

# AIA Blog USPTO Message From PTAB: How to Make Successful Claim Amendments in an AIA Trial Proceeding

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## USPTO Message From PTAB: How to Make Successful Claim Amendments in an AIA Trial Proceeding

In an AIA trial proceeding, such as an inter partes review (IPR), post-grant review (PGR), or a covered business method patent review (CBM), a patent owner may move to amend the claims of the challenged patent. The patent owner should not, however, approach the amendment process in an AIA trial proceeding like the amendment process to overcome an Office rejection filed during the prosecution of a patent application or during a reexamination or reissue proceeding.

During the prosecution of a patent application or during a reexamination or reissue proceeding, an applicant has a right to amend claims prior to a final Office action. Once an amendment is made, the burden then falls on the Examiner to show that the amended claims are unpatentable. In doing so, the Examiner undertakes a further prior art search, taking into account the added limitations. These aspects are different in an IPR, PGR, or CBM proceeding.

First, per the statute, a patent owner in an IPR, PGR, or CBM proceeding only may “move” to amend the claims. The proposed amendment is not entered automatically as it would be during prosecution of a patent application or during a reexamination or reissue proceeding.

Second, the patent owner in an IPR, PGR, or CBM proceeding bears the burden to show that the proposed substitute claims are patentable. The statute prescribes that the patent owner must move to amend the claims, and in so doing, as the moving party bears the burden to show entitlement to the relief requested by motion. An applicant bears no such burden during the prosecution of a patent application. Likewise, a patent owner bears no such burden due a reexamination or reissue proceeding. Rather, the Examiner has the burden to establish the unpatentability of any claim during examination, reexamination, and reissue.



Finally, the Board in an IPR, PGR, or CBM proceeding conducts no prior art search and performs no examination. Instead, the Board’s grant of a motion to amend operates to add the proposed substitute claims directly to an issued patent without a search or examination.

To succeed on a motion to amend in an IPR, PGR, or CBM proceeding given these distinguishing aspects, a patent owner should, with respect to each claim feature added by amendment, discuss what it knows what was previously known about the feature and about the level of ordinary skill in the art. A patent owner does not need to address individually all the items of prior art known to the patent owner. Nor does a patent owner need to address all of the prior art in existence at the time of filing. Rather, the patent owner should explain why the claim feature added by amendment, in combination with all the other features of the claim, would not have been obvious to a person of ordinary skill in the art at the time of the invention, in light of the knowledge and skill level of the person of ordinary skill in the art.

Additionally, a patent owner must be mindful that it is not sufficient to establish that its amended claims are patentable over the prior art applied by the petitioner. The petitioner did not select the prior art identified in the petition with knowledge of patent owner’s proposed substitute claims. In fact, the references applied by the petitioner reasonably are not expected to be the closest prior art regarding the added feature in the amended claims. Thus, while it is necessary for the patent owner to distinguish its amended claims over the prior art applied by the petitioner, a patent owner should not limit its motion to amend to that art. Demonstrating patentable distinction over the prior art applied by the petitioner does not establish the overall patentability of the proposed claims sufficient to have them added to the involved patent.

Finally, a statement by the patent owner that the closest prior art it knows about was applied by the petitioner in the petition can be helpful if the supporting basis is explained in and established by the motion to amend. A conclusory statement to this effect would be of questionable value because its meaning depends on the patent owner’s subjective focus when making the statement.

Posted at [03:57PM May 05, 2014](#) in Congressional Testimony |

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