

Raghav Bajaj in World IP Review: USPTO Seeks Comments on Motions to Amend Changes

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Raghav Bajaj, Haynes Boone associate, talked with *World IP Review* about the U.S. Patent and Trademark Office's new amendment process for America Invents Act (AIA) proceedings.

Here is an excerpt:

Raghav Bajaj, a lawyer at Haynes Boone's Austin, Texas, office, explained that the primary change is a two-stage process for motions to amend.

First, the patent owner proposes an amendment, to which the petitioner may respond.

This is followed by a preliminary decision from the PTAB [Patent Trial and Appeal Board] on the merits of the motion. The progression of the second stage is dependent on this decision.

If the board's decision finds that the proposed amendment fails to meet the statutory or regulatory requirements, the patent owner may propose further amendments, said Bajaj. Alternatively, if the board finds that the claims do meet the requirements to be granted, the petitioner can file new evidence in opposition.

"Another interesting factor is that it appears that amendments will be judged under the Phillips claim construction standard, unlike typical prosecution in which claims are judged under the broadest reasonable interpretation (BRI) standard," said Bajaj.

In October, the PTAB published the final rule for claim construction in AIA proceedings. The Phillips claim construction rule will replace the BRI standard and apply to all petitions filed on or after November 13, 2018.

Bajaj believes that the new amendment procedure may increase costs for both parties in the proceedings, as it adds additional briefing if the patent owner wishes to amend its claims.

"The proposal seems to suggest that this 'pilot programme' is mandatory for all future proceedings; the parties cannot choose to operate under the prior regime," he added.

Bajaj expects parties on both sides to be very active in commenting.

"Based on the changes in the final rule-making that stemmed from comments on prior Phillips notice of proposed rule-making, the USPTO has shown a willingness to change their initial positions," he concluded.

To read the full *World IP Review* article, click [here](#).