Insights: Alerts

A Non-illusory Opportunity to Amend

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The Patent Trial and Appeal Board ("Board") recently granted a motion to amend. A successful motion to amend is rare; only six have been granted to date. The case is *Shinn Fu Co. of America Inc. et al. v. The Tire Hanger Corp*., IPR2015-00208.

Following institution, the patent owner filed a Motion to Amend in lieu of a Patent Owner Response. In the Motion, patent owner proposed five substitute claims in the event that the original claims were held unpatentable. At oral argument, the patent owner acknowledged that it had made a decision not to pursue the original claims but to instead "rest [its] hat on the amended claims." Paper 24 at 15.

As the moving party, the patent owner bore the burden of proof to demonstrate the patentability of the proposed substitute claims. To carry that burden, a patent owner must show that the claims are patentable over the prior art of record and any relevant prior art known to it. *Id.* at 19 (citing *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1350–51 (Fed. Cir. 2016)). Petitioner argued that patent owner had failed to address a particular reference. However, the Board found that the patent owner addressed substantially similar prior art and thus met its burden. In granting patent owner's motion, the Board noted, “[a]lthough the claimed invention is seemingly simple, simplicity is not inimical to patentability.” *Id.* at 26 (citations omitted).

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