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AIA Patent Amendments Not As Tough As You Think: Judge

By **Ryan Davis**

Law360, New York (May 14, 2015, 8:40 PM ET) -- The apparent difficulty of getting patents amended in America Invents Act reviews has gotten considerable attention from patent owners, judges and lawmakers, but the chief judge of the Patent Trial and Appeal Board said Thursday that amendments aren't as hard to come by as many think.

The often-cited figure that the PTAB has only allowed amendments four times in over 3,000 AIA review cases filed is misleading, since amendments are only requested in a small number of cases, Chief Judge James Donald Smith told a U.S. Patent and Trademark Office advisory panel.

Amendments have only been requested in fewer than 100 AIA review cases, Judge Smith said at a meeting of the Patent Public Advisory Committee. Many of those requests were rejected because the patent owner introduced new terminology that had never been used before and had no support in the patent, or failed to make any argument that the proposed new claims were patentable over the prior art, he said.

He suggested that people concerned about amendments should read some of the board's decisions on the issue, and said that "I think a careful study of them would alleviate much of the concern."

"If you look at the instances where motions were granted, one develops appreciation that it's perhaps not nearly as difficult as has been described," he said, adding that patent owners who have made an "appropriate representation as to patentability" have had their motions to amend granted.

Judge Smith said that the standard for showing that a proposed amendment is patentable is not as stringent as many people believe. He said that while he has seen in print "more times than I can count" the claim that a patent owner must show that the proposed amended claim is patentable over "all prior art known to man," that is not the case.

"The requirement in our cases never goes that far," he said, and patent owners must only show that the amended claims are patentable over the prior art of record in the case.

Advisory committee member Peter Thurlow of Jones Day said that it's helpful to know that the PTAB believes that patent owners can look to prior decisions for guidance on motions to amend.

"There may be a sense in the public about claim amendments that you're not going to get it, so why try it?" he said. "If the feeling is that you will get it if you do it correctly, so please try, I think that's a message to get out even more."

The low number of amendments granted by the PTAB has been one of the main criticisms of the AIA review process for many patent owners, who say that it slants the process against them and in favor of accused infringers by making it too hard to change claims to avoid prior art.

The USPTO has cited the ability to amend claims as one of the reasons why the PTAB uses the so-called broadest reasonable interpretation standard for claim construction, which makes it easier to invalidate patents than the standard used in district court. But critics, including Federal Circuit Judge Pauline Newman, have said that the PTAB has allowed amendments so rarely that the different standard can't be justified.

In March, Sen. Chris Coons, D-Del., introduced the **STRONG PATENTS Act**, which among other things would make it much easier to amend patents in AIA reviews. The same month, USPTO Director Michelle Lee said that the office is **considering new rules** aimed at making it easier to amend claims.

Judge Smith also updated the advisory committee on the PTAB's workload, noting that it now receives about 150 to 170 AIA review petitions per month. If the number of monthly filings stays below 200, he said, the PTAB should have no problem meeting all of the statutory deadlines for AIA decisions.

Beginning in the fall, the board will have to issue more than 100 institution decisions and well over 100 final written decisions in AIA review each month for several months, which he said "will substantially tax the capabilities of the board."

However, he said the board is ready to meet those targets, noting that it currently has 231 judges and expects to have up to 260 by the end of the year.

Judge Smith also noted that the Federal Circuit has to date decided 14 appeals of AIA review decisions and affirmed every one, 12 of them without issuing an opinion, which he said "reflects favorably" on the board's work in the eyes of the appeals court.

--Editing by Katherine Rautenberg.

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