

Insights: Alert

The PTAB Designates a New Precedential Order on Motions to Amend

March 12, 2019

Written by **John C. Alemanni** and **Michael T. Morlock**

The PTAB designated as precedential a recent order regarding Motions to Amend. *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, 01130, Paper 15 (Feb. 25, 2019) (Designated Precedential: Mar. 7, 2019). The order sets out the requirements and burden for motions to amend under 35 U.S.C. § 316(d). Notably, Scott Boalick, acting Chief Administrative Patent Judge, was a member of the three-judge panel that issued the order. Also, the Board appears to have issued the order *sua sponte*, two months before the Patent Owner's deadline to file a motion to amend.

The order is not surprising in light of the Federal Circuit's decision in *Aqua Products*, which made clear that petitioners have the burden of persuasion with respect to the patentability of amended claims. *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1324 (Fed. Cir. 2017). As to burden of persuasion, consistent with *Aqua Products*, the order notes that the patent owner does not bear the burden of persuasion with respect to substitute claims. (Slip at 4) Rather, the burden will ordinarily lie with the petitioner, or if the petitioner withdraws, with the Board itself. (*Id.*)

Further, the order sets out procedures for motions to amend, including: what is a reasonable number of substitute claims (rebuttable presumption that one substitute claim per challenged claim is reasonable), scope of substitute claims (substitute claims may not broaden the scope of claims in any respect and may not include any new matter), required content of the motion (the motion to amend must respond to the ground of unpatentability involved in the trial), and page limits (twenty-five pages). (*Id.* at 4-9) The order also notes that both parties have a duty of candor requiring them to disclose to the Board information material to patentability, if that information is not already of record in the proceeding. (*Id.* at 9-10)

Patent Owners who plan to amend claims should begin with this order to ensure that they satisfy the Board's requirements. Petitioners should also be aware of this precedential guidance in responding to motions to amend. Petitioners should also consider that having precedential guidance may increase the number of motions to amend filed by Patent Owners.