

**Proposed Amendments to 35 U.S.C. § 316(a)**  
**(Relating to Claim Construction and Discovery)**

35 U.S.C. 316 CONDUCT OF INTER PARTES REVIEW

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

[Subsections (a)(1)-(a)(4) are unchanged.]

(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to--

(A) the deposition of witnesses submitting affidavits or declarations; ~~and~~

(B) evidence identifying the petitioner's real parties in interest; and

(C) what is otherwise necessary in the interest of justice;

[Subsections (a)(6)-(a)(8) are unchanged.]

(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, including the standard for how substitute claims should be construed, 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;

[Subsection (a)(10) is unchanged]

(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under ~~section 315(e)~~ section 315(d);

(12) setting a time period for requesting joinder under ~~section 315(e)~~ section 315(d); ~~and~~

(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director; and

(14) providing that for all purposes under this chapter—

(A) each challenged claim of a patent shall be construed as the claim would be construed under section 282(b) in an action to invalidate a patent, including by construing each challenged claim of the patent in accordance with—

(i) the ordinary and customary meaning of the claim as understood by a person having ordinary skill in the art to which the claimed invention pertains; and

(ii) the prosecution history pertaining to the patent; and

(B) if a court has previously construed a challenged claim of a patent or a challenged claim term in a civil action to which the patent owner was a party, the Office shall consider that claim construction.