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Amending Claims During an *Inter Partes* Review

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One of the procedures open to the Patent Owner in an *Inter Partes* Review ("IPR") is to file a Motion to Amend the Claims. This is usually three months from the date of institution of the IPR. These motions are rarely granted. Recently, the Patent Trial and Appeal Board ("PTAB") provided some guidance on what should be included in a Motion to Amend the Claims in an IPR. IPR2014-00441, Paper No. 19, October 30, 2014. Specifically, the PTAB stated that the motion to amend can only cancel claims or propose substitute claims and that the proposed substitute claim should be responsive to the ground of unpatentability asserted against the original patent claim. See 37 C.F.R. § 42.221(a)(2)(i). Each substitute claim must relate back to an original claim it is intended to replace, and so generally it should not eliminate any element of the original claim that it is intended to replace. Also, if the Patent Owner needs more than one substitute claim per original claim the motion should articulate a special circumstance to support such a request.

Additionally, the Patent Owner is required to show patentability of the proposed substitute claims because the substitute claims will not be examined. In this regard, it is not just the prior art of record in the IPR, but the prior art in general that must be considered. Further, the Patent Owner must set forth any knowledge it possesses on any element added to

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the substitute claim, *e.g.*, has the element been used in combination with any other elements, what is generally known about the element, etc. Conclusory statements that are normally used in prosecution, such as the prior art does not teach the combination, or that one of skill in the art has X number of years of education or experience will likely not be sufficient. Also, the Patent Owner must show written description support for the entire substitute claim, not just the additional elements, and must show it in any and all parent applications for which it seeks the benefit of priority dates.

Moreover, the Patent Owner may be required to set forth claim constructions for elements in the substitute claims and cannot rely on an assertion of plain and ordinary meaning for a claim term. All of these requirements mean that it will likely be difficult to obtain approval of a motion to amend the claims during an IPR. Because of the difference in practice for amending claims during prosecution compared to IPRs, counsel with only prosecution practice experience is unlikely to be able to be as effective as counsel with litigation experience.

If you have any questions, or would like to know more about IPRs, or amending claims during an IPR, please contact the author.

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