

Insights: Alerts

Takeaways, Leading Edge Challenges: Amendments at PTAB

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Written by

Kilpatrick Townsend partner **Matthew Holohan** recently participated at the Federal Circuit Bar Association's high-profile panel in Denver — **"Patent Litigation 2017: The Courts and Patent Trial and Appeal Board (PTAB)."** He and his fellow panelists discussed **"Leading Edge Challenges: Amendments at PTAB."**

5 key takeaways from the discussion, include:

- Unlike examination proceedings, the ability to amend claims in inter partes review ("IPR") proceedings is limited. The PTAB must grant permission to amend claims in IPR proceedings after the Patent Owner files a motion. Also, the Patent Owner must show that the proposed amended claims are patentable over the prior art of record and prior art known to the Patent Owner.
- Motions to amend in PTAB proceedings have been used sparingly and are rarely granted — not only because of low likelihood of success but because amending a claim generally surrenders rights to past infringement damages.
- The Federal Circuit has granted en banc review in *In re Aqua Products* to consider the burden of proof on a motion to amend. The outcome may make motions more attractive for Patent Owners if the Federal Circuit rules that the Patent Owner need not meet the burden of showing patentability.
- Proposals have been made to "off-ramp" motions to amend so that they can be considered by examiners rather than Administrative Patent Judges. The proposed amended claims would be considered through reexamination in parallel to the IPR proceedings — which would continue as to the non-amended claims.
- While "off-ramp" proposals may have benefits in terms of claim quality, it has proven difficult to develop a workable system to implement them.