



# THINK FORWARD

## USPTO Finalizes New Rules for AIA Reviews

On March 31, 2016, the U.S. Patent and Trademark Office (USPTO) announced final rule changes for America Invents Act (AIA) proceedings. The new rules will take effect 30 days after publication of the corresponding Federal Register, and will apply to all AIA petitions filed on or after the effective date, as well as to any ongoing AIA proceedings before the USPTO.

The final rule changes are substantially similar to those published on August 19, 2015, with some exceptions. Notably, the USPTO did not adopt its proposed pilot program pertaining to the institution of some AIA reviews by a single judge, rather than by a three-judge panel.

Notable changes that were implemented by the USPTO's new rules are discussed below.

### Patent Owner Preliminary Response

The new rules allow patent owners to submit new testimonial evidence with their preliminary responses, which are filed before the PTAB decides whether to institute a petition. The rules also clarify that a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for the purposes of deciding whether to *institute* AIA review.

The new rules also state that a petitioner may seek leave to file a reply to the preliminary response after showing good cause.

### Word Count

The new rules implement a word count for petitions, patent owner preliminary responses, patent owner responses, and petitioner replies, as follows:

- Petition for inter partes review: **14,000 words**
- Petition for post-grant review (including CBMPRs): **18,700 words**
- Petition for derivation proceeding: **14,000 words**
- Patent Owner Preliminary Response: **Same as word count for petition**
- Patent Owner Response: **Same as word count for petition**
- Petitioner Reply: **5,600 words**

Assuming an average of about 250 words per page, this rule change could amount to an approximately 4-5 page reduction for petitions. The new rule may decrease parties' reliance on single-spaced claim charts, or at least result in less compressed, more uniform claim charts in petitions. Additionally, parties may rely more on figures and charts rather than text.

### Claim Construction

The new rules clarify that the PTAB may apply the district court-type claim construction standard, i.e.,

the “*Phillips*-type” standard, for patents that will expire during a proceeding. According to the new rules, a request by either party for a *Phillips*-type construction must be made by motion within 30 days from the filing of a petition. Patents subject to the *Phillips*-type standard cannot be amended during post-grant proceedings.

The new rules also confirm that the PTAB will use the broadest reasonable interpretation standard for all other patents.

### **Rule 11-Type Certification**

The new rules add a Rule 11-type certification for papers filed in a proceeding, under which an attorney can be sanctioned for failing to complete adequate pre-filing investigation or certification.

### **Moving Forward**

As noted, the new rules take effect 30 days from publication of the Federal Register and apply not just to petitions filed on or after the effective date, but to ongoing AIA trials as well. Thus, practitioners should be aware of what effect, if any, the new rules can have on their proceeding and any upcoming briefings given their trial schedule.

Also worth mentioning is that the USPTO will amend the PTAB Trial Practice Guide to reflect these rule changes, as well developments in how the USPTO handles motions to amend, additional discovery, real party-in-interest and privity issues, and confidential information.

### **Contact Us**

Additional information about post-grant proceedings can be found on our [Post-Grant Patent practice group page](#).