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PTAB Update – Limits on the Scope of Proposed Claim Amendments

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A Patent Owner in an *inter partes* review may amend the claims by motion, but the motion "may be denied" if the amendment does not respond to a ground of unpatentability or attempts to broaden the claim. 37 C.F.R. § 42.121. In a recent case, the Federal Circuit made clear that while an amendment must respond to a ground of unpatentability, the amendment may address other issues as well. *American National Manufacturing. v. Sleep Number Corp.*, Case. No. 2021-1321 (Nov. 14, 2022).

During the IPR proceeding, Sleep Number submitted contingent motions to amend, adding claim limitations from dependent claims to address the unpatentability grounds but also including changes that were not responsive to those grounds, e.g., changing "pump housing" to "valve enclosure" and "chamber" to "bladder." Slip. at 11, 13. American National argued during the proceeding and on appeal that because the amendments were not directly "aimed at responding to a ground of unpatentability at issue in" the IPR, they were improper. *Id.*

In rejecting American National's argument, the Court noted, "the Board has previously determined that § 42.121 'does not require . . . that every word added to or removed from a claim in a motion to amend be solely for the purpose of overcoming an instituted ground.' *Id.* (quoting *Lectrosonics, Inc. v. Zaxcom, Inc.*, No. IPR2018-01129, 2019 WL 1118864, at *2 (P.T.A.B. Feb. 25, 2019) (precedential)). The Court here agreed with the Board's reasoning in *Lectrosonics*, finding that "nothing in the America Invents Act (AIA) or the Board's regulations precludes a patent owner from amending a claim to both overcome an instituted ground and correct other perceived issues in the claim." *Id.* at 13-14.

The percentage of motions to amend that have been granted has increased significantly since the PTAB instituted the MTA pilot program, from 14% pre-pilot program to 25% post. *See*, USPTO MTA Study (Mar. 31, 2022). Thus, they have become a potentially useful strategy for Patent Owners. When considering such motions, Patent Owners should consider various changes to the claims unrelated to patentability, such as clarifying the claims, so long as those changes do not broaden the scope of the claims or introduce new matter. And Petitioners should be prepared to respond to such amendments substantively.