

# Proposed USPTO Rules for Post Grant Review

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## Subpart C—Post-Grant Review

### § 42.200 Procedure; pendency

- (a) A post-grant review is a trial subject to the procedures set forth in subpart A of this part.
- (b) A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.
- (c) A post-grant review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge.
- (d) Interferences commenced before September 16, 2012, shall proceed under part 41 of this chapter except as the Chief Administrative Patent Judge, acting on behalf of the Director, may otherwise order in the interests of justice.

### § 42.201 Who may petition for a post-grant review

A person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent unless:

- (a) Before the date on which the petition for review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent; or
- (b) The petitioner, the petitioner's real party in interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition.

### § 42.202 Time for filing.

- (a) A petition for a post-grant review of a patent must be filed no later than the date that is nine months after the date of the grant of a patent or of the issuance of a reissue patent. A petition, however, may not request a post-grant review for a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued unless the petition is filed not later than the date that is nine months after the date of the grant of the original patent.
- (b) The Director may impose a limit on the number of post-grant reviews that may be instituted during each of the first four one-year periods in which 35 U.S.C. 321 is in effect by providing notice in the Office's Official Gazette or **Federal Register**. Petitions filed after an established limit has been reached will be deemed untimely.

### § 42.203 Post-grant review fee

- (a) A post-grant review fee set forth in § 42.15(b) must accompany the petition.
- (b) No filing date will be accorded to the petition until full payment is received.

### §42.204 Content of petition.

In addition to the requirements of §§ 42.8 and 42.22, the petition must set forth:

- (a) *Grounds for standing*. The petitioner must certify that the patent for which review is sought is available for post-grant review and that the petitioner is not barred or estopped from requesting a post-grant review of the patent.
- (b) *Identification of challenge*. Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:
  - (1) The claim;
  - (2) The specific statutory grounds permitted under paragraph (2) or (3) of 35 U.S.C. 282(b) on which the challenge to the claim is based;
  - (3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus- function or step-plus-function limitation as permitted under 35 U.S.C. 112, sixth paragraph, the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function;
  - (4) How the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. Where the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is found in the prior art. For all other grounds of unpatentability, the petition must

identify the specific part of the claim that fails to comply with the statutory grounds raised and state how the identified subject matter fails to comply with the statute; and

- (5) The exhibit number of the supporting evidence relied upon to support the challenge and state the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge. The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.
- (c) A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.

#### **§ 42.205 Service of petition.**

In addition to the requirements of § 42.6, the petitioner must serve the petition and exhibits relied upon in the petition as follows:

- (a) The petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.
- (b) If the petitioner cannot effect service of the petition and supporting evidence on the patent owner at the correspondence address of record for the subject patent, the petitioner must immediately contact the Board to discuss alternate modes of service.

#### **§ 42.206 Filing date.**

- (a) *Complete petition.* A petition to institute a post grant review will not be accorded a filing date until the petition satisfies all of the following requirements:
  - (1) Complies with § 42.204 or § 42.304,
  - (2) Service of the petition on the correspondence address of record as provided in § 42.205(a); and
  - (3) Is accompanied by the filing fee in § 42.15(b).
- (b) *Incomplete request.* Where a party files an incomplete petition, no filing date will be accorded and the Office will dismiss the request if the deficiency in the petition is not corrected within the earlier of either one month from the notice of an incomplete petition, or the expiration of the statutory deadline in which to file a petition for post-grant review.

#### **42.207 Preliminary response to petition.**

- (a) The patent owner may file a preliminary response to the petition. The response is limited to setting forth the reasons why no post-grant review should be instituted under 35 U.S.C. 324. The response can include evidence except as provided in paragraph (c) of this section. The preliminary response is an opposition for purposes of determining page limits under § 42.24.
- (b) *Due date.* The preliminary response must be filed no later than two months after the date of a notice indicating that the request to institute a post-grant review has been granted a filing date. A patent owner may expedite the proceeding by filing an election to waive the preliminary patent owner response.
- (c) *No new testimonial evidence.* The preliminary response shall not present new testimony evidence beyond that already of record.
- (d) *No amendments.* The preliminary response shall not include any amendment.
- (e) *Disclaim Patent Claims.* The patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a), disclaiming one or more claims in the patent. No post-grant review will be instituted based on disclaimed claims.

## **Instituting Post-Grant Review**

### **§ 42.208 Institution of post-grant review.**

- (a) When instituting post-grant review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.
- (b) At any time prior to institution of post-grant review, the Board may deny some or all grounds for unpatentability for some or all of the challenged claims. Denial of a ground is a Board decision not to institute post-grant review on that ground.
- (c) *Sufficient grounds.* Post-grant review shall not be instituted for a ground of unpatentability, unless the Board decides that the petition supporting the ground would, if un rebutted, demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable. The Board's decision will take into account a preliminary patent owner response where such a response is filed.
- (d) *Additional grounds.* Sufficient grounds under § 42.208(c) may be a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

## **After Institution of Post-Grant Review**

### **§ 42.220 Patent owner response.**

- (a) *Scope.* A patent owner may file a response to the petition addressing any ground for unpatentability not already denied. A patent owner response is filed as an opposition and is subject to the page limits provided in § 42.24.
- (b) *Due date for response.* If no date for filing a patent owner response to a petition is provided in a Board order, the default date for filing a patent owner response is two months from the date the post-grant review is instituted.

### **§ 42.221 Amendment of the patent.**

- (a) A patent owner may file one motion to amend a patent but only after conferring with the Board. Any additional motions to amend may not be filed without Board authorization.
- (b) A motion to amend must set forth:
  - (1) The support in the original disclosure of the patent for each claim that is added or amended; and
  - (2) The support in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.
- (c) A motion to amend the claims of a patent will not be authorized where:
  - (1) The amendment does not respond to a ground of unpatentability involved in the trial; or
  - (2) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

### **§42.222 Multiple proceedings.**

Where another matter involving the patent is before the Office, the Board may during the pendency of the post-grant review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

### **§ 42.223 Filing of supplemental information.**

Once a trial has been instituted, a petitioner may request authorization to file a motion identifying supplemental information relevant to a ground for which the trial has been instituted. The request must be made within one month of the date the trial is instituted.

### **§42.224 Discovery.**

Notwithstanding the discovery provisions of subpart A:

- (a) Requests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed; and
- (b) Discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding.