



May 3, 2024

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 Notice of Proposed Rulemaking concerning "Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board."

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

Our responses to the proposed rulemaking are below.

(1) Proposed Provisions on Preliminary Guidance and Revised Motions to Amend

IPO agrees that the Motion to Amend ("MTA") Pilot Program has been generally well-received. The options to request preliminary guidance and file revised MTAs have been popular among those participating in MTAs and have had a positive effect in guiding patent owners to revise their MTAs. For these reasons, IPO agrees that the final rule should offer options for obtaining preliminary guidance and revised MTAs.

Notwithstanding the above, the MTA Pilot Program has had only a limited impact on patent owners' abilities to successfully amend claims in an AIA proceeding. As of March 31, 2023, pilot MTAs were filed in 9% of pilot-eligible trials, whereas pre-pilot program MTAs were filed in 10%

- President Krish Gupta Dell Technologies
Vice President John Cheek Tenneco Inc.
Treasurer Yen Florczak 3M Innovative Properties Co.
Directors Steve Akerley InterDigital, David Alban Xylem, Brett Aiten Hewlett Packard Enterprise, Matthew Anderson Medtronic, Inc., Ron Antush Nokia of America Corp., Estelle Bakun Exxon Mobil Corp., Scott Barker Micon Technology, Inc., Thomas Beall Corning Inc, Tyrome Brown Dolby Laboratories, Karen Cochran Shell USA, Inc., Tonya Combs Eli Lilly and Co., Anthony DiBariolomeo SAP SE, Daniel Enebo Cargill Inc., Andrea Evensen Danaher Corp., Louis Foreman Enventys, Scott M. Frank AT&T, Darryl P. Frickey Dow Chemical Co., Tanuja Garde The Boeing Co., Mike Geise General Mills, Inc., Robert Giles Qualcomm, Inc., Laura Ginkel Merck & Co., Inc., Henry Hadad Bristol-Myers Squibb Co., Scott Hayden Amazon, Thomas R. Kingsbury Bridgestone Americas Holding Co., Laurie Kowalsky Koninklijke Philips N.V., Christine Lam NetApp, Hsin Lin The Goodyear Tire & Rubber Co., Alexander Long GE Aerospace, Ceyda Maisami HP Inc., Aseem Mehta Bayer Intellectual Property GmbH, Kelsey Milman Caterpillar Inc., Jeffrey Myers Apple Inc., Robin Nava SLB, Troy Prince RTX Corporation, Kaveh Rashidi-Yazd Eaton Corp., Corey Salsberg Novartis, Matthew Sarbaroria Oracle Corp., Derek Scott Roche, Inc., Laura Sheridan Google Inc., Jessica Sinnott DuPont, Thomas Smith GlaxoSmithKline, Gillian Thackray Thermo Fisher Scientific, Brian Tomko Johnson & Johnson, Mark Vallone IBM, Corp., Stuart Watt Amgen, Inc., Bryan Zielinski Pfizer Inc., General Counsel Lauren Leyden Akin Gump Strauss Hauer & Feld LLP, Executive Director Jessica K. Landacre

of trials.<sup>1</sup> Moreover, 24% of pilot MTAs have been granted or granted-in-part, whereas only 14% of pre-pilot MTAs have been granted. IPO believes that although options for obtaining preliminary guidance and revised MTAs are a step forward for patent owners, further improvements are needed.

## **(2) Comments on the Schedule of the MTA Process**

To address concerns about parties' ability to have sufficient time to fully take advantage of the MTA procedure, the Office proposes rule language clarifying that the Board may extend deadlines in the MTA timeline. However, the Office suggests that such extensions are not anticipated to be needed in most cases because, in the Board's experience, default timelines are sufficient to permit full and fair briefing in cases under the MTA pilot program. Thus, the Office proposes continuing to use the existing timelines by default as currently implemented under the MTA pilot program, unless an extension of the deadline for issuing a final written decision is granted upon a showing of good cause.

IPO agrees that MTA-related complexity can constitute "good cause" under 35 U.S.C. § 316(a)(11). However, instead of waiting for a party to request authorization to move for an extension of the deadline, the Office should develop a process for proactively addressing the schedule when the MTA process is initiated. 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 to provide sufficient time for the parties to prepare filings. The panel should schedule the call as soon as possible after a request. The parties should meet and confer in good faith before the call; if they reach an agreement, they should provide the panel with a proposed modified schedule before the call. The panel should consider whether the patent owner intends to file a revised MTA when adjusting the schedule.

## **(3) Comments on the Reissue and Reexamination**

The proposed rulemaking addresses comments in the 2023 RFC regarding whether reexamination and/or reissue proceedings are better options for patent owners seeking to amend claims in AIA proceedings. In response, the proposed rules codify the MTA process and do not change the Office's current guidance in reissue and reexamination practice as they relate to AIA proceedings.

The proposed rules provide patent owners preliminary guidance resulting in increased success, but the patent owner success rate remains low compared to reexamination and reissue proceedings. AIA proceedings provide patent owners less 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. In some instances, the proposed rules may not provide patent owners with additional time for the back and forth required to arrive at claims of the appropriate scope. Administrative patent judges are not examiners, and the time needed for a proper examination of claims is not always compatible with the statutory deadline on Final Written

---

<sup>1</sup> See *PTAB Motion to Amend Study: Installment 8*, USPTO, [https://www.uspto.gov/sites/default/files/documents/mta\\_installment\\_8\\_.pdf](https://www.uspto.gov/sites/default/files/documents/mta_installment_8_.pdf) (last visited May 1, 2024).

Decisions. Further, because the process is conducted within the AIA proceeding, it significantly adds to the cost of the proceeding.

In many circumstances, reexamination and/or reissue proceedings may 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, engage in the back and forth of claim examination with an examiner, and do not delay issuance of the Final Written Decision in the AIA proceeding.

#### **(4) Proposed Provisions on Board's Discretion to Raise New Grounds of Unpatentability Allocation of Burden and Evidence of Record for Proposed Amended Claims**

The proposed rulemaking recognizes that commenters favored continuing the exercise of discretion by the Board to raise new grounds of unpatentability. The proposed rulemaking further recognized the divergence in views over the scope of discretion and the Board's ability to conduct a prior art search or seek examination assistance. As reported in the proposed rulemaking, some favor broader discretion for the Board to consider all prior art of record and conduct a prior art search in each case where an MTA is filed. Others do not favor the Board conducting a prior art search. The Office proposes changes that allow the Board to consider the entirety of the record and to request examination assistance by having the Office conduct a prior art search when justified by circumstances. Such circumstances may include when a petitioner fails to oppose an MTA or ceases to participate in the proceeding altogether.

In some 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 an MTA, the Board should ensure that the amended claims undergo review prior to a decision being made by the Board and, if applicable, raise a new ground of unpatentability. In these circumstances, it is important that the patent owner is afforded the opportunity to respond to that evidence and related grounds of unpatentability, and the petitioner is provided an opportunity to respond, consistent with principles of due process.

#### **(5) Proposed Provisions on Allocation of Burden**

Proposed Rules 42.121 (IPRs) and 42.221 (PRGs) allocate the burden of persuasion in inter partes review and post grant review proceedings. IPO agrees that to the extent the Board uses its discretion to raise a new ground of unpatentability, the Board should determine unpatentability on a preponderance of the evidence of record.

Sincerely,



Krish Gupta  
President