



## **MBHB *snippets* Alert**

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### **PTO Announces Current and Anticipated "Quick-Fix" Changes to PTAB Practice**

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On Friday, March 27, Director Lee issued a statement on the PTO Blog, indicating several current and proposed "quick-fix" rule changes. Immediate changes include nearly doubling the number of pages for a motion to amend to up to 25 pages, along with the addition of a claims appendix. Opposition briefing and reply briefing will get a commensurate amount of additional pages. Judges will begin implementing these changes through scheduling orders effective immediately.

Upcoming anticipated rule changes (second "quick-fix" rule changes) include:

- Modifying the motion to amend process;
- Adjustments to the evidence a patent owner can provide in a preliminary response; and
- Clarification of the claim construction standard as applied to expired patents in AIA proceedings.

Other rule changes under consideration include:

- Adjustments to the scope of additional discovery;
- How to handle multiple proceedings before the Office involving the same patent;
- Use of live testimony at oral hearings;
- Whether the parties should be required to make a certification with their filings similar to a Rule 11 certification in district court litigation;
- For motions to amend, emphasizing that a motion for a substitutionary amendment will always be allowed to come before the Board for consideration (i.e., be "entered");

- For amendments to result in the issuance (“patenting”) of amended claims, a patent owner will not be required to make a prior art representation as to the patentability of the narrowed amended claims beyond the art of record before the Office;
- Changes to the Trial Practice Guide to clarify usage of live testimony and to emphasize the importance of real-party-in-interest discovery; and
- A single-judge pilot program where the single judge would make the decision on whether to institute a trial.

Director Lee’s full blog posting is available at <http://www.uspto.gov/blog/>

For up-to-date information on IPR, PGR and CBM Info, visit MBHB’s [PTAB TRIALS](#) group on LinkedIn.

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