

REVISION OF IPR AMENDMENT PROCESS
OVERVIEW

Working with a small group of stakeholders, and with technical assistance from the PTO, Senate staff has developed proposed statutory text responding to concerns about the existing process for amendment claims in an instituted inter partes or post grant review. The uncertainty inherent in the current amendments process has led to the general unavailability of amended claims. To help ensure that patentees have a meaningful opportunity to amend claims while protecting the interests of petitioners, patentees will be given an opportunity to prosecute such amendments through examination by the PTO rather than through motions practice before the PTAB.

Examination of an amendment. Following institution, a patentee will have the option to request that the PTO examine proposed amendments to one or more claims on which the PTAB has institute review. The PTO will then examine any such proposed amendments for patentability, using the existing model for reexamination of issued patents. The original claim on which the IPR/PGR was instituted will remain under the review of the PTAB, and a request for amendment will not be deemed an admission of unpatentability.

Interaction between examination and IPR/PGR. The examination of proposed amendment(s) may not be stayed without the patentee's consent, and the examination and the instituted IPR/PGR will proceed separately. In the context of examining a proposed amendment, however, the PTO shall consider documents from the relevant IPR/PGR, including the petition, the evidence, prior art and arguments submitted by the parties, the institution decision of the PTAB, and any final written opinion if issued during the examination of the request. This will allow the PTO to ensure that different outcomes do not occur for substantially-similar claims.

Effect of examination. Any amended claims that eventually issue from examination will be presumed to be valid (as they now are under existing law) regardless of the outcome of the IPR/PGR. Moreover, intervening rights will apply to any such claims; so infringement liability will only issue from the time the amended claim itself issues. Petitioners will not be estopped by the outcome of the IPR/PGR from challenging amended claims issued from examination in future proceedings before the Office or in the courts.

Permissible changes in an IPR/PGR. There will be only two ways for a patentee to change the scope of a claim before the PTAB. First, a patentee will continue to be permitted to cancel claims. Second, the PTAB may grant a motion to amend on the joint request of both parties in order to materially advance settlement of an IPR/PGR. The PTAB will continue to review any such motions and determine whether they should be granted on a case-by-case basis.

###

Under this approach, patentees will obtain new levels of predictability and certainty, based on substantial experience with existing examination practice, about how amended claims can be obtained once an IPR/PGR has been instituted. Current and potential petitioners will be protected from unexamined claims being added to patents and unfair gamesmanship by patentees seeking to subvert the adversarial PTAB proceedings. And PTAB proceedings will be streamlined with the removal of consideration of contentious, and rarely granted, motions to amend.