

**MOTIONS TO AMEND IN *INTER PARTES* REVIEW  
PROCEEDINGS – A QUICK REFERENCE**

**IIPI/BBNA AIA POST-GRANT PATENT PRACTICE CONFERENCE**

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**Statutory Basis:** 35 U.S.C. § 316(d).

**Rule:** 37 C.F.R. § 42.121.

**Guidance:** Office Patent Trial Practice Guide (OPTPG), 77 Fed. Reg. 48766-67.

**PTAB Decisions:** Some discussed below.

1) Board approach to motions to amend highly restrictive. THIS IS NOT LIKE REEXAMINATION.

2) Procedural Requirements/Limitations

a. Generally only one opportunity to move to amend claims.

i. To be filed no later than with Patent Owner Response Rule 42.121(a)(1).  
No opportunity to amend claims with Preliminary Response. Rule 42.107(d).

b. Must discuss motion to amend with Board in conference call in advance of filing. Rule 42.121(a).

c. Proposed claim amendments may be contingent or non-contingent -- to be clearly stated in motion. *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR 2012-00027, Paper 26 at 10.

3) Substantive Requirements/Limitations

- a. Amendments may not enlarge the overall scope of the patent claims (same as in reexam). Rule 42.121(a)(2)(ii).
- b. Claim amendments must be responsive to unpatentability grounds asserted: “[A] proposed substitute claim is not responsive to an alleged ground of unpatentability of a challenged claim if it does not either include or narrow each feature of the challenged claim being replaced.” *Idle Free*, IPR2012-00027, Paper 26 at 5.
  - i. appears to prohibit broadening of a dependent claim within the scope of its original base claim (more restrictive than reexam).
- c. The permitted reasonable number of substitute claims (35 U.S.C. § 316(d)) means no more than a one for one substitution of an amended claim for each claim in trial, absent a demonstration of need. Rule 42.121(a)(3). Strictly applied.
  - i. “A desire to obtain a new set of claims having a hierarchy of different scope typically would *not* constitute a sufficient special circumstance. . . . If a patent owner desires a complete remodeling of its claim structure according to a different strategy, it may do so in another type of proceeding before the Office.” *Idle Free*, IPR2012-00027, Paper 26 at 6.
  - ii. No provision for alternative proposed amendments akin to European opposition proceedings.
  - iii. The one-for-one claim substitution limitation has been applied very restrictively: “If a proposed substitute claim includes all the features of an original patent claim, then it counts as a substitute claim for that original patent claim, regardless of the actual designation of substitution contained in the motion.” *ZTE Corp. v. Contentguard Holdings Inc.*, IPR 2013-00136, Paper 33 at 4. Here, the Board was addressing a situation

- where the Patent Owner sought to substitute claims for dependent claims to make those claims depend from a proposed substitute base claim. The limitation stated would seemingly preclude such changes of claim dependency absent a demonstration of special need for more than a one for one substitution of amended claims.
- d. Must demonstrate written description support for amendments in application as filed, **and** in any earlier application from which priority is sought. Rule 42.121(b).
    - i. Not enough to show support in patent as issued.
  - e. BURDEN IS ON PATENT OWNER TO PROVE PATENTABILITY OF AMENDED CLAIMS. Under *Idle Free*, IPR2012-00027:
    - i. Rule 42.20(c), addressing motions generally, provides the basis (“moving party has the burden of proof to establish that it is entitled to the requested relief.”) Paper 26 at 7; Paper 66 at 26 and 33.
    - ii. Need to show general patentability over prior art.
      - 1. “A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable . . .” Paper 26 at 7; Paper 66 at 34.
    - iii. Not enough to establish patentability over prior art applied to original patent claims. Paper 66 at 33. Need to show patentability over prior art of record and the closest prior art known to Patent Owner. Paper 26 at 7; Paper 66 at 34.

- iv. Need to address what is known about the level of skill in the art, in terms of the ordinary creativity and skill set of one of ordinary skill in the art. This is to be done *with respect to each added feature*. Paper 66 at 33-34.
- v. Need to address whether the element/limitation relied upon in the amended claim is known in any context, and if it is, need address non-obviousness of use in context of claimed invention, i.e., “why it would not have been applicable to render [the claimed invention] obvious to one with ordinary skill in the art.” Paper No. 66 at 35-36.

f. Page limits are a significant constraint!

- i. 15 pages for a motion to amend. Rule 42.24(a)(v). Listing of substitute claims counts against the 15 page limit. *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR 2012-00042, Paper 30.
- ii. Petitioner likewise has 15 pages for opposition (Rule 42.24(c)(2)), and can raise new evidence (e.g., prior art, declaration testimony) to show unpatentability of claims. OPTPG, 77 Fed. Reg. 48767.
- iii. Patent Owner gets only 5 pages for reply. Rule 42.24(c)(2) (strictly enforced).
  - 1. Board has refused a Patent Owner request for three additional pages to address six new references cited by Petitioner against amended claims. *Synopsys*, IPR2012-00042, Paper 39.

4) An Opportunity for the Patent Owner: The Office Patent Trial Practice Guide (OPTPG) expressly provides for requesting from the Board a “substantial identity” determination that may support an argument that proposed substitute claims found patentable are not subject to the doctrine of intervening rights:

- a. “When filing a motion to amend, a patent owner may demonstrate that the scope of the amended claim is substantially identical to that of the original

patent claim, *as the original patent claim would have been interpreted by a district court*. In such cases, a patent owner may request that the Board determine that the amended claim and original patent claim are substantially identical within the meaning of 35 U.S.C. 252”. (OPTPG, 77 Fed. Reg. 48766; emphasis added)

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