



THINK FORWARD

Post-Aqua: The Federal Circuit Vacated Denial Of Patent Owner's Motion To Amend

In *Silver Peak Systems, Inc. v. Matal*, No. 2015-2017 (Fed. Cir. Oct. 24, 2017), the Federal Circuit vacated the judgment of the Patent Trial and Appeal Board (PTAB) and remanded the case for further proceedings consistent with court's en banc decision in *Aqua Products, Inc. v. Matal*, No. 2015-1177 (Fed. Cir. Oct. 4, 2017)(en banc). See related blog posting, [Aqua Products, Inc. v. Matal: En Banc Decision on Motions to Amend Claims in AIA Post-Grant Proceedings Issues BLOG POST - OCTOBER 06, 2017](#). The Federal Circuit did not provide analysis and simply stated that its decision was based on *Aqua*. The PTAB decision that was vacated is *Riverbed Technology, Inc. v. Silver Peak Systems, Inc.*, IPR2014-00245, Paper No. 42 (P.T.A.B. June 9, 2015).

Inter partes review was initiated by Riverbed Technology, Inc. with respect to U.S. Patent No. 8,392,684. The PTAB instituted *inter partes* review of claims 1-24. In response, the patent owner moved to cancel original patent claims 1-24 and instead, proposed substitute claims 25-48 for the original patent claims. In the final written decision, the PTAB granted the patent owner's motion to amend with respect to cancelling claims 1-24 but denied the motion as to the proposed substitute claims 25-48. In denying the substitute claims, the PTAB stated that "[a]s the moving party, Patent Owner bears the burden of proof to establish that it is entitled to the relief requested," citing 37 C.F.R. § 42.20(c). The PTAB further stated that entry of proposed amendments occurs only upon the patent owner having met the requirements of 37 C.F.R. § 42.121 and demonstrated, by a preponderance of the evidence, the patentability of the proposed substitute claims. The requirements of § 42.121 include, among other things, (i) no broadening of scope and (ii) written description support.

In *Aqua*, the leading plurality opinion held that the burden of persuasion with respect to the patentability of amended claims falls on the petitioner and not on the patent owner. *Aqua Products, Inc.*, No. 2015-1177. Thus, the standard adopted by the PTAB in this case is inconsistent with the *Aqua* standard. On remand, the PTAB will need to evaluate the parties' arguments and evidence based on the burden of proof standard spelled out in *Aqua*. As parties' briefings on the motion to amend were prepared under the standard in 37 C.F.R. § 42.20(c), the PTAB may request new briefing under the *Aqua* standard. It will be interesting to see what procedural steps and changes the PTAB will implement on remand and whether the PTAB's original decision in this case will change under the *Aqua* standard.

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