

REVISION OF IPR AMENDMENT PROCESS
LEGISLATIVE TEXT

§ 316. Conduct of inter partes review [NB: Corresponding changes will be made to § 326 for PGR]

(a) REGULATIONS.—The Director shall prescribe regulations—

(9) setting forth standards and procedures for allowing the patent owner to cancel a challenged claim under subsection (d) or request examination of amended claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent. Such regulations shall provide that:

- (i) the request for examination of any proposed amendment shall reference the instituted inter partes review involving the patent sought to be amended;
- (ii) the request for examination may, but is not required to, include a preliminary statement explaining why the amended claim is patentable over the prior art relied upon by the Director in instituting the inter partes review; and
- (iii) in examining any proposed amendment, the Director shall consider the petition in the relevant inter partes review, including the evidence, prior art and arguments submitted by the parties, the institution decision of the Patent Trial and Appeal Board, and any final written opinion if issued during the examination of the request.

(d) AMENDMENT OF THE PATENT.—

(1) MOTIONS TO AMEND.—During an inter partes review instituted under this chapter, motions to amend the patent may be granted by the Patent Trial and Appeal Board only:

- (A) to cancel a challenged patent claim; or
- (B) upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317.

(2) REQUEST FOR EXAMINATION.— Not later than three months after the institution of an inter partes review under this chapter, the patent owner may file a request for examination by the Director of one or more amendments of any claim or claims that are the subject of the instituted inter partes review. Upon receipt of a request for examination in compliance with this subsection, the Director shall order any proposed amended claims examined for patentability under sections 131 to 133 and such examination will be conducted with special dispatch. The examination proceedings and any subsequently issued certificate are subject to the provisions of section 305 through 307 as if such amended claims were added in reexamination.

(3) SCOPE OF CLAIMS.—A request for examination under this subsection must amend claims that are the subject of the inter partes review and may not enlarge the scope of the claims

of the patent. A request for examination of an amendment to a claim on which an inter partes review has been instituted shall not be deemed an admission of unpatentability of that instituted claim.

- (4) **INTERACTION BETWEEN INTER PARTES REVIEW AND EXAMINATION.**— An examination under this subsection shall not be stayed without the patentee’s consent and shall proceed notwithstanding any other proceedings related to the issued patent, including any instituted inter partes review. All challenged claims on which the inter partes review was instituted shall continue to be reviewed by the Patent Trial and Appeal Board unless cancelled by the patentee, or otherwise withdrawn or amended as part of a settlement. The Patent Trial and Appeal Board shall have the authority to coordinate any appeal of an examination proceeding with any instituted inter partes review, if the appeal arises before a final written decision. The issuance of a certificate under section 307 shall not result in review of any added claims during the previously instituted inter partes review.
- (5) **CONCLUSION OF EXAMINATION.**—The proceeding will conclude with the issuance of a certificate under section 307 incorporating into the patent any amended claim or new claim, if any, that is determined to be patentable as a result of the examination under this subsection.
- (6) **EFFECT OF GRANTING A CERTIFICATE FOR AMENDED CLAIMS.**— Any claim that is determined to be patentable and incorporated into a patent following conclusion of an examination conducted under this subsection through the publication of a certificate shall be presumed valid in accordance with section 282(a) notwithstanding the outcome of the inter partes review of the related challenged claim.
- (7) **FUTURE PROCEEDINGS.**— Neither the petitioner nor the patent owner shall be estopped from challenging or asserting in a future proceeding any claim that is determined to be patentable and incorporated into a patent in an examination under this subsection. The time limitation set forth in section 315(b) shall operate with respect to any such claim only on account of a complaint alleging infringement of the patent that is served after the issuance of the certificate including such claim.
- (8) **RULE OF CONSTRUCTION.**—Nothing in this subsection shall abridge the right of a patentee to seek reexamination, supplemental examination, or reissue of a patent, or claims thereof, that are the not subject of an instituted inter partes review.
- (9) **FEE.**—Any request for examination shall be accompanied by the fee set for reexamination for the patent owner requesting examination.

§ 318. Decision of the Board [NB: Corresponding changes will be made to § 328 for PGR]

(a) **Final Written Decision.**— If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d)(1).

(b) **Certificate.**— If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim added under section 316(d)(1).

(c) **Intervening Rights.**— Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

(d) **Data on Length of Review.**— The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

37 C.F.R. 42.73(d)(3)

(3) *Patent applicant or owner.* A patent applicant or owner will be precluded from obtaining in the patent challenged in the inter partes review, or any patent claiming priority therefrom, or with a common priority claim, a claim canceled under section 316(d)(1)(A) or a claim that is not patentably distinct over the prior art on the basis of which a challenged claim was finally refused