



Patent Law Alert: PTAB ISSUES A GUIDANCE ON MOTIONS TO AMEND IN VIEW OF FEDERAL CIRCUIT’S AQUA PRODUCTS DECISION

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On November 22, 2017, the Patent Trial and Appeal Board (“PTAB”) issued a guidance on motions to amend filed in *inter partes* review (“IPR”) and post-grant review (“PGR”) proceedings following the Federal Circuit’s *en banc* decision in *Aqua Products, Inc. v. Matal*

https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=) (“the Guidance”).

In the Guidance, the PTAB confirmed that in light of the Federal Circuit’s *Aqua Products* decision, the burden of persuasion will no longer be placed on a patent owner with respect to the patentability of substitute claims presented in a motion to amend. In reviewing patent owner’s motion to amend, as long as the motion satisfies the statutory requirements under 35 U.S.C.

§ 316(d) (*i.e.*, proposing a reasonable number of substitute claims, not enlarging the scope of the claims, and introducing no new matter), the PTAB will “determine whether the substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner.” According to an example provided in the Guidance, “if the entirety of the evidence of record before the Board is in equipoise as to the unpatentability of one or more substitute claims, the Board will grant the motion to amend with respect to such claims, and the Office will issue a certificate incorporating those claims into the patent at issue.”

Beyond this shift in where the burden of persuasion lies, the PTAB advised in the Guidance that the PTAB’s practice and procedure relating to motions to amend will not change:

- “[A] patent owner still must meet the requirements for a motion to amend under 37 C.F.R. § 42.121 or § 42.221, as applicable,” in that “a motion to amend must set forth written description support and support for the benefit of a filing date in relation to each substitute claim, and respond to grounds of patentability involved in the trial.”
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“[U]nder 37 C.F.R. § 42.11, all parties have a duty of candor, which includes a patent owner’s duty to disclose to the Board information that the patent owner is aware of that is material to the patentability of substitute claims, if such information is not already of record in the case.”

- “The Board will continue its current briefing practice as to the types, timing, and page-limits of briefs, as set forth in the rules governing trial practice before the Board and the Office Patent Trial Practice Guide. See, e.g., 37 C.F.R. §§ 42.22–42.25; Office Patent Trial Practice Guide, 77 F.R. 48756, 48766-48767 (Aug. 14, 2012).”
- “The Board’s standard Scheduling Order will remain the same in that a patent owner may file a motion to amend the claims of the challenged patent, in accordance with 37 C.F.R. § 42.121 or § 42.221, on Due Date 1 [*i.e.*, no later than the filing of a patent owner response].”
- “A patent owner also must continue to confer with the Board before filing a motion to amend. See 37 C.F.R. §§ 42.121(a), 42.221(a).”
- “The above guidance notwithstanding, if any party in a matter involving a pending motion to amend believes there is need to discuss the impact of *Aqua Products* with the Board in a particular case, the party may contact the Board to arrange a conference call. The Board already has contacted, or soon will contact, parties with motions to amend pending at the time that the *Aqua Products* decision issued to let them know that a request for a conference call is appropriate in this regard. During such a call, any party may request briefing changes or additional briefing. The Board generally will permit supplemental briefing regarding the patentability of substitute claims proposed in a motion to amend, if requested.”

In view of the shift of burden of persuasion from patent owner to petitioner, the PTAB will entertain requests from petitioners to authorize petitioner’s sur-reply brief with respect to any motion to amend.

In accordance with the Guidance, a motion to amend filed in an IPR or PGR proceeding:
May cancel any challenged claim (35 U.S.C. § 316(d)(1));

- May only propose a reasonable number of substitute claims for each challenged claim (35 U.S.C. § 316(d)(2)). “The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.” (37 C.F.R. § 42.121(a)(3) or § 42.221(a)(3));
- May be denied if it “does not respond to a ground of unpatentability involved in the trial (37 C.F.R. § 42.121(a)(2)(i) or § 42.221(a)(2)(i));
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May be denied if it seeks to enlarge the scope of the claims of the patent (37 C.F.R. § 42.121(a)(2)(ii) or § 42.221(a)(2)(ii));

- May be denied if it introduces new subject matter (37 C.F.R. § 42.121(a)(2)(ii) or § 42.221(a)(2)(ii));
- Must include a claim listing (e.g., in an appendix to the motion) and set forth written description support and support for the benefit of a filing date in relation to each substitute claim (37 C.F.R. § 42.121(b) or § 42.221(b)).

We will continue to monitor the PTAB for the latest developments in the PTAB rules and practice on amendments in IPR proceedings.

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