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# PTAB HIGHLIGHTS

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## PTAB Provides Guidance for Meeting Burden to Show Written Description for Substitute Claim

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September 24, 2014 – In a Final Written Decision finding the patentee’s claim 1 unpatentable, the PTAB denied a motion to add a substitute claim that added hundreds of words to challenged claim 1. The PTAB held that the patentee failed to explain the relevance of supporting citations to the patent, or how the substitute claim was an “integrated whole” within the context of the patent.

[IPR2013-00322 – Respironics, Inc. v. ZOLL Medical Corporation \(Paper 46\)](#)

The patentee, Zoll, filed a motion to amend seeking to add a substitute claim for challenged claim 1. The substitute claim added hundreds of words, more than tripling its length. The motion provided a listing of string citations to the patent by column and line number. These were alleged to provide written description support for the amended language. The motion lacked an explanation of the relevance of the citations and was unsupported by an expert declaration.

The PTAB explained that a substitute claim will only be added to an *inter partes* review if the patentee meets a burden to show adequate written description in the original application and any “benefit applications” (applications to which benefit is claimed). In denying the motion to amend, the PTAB held that “Zoll’s string citations amount to little more than an invitation to us (and to Respironics, and to the public) to peruse the cited evidence and piece together a coherent argument for them. This we will not do; it is the province of advocacy.” The PTAB noted the contrast between the extensive amendments and the lack of any explanation of the relevance of the string citations. The PTAB stated “[s]o extensive a modification of the claim requires a more detailed showing of how each limitation of the proposed claim not only is disclosed in the original and benefit applications, but also is disclosed in combination with all of the other

claim limitations. See *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013) (claim is considered as an “integrated whole” when assessing written description).

Zoll attempted to cure the deficiencies of its motion with a reply that included both a claim chart identifying citation support for the proposed claim limitations and an expert declaration. But, the PTAB criticized the reply as “too little, too late” on substantive and procedural grounds.

The PTAB determined that neither the expert declaration nor the claim chart explained the relevance of the citations to the proposed claim limitations or how the citations, which were “dispersed throughout the specification and figures, demonstrate possession of the claimed subject matter as an ‘integrated whole.’” The PTAB also noted that the proper role of a reply brief is to “refute arguments and evidence advanced by the opposing party.” In contrast, the PTAB viewed Zoll’s reply brief as an attempt to improve its original motion by presenting additional evidence in support of written description. The PTAB criticized Zoll for not explaining why the expert declaration could not have been provided with the motion or why the late evidence should even be considered. The PTAB also accused Zoll of attempting to circumvent the reply brief page limit by not discussing within the reply itself the evidence in the expert declaration and claim chart.

In denying the motion to amend, the PTAB did not conclude that the proposed substitute claim lacked adequate written description. Instead, the PTAB decided that Zoll did not meet its burden of proving adequate written description for the proposed substitute claim based on the record before it. The PTAB did not reach the issue of whether the proposed substitute claim was patentable over the prior art.

*The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.*



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