



## American Intellectual Property Law Association

July 24, 2023

The Honorable Kathi Vidal  
Under Secretary of Commerce for Intellectual Property and  
Director of U.S. Patent and Trademark Office  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Via Online Submission: *Regulations.gov*

**Re: Request for Comments Regarding the Motion To Amend Pilot Program and Rules of Practice To Allocate the Burdens of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board [Docket No. PTO-P-2023-0024]**

Dear Director Vidal:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to present its views to the United States Patent and Trademark Office (“Office”) on the Motion to Amend Pilot Program and Rules of Practice to Allocate the Burdens of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, published in 88 Fed. Reg. 33063 (May 23, 2023).

AIPLA is a national bar association of approximately 7,000 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA appreciates the Office’s efforts to improve AIA trial proceedings, which have become pervasive since their initial implementation in September 2012. On several prior occasions, AIPLA has expressed its concerns with the existing motions to amend (“MTA”) practice and procedure<sup>1</sup>, and especially appreciates the Office’s attempt to improve this practice and make

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<sup>1</sup> AIPLA, Response to the Request for Comments on “Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board” (Oct. 16, 2014), [https://www.aipla.org/docs/default-source/advocacy/documents/aipla-comments-to-uspto-on-aia-trial-proceedings-before-ptab-10-16-14-\(1\).pdf](https://www.aipla.org/docs/default-source/advocacy/documents/aipla-comments-to-uspto-on-aia-trial-proceedings-before-ptab-10-16-14-(1).pdf); AIPLA, Comments on Proposed PTAB Rules (Oct. 21, 2015), <https://www.aipla.org/docs/default-source/advocacy/documents/2015/aipla-comments-on-proposed-ptab-rules-2015-1021.pdf>; AIPLA, Response to the Request for Comments on “PTAB Procedural Reform Initiative” (July 14, 2017), <https://www.aipla.org/docs/default-source/advocacy/documents/aipla-letter-on-ptab-procedures-7-14-201797eaf6c385ba4bb2adfdc2941f7aad81.pdf>; AIPLA Amicus Brief in *In re Aqua Products*,

MTAs, as contemplated by the statute, a more viable option as part of a trial proceeding. While the current proposal presents some challenges to both patent owners and petitioners, especially in terms of timing and expense, AIPLA generally supports the proposed procedures for handling MTAs. We address selected issues with the proposal in the comments that follow.

**1. Has the MTA Pilot Program positively or negatively impacted a patent owner’s ability to amend claims successfully in an AIA proceeding? Has it made it more likely that a patent owner will avail itself of the MTA process?**

It is unclear. The Office irregularly publishes data on the MTA process.<sup>2</sup> To the best of our knowledge, the Office has not released data on the MTA Pilot Program since March 2022. Thus, the Office’s public data on the MTA process is over a year out of date. Up to date data is needed to assess whether the MTA Pilot Program positively or negatively impacts a patent owner’s ability to amend claims successfully. This, in turn, would make it more or less likely that a patent owner would avail itself of the MTA process. As the USPTO has recognized, there are many reasons patent owners may choose not to participate in the MTA process. These could include uncertainty, expense, delay, and intervening rights, which could preclude recovery of past infringement damages.

Regardless of whether patent owners use the MTA process, the process should be fair and provide a predictable method with a reasonable probability of success in amending claims during AIA proceedings. Early statistics on the MTA Pilot Program showed that the program initially helped patent owners achieve better success rates when filing MTAs. December 2020 data reflects the success rate for MTAs rose from 14% before the MTA Pilot Program to 36%.<sup>3</sup>

As of March 2022, however, patent owner success rates during the MTA Pilot Program dropped to 25%. And MTA filings decreased each year during the MTA Pilot Program.<sup>4</sup> So, the available data do not provide a clear answer to this question. The unavailability of an effective means to amend claims distinguishes the current USPTO system from EPO opposition practice, which regularly enables claim amendment and is generally regarded as effective.

**2. Are there circumstances in which reexamination and/or reissue proceedings are better options for patent owners seeking to amend claims challenged in an AIA proceedings, as compared to the MTA Pilot Program? Is there anything more the Office can do to make the MTA process more useful to patent owners?**

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[https://www.aipla.org/docs/default-source/uploadedfiles/documents/advocacy/judicial/2016/documents/aqua-filed.pdf?sfvrsn=ef3c94eb\\_1](https://www.aipla.org/docs/default-source/uploadedfiles/documents/advocacy/judicial/2016/documents/aqua-filed.pdf?sfvrsn=ef3c94eb_1); AIPLA, Comments on Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board (Dec. 20, 2018), [https://www.aipla.org/docs/default-source/advocacy/documents/aipla\\_ptab\\_trial\\_committee\\_motion\\_to\\_amend\\_comments-2018dec20final.pdf?sfvrsn=b5bb902f\\_0](https://www.aipla.org/docs/default-source/advocacy/documents/aipla_ptab_trial_committee_motion_to_amend_comments-2018dec20final.pdf?sfvrsn=b5bb902f_0); AIPLA, Comments on Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the PTAB (Dec. 23, 2019), <https://www.aipla.org/detail/advocacy-article/aipla-comments-to-uspto-on-rules-of-practice-to-allocate-the-burden-of-persuasion-on-motions-to-amend-in-trial-proceedings-before-the-patent-trial-and-appeal-board> (“Persuasion”).

<sup>2</sup> USPTO, Motion to Amend Studies, <https://www.uspto.gov/patents/ptab/motions-amend-study> (“MTA Study”).

<sup>3</sup> USPTO, Patent Trial and Appeal Board Boardside Chat: SOP2-related forms, Motion to Amend (MTA) Pilot Program, Preliminary Results, and Multiple Petitions Study Update (Dec. 10, 2020), <https://www.uspto.gov/sites/default/files/documents/12720201212020BoardsideChatMultiplePetitionMTAStudyandSOP2relatedforms.pdf>.

<sup>4</sup> USPTO, Patent Trial and Appeal Board Motion to Amend (MTA) Study, <https://www.uspto.gov/sites/default/files/documents/IQ824409MTADataStudy.pdf>.

Yes. Reissue and reexamination proceedings initiated by a patent owner remain important alternatives and provide a clear benefit to patent owners—the petitioner has limited or no involvement in such proceedings. These three options are not synchronized or coordinated; once an IPR is filed, any reexamination or reissue is typically stayed. The patent owner may not be able to use these alternatives effectively, if at all.

The Office’s most recently posted *Ex Parte* Reexamination Filing Data show that, through September 30, 2020, about 70% of certificates issued after patent-owner requested reexamination include changed claims.<sup>5</sup> This data, although outdated, shows that patent owners have a substantially higher probability of obtaining claim amendments through reexamination than they do through the MTA Pilot Program.

Participation in the MTA process is likely to continue to decline unless patent owner success rates improve. In response to Question 7, AIPLA proposes an “off ramp” that may make the MTA process more comparable to the well-established reexamination process and more useful to and popular among patent owners. AIPLA notes that current practice at the Office is to stay reexamination and reissue requests filed during AIA trial proceedings. This practice discourages patent owners from using reexamination and reissue proceedings that could otherwise provide an effective avenue for amending claims.

**3. Should the Office modify any aspect of the MTA Pilot Program? Should the Office continue to provide the option of receiving preliminary guidance and being able to revise an MTA, as currently implemented?**

Yes. AIPLA’s letter regarding the Request for Comments on 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-2018-0062], dated December 20, 2018, supported having a preliminary non-binding decision by the Board and providing patent owners with a second opportunity to amend their claims. Our comments reflect the belief that providing such guidance and flexibility should help make MTAs more viable than they have been under the current procedure.

As of March 2022, Office data establishes that preliminary guidance requests have been popular among those participating in MTAs and have been effective, causing patent owners to revise their MTA in many cases.

Consistent with our earlier comments from December 2018, and supported by the Office’s data, we believe the Office should continue providing the option of receiving preliminary guidance and being able to revise an MTA, at least as currently implemented.

**4. Assuming the MTA Pilot Program should remain, should any aspect of preliminary guidance, as currently provided by the Board, be changed?**

Yes. Before filing a MTA, patent owners need sufficient time to cross-examine declarants. In opposing a MTA, petitioners need sufficient time to conduct additional prior art searches and prepare responses and testimonial evidence. The parties should have increased flexibility in modifying deadlines. To accommodate this flexibility, where good cause is established, the Board should be willing to extend beyond 12 months the timeframe for a final written decision.

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<sup>5</sup> USPTO, *Ex Parte* Reexamination Filing Data - September 30, 2020, [https://www.uspto.gov/sites/default/files/documents/ex\\_parte\\_historical\\_stats\\_roll\\_up\\_21Q1](https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_roll_up_21Q1).

The Board has statutory authority to extend this timeframe an additional six months. This authority has rarely been exercised. We believe that this discretion should be exercised more freely for certain MTAs. Extending the schedule should not be the norm; nonetheless, good cause may exist for short extensions to accommodate witness/declarant availability, among other issues. AIPLA recognizes that undue extensions schedules may adversely impact co-pending litigation. Yet, parties should be afforded some flexibility to propose mutually agreed schedules, and for good cause shown, the Board should be willing to enter modified schedules.

The Board may be reluctant to extend the proceedings automatically out of concern that patent owners would make these filings solely to delay. Yet, it is unlikely that patent owners would pursue a meritless MTA simply to delay IPR proceedings by a month or two. It is too risky because of potential intervening rights associated with any substantive amendment. The concern about gamesmanship by patent owners is substantially outweighed, in our opinion, by the potentially positive impact claim amendments have on the patents at issue. While we appreciate that an automatic extension of time may create a slight opportunity for gamesmanship, the lack of an effective way to amend the claims is a far more serious disadvantage of the current system. We believe that justified, case-by-case extensions provide sufficient safeguards to prevent abuse.

**5. What barriers, if any, exist that the Office can address to increase the effectiveness of the MTA procedure?**

Our answer to Question 7 identifies barriers and suggests an “off ramp” for addressing them.

**6. Should the Office modify its practice of when the Board can or should raise a new ground of unpatentability, and if so, how? Should the Board’s decision in the *Hunting Titan* case continue to guide when and how the Board can and should raise a new ground of unpatentability? If so, why and how?**

Yes. The Board’s decision in *Hunting Titan* should not continue to guide when and how the Board can and should raise a new ground of unpatentability. AIPLA has repeatedly explained why the Board should not raise new grounds of unpatentability during an AIA trial and summarizes its past positions below.<sup>6</sup>

If a patent owner meets the limited initial burden of production under 37 C.F.R. § 42.121, then the Board should not *sua sponte* raise new patentability challenges to that claim. The statutory and regulatory framework upon which AIA trials are based includes the requirement in 5 U.S.C. § 706(2)(E) of the Administrative Procedure Act that the Board’s decisions be supported by “substantial evidence,” as well as the requirement of 35 U.S.C. § 316(e) that the burden of proving unpatentability lies with the petitioner.

The requirement in the Administrative Procedure Act that the Board’s decisions be based on “substantial evidence” means:

[w]ith respect to core factual findings in a determination of patentability, . . . the Board cannot simply reach conclusions based on its own understanding or

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<sup>6</sup> Persuasion, *supra* note 1; AIPLA Amicus Brief in *Hunting Titan, Inc. v. DynaEnergetics GmbH & Co. KG*, <https://www.aipla.org/docs/default-source/uploadedfiles/documents/advocacy/judicial/2016/documents/aqua-filed.pdf>, <https://www.aipla.org/docs/default-source/advocacy/documents/hunting-titan-aipla-amicus-brief.pdf>.

experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.<sup>7</sup>

And the essence of a burden of persuasion for a particular proposition is that in the absence of sufficient evidence demonstrating that proposition, the proposition must be found not to be true.

Because the burden of proving unpatentability lies with the petitioner, this means that, in the absence of sufficient evidence from the petitioner that an amended claim is unpatentable, the Board should find the claim to be patentable on the record before it, provided that the patent owner meets its initial burden of production.<sup>8</sup> If the Board were to supply its own evidence that a claim is unpatentable, then it would effectively relieve the petitioner from its burden of proving unpatentability.

The Federal Circuit recognized the role of the Board's role in *In re Magnum Oil Tools International Ltd.*,<sup>9</sup> in addressing a non-amended claim. In *Magnum Oil Tools*, the petitioner provided only a conclusory analysis for combining features of the prior art references on which the IPR trial was instituted. In its final written decision, the Board supplied an obviousness argument that had not been made by the petitioner. The Federal Circuit observed:

[Inter partes review] is . . . a system that is predicated on a petition followed by a trial in which the petitioner bears the burden of proof. Given that framework, we find no support for the PTO's position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR. Instead, the Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond. . . . Thus, while the PTO has broad authority to establish procedures for revisiting earlier-granted patents in IPRs, that authority is not so broad that it allows the PTO to raise, address, and decide unpatentability theories never presented by the petitioner and not supported by record evidence.<sup>10</sup>

The burden of showing unpatentability applies equally to proposed amended claims as it does to originally challenged claims. So, the reasoning in *Magnum Oil Tools* applies equally to proposed amended claims. Although 35 U.S.C. § 318(a) requires the Board to issue a decision “with respect to the patentability . . . of any new claim added under section 316(d),” that statute does not authorize the Board to base its decision on its own theories of unpatentability.

The Board's role in AIA trial proceedings should be to decide the dispute before it based on the arguments and evidence of record, not raise new patentability challenges. The Supreme Court clarified in *Cuozzo* that the “basic purpose[]” of an IPR is “to reexamine an earlier agency decision” and is, therefore, “not quite the same as the purpose of district court litigation.”<sup>11</sup> The Court confirmed that the burden of proof is one aspect of an IPR that is “adjudicatory” and is

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<sup>7</sup> *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (internal citations omitted).

<sup>8</sup> *E.g.*, *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) (“Failure to prove the matter as required by the applicable standard means that the party with the burden of persuasion loses on that point.”).

<sup>9</sup> 829 F.3d 1364 (Fed. Cir. 2016).

<sup>10</sup> *Id.* at 1381.

<sup>11</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143–44 (2016).

one aspect that “make[s] these agency proceedings similar to court proceedings.”<sup>12</sup> And “[i]t is beyond cavil that a district court does not have authority to invalidate a patent at its own initiative if validity is not challenged by a party.”<sup>13</sup> Just as district courts must determine validity based on the evidence of record, the Board must determine the patentability of both issued and proposed substitute claims based on the evidence of record.

The Board’s role in AIA trial proceedings is different from the Board’s role in other contexts, in which it may raise patentability challenges *sua sponte*. Those contexts involve a different burden of proof, a different evidentiary framework, and additional procedural safeguards that are not in place in AIA trial proceedings. For example, in an *ex parte* appeal from an examiner’s decision that a claim is unpatentable, the Board may *sua sponte* raise “new grounds of rejection.” But in that context there is no statute that imposes a burden of proof on the examiner (as opposed to the Office generally), and there are regulations in place that allow the patent applicant to respond to the new ground of rejection or to reopen prosecution (where additional rebuttal evidence may be marshalled or additional amendments may freely be made).<sup>14</sup>

In contrast, in an AIA trial proceeding, the burden of proof is on the petitioner by statute. The corresponding regulations do not provide procedural safeguards and ensure fairness for the patent owner if the Board raises a new theory of unpatentability in response to a MTA. The current process does not provide any opportunity for response to new theories of unpatentability raised by the Board. Such an opportunity is required by the Administrative Procedure Act.<sup>15</sup> In *EmeraChem*, the Federal Circuit held that an APA violation occurred when the Board relied on a prior art reference that was included in the initial petition for an IPR, but only in general statements concerning obviousness.<sup>16</sup> By raising new grounds against substitute claims, the Board would impose an entire new round of briefing and unduly delay the proceedings.

Limiting patentability challenges to those raised by the petitioner is also sound public policy. The claims in an AIA trial proceeding are from issued patents. All of the claims were previously examined by the Office. Any amended claim must be narrower than the originally issued claim and may give rise to statutory “intervening rights.”<sup>17</sup> In addition, the patent owner must demonstrate that the proposed amendment “respond[s] to a ground of unpatentability involved in the trial.”<sup>18</sup> In complying with these provisions, the patent owner has “a duty of candor and good faith” to the Board to guard against overreaching.<sup>19</sup>

Although the statute permits the Board to proceed to a final written decision even when a petitioner has withdrawn,<sup>20</sup> such a decision would still need to be based on the evidence and arguments presented by a petitioner.<sup>21</sup> The statute provides no basis for the Board to oppose *sua sponte* an amendment if the petitioner does not. To the contrary, the AIA encourages amendments as a means to resolve disputes, not as a reason for the Board to create new ones.<sup>22</sup>

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<sup>12</sup> *Id.*

<sup>13</sup> *Lannom Mfg. Co. v. U.S. Int’l Trade Comm’n*, 799 F.2d 1572, 1579 (Fed. Cir. 1986).

<sup>14</sup> 37 C.F.R. § 41.50(b).

<sup>15</sup> *EmeraChem Holdings, LLC v. Volkswagen Group of Am., Inc.*, 859 F.3d 1341, 1348 (Fed. Cir. 2017).

<sup>16</sup> *Id.* (citing 5 U.S.C. §§ 554(b)–(c), 556(d)).

<sup>17</sup> 35 U.S.C. §§ 316(d)(3), 318(c).

<sup>18</sup> 37 C.F.R. § 42.121(a)(2)(i).

<sup>19</sup> 37 C.F.R. § 42.11.

<sup>20</sup> *E.g.*, 35 U.S.C. § 317(a).

<sup>21</sup> *See Magnum Oil Tools*, 829 F.3d at 1381.

<sup>22</sup> *See* 35 U.S.C. § 316(d)(2) (“Additional motions to amend may be permitted . . . to materially advance the settlement of a proceeding . . .”).

For the same reason that the Board does not use its resources to reach out and address the patentability of issued claims unless a petitioner files a post grant petition, the Board should not challenge the patentability of amended claims the petitioner has not challenged.

Additional avenues exist to challenge an amended claim resulting from an AIA trial. The amended claim may be challenged by another member of the public, either in court or at the Office by way of an *ex parte* reexamination or in a further AIA trial proceeding.<sup>23</sup> There is nothing preventing a court or the Board from considering a challenge to the patentability of an amended claim in a subsequent trial proceeding, even based on art previously considered by the Board.

Further, the statutes governing *ex parte* reexamination (in contrast to the statutes governing *inter partes* review) expressly state that “[o]n his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 or 302.”<sup>24</sup> Thus, the Board is free to bring any ground for unpatentability of an amended claim to the Director, who may then institute an *ex parte* reexamination of that claim. Significantly, *ex parte* reexamination has procedural safeguards allowing a patent owner to respond to an examiner’s rejections and to propose multiple amendments to its claims freely, safeguards which are not present in connection with a MTA in an IPR.

**7. Should the Office involve patent examiner assistance in relation to MTAs? Should the Office conduct a search in relation to proposed substitute claims in certain situations? If so, under what circumstances? Should examiner assistance on prior art searches be limited in any way?**

Yes. We believe that the Office should involve patent examiner assistance in relation to MTAs. The timing of AIA trial proceedings often does not provide sufficient time or expertise for evaluating proposed amended claims, and the Board does not engage in examination of claims in the first instance. The Office’s patent examining corps may address these deficiencies in Board practice. The examining corps possesses the requisite experience and expertise to examine proposed amendments.

In this regard, AIPLA supports an “off ramp” that provides a meaningful mechanism for a patent owner to obtain claim amendments. Under this “off ramp,” one or more patent examiners would examine amendments to claims challenged in AIA trial proceedings.<sup>25</sup> Examiners could be detailed to the Board for this express purpose.

In the proposed “off ramp” discussed above, any patent-examiner involvement must not impact the timing for final written decisions in trial proceedings, and the “off ramp” should be conducted with special dispatch.

**8. Should the Office clarify in its rules where the burden of persuasion for Board-raised grounds lies? Who should bear that burden?**

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<sup>23</sup> See 35 U.S.C. § 315(e)(1), (e)(2) (estoppel only applies to “[t]he petitioner”).

<sup>24</sup> 35 U.S.C. § 303(a).

<sup>25</sup> See AIPLA, Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board [Docket No. PTO-P-2020-0022], at 17 (June 20, 2023), <https://www.aipla.org/docs/default-source/advocacy/aipla-response-to-uspto-anprm-on-ptab-practice.pdf>.

Yes. First, we reiterate, we do not believe the Board should raise grounds of unpatentability as to amended claims. Rather, this is the responsibility of the petitioner, and the burden of persuasion lies with the petitioner.

Nonetheless, if the Board is going to raise, *sua sponte*, grounds of unpatentability as to amended claims, AIPLA's letter regarding the Proposed Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board [Docket No. PTO-P-2019-0011], dated December 23, 2019, explains why AIPLA supports placing the burden of persuasion *on the petitioner* to show that any proposed substitute claims are unpatentable.<sup>26</sup>

Placing the burden of persuasion on the petitioner is consistent with 35 U.S.C. § 282(a), the longstanding provision that governs burdens of proof in patent infringement actions in federal court, and there is a wealth of supporting precedent. Compare 35 U.S.C. § 316(e) with 35 U.S.C. § 282(a). Section 316(e) provides that “the petitioner shall have the burden of proving a proposition of unpatentability,” and section 282(a) similarly provides that “[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” Under section 282(a), the challenger to the validity of an issued claim always bears the burden of persuasion and bears a corresponding burden of producing evidence demonstrating that the claim is invalid.<sup>27</sup> Likewise, under section 316(e), the petitioner bears the burden of proving unpatentability of the challenged claims.<sup>28</sup> Given that both section 282(a) and section 316(e) place the ultimate burden of persuasion on the party challenging patentability, the burdens of persuasion and of producing evidence in AIA trial proceedings should be the same as when adjudicating the validity of claims in federal court.

The Supreme Court's decision in *Cuozzo* confirmed that the burden of proof in an IPR is among the “adjudicatory characteristics” of an IPR that “make these agency proceedings similar to court proceedings,” even if “in other significant respects, *inter partes* review is less like a judicial proceeding and more like a specialized agency proceeding.”<sup>29</sup> Consistent with the foregoing analysis, the Federal Circuit has concluded that the “shifting burdens . . . in district court litigation parallel the shifting burdens . . . in *inter partes* reviews.”<sup>30</sup>

Our answer to Question 6 further addresses our reservations regarding any rule that allows the Board to raise its own grounds in AIA trials.

**9. Should any other aspects of the MTA rules (37 CFR 42.121, 42.221), including as they related to the Board's discretion to grant or deny an MTA, be changed, and if so, how?**

AIPLA supports maintaining the differences between the patent owner's burden of production and the petitioner's ultimate burden of persuasion in the context of amended or substitute claims presented by MTA. The Office has placed a burden of production on the patent owner, requiring the patent owner to produce evidence showing that the MTA proposes a reasonable number of

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<sup>26</sup> [https://www.aipla.org/docs/default-source/advocacy/documents/aipla\\_comment\\_letter-ptabmotion\\_to\\_amend2019dec23.pdf](https://www.aipla.org/docs/default-source/advocacy/documents/aipla_comment_letter-ptabmotion_to_amend2019dec23.pdf), at 4-8.

<sup>27</sup> *Tech. Licensing Corp.*, 545 F.3d at 1326-29.

<sup>28</sup> *Dynamic Drinkware LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015) (citing *Tech. Licensing Corp.*, 545 F.3d 1327).

<sup>29</sup> *Cuozzo*, 136 S. Ct. at 2143.

<sup>30</sup> *Dynamic Drinkware*, 800 F.3d at 1378-81.




substitute claims; that the amendment does not enlarge the scope of the claims of the patent or introduce new matter; that the amendment responds to a ground of unpatentability involved in the trial; and that the substitute claims have support in the original disclosure and support in an earlier-filed disclosure for each substitute claim for which benefit of the filing date of the earlier-filed disclosure is sought.<sup>31</sup> Nevertheless, as discussed above, the petitioner should always bear the ultimate burden of persuasion to prove unpatentability of claims in an AIA trial proceeding, including for substitute or amended claims. Indeed, the Office has already adopted this view.<sup>32</sup> The Office should clarify that the petitioner's burden of persuasion extends to questions related to patentability over 36 U.S.C. § 112, with respect to written description support for the substitute claims.

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AIPLA appreciates the opportunity to provide feedback to the Office on the Request for Comments. AIPLA looks forward to further dialog with the Office with regard to the issues raised above.

Sincerely,

A handwritten signature in blue ink, appearing to read "B. Batzli".

Brian H. Batzli  
President  
American Intellectual Property Law Association

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<sup>31</sup> 37 C.F.R. § 42.121(d)(1) (patent owner's burden of production).

<sup>32</sup> 37 C.F.R. § 42.121(d)(2).