



THINK FORWARD

Practical Guidance for Amending Claims in an Inter Partes Review

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The seeming unwillingness of the Patent Trial and Appeal Board (PTAB) to grant motions to amend patent claims in *Inter Partes Review* (IPR) proceedings has left many patent owners wondering whether the purported ability to amend claims is merely illusory. In fact, since IPR proceedings began in September 2012, only four motions to amend have been granted.

Recent USPTO actions, however, may signal a willingness to more favorably consider allowing amended claims in IPR proceedings. In March 2015, the USPTO announced a series of “quick fixes” to PTAB rules (available [here](#)), which collectively increased a patent owner’s opportunity to argue the patentability of proposed amended claims. In the “quick fixes,” for example, the page limit for motions to amend was increased from 15 to 25 pages. In addition, the requirement that amended claims be set forth as part of the motion to amend, thus counting toward the page limit, was eliminated. Instead, the proposed amended claims can now be presented in a claim appendix that does not count toward the 25 page limit.

In June 2015, the PTAB issued a key decision addressing a motion to amend in *REG Synthetic Fuels v. Neste Oil Oyj*, IPR2014-00192, Paper 48 (PTAB June 5, 2015) (available [here](#)). According to the PTAB, the patent owner had met the initial requirements for requesting claim amendments in its motion to amend: (1) the amendment was responsive to a ground of unpatentability, (2) the amendment did not enlarge the scope of unpatentability or introduce new matter, (3) the motion did not propose an unreasonable amount of new claims, and (4) the motion set forth support for the proposed new claims in the original disclosure. However, there was a question of whether the patent owner had met its burden of proving that the proposed new claims were patentable over the prior art of record and any prior art not of record but known to the patent owner.

The PTAB explained that “prior art of record” does not include every reference that has been cited during the proceeding. Rather, it only includes references that are relevant to the patentability of the proposed amended claims. Thus, a reference that has been cited as a basis of unpatentability for the original claims but is not material to the question of patentability for the proposed amended claims does not need to be addressed in the motion to amend. Applying this definition of “prior art of record,” the PTAB granted the patent owner’s motion to amend.

In July 2015, an expanded six judge panel issued another key decision, later designated as a representative decision, concerning a motion to amend in *MasterImage 3D, Inc. v. RealD Inc.*, IPR2015-00040, paper 42, (PTAB July 15, 2015) (available [here](#)). This decision provided further guidance regarding attempts to amend claims during IPR proceedings.

Expanding on the *REG Synthetic Fuels* decision, the panel explained that “prior art of record” for

purposes of proving patentability of proposed amended claims refers to: (1) any material prior art in the prosecution history of the patent, (2) any material prior art of record in the current proceeding, including prior art asserted in grounds on which the Board did not institute review, and (3) any material prior art of record in any other proceeding before the Office involving the patent. *Id.* at 2. In addition, the panel clarified that “prior art known to the patent owner” “should be understood as no more than the material prior art that the Patent Owner makes of record in the current proceeding pursuant to its duty of candor and good faith to the Office under 37 C.F.R. § 42.11, in light of a Motion to Amend.” *Id.* at 3.

The panel also explained that, “[b]ecause a proposed substitute claim is considered after the corresponding patent claim is determined unpatentable, Patent Owner’s addition of a limitation to render the claim as a whole patentable places the focus, initially, on the added limitation itself.” *Id.* According to the panel, therefore, the patent owner should place initial emphasis on the added limitations when considering the duty of candor and good faith and should also keep in mind that information about an added limitation can be material even if it does not include all of the rest of the claim limitations. *Id.*

Altogether, the recent “quick fixes” to the rules and decisions by the PTAB suggest that the PTAB may be more open to granting motions to amend that follow the PTAB’s guidance. Brinks has expertise in IPR proceedings, both at the PTAB and on appeal to the Federal Circuit. If you have any questions please contact a member of our [Post-Grant Patent Practice Group](#) for assistance regarding IPR proceedings.