



ARE Patent Law Alert: Patent Trial and Appeal Board Rule Changes

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On Tuesday, May 19, 2015, the U.S. Patent and Trademark Office amended the rules of practice before the Patent Trial and Appeal Board (PTAB). These rules clarify and correct many of the procedural aspects of the inter partes review, post-grant review, transitional program for business method patents, and derivation proceedings governed by the 2011 Leahy-Smith America Invents Act.

The major changes to the rules are:

- **Page Limitations:** A Patent Owner's Motion to Amend may now be 25 pages long, and may include a claims appendix that does not count toward the page limit. Similarly, a Petitioner's reply to a Patent Owner's response to a petition may now be 25 pages long, and a Patent Owner's reply to an opposition to a Motion to Amend may be 12 pages long. (37 C.F.R. §§ 42.24(a)(1)(vi), 42.24(c)(1), 42.24(c)(3), 42.121(b), 42.221(b))
- **Font Size and Spacing:** All documents must have 14-point, Times New Roman proportional font with normal spacing. (37 C.F.R. § 42.6(a)(2)(ii))
- **Objections to Evidence:** Objections to evidence must be filed with the PTAB, and not simply served on the opposing side. (37 C.F.R. § 42.64(b)(1))
- **Fee Calculations:** Unchallenged claims from which a challenged claim depends must be included in fee calculations. (37 C.F.R. § 42.15)
- **Routine Discovery Definition:** Routine discovery contemplates only cross-examination of affidavit testimony prepared for the PTAB proceeding. (37 C.F.R. § 42.51(b)(1)(ii))
- **Testimony as Exhibit:** Either party may file testimony, such as a deposition transcript, as an exhibit. (37 C.F.R. § 42.53(f)(7))
- **Back-Up Counsel:** More than one back-up counsel may be designated. (37 C.F.R. § 42.10(a))
- **Rehearing Requests:** A party may only file a single request for hearing as of right. (37 C.F.R. § 42.71(d))
- **Statement of Material Facts:** Providing a statement of material facts to be admitted or denied in support of a petition or a motion is optional and the rules relating to an opposition or a reply thereto have been amended accordingly. (37 C.F.R. §§ 42.23(a), 42.24(c))
- **Direct Testimony:** Uncompelled direct testimony must be in the form of an affidavit, not a deposition. (37 C.F.R. § 42.53(c)(2))
- **Motions in Limine:** Motions in limine are not part of AIA practice. (37 C.F.R. § 42.64)
- **Covered Business Method Patent Review:** A covered business method patent petition may not be filed if the petitioner or real party-in-interest filed a civil action challenging the



validity of a claim of the patent. (37 C.F.R. § 42.302(c))

- **Pendency of CBM Patent Review:** Like *inter partes* review and post-grant review, the pendency of a CBM patent review proceeding can be extended beyond one-year period by the Board in the case of joinder. (37 C.F.R. § 42.300(c))

As always, we will continue to monitor the USPTO's rules and regulations and will provide alerts for any further changes. We continue to analyze and follow developments associated with the AIA, and will post additional reports on our website.

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Mr. Macedo is also the author of *The Corporate Insider's Guide to U.S. Patent Practice*, published by Oxford University Press in 2009.