



Andrei Iancu, Co-Chair  
David Kappos, Co-Chair  
Judge Paul Michel (Ret.), Board Member  
Judge Kathleen O'Malley (Ret.), Board Member  
Frank Cullen, Executive Director

May 3, 2024

**Via Electronic Submission**

The Honorable Katherine K. Vidal  
Under Secretary of Commerce for Intellectual Property and Director  
of the United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Dear Director Vidal,

The Council for Innovation Promotion (C4IP) is pleased to submit this response to the March 4, 2024, Notice of Proposed Rulemaking (NPRM) regarding the Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board (Docket No. PTO-P-2020-0060).

C4IP is a bipartisan coalition dedicated to promoting strong and effective intellectual property rights that drive innovation, boost economic competitiveness, and improve lives everywhere. Founded and chaired by former directors of the U.S. Patent and Trademark Office from previous Democratic and Republican administrations, our nonprofit organization aims to be a valued partner to those considering policies impacting America's intellectual property system.

In March of 2019, the United States Patent and Trademark Office (USPTO) implemented a new Motion to Amend (MTA) Pilot program after receiving significant feedback from the public regarding the inability of patent owners to successfully amend during post-grant proceedings.<sup>1</sup> The MTA Pilot Program improved the Board's rate of granting at least one claim entry in the final determination from 14% to 24%, based on data collected between the start of the pilot program through March 31, 2023.<sup>2</sup>

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<sup>1</sup> USPTO, *Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board*, 84 FR 9497 (Mar. 15, 2019).

<sup>2</sup> USPTO, *PTAB Motion to Amend Study 18* (updated March 31, 2023), [https://www.uspto.gov/sites/default/files/documents/mta\\_installment\\_8\\_.pdf](https://www.uspto.gov/sites/default/files/documents/mta_installment_8_.pdf).

The NPRM proposes to revise 37 C.F.R. §§ 42.121 and 42.221 to codify the two options offered under this pilot program (i.e., allowing a patent owner to seek preliminary Board guidance on a motion to amend and being allowed to submit a revised motion to amend) while streamlining certain aspects of it and making select changes. In most regards, C4IP believes that the USPTO's NPRM strikes the right balance between allowing for a robust amendment process in accord with the original policy goals of the MTA Pilot program and the Leahy-Smith America Invents Act of 2011 (AIA) by allowing for a fair process to hear from both patent owner and petitioner regarding the patentability of substitute claims, in keeping with the adversarial process created by this landmark legislation. In this sense, the NPRM should contribute to the stability, predictability, and strength of the United States intellectual property system.

However, C4IP has concerns with the proposed changes to 37 C.F.R. §§ 42.121(d)(3) and 42.221(d)(3) along with the de-designation of *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*.<sup>3</sup> The proposed changes would give the Board unfettered discretion to advance objections to proposed amended claims -- even in the context of zealous advocacy for and against an amendment. To be sure, even the Board's rule in *Hunting Titan* would allow new grounds of rejection in such a case "in the interests of justice," but *Hunting Titan* also made clear that the Board should not abandon its role as a neutral arbiter between adverse parties in favor of an inquisitorial role routinely absent a particularized need.

The degree of discretion the proposed rule would grant the Board seems particularly disproportionate in light of what a patent owner already must show, and the burdens of persuasion it must bear, when attempting to amend claims. Title 35 provides that proposed amended claims "may not enlarge the scope of the claims of the patent or introduce new matter."<sup>4</sup> USPTO rules further require patent owners to bear the burden of persuasion in meeting these requirements as well as the USPTO rule that the amendment must respond to a ground of unpatentability raised in the trial.<sup>5</sup> These statutory and regulatory requirements limit the scope of potential amendments considerably, which can be justified given that these new claims are not being re-examined completely in the first instance. But these safeguards call into question the need for wide-ranging discretion of the Board to propose further new rejections to such amendments of limited scope.

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<sup>3</sup> No. IPR2018-00600 (PTAB, July 6, 2020) (Paper 67).

<sup>4</sup> 35 U.S.C. § 316(d)(3).

<sup>5</sup> 37 C.F.R. §§ 42.121(d)(1), 42.221(d)(1) (burden of persuasion); 42.121(a)(2)(i), 42.221(a)(2)(i) (responding to a ground of unpatentability involved in the trial).

Along with the expansion of the Board's discretion, the proposed changes to 37 C.F.R. §§ 42.121(d)(3) and 42.221(d)(3) broaden the scope of what the Board may consider from "only readily identifiable and persuasive evidence in a related proceeding before the Office" to "[a]ny evidence in a related proceeding before the Office." Again, this change seems unnecessary in light of the limitations already imposed on the IPR and PGR amendment process, particularly the rule that an amendment must respond to a ground of patentability raised in the proceeding. Presumably, the petitioner (even if no longer present in the case) had sufficient incentive to find prior art that was persuasive enough to have the Board institute the proceeding, and the rules require an amendment to be responsive to a ground raised by this art. It is unclear, therefore, why the Board needs a hunting license to go through all prior art that may have been cited in an IDS during original prosecution, for example. It comes close to implying that the Board *should* do such an analysis when substantive examination is not contemplated by the governing statutes as a routine part of the process for amendments in post-grant proceedings. This implication, in turn, would seem to put pressure on the Board to come up with rejections even when the adversarial process has not.

In sum, the proposal to give the Board unlimited discretion to issue new rejections, along with the suggestion that the Board should dig deeply into the records of other proceedings, will disadvantage patent owners seeking to save patentable claim scope under the currently available, narrowly circumscribed parameters. It does not seem to provide a clear upside, given the already robust adversarial opposition to the amendment process in most cases. The rules change considerably broadens the uncertainty for a patent owner that any proposed amendment might be successful, and it threatens to undermine the adversarial nature of these proceedings by turning both the petitioner and the Board into a patent owner's adversaries. This change goes against the spirit of the Leahy-Smith America Invents Act, which allowed claim amendments as part of these proceedings in the first place to ensure that patent owners could emerge from a proceeding with an appropriately-scoped patent, and weakens the ability of a patent to protect an inventor's innovation.

C4IP urges the USPTO to consider adding limiting language to this part of the proposed rules to make clear that intervention is not needed or expected in run-of-the-mine proceedings. Such a change will give patent owners a more meaningful opportunity to save patentable claim scope and will provide greater certainty for patent owners and petitioners alike. C4IP also strongly suggests that the USPTO keep the current regulatory limitation that the Board may consider "only readily identifiable and persuasive evidence in a related proceeding before the Office" in keeping with the existing statutory and regulatory limitations that circumscribe what amendments may be offered, and in order to provide greater predictability to the parties on the scope of the Board's discretion.

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Establishing a strong and reliable patent system for innovators and the public is an indispensable component to growing the economy and improving the quality of life for Americans and people worldwide. Ensuring that there is a balanced and judicious claim amendment process for parties to IPR and PGR proceedings is a narrow, but vital, part of this overall scheme. As such, C4IP thanks the USPTO for their work on this important issue and stands ready to provide any further input that may be requested.

Sincerely,

A handwritten signature in black ink, appearing to read "Frank Cullen", is positioned below the word "Sincerely,".

Frank Cullen  
Executive Director  
Council for Innovation Promotion (C4IP)