

# Proposed USPTO Rules for Review of Business Method Patents

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## Subpart D—Transitional Program for Covered Business Method Patents

### § 42.300 Procedure; pendency.

- (a) A covered business method patent review is a trial subject to the procedures set forth in subpart A of this part and is also subject to the post-grant review procedures set forth in subpart C except for §§ 42.200, 42.201, 42.202, and 42.204.
- (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 covered business method patent 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 by the Chief Administrative Patent Judge for good cause.
- (d) The rules in this subpart are effective until September 15, 2020, except that the rules shall continue to apply to any petition for a covered business method patent review filed before the date of repeal.

### § 42.301 Definitions.

In addition to the definitions in § 42.2, the following definitions apply to proceedings under this subpart:

- (a) *Covered business method patent* means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.
- (b) [Reserved].

### § 42.302 Who may petition for a covered business method patent review.

- (a) A petitioner may not file with the Office a petition to institute a covered business method patent review of the patent unless the petitioner, the petitioner's real party in interest, or a privy of the petitioner has been sued for infringement of the patent or has been charged with infringement under that patent.
- (b) A petitioner may not file a petition to institute a covered business method patent review of the patent where 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.

### § 42.303 Time for filing.

A petition requesting a covered business method patent review may be filed any time except during the period in which a petition for a post-grant review of the patent would satisfy the requirements of 35 U.S.C. 321(c).

### § 42.304 Content of petition.

In addition to any other notices required by subparts A and C of this part, a petition must request judgment against one or more claims of a patent identified by patent number. In addition to the requirements of § 42.22, the petition must set forth:

- (a) *Grounds for standing*. The petitioner must demonstrate that the patent for which review is sought is a covered business method patent, and that the petitioner meets the eligibility requirements of § 42.302.
- (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, paragraph 6, 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 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 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 mistake in the petition where the mistake is of a clerical or typographical nature. The grant of such a motion does not change the filing date of the petition.