

First in Three-Part Roll-Out of AIA Rule Changes Announced, Including Page Limits for Petitioner Replies and Patent Owner Motions to Amend

March 27, 2015 – In a blog post today, U.S. Patent and Trademark Office (“PTO”) Director Michelle K. Lee announced plans for a three-part roll-out of changes to the rules governing America Invents Act (“AIA”) post-grant proceedings, with the first including “‘quick fixes’ – changes of simple scope that will immediately improve the trial proceedings.” According to Director Lee’s announcement, these include increasing the page limits for Petitioner Replies and Patent Owner Motions to Amend filed in connection with AIA proceedings, including covered business method reviews and *inter partes* reviews.

The Director stated that the PTO will be increasing the page limits for Petitioner Replies and Motions to Amend from 15 to 25 pages. Although this modification to AIA proceedings will officially issue in a package of “quick fix” rule changes that will be promulgated later this spring, the announcement stated that Administrative Patent Judges of the Patent Trial and Appeal Board will begin implementing them “effective immediately” through scheduling orders.

The PTO Director’s announcement also confirmed that it expects to issue a second rule-making package this summer. In connection with the second package, the announcement states that the PTO is considering changes to the requirements for motions to amend, modifications to the type of evidence that can be relied on to support the Patent Owner Preliminary Response, and clarification of the claim construction standard applicable to expired patents challenged in AIA proceedings, along with several other changes.

Director Lee announced that the PTO also expects to revise its Trial Practice Guide, including to “emphasize the availability of live testimony” at oral hearings upon the grant of a motion for such testimony, and the “importance of . . . discovery” about the real-party-in-interest.

Director Lee’s blog post is available [here](#). To discuss further the potential impact of the new rules, please contact your usual Ropes & Gray attorney or one of the Ropes & Gray attorneys listed below.

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