Insights: Alerts

Federal Circuit Grants En Banc Review Of Amendment In AIA Trials

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Successful motions to amend in AIA trials continue to be rare. The Patent Trial and Appeal Board conducted and published a Motion to Amend Study this year: as of April 30, 2016, the Board had completed 1539 trials; 192 of those trials included a motion to amend. Of those, only 118 amendments were ultimately decided by the Board. And only six amendments (approximately 5%) were granted or granted-in-part.

With an order on August 12, 2016, the Court of Appeals for the Federal Circuit declared it will address the issue. In early December 2016, the Court will hear *en banc* the appeal of *In re: Aqua Products, Inc.* (IPR2013-00159), addressing the burdens and roles of the parties and Board in amendment. Specifically, the Court has requested briefing on the following two questions:

> (a) When the patent owner moves to amend its claims under 35 U.S.C. § 316(d), ***may the PTO require the patent owner to bear the burden of persuasion, or a burden*** of production, regarding patentability of the amended claims as a condition of allowing them? Which burdens are permitted under 35 U.S.C. § 316(e)?
>
> (b) When the petitioner does not challenge the patentability of a proposed amended claim, or the Board thinks the challenge is inadequate, ***may the Board sua sponte raise patentability challenges*** to such a claim? If so, where would the burden of persuasion, or a burden of production, lie?

The Board itself has wrestled with the first question in previous final written decisions. For example, in a precedential decision in *MasterImage 3D, Inc.* (IPR2015-00040) the Board effectively relaxed the patent owner's burden for amendment, clarifying that the patent owner's burden to amend requires a showing of patentability over only the "prior art of record," rather than all prior art.

Still, many patent owners like Aqua Products Inc. contend their burden should be further relaxed in seeking amendment in AIA trials.

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