

McCombs, Bowser and Goryunov in Reuters: USPTO Issues New Rules on Motions to Amend in IPRs

October 22, 2024 David McCombs, Jonathan Bowser

PRACTICES Patent Litigation, Patent Office Trials, Patents, Patent Prosecution and Counseling, Intellectual Property

Haynes Boone Partners [David McCombs](#), [Jonathan Bowser](#) and Eugene Goryunov authored an article for *Reuters* on non-inventor testimony corroborating inventor testimony carrying more weight than initially thought, even though it may not deserve as much weight as it was given.

Read an excerpt below.

Inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB) are frequent components of patent litigation disputes. In an IPR, a third party may challenge the validity of issued claims of a patent. The PTAB determines whether to institute a trial based on the IPR petition and the patent owner's preliminary response.

If the PTAB institutes trial, the patent owner may file a contingent motion to amend seeking to amend the original claims of the patent. The PTAB will consider the motion to amend if it determines that the original challenged claims of the patent are unpatentable. If the PTAB grants a motion to amend at the conclusion of an IPR trial, the amended claims replace the original claims of the patent.

Congress established motions to amend as part of IPR trials when it created IPRs in the America Invents Act. 35 U.S.C. § 316(d). However, the implementation of motions to amend was initially criticized in part because the PTAB infrequently granted motions to amend. There were also questions about whether the PTAB itself could raise grounds of unpatentability for proposed amended claims if the petitioner did not oppose a patent owner's motion to amend.

On Sept. 18, 2024, the USPTO issued a [final rule](#) governing motion to amend practice in IPRs. 89 Fed. Reg. 76421. The final rule was issued in response to public comments to the USPTO's [Notice of Proposed Rulemaking](#) (NPRM) issued on March 4, 2024. 89 Fed. Reg. 15531. The final rule codifies several provisions of the USPTO's motion to amend [pilot program](#), that it introduced in March 2019. 84 Fed. Reg. 9497.

The final rule provides a patent owner the opportunity to receive preliminary guidance from the PTAB on proposed claim amendments before the PTAB issues a final written decision. The USPTO first introduced the opportunity to receive preliminary guidance in the motion to amend pilot program. At its core, preliminary guidance is intended to provide feedback to the patent owner that may lead to improved chances of having a motion to amend granted.

To read the full article from *Reuters*, click [here](#).