

PTO Formally Issues First Set of New Changes to PTAB Rules, Including Increased Page Limits for Petitioner Replies and Patent Owner Motions to Amend

The U.S. Patent & Trademark Office (PTO) has issued several rule amendments that it refers to as “ministerial changes” to procedures for post-grant proceedings before the Patent Trial and Appeal Board (PTAB), including *Inter Partes* Reviews (IPRs), Post-Grant Reviews (PGRs), and Covered Business Method Patent Reviews (CBMs). These rule changes go into effect today and increase the page limits for Patent Owner motions to amend claims and Petitioner reply briefs, and also provide for other “clarifying changes.” Specifically, the new rules address the following:

Content of Briefs, Fees, and Appearances

- Adding 10 pages (25 total) to the limit for Patent Owner’s motion to amend claims (as well as Petitioner’s opposition to the motion to amend) (37 C.F.R. § 42.24(a)(1)(vi), (b)(3)), and adding 7 pages (12 total) to the limit for Patent Owner’s reply in support of the motion to amend (§ 42.24(c)(3));
- Adding 10 pages (25 total) to the limit for Petitioner’s reply (to Patent Owner’s response to the petition) (§ 42.24(c)(1));
- Allowing a claims appendix for a motion to amend, which is not included in the page limits (§§ 42.121(b), 42.221(b));
- Requiring the parties to use Times New Roman font (§ 42.6(a)(2)(ii));
- Clarifying that providing a statement of material facts is optional (§ 42.23(a));
- Clarifying that multiple back-up counsel can be named (§ 42.10(a)); and
- Clarifying the counting of challenged claims for calculating fees (§ 42.15(a)(3)-(4), (b)(3)-(4)).

Standing and Joinder

- Clarifying that no CBM petition may be filed if the Petitioner or real party-in-interest filed a civil action challenging the patent’s validity (§ 42.302(c)); and
- Clarifying that the timeline for concluding a CBM may be extended in the case of joinder (§ 42.300(c)).

Depositions

- Clarifying that routine discovery contemplates only cross-examination of the affidavit/declaration testimony prepared for the proceeding (§ 42.51(b)(1)(ii)); and
- Providing that uncompelled direct testimony must be by affidavit/declaration, not deposition (§ 42.53(c)(2)).

Evidentiary Issues and Requests for Rehearing

- Clarifying that there are no motions *in limine* for PTAB proceedings (§ 42.64);
- Providing that evidentiary objections must be filed, instead of just served (§ 42.64(b)(1)); and
- Providing that only one request for rehearing may be filed as of right (§ 42.71(d)).

The new rules add additional pages to Petitioner's substantive reply brief in response to several commenters who suggested that the previous 15-page limit was insufficient. And with the additional pages for Patent Owner motions to amend—which had also been requested by numerous commenters—also comes corresponding additional pages to Petitioner oppositions to motions to amend and Patent Owner replies in support of motions to amend. The requirement to use Times New Roman font, however, may effectively decrease the amount of content that might otherwise be achieved within the page limits by use of different fonts. The PTO asserts that this change in font is required because it “has received briefs from parties that utilize narrow fonts that may be compliant with [the previous] requirements, but nevertheless, have proved difficult to read.” And the clarification on counting challenged claims for purposes of calculating fees now states that the fee for challenging a dependent claim will also require a separate fee for the claim from which it depends (unless it is also challenged and therefore already subject to a fee).

These rule changes are effective immediately and are the first of two sets of anticipated amendments to PTAB trial procedures, the later of which is expected this summer and will address “more involved changes to the rules.” The new rules were published today, May 19, 2015, in the Federal Register and can be found [here](#).

For further information, please contact your usual Ropes & Gray attorney or one of the Ropes & Gray attorneys listed below.

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