

Motion to amend: focus on detail or face denial

Kenneth R Adamo, David W Higer, Eugene Goryunov and Mishele Kieffer describe some lessons learned on seeking claim amendments in a post-grant patent challenge

To date, only one patent owner has successfully been able to amend a claim subject to *inter partes* review (IPR) or covered business method review (CBMR) at the United States Patent and Trademark Office (USPTO). Despite this almost total lack of early success, the US Patent Act, USPTO Rules, and especially the decisions of the Patent Trial and Appeal Board (PTAB) provide guidance on the requirements for motions to amend. Those participating in IPR and CBMR proceedings must follow that PTAB guidance, as the PTAB focuses further on refining the amendment process to get the procedure “just so”.

Here, the requirements for motions to amend mandated by the Patent Act and USPTO Rules are summarised, and the PTAB’s current guidance on how the USPTO Rules are to be interpreted is addressed. The focus is to identify and analyse deficiencies that have doomed all but one motion to amend to date. Patent owners must be careful to heed scrupulously the letter of the PTAB guidance – from page limits to substantive arguments – lest their motions to amend suffer the same fate as virtually all of those before them.

Relevant rules and regulations

The relevant provisions of the Patent Act permit a patent owner to file one motion to amend the patent during an IPR or CBMR proceeding, but only after conferring with the PTAB first. A patent owner may file additional motions to amend but, again, only with PTAB pre-authorisation and upon either a showing of good cause or a joint request of the petitioner of the IPR or CBMR and the patent owner to materially advance a settlement. The motion may seek to cancel any challenged claim or “propose a reasonable number of substitute claims”. Similar to the former *inter partes* reexaminations, a motion to amend “may not enlarge the scope of the claims . . . or introduce new matter.”¹

Stay informed: refinement vis-à-vis PTAB decisions

Numerous IPR and CBMR proceedings involving motions to amend contain useful guidance from the PTAB on how it is interpreting the relevant statute and USPTO rules governing motions to amend. Even more important, however, are the PTAB’s discussion of filed motions to amend contained in Final Written Decisions concluding an IPR or CBMR proceeding.

Table 1 (page 68) lists the Final Written Decisions surveyed for this article.

These decisions provide a roadmap for how requests to amend claims must be made, ie:

- Confer with the PTAB before filing the motion. It’s required, and the patent owner may glean some useful insight that could make its arguments more persuasive.
- Adhere to the style and page limits set by PTAB rules and the statute, eg, include a claim listing showing all proposed changes.
- Support all arguments and proposed changes by identifying written description support in the as-filed patent application, not the as-

issued patent.

- Propose a “reasonable” number of substitute claims, preferably to a one-to-one ratio with the claims being replaced.
- Respond to all grounds of unpatentability to demonstrate the proposed changes result in patentable claims.

Don’t jump the gun – confer

Before filing a motion to amend, a patent owner must confer with the PTAB to “obtain guidance”. A conference with the PTAB is intended to “enhance[] efficiency by saving the patent owner’s time and resources to prepare a motion that would otherwise be denied...” Failure to confer with the PTAB results in dismissal of the motion.²

It may be possible, though not guaranteed, for the patent owner to satisfy the conference requirement by including the motion to amend in its list of proposed motions submitted in connection with the initial conference call.³ The best practice would be, however, for a patent owner separately to confer with the PTAB before filing its motion to avoid the possibility of having the motion dismissed.

Armed with guidance from the board, the patent owner may safely file a motion to amend. The next hurdle is to satisfy the filing requirements.

Colour inside the lines – strictly adhere to filing requirements

The USPTO Rules require a motion to stay within the bounds of a 15-page, 14-point font, double-spaced document.⁴ A motion to amend must include a claim listing clearly showing the proposed changes, including all amendments or substitutions. The claim listing must include any claim with a changed scope, subsequent to amendment, and assign any such claim a new number. To eliminate any confusion, the PTAB has instructed that “an unchanged dependent claim, which depends from a cancelled claim, still retains its same scope and does not need to be rewritten.” Along with the written description and patentability arguments, the claim listing must be part of the motion and may not be filed “as a separate paper, an appendix to the motion, or an attachment to the motion.” The claim listing may *not* be in a single spaced claim chart.⁵

Provide written description support for proposed amendments

Separate from the technical requirements for a motion, a motion to amend must also identify “support in the original disclosure of the patent for each claim that is added or amended.”⁶ The patent owner bears the burden to demonstrate that the proposed changes are fully supported by the original disclosure – the contents of the original application as filed with the USPTO prior to any amendments as a result of prosecution – not the issued patent,⁷ and that the amendments do not present any new matter. The motion must further identify support in any “earlier-filed disclosure” – including any foreign priority applications – for each proposed change if the patent owner is seeking

					Factors considered			
Case Name	Case No	Date	Motion filed?	Granted?	Page limit	Written description	Reasonable number	Responsive to prior art
<i>Garmin Int'l, Inc v Cuozzo Speed Techs LLC</i>	IPR2012-00001	11/13/13	Yes	No		•		•
<i>Idle Free Sys, Inc v Bergstrom, Inc</i>	IPR2012-00027	01/07/14	Yes	No		•		•
<i>Intellectual Ventures Mgmt, LLC v Xilinx, Inc</i>	IPR2012-00018	02/10/14	Yes	No		•		•
<i>Intellectual Ventures Mgmt, LLC v Xilinx, Inc</i>	IPR2012-00019	02/10/14	Yes	No		•		•
<i>Nichia Corp v Emcore Corp</i>	IPR2012-00005	02/11/14	Yes	No	•	•	•	•
<i>Intellectual Ventures Mgmt, LLC v Xilinx, Inc</i>	IPR2012-00020	02/11/14	Yes	Yes*				
<i>Intellectual Ventures Mgmt, LLC v Xilinx, Inc</i>	IPR2012-00023	02/11/14	Yes	No				•
<i>Liberty Mut Ins Co v Progressive Cas Ins Co</i>	CBM2013-00002	02/24/14	Yes	Yes*				
<i>Microsoft Corp v Proxyconn, Inc</i>	IPR2012-00026	02/19/14	Yes	No				•
<i>Synopsys, Inc v Mentor Graphics Corp</i>	IPR2012-00042	02/19/14	Yes	No		•		•
<i>Microsoft Corp v Proxyconn, Inc</i>	IPR2013-00109	02/19/14	Yes	No				•
<i>BlackBerry Corp v MobileMedia Ideas LLC</i>	IPR2013-00016	02/25/14	Yes	No			•	•
<i>CBS Interactive Inc, v Helferich Patent Licensing, LLC</i>	IPR2013-00033	03/03/14	Yes	No		•		•
<i>Illumina, Inc v The Trs of Columbia Univ in the City of NY</i>	IPR2012-00006	03/06/14	Yes	No				•
<i>Illumina, Inc v The Trs of Columbia Univ in the City of NY</i>	IPR2012-00007	03/06/14	Yes	No				•
<i>Illumina, Inc v The Trs of Columbia Univ in the City of NY</i>	IPR2013-00011	03/06/14	Yes	No				•
<i>Xilinx, Inc v Intellectual Ventures I LLC</i>	IPR2013-00029	03/10/14	Yes	No		•		•
<i>Bloomberg Inc v Markets-Alert Pty Ltd</i>	CBM2013-00005	03/26/14	Yes	No	•	•	•	•
<i>LKQ Corp v ClearLamp, LLC</i>	IPR2013-00020	03/27/14	Yes	No			•	•
<i>Munchkin, Inc v Luv N' Care, Ltd</i>	IPR2013-00072	04/21/14	Yes	No		•		•
<i>Motorola Solutions, Inc v Mobile Scanning Techs, LLC</i>	IPR2013-00093	04/24/14	Yes	No		•		•
<i>Adidas AG v Nike, Inc</i>	IPR2013-00067	04/28/14	Yes	Yes* / No		•	•	•
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00043	5/1/14	Yes	No**				•
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00044	5/1/14	Yes	No**				•
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00046	5/1/14	Yes	No				•
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00050	5/1/14	Yes	No		•		
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00048	5/9/14	Yes	No**				
<i>Corning Inc v DSM IP Assets BV</i>	IPR2013-00049	5/9/14	Yes	No**				
<i>Int'l Flavors & Fragrances Inc v The US of Am</i>	IPR2013-00124	5/20/14	Yes	Yes (in part)		•	•	•

* Motion to amend requested cancellation of claims only
** Challenged claims were confirmed patentable

Table 1: Final Written Decisions from the Patent Trial and Appeal Board concluding an *inter partes* review or covered business method review

the benefit of an earlier filing date under Sections 119 and/or 120.⁸ The PTAB has cautioned, however, that indicating where each claim limitation is “individually” described in the original disclosure “may be insufficient to demonstrate support for the claimed subject matter as a whole.” Though support in the disclosure need not be in *haec verba*, a, “mere citation to the original disclosure without any explanation as to why a person or ordinary skill in the art would have recognised that the inventor possessed the claimed subject matter as a whole may be similarly inadequate.”

The takeaway is that unless the proposed changes appear in *haec verba* in the supporting disclosure, a patent owner will need to provide an explanation as to why one of ordinary skill in the art would have recognised that the inventor possessed the amended claimed subject matter as a whole as of its filing date.⁹

Offer a “reasonable” number of proposed changes

A motion to amend may cancel a challenged claim or propose a “reasonable” number of substitute claims, begging the question: how many are “reasonable”?

Before considering how many substitute claims are reasonable, the patent owner must consider what claims are proper to amend in the first place. The patent owner must specifically identify and trace back each proposed substitute claim to a challenged claim it is intended to replace.¹⁰ And the motion to amend must further, “state, as to each proposed substitute claim, whether the claim is contingent on the corresponding claim in the challenged patent being determined to be unpatentable.”¹¹ Proposed substitute claims are not entered automatically and then examined: “If a patent owner’s motion to

amend is granted, the proposed substitute claims will be added directly to the patent, without examination.”¹² In other words, the PTAB does not examine, it adjudicates.

A claim amendment in an IPR proceeding is intended to be narrowly focused on those necessary to establish patentability over the prior art. Motions to amend are thus not an opportunity for the patent owner to conduct “a complete remodeling” of claims; an *ex parte* reexamination or reissue is the appropriate vehicle for that purpose.¹³ Indeed, the PTAB has looked with approval to a patent owner filing an *ex parte* reexamination request for claims challenged in an IPR proceeding in an attempt to amend the claims in front of the Central Reexamination Unit.¹⁴

What is a reasonable number of substitute claims? The USPTO Rules contain the rebuttable presumption that “only one substitute claim would be needed to replace each challenged claim.”¹⁵ But just because the total number of claims before and after the proposed change remains, the same does not mean that the patent owner is in compliance with the USPTO Rules. Rather, each proposed substitute claim must:

be traceable back to the original patent claim that it is intended to replace. In general, claim X is properly named as a substitute claim for claim Y if claim X includes all of the features of claim Y.¹⁶

A patent owner may, however, attempt to submit more than one substitute claim under certain circumstances. In *Idle Free Sys, Inc v Bergstrom, Inc*, the PTAB explained that deviation from a one-to-one correspondence is appropriate only upon a showing of a “special circumstance”. The PTAB has not defined what constitutes a “special circumstance”, but has stated that a, “desire to obtain a new set of claims having a hierarchy of different scope typically would not constitute a sufficient special circumstance.”¹⁷ The PTAB has suggested that it may be possible to establish special circumstances to rebut the presumption of the one-to-one substitute rule by demonstrating patentable distinction “from the first substitute claim, given the first substitute claim as prior art.”¹⁸

The patent owner must further demonstrate – for each proposed substitute claim – that the claim is patentably distinct from all other proposed substitute claims.¹⁹ The PTAB will not accept redundant substitute claims. For example, in *adidas AG v Nike, Inc* the patent owner filed a motion to amend, substituting two dependent claims for one challenged dependent claim. The PTAB found the patent owner had failed to propose a reasonable number of substitute claims, but nevertheless exercised its discretion and did not deny the motion on this particular basis.²⁰

Respond to grounds of unpatentability

Once the number of proposed claims is acceptable, any proposed substitute claims must respond to all grounds of unpatentability to result in a successful motion to amend.²¹ To date, this has proven to be the most difficult hurdle to overcome to gain an amended claim. Indeed, only one patent owner has been successful as of the submission date of this article.

Specifically, a patent owner must:²²

- Identify with particularity the feature or features added to each proposed substitute claim. A proposed claim, for example, is not responsive to an alleged ground of unpatentability, “if it does not either include or narrow each feature of the challenged claim being replaced.” Generally, this requires any substitute claim to, “not eliminate any feature or element of the original patent claim which it is intended to replace.” Deviation from this general rule may, however, be established on an “adequate and persuasive explanation” of a

special circumstance;

- State a proposed construction of new terms used in the proposed substitute claims;
- Present “technical facts and reasoning” supporting the amendment;
- Make a representation “about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims”; and
- Make a statement – potentially supported by an expert’s declaration – about the level of ordinary skill in the art as well as what was previously known and the closest known prior art, for each feature relied upon to establish patentability of the proposed substituted claims. Such statement should discuss, “the significance and usefulness of the feature(s) added by the proposed substitute claim, from the perspective of one with ordinary skill in the art, and also on the level of ordinary skill, in terms of ordinary creativity and the basic skill set.”

The patent owner bears the burden to demonstrate it is entitled to the proposed substitute claims, which further requires the patent owner to show that each proposed substitute claim is “patentably distinct over the prior art”, not just the prior art of record.²³ PTAB decisions show that this does not require the patent owner to be aware of every item of prior art presumed to be known to a person having ordinary skill in the art; rather, the patent owner must set out “what it does know about the level of ordinary skill in the art, and what was previously known, regarding each feature it relies and focuses on for establishing patentability of its proposed substitute claims.”²⁴ In other words, failure to address other known prior art – in addition to any combinations identified by the petitioner – will likely result in the denial of the proposed substitution.²⁵

In *Avaya Inc v Network-1 Sec Solutions, Inc*, the PTAB provided an example of how a patent owner may meet these requirements:

To illustrate, if a feature Z is proposed to be added to a claim to render it patentably distinct from the prior art, it would be essential for Patent Owner to establish the significance of feature Z from the perspective of the level of ordinary skill in the art. It is of little value only to state that no prior art teaches or suggests multiple claim elements including feature Z... Instead, it would be helpful for Patent Owner to focus first on feature Z and indicate whether feature Z was known in any context, and if so, then explain why that context is so remote or different from that of the claimed invention that one with ordinary skill in the art would not have applied that teaching to arrive at the claimed invention. Similarly, it would be helpful to know why one with ordinary skill in the art would not have adapted relevant basic or general techniques taught in textbooks in the field of the invention to the particular use required by the claimed invention.²⁶

To fully comply with these requirements, the PTAB has encouraged patent owners to, “propose focused amendments for a limited set of claims and use the bulk of [a] motion [to amend] to explain why the motion should be granted.”²⁷ Failure to heed this advice gives the PTAB grounds to deny entry of the proposed substitute claim. After all, the PTAB, “would not want to grant a motion to add claims to a patent where such claims have not been demonstrated to be patentable over prior art. To do otherwise would not serve the interests of the Petitioner in this case or the public in general.”²⁸

In fact, during a recent PTAB roundtable discussion in New York, Chief Judge James Smith of the PTAB stated that in moving to amend claims, the patent owner must embrace that it bears the ultimate burden

to show that the proposed changes are patentable. He suggested that patent owners who attempt to carry this burden are more likely to succeed in amending claims.

The one that made it through

The patent owner in *Int'l Flavors & Fragrances Inc v The US of Am* succeeded in carrying its burden in amending claims involved in an IPR.

First, the patent owner proposed 19 substitute claims – one for each challenged claim – adding various elements to the two proposed independent claims. The PTAB concluded that the proposed substitute independent claims did not impermissibly enlarge the scope of the original claims.

Next, the patent owner identified what it argued was the written description support for the proposed substitute claims as a whole, not just the newly added elements. The citations were made to the as-filed version of the application that issued as the patent at issue.

Finally, the patent owner argued that one of the cited prior art references was the “apparent” closest prior art reference. The patent owner, however, went further in its motion, according to the PTAB, to demonstrate the relevant ordinary skill in the art and identified evidence of, “what would have been understood by the ordinary artisan as to those features being relied upon to demonstrate patentability of the proposed claim.” Specifically, the patent owner presented evidence that even a small change to the chemical structure of the claimed compound would result in a compound having very different properties. On this basis, patent owner’s expert declarant concluded that “the ordinary artisan would not expect that minor structural changes . . . would result in a modified compound having the same [properties] as the parent compound.” The PTAB agreed, concluding that the prior art did not provide “a reasonable expectation” that modifying the claimed compound would result in a compound having the desired qualities. The PTAB held that the patent owner demonstrated, by a preponderance of the evidence, that one of the proposed substitute independent claims was patentable. As to the second proposed substitute independent claim, however, the PTAB concluded that the claim was not patentable because it attempted to claim a new benefit of an old process.²⁹

This decision is encouraging news for patent owners and patent owners should continue to pursue amendments (to the extent feasible and/or strategically appropriate) to the claims involved in a post-grant challenge at the PTAB. Though the standard may be relatively high, it is by no means impossible.

The takeaway

To increase the likelihood of success for a motion to amend claims in any post-grant challenge before the PTAB, a patent owner must meet – definitely – every requirement set out in statute, rule, and PTAB precedent, from the procedural details to the substantive arguments. Glossing over any step in the motion to amend process risks a swift denial from the PTAB.

Footnotes

1. 37 CFR § 42.121(a)(2)(ii).
2. *Nichia Corp v Emcore Corp*, IPR2012-00005, Paper 27, 2 (3 June 2013); *Idle Free Sys, Inc v Bergstrom, Inc*, IPR2012-00027, Paper 26, 2 (11 June 2013).
3. *Compare Nichia Corp*, IPR2012-00005, Paper 27 at 2 (patent owner satisfied the conference requirement by including a motion to amend in its proposed motions list) with *Idle Free Sys*, IPR2012-00027, Paper 26 at 10 (patent owner did not satisfy the conference requirement by discussing the motion to amend during the initial conference call).
4. 37 CFR § 42.24(a)(1)(v); 37 CFR § 42.6.
5. *Toyota Motor Corp v Am Vehicle Sci LLC*, IPR2013-00419, Paper 32, 2 (7 Mar 2014); *Synopsys, Inc v Mentor Graphics Corp*, IPR2012-00042, Paper 30, 2 (28 June 2013); *Innolux Corp v Semiconductor Energy Lab Co, Ltd*, IPR2013-00066, Paper 24, 3 (18 July 2013).
6. 37 CFR § 42.121(b).
7. *Nichia Corp*, IPR2012-00005, Paper 27 at 3.
8. *Research In Motion Corp v MobileMedia Ideas LLC*, IPR2013-00016, Paper 20, 3 (16 May 2013) (citing 37 CFR § 42.121(b)).
9. *Nichia Corp*, IPR2012-00005, Paper 27 at 3–4.
10. *Idle Free Sys*, IPR2012-00027, Paper 26 at 5.
11. *RiverBed Tech, Inc v Silver Peak Sys, Inc*, IPR2013-00402, Paper 24, 2 (27 Mar 2014).
12. *Volusion, Inc v Versata Software, Inc*, CBM2013-00017, Paper 24, 3 (27 Jan 2014).
13. *Idle Free Sys*, IPR2012-00027, Paper 26 at 6.
14. *Game Show Network, LLC, et al v John H Stephenson*, IPR2013-00289, Paper 31, 2 (21 Mar 2014).
15. 37 CFR § 42.121(a)(3).
16. *Toyota*, IPR2013-00419, Paper 32 at 3.
17. *Idle Free Sys*, IPR2012-00027, Paper 26 at 5–6.
18. *Toyota*, IPR2013-00419, Paper 32 at 3.
19. *Idle Free Sys*, IPR2012-00027, Paper 26 at 8–9.
20. *adidas AG v Nike, Inc*, IPR2013-00067, Paper 60, 24–26 (28 Apr 2014).
21. *Nichia Corp v Emcore Corp*, IPR2012-00005, Paper 68, 53 (11 Feb 2014).
22. *Idle Free Sys*, IPR2012-00027, Paper 26 at 5, 7–8; *Toyota*, IPR2013-00419, Paper 32 at 3.
23. *Id* at 6–7 (emphasis added).
24. *Idle Free Sys, Inc v Bergstrom, Inc*, IPR2012-00027, Paper 66, 33 (7 Jan 2014).
25. *adidas*, IPR2013-00067, Paper 60 at 34.
26. *Avaya Inc v Network-1 Sec Solutions, Inc*, IPR2013-00071, Paper 38, 2–3 (22 July 2013) (emphasis added).
27. *RiverBed Tech*, IPR2013-00402, Paper 24 at 3.
28. *Volusion*, CBM2013-00017, Paper 24 at 4.
29. *Int'l Flavors & Fragrances Inc v The US of Am*, IPR2013-00124, Paper 12, 9–10, 12, 14, 16–18 (20 May 2014).

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