Board. However, the USPTO should consider whether this proposal comports with the statutory requirements of 35 U.S.C. § 316(d)(1)-(2) as applied to IPR proceedings, and § 326(d)(1)-(2) as applied to PGR and CBM³ proceedings.

In particular, §§ 316(d)(1) and 326(d)(1) specify that the Patent Owner may file one motion to amend the patent in IPR, PGR, and CBM proceedings. Additionally, § 316(d)(2) specifies that additional motions to amend may be permitted in IPR proceedings either upon the joint request of the Petitioner and the Patent Owner to materially advance the settlement of a proceeding, "or as permitted by regulations prescribed by the Director." Similarly, § 326(d)(2) indicates that additional motions to amend may be permitted in PGR and CBM proceedings either upon the joint request of the Petitioner and the Patent Owner to materially advance the settlement of a proceeding, "or upon the request of the patent owner for good cause shown."

The BPLA encourages the USPTO to consider whether the final clauses of §§ 316(d)(2) and 326(d)(2) quoted above can be interpreted to allow for a rule that may effectively vitiate the express language of §§ 316(d)(1) and 326(d)(1), as well as the remaining language in §§ 316(d)(2) and 326(d)(2).

II. The USPTO Should Consider Modifying its Proposal with Respect to Additional Briefing in the MTA Process, and/or Issuing Guidance on Extension of the Statutory Timeline to Accommodate the Same

In addition to providing a proposal that would allow Patent Owners to revise a previously filed MTA, the USPTO's proposal further proposes allowing for additional responsive briefing by both Patent Owners and Petitioners. 83 Fed. Reg. at 54322 ("After receiving the preliminary decision, a patent owner may file a revision to its motion to amend... The petitioner would have an opportunity to file an opposition responding to the revised motion to amend and the

² *I.e.*, *Inter Partes* Review ("IPR"), Post-Grant Review ("PGR"), and Covered Business Method ("CBM") proceedings.

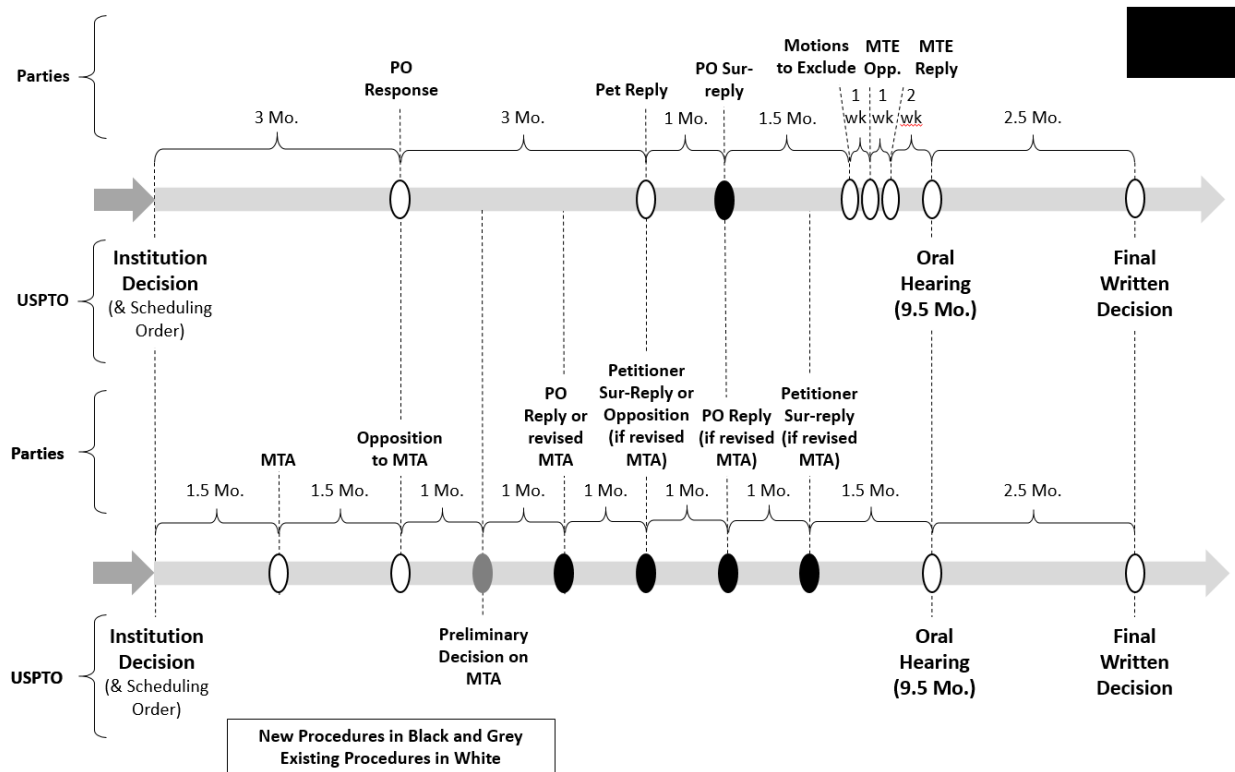
³ *See* Leahy-Smith America Invents Act, Pub. L. No 125-29, § 18(a)(1), 125 Stat. 329-30 (2011) (CBM proceedings shall be regarded as, and shall employ the standards and procedures of, a PGR).



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preliminary decision. Before the oral hearing, the patent owner also may file a reply to an opposition to the revised motion to amend, and the petitioner may file a corresponding sur-reply.”). The Request also suggests that additional cross-examination of reply witnesses may be permitted as a result of the proposed changes. *See id.* (“*Cross-Examination Through Depositions*: In the current proposal, all cross-examinations, *i.e.*, depositions, of witnesses in relation to direct testimony (provided in declarations) pertaining to a motion to amend would occur after the Board issues the preliminary decision on a motion to amend.”).

The BPLA notes that these changes would introduce four additional rounds of briefing and potential cross-examination of witnesses into the already short AIA trial timelines, representing a substantial increase in the burden on both Patent Owners and Petitioners in AIA proceedings. The Overlay of Proposed New Motion to Amend Process Timeline and AIA Trial Timeline included in the Request provides a visual demonstration of the expanded undertaking that the proposed process would bring to all parties:



See id. at 54326, Appendix A2.

The BPLA believes that this proposal, and the concomitant significant increase in onus for both Patent Owners and Petitioners, may lead to reduced reliance on MTA procedures, and accordingly may run counter to the USPTO’s intent in issuing this proposal. Accordingly, the



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BPLA suggests that the USPTO reconsider these proposed changes to the MTA procedure. Members of the BPLA have suggested the following potential solutions:

- Rather than allowing for additional briefing, instead allow the Petitioner to address the proposed Preliminary Decision on MTA with its existing Reply, and allow the Patent Owner to respond or revise its motion to amend in its Sur-Reply (potentially limited to MTA issues and an optional revised MTA), both with increased page limits and potentially relaxed evidentiary restrictions. Should Patent Owner elect to file a revised MTA, Petitioner would receive an opportunity to file a Sur-Reply.
- Implement the proposed additional briefing and cross-examination, but only with extension of the statutory term to allow for a less compressed schedule.
- Implement the proposed Patent Owner Reply or revised MTA and Petitioner Sur-Reply or Opposition, but eliminate the two subsequent rounds of proposed briefing (*i.e.*, the Patent Owner Reply and Petitioner Sur-Reply).

Additionally, given the increased density in briefing and short time for the same that would be effected by this proposal, the USPTO should also consider reducing the time between oral hearing and final written decision and/or issuing guidance on whether this would constitute good cause for the Board to extend the statutory timeline in order to accommodate these procedures. *See* 35 U.S.C. § 326(a)(11) (indicating that the Director may, for good cause shown, extend the one-year statutory deadline for a final determination in post-grant proceedings by not more than six months). The BPLA suggests that such adjustments could serve to ameliorate the time constraints discussed above.

III. The Board Should Not Be Permitted to Justify Findings of Unpatentability Based on Grounds Not Raised by the Petitioner

Finally, the Request seeks public comment on circumstances in which the Board itself may justify findings of unpatentability. 83 Fed. Reg. at 54324. In particular, the Request states that “the Board is permitted, but not required, to find claims unpatentable for reasons other than those advanced by the petitioner as long as the patent owner has notice and an opportunity to be heard.” *Id.*

The BPLA submits that, even in circumstances where the Petitioner withdraws from the proceeding or does not oppose a MTA, the Board should only be able to justify findings of unpatentability based on grounds actually raised by the Petitioner. To allow the Board to do otherwise would place it in the shoes of the Petitioner, effectively transforming its role from that of an independent fact-finder and arbiter into an advocate for Petitioner, and a party to the trial proceedings. This could compromise the fairness and balance that the USPTO seeks to promote through this process. *See* 83 Fed. Reg. at 54320 (“The 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.”).



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Moreover, allowing the Board to raise grounds of unpatentability not previously advanced by Petitioner would risk contravening previous guidance provided by the Federal Circuit and the USPTO itself. *See Bosch Automotive Service Solutions, LLC v. Matal*, 878 F.3d 1027, 1040 (Fed. Cir. 2017), as amended in part on reh'g (Mar. 15, 2018) (“where the challenger ceases to participate in the IPR and the Board proceeds to final judgment, it is the Board that must justify any finding of unpatentability by reference to the evidence of record in the IPR.”) (quoting *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1311 (Fed. Cir. 2017) (*en banc*) (opinion of O’Malley, J.) (emphasis added); *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018–00082 (Paper 13) at 4 (PTAB April 25, 2018) (“The Board itself may justify any finding of unpatentability by reference to evidence of record in the proceeding...”) (emphasis added).


Accordingly, the USPTO should promulgate regulations or otherwise issue guidance to the Board making clear that it may find claims unpatentable only based on grounds that were previously advanced by the Petitioner.

IV. Conclusion

The BPLA appreciates the opportunity to respond to the Request. Thank you in advance for your consideration of these comments.

Sincerely,

Boston Patent Law Association

By: 

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