

Comments on Proposed Change to PTAB Rules (Procedure for Amending Claims during AIA trial proceedings)

Changed rule should not be applied retroactively in the name of a pilot program

According to the Office's current proposal, the proposed pilot program will be implemented after the deadline for submission of comments on December 14, 2018, and the new procedure will be used in every AIA trial proceeding involving a motion to amend where the Board issues a decision to institute a trial after the implementation date of the pilot program. Consequently, the changed rule will also apply to those AIA trial proceedings where the petitioner had no way to know about this change at the time of filing the petition. This is, in effect, retroactive application of a changed rule and violates the principle of due process of law, unfairly harming the interests of the petitioner, in particular.

In the case of the change to the claim construction standard on which the Office solicited comments earlier this year, the new rule applies only to those AIA reviews that are requested on or after the effective date of that rule. This is because the Office finally decided not to retroactively apply the rule, despite the original proposal, in response to opposing opinions from the public.

If the Office adopts the new change as they propose, it will be indispensable at least to avoid the retroactive application as in the previous case to ensure a smooth transition.