Amending Claims During an Inter Partes Review

December 1, 2014

DC Client Alert

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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.