



THINK FORWARD

Federal Circuit Addresses PTAB Requirements for IPR Motions to Amend

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On August 30, 2016, the Federal Circuit issued a decision in *Veritas Technologies LLC v. Veeam Software Corp.* addressing a patent owner's motion to amend filed in an *Inter Partes* Review (IPR) proceeding. The Court held that the Patent Trial and Appeal Board's (PTAB's) requirements relating to the motion were too demanding, thereby potentially making it easier for patent owners to successfully file such motions going forward.

During the IPR, the patent owner filed a motion to amend to add two new claims if the PTAB ultimately concluded the challenged existing claims were unpatentable. In considering the motion, the PTAB insisted "that the patent owner discuss whether each newly added feature was separately known in the art." The PTAB denied the motion, because it found that the patent owner had only addressed whether the new claimed *combination* was in the prior art, rather than whether each new claimed feature was separately in the prior art.

On appeal, the Federal Circuit rejected this requirement. According to the Court, "a long line of Supreme Court and Federal Circuit cases not[e] that novel and nonobvious inventions often are only a combination of known individual features." Thus, the Court held it was sufficient for the patent owner to address the new claimed *combination* in its motion to amend, rather than each new claimed *feature* separately. The Court vacated the PTAB's denial of the motion to amend and remanded.

The Court further made clear that the PTAB's decision [here](#) was erroneous independent of the resolution of the Court's upcoming *en banc* rehearing of the panel decision in *In re Aqua Products, Inc.*, 823 F.3d 1369 (Fed. Cir. 2016).

The Federal Circuit's decision can be found [here](#). More information about the Federal Circuit's upcoming *en banc* rehearing in *In re Aqua Products* can be found [here](#). If you would like to further discuss the decision or how it may impact your business going forward, please contact one of the authors below.