



July 24, 2023

Miriam L. Quinn, Acting Senior Lead Administrative Patent Judge
Melissa Haapala, Vice Chief Administrative Patent Judge
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Submitted via: https://www.regulations.gov

Dear Judges Quinn and Haapala:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the USPTO's request for comments, published on May 23, 2023, in the Federal Register, concerning the Motion To Amend Pilot Program and Rules of Practice To Allocate the Burdens of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board.

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Our responses to questions posed by the USPTO in the request for comments are below.

(1) Has the MTA Pilot Program positively or negatively impacted a patent owner's ability to successfully amend claims in an AIA proceeding? Has it made it more likely that a patent owner will avail itself of the MTA process?

The answers to these questions would be best informed by an eighth installment of PTAB's MTA Study. Based on the most recent installment, which reflects data through March 31, 2022,1 the MTA Pilot Program has had limited impact on patent owners' ability to successfully amend claims in an AIA proceeding.

1 https://www.uspto.gov/sites/default/files/documents/IQ824409MTADataStudy.pdf

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The MTA Pilot Program has made it more likely that a patent owner will consider filing an MTA. As of March 31, 2022, pilot MTAs were filed in 11% of trials, whereas MTAs were filed in only 10% of pre-pilot trials. Moreover, 25% of pilot MTAs have been granted or granted-in-part, whereas only 14% of pre-pilot MTAs were granted or granted-in-part.

**(2) Are there circumstances in which reexamination and/or reissue proceedings are better options for patent owners seeking to amend claims challenged in an AIA proceeding, as compared to the MTA Pilot Program? Is there anything more the Office can do to make the MTA process more useful to patent owners?**

The MTA Pilot Program provides patent owners preliminary guidance resulting in increased success, but the patent owner success rate remains low as compared to reexamination and reissue proceedings because it does not allow for a complete examination of the amended claims. Patent owners need more time to consider the art applied against the claims, potential amendments, available evidence of secondary considerations, and to engage in the necessary back and forth of claim examination. The MTA Pilot Program does not provide patent owners with this back and forth required to arrive at claims of the appropriate scope. APJs are not examiners, and the time needed for a proper examination of claims is not compatible with the statutory deadline on Final Written Decisions. Because the process is conducted within the AIA proceeding, it significantly adds to the cost of the proceeding.

For all but the most minor amendments, reexamination and/or reissue proceedings are likely to be better avenues for amending claims because they provide patent owners with sufficient time to consider the art, potential claim amendments, and evidence of secondary considerations and engage to in the back and forth of claim examination with an examiner.

**(3) Should the Office modify any aspect of the MTA Pilot Program? Should the Office continue to provide the options of receiving preliminary guidance and being able to revise an MTA, as currently implemented?**

The Office could consider offering more time for the MTA process. At the request of either party, the schedule could include an optional conference call with the panel shortly after the Preliminary Decision on the MTA to discuss whether changes to the default schedule are warranted. The panel could schedule the call as soon as possible after a request. The parties could meet and confer in good faith before the call; if they reach an agreement, they could provide the panel with a proposed modified schedule before the call. The panel could consider whether the patent owner intends to file a revised MTA when adjusting the schedule.

**(4) Assuming the MTA Pilot Program should remain, should any aspect of preliminary guidance, as currently provided by the Board, be changed?**

We have no suggestions for changes to preliminary guidance.

**(5) What barriers, if any, exist that the Office can address to increase the effectiveness of the MTA procedure?**

See response to Question 3.

**(6) Should the Office modify its practice of when the Board can or should raise a new ground of unpatentability, and if so, how? For example, should the PTAB's decision in the *Hunting Titan* case continue to guide when and how the Board can and should raise a new ground of unpatentability? If so, why and how?**

In most circumstances, the Board will not need to raise its own arguments of unpatentability because the adversarial system creates an incentive for a petitioner to set forth reasons why proposed substitute claims are unpatentable. Where the adversarial system fails to provide the Board with potential arguments for the unpatentability of the proposed substitute claims, such as where a petitioner chooses not to participate or oppose a motion to amend, the Board can and should raise a new ground of unpatentability to ensure that the amended claims undergo review prior to a decision being made by the Board. In these circumstances, it is important that the patent owner is afforded the opportunity to respond to that evidence and related grounds of unpatentability consistent with the principles of due process.

**(7) Should the Office involve patent examiner assistance in relation to MTAs? Should the Office conduct a prior art search in relation to proposed substitute claims in certain situations? If so, under what circumstances? And should examiner assistance or prior art searches be limited in any way?**

Because the statutory deadline for the FWD does not permit the typical examination timelines for prior art searching and Office Actions, the USPTO should not conduct a prior art search or involve an examiner unless those things can be done on expedited bases with guaranteed timelines consistent with the statutory deadline.

**(8) Should the Office clarify in its rules where the burden of persuasion for Board-raised grounds lies? Who should bear that burden?**

Rules 42.121 (IPRs) and 42.221 (PRGs) allocate the burden of persuasion in inter partes review and post grant review proceedings. The rules are identical, and read as follows:

(d) Burden of Persuasion. On a motion to amend:

(1) A patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of this section;

(2) A petitioner bears the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable; and

(3) Irrespective of paragraphs (d)(1) and (2) of this section, the Board may, in the interests of justice, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record. In doing so, the Board may make of record only readily identifiable and persuasive evidence in a related proceeding before the Office or evidence that a district court can judicially notice. Where the Board exercises its discretion under this paragraph, the parties will have an opportunity to respond.

The patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of the rule. The petitioner should bear the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable. In the case of a Board-raised ground, the Board should bear the burden of persuasion to show, by a preponderance of the evidence, that any proposed substitute claims are unpatentable.

**(9) Should any other aspects of the MTA rules ([37 CFR 42.121](#), [42.221](#)), including as they relate to the Board's discretion to grant or deny an MTA, be changed, and if so, how?**

IPO does not recommend any other aspect of Rules 42.121 and 42.221 be changed.

We again thank the USPTO for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,

A handwritten signature in black ink, appearing to read 'Karen Cochran', is written over a light gray rectangular background.

Karen Cochran  
President