

# KIRKLAND & ELLIS

Kirkland Alert

## New Pilot Program Concerning Motion to Amend Practice in AIA Trial Proceedings Before the Patent Trial and Appeal Board

21 March 2019

On March 15, 2019, the U.S. Patent and Trademark Office ("USPTO") published a Notice regarding a new pilot program concerning motion to amend practice in America Invents Act ("AIA") trial proceedings before the Patent Trial and Appeal Board ("PTAB"). Under the new pilot program, a patent owner who files a motion to amend can choose how that motion will proceed before the PTAB, including whether to request preliminary guidance and whether to file a revised motion to amend. Historically, motions to amend in AIA trial proceedings have rarely been filed, and even more rarely granted. The pilot program is expected to result in an uptick in motion to amend filings and may potentially result in many more successful amendments in such proceedings.

The pilot program applies to all *inter partes* reviews, post-grant reviews and covered business method patent reviews instituted on or after March 15, 2019. All cases that have been instituted prior to the effective date will proceed pursuant to the motion to amend practice previously in effect. The USPTO anticipates it will reassess the pilot program in approximately one year, and may terminate or continue the program (with or without modifications) based on information and feedback received.

### New Options for Patent Owners Filing a Motion to Amend

The pilot program provides a patent owner who files a motion to amend with two options that were not previously available:

1. A patent owner may choose to receive preliminary guidance from the PTAB after a petitioner files an opposition to a motion to amend (or after the due date for the opposition, if none is filed). The preliminary guidance typically will be in the form

of a short paper, although it may be oral guidance provided in a conference call, at the PTAB's discretion.

2. A patent owner may choose to file a revised motion to amend after receiving a petitioner's opposition to the original motion to amend and/or after receiving the PTAB's preliminary guidance (if requested). A revised motion to amend may only provide amendments, arguments or evidence that is responsive to issues raised in the preliminary guidance and/or a petitioner's opposition to the motion.

In addition to these new options, the patent owner can also pursue a motion to amend in effectively the same way as current practice, by electing not to receive preliminary guidance or file a revised motion to amend. The full Notice can be found [here](#).

## Potential Practical Issues

From a practice standpoint, the new pilot program is expected to result in more motions to amend being filed and granted, and raises several practical issues:

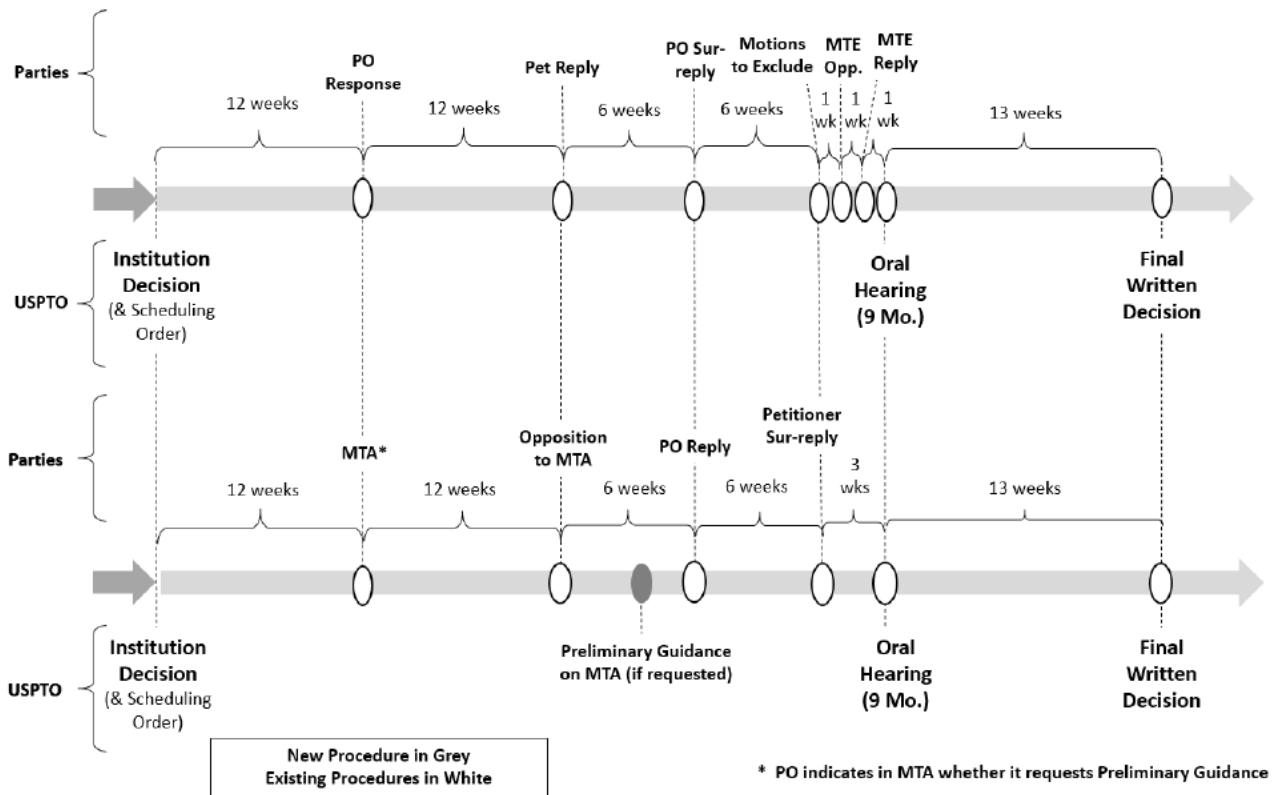
- Proceedings with a motion to amend involve additional substantive filings that will increase the cost – both to patent owners who initiate the motion practice and to petitioners who defend against such motions – relative to proceedings that do not involve a motion to amend. The added costs may vary depending on the options selected by the patent owner.
- Motions to amend will increase the significance of protective orders that govern access and use of confidential information. Most proceedings before the PTAB relate to parallel district court litigation, where discovery rules require accused infringers to provide confidential technical information to patent owners. Accused infringers may seek to bar attorneys representing patent owners from accessing their confidential technical information, if such attorneys will be involved in motion to amend practice before the PTAB.
- The new pilot program presents significant scheduling challenges for both patent owners and petitioners, particularly in instances where the patent owner chooses to file a revised motion to amend. As an example, a patent owner must file a reply in support of a revised motion to amend within three weeks of a petitioner's opposition to the revised motion to amend. If the patent owner submits an expert declaration with its reply, the patent owner is expected to make the expert declarant available for deposition within one week of submitting the declaration.

## Timelines for the New Pilot Program

The timelines associated with the new motion to amend pilot program are as follows:

Upon institution, the scheduling order will set dates for a motion to amend and briefing related thereto, as set forth in Appendix 1A of the Notice (depicted below). In particular, a motion to amend will be due 12 weeks after an institution decision (on the same due date as the patent owner response), and a petitioner’s opposition to the motion to amend will be due 12 weeks later (on the same due date as the petitioner reply). If the patent owner requests preliminary guidance from the PTAB, the PTAB will issue such guidance within four weeks after the due date for the petitioner’s opposition to the motion. If the patent owner chooses to file a reply to the petitioner’s opposition to the motion and/or preliminary guidance (if requested), instead of filing a revised motion to amend, the due date for the reply is six weeks after the due date for the petitioner’s opposition to the motion. The due date for the petitioner’s sur-reply relating to the motion to amend will be six weeks after the due date for the patent owner’s reply.

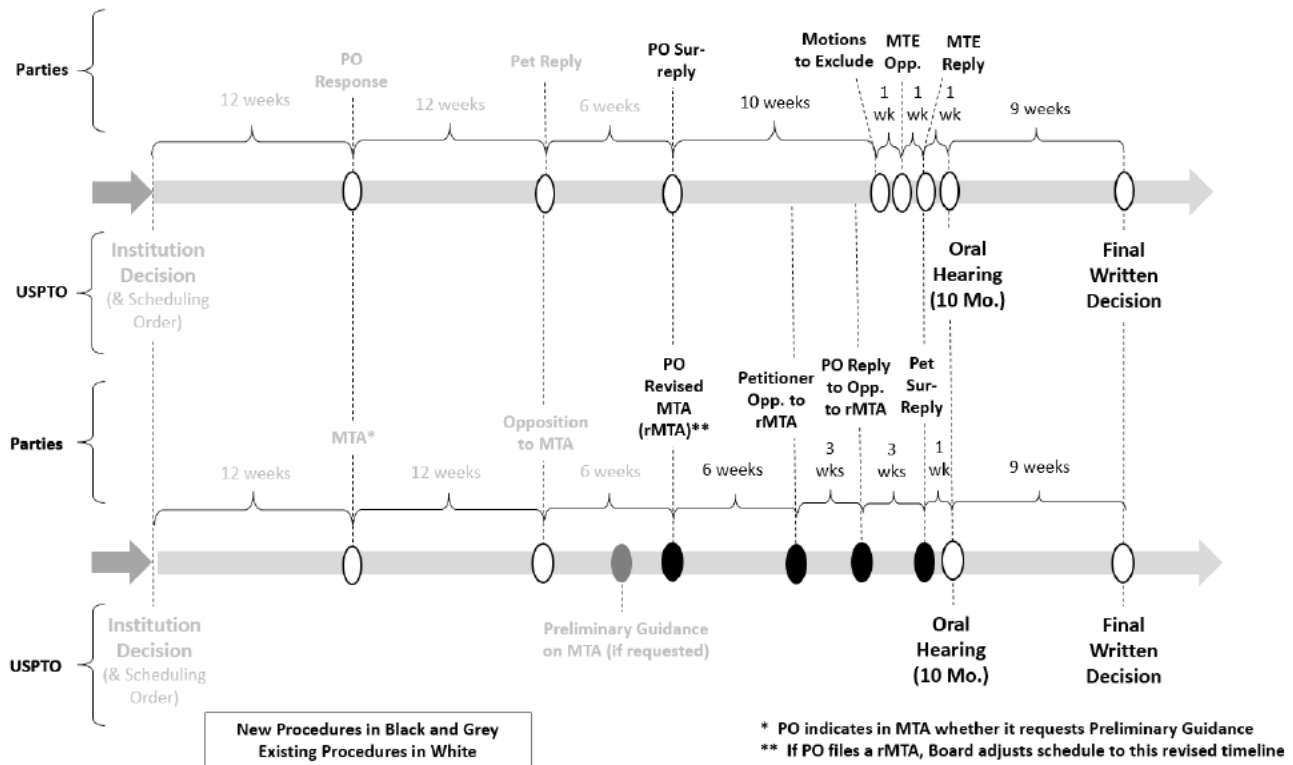
### APPENDIX 1A (PO REPLY TIMELINE)



As an alternative to filing a reply, a patent owner instead may file a revised motion to amend after receiving the petitioner’s opposition and/or the PTAB’s preliminary

guidance (if requested). The patent owner may file a revised motion to amend on the due date for the patent owner’s reply relating to its motion to amend (i.e., six weeks after the due date for the petitioner’s opposition to the motion to amend). Shortly after the patent owner files a revised motion to amend, the PTAB will issue a revised scheduling order, typically along the timeline shown in Appendix 1B of the Notice (depicted below). The revised scheduling order will set the dates for: the petitioner’s opposition to the revised motion to amend; the patent owner’s reply to the opposition to the revised motion to amend and motions to exclude; the petitioner’s sur-reply relating to the revised motion to amend; and, the oral hearing.

## APPENDIX 1B (REVISED MTA TIMELINE)



## Authors

Joel R. Merkin

Partner / Chicago

## Related Services

## Practices

- [Intellectual Property](#)
- [Patent Infringement Litigation](#)
- [Patent Office Post-Grant Review Proceedings](#)

## Suggested Reading

- [15 May 2019 Kirkland Seminar The 26th Annual Technology & Law Seminar](#)
- [20 March 2019 Press Release Kirkland Represents GTCR in Partnership to Form Corza Health, Inc.](#)
- [14 March 2019 Speaking Engagement PLI's Advanced Copyright Law 2019: Current Issues](#)

This publication is distributed with the understanding that the author, publisher and distributor of this publication and/or any linked publication are not rendering legal, accounting, or other professional advice or opinions on specific facts or matters and, accordingly, assume no liability whatsoever in connection with its use. Pursuant to applicable rules of professional conduct, portions of this publication may constitute Attorney Advertising.

© 2019 KIRKLAND & ELLIS LLP. All rights reserved