Patent Trial and Appeal Board Issues Updated Rules for Post-Issuance Proceedings

April 6, 2016

DC Client Alert - April 2016

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On March 31, 2016, the U.S. Patent and Trademark Office updated the rules of its Patent Trial and Appeal Board (PTAB) for inter partes review, post-grant review, and covered business method patent proceedings. These most recent rule changes could shift the calculus of challenging patents before the PTAB and could alter the timing in which a patent owner files suit.

Notable rules changes include the following:

• New testimonial evidence can now be submitted with a patent owner's preliminary response;
• A Rule 11-type certification must now be filed with papers filed in a proceeding, exposing attorneys to possible sanctions for failing to conduct an adequate pre-filing investigation;
• Certain situations now call for a narrower, district court-like claim construction that could reduce the number of patents found unpatentable; and
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Some of these changes will have greater impact than others, the scope of which will take time to be seen. Nonetheless, the change that allows a patent owner to file testimonial evidence with its preliminary response and potentially narrowed claim constructions will undoubtedly alter strategies employed by both parties.

Continued PTAB rule changes will impact the way parties assert patents and defend against alleged patent infringement. These new rules may change the strategies that have been evolving over the last several years. Litigants must fully consider their options during patent lawsuits to fully leverage the most advantageous options to reach their desired outcome.

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