

USPTO To Extend Amendment Timeline As AIA Pilot Launches

By **Tiffany Hu**

Law360 (March 14, 2019, 6:53 PM EDT) -- The U.S. Patent and Trademark Office is set to launch a pilot program Friday aimed at making it easier to amend patents in America Invents Act reviews, with the patent office revising the program to give owners more time in the amendment process.

A notice of the finalized pilot program, which will be published Friday in the Federal Register, addresses **earlier concerns** over the tight deadlines to prepare and submit briefs and other evidence once a patent owner decides to file a revised claim amendment.

The Patent Trial and Appeal Board now issues decisions on motions to amend at the end of the review of a patent's validity. But under the new program, patent owners can seek initial guidance from the board on their motion to amend the patent claims, or file a revised motion after receiving the petitioner's opposition to their original bid and the PTAB's guidance, if requested, according to the notice.

While patent owners have now been given more time to take depositions and prepare declarations after filing the motion, there's still an "enormous amount" of work to do during that time, Latham & Watkins LLP partner Bob Steinberg told Law360 on Thursday.

"There's still compressed time, but it's further spread apart at the end of the process," Steinberg said, noting that oral hearing has been pushed back to 10 months, instead of nine months, with the latest iteration of the new rules. "It doesn't fix the fact that it's still compressed, though, there's still a lot to do. It's going to be a lot of work for both parties."

If a patent owner does not choose either option, then the amendment process will essentially remain the same as the current practice, according to the notice.

After the patent office **first announced** the new plan in October, the proposed changes were welcomed by major intellectual property groups and denounced by the technology industry in recent public comments.

While groups like the Intellectual Property Owners Association and the American Intellectual Property Law Association said that they supported the effort to make amendments a more viable option, they voiced concerns over the short deadlines given to prepare filings and evidence.

This concern was shared by groups representing the technology industry, which often uses AIA reviews to challenge patents, who were critical of the plan to make it easier to amend patents and argued that the tight deadlines will only make matters worse.

"The added burden on an already heavily burdened board will lead to delay and impede the board's ability for timely resolution of its trial and appellate docket," the Internet Association, which includes Microsoft Corp., Facebook Inc. and others, said at the time.

The USPTO had then announced that it would implement a pilot program applying the new rules in every newly implemented review "shortly after" the comment deadline. The agency said in its notice that it will reassess the program in about a year and, if it's not working as intended, it can change or even end it.

--Additional reporting by Ryan Davis. Editing by John Campbell.

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