United States Patent and Trademark Office
Office of the Chief Administrative Patent Judge

MEMORANDUM

TO: Patent Trial and Appeal Board

FROM: David P. Ruschke
Chief Administrative Patent Judge
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DATE: November 21, 2017

RE: **Guidance on Motions to Amend in view of *Aqua Products***

On October 4, 2017, the U.S. Court of Appeals for the Federal Circuit issued an *en banc* decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017). In the decision containing five separate opinions, the court addressed the burden of proof that the Board applies when considering the patentability of substitute claims presented in a motion to amend filed under 35 U.S.C. § 316(d) in an *inter partes* review proceeding ("IPR") under the Leahy-Smith America Invents Act ("AIA"). As noted in the lead opinion, "very little said over the course of the many pages that form the five opinions in this case has precedential weight." *Aqua Prods.*, 872 F.3d at 1327. The lead opinion concludes with the following.

> The only legal conclusions that support and define the judgment of the court are: (1) the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference; and (2) in the absence of anything that might be entitled deference, the PTO may not place that burden on the patentee.

Id.

In light of the *Aqua Products* decision, the Board will not place the burden of persuasion on a patent owner with respect to the patentability of substitute claims presented in a motion to amend. Rather, if a patent owner files a motion to amend (or has one pending) and that motion meets the requirements of 35 U.S.C. § 316(d) (i.e., proposes a reasonable number of substitute claims, and the substitute claims do not enlarge scope of the original claims of the patent or introduce new matter), the Board will proceed to determine whether the substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner. Thus, for example, if the entirety of the evidence of record before the Board is in equipoise as to the unpatentability of one or more substitute claims, the Board will grant the motion to amend with respect to such claims, and the Office will issue a certificate incorporating those claims into the patent at issue.

Beyond that change, generally speaking, practice and procedure before the Board will not change. For example, a patent owner still must meet the requirements for a motion to amend under 37 C.F.R. § 42.121 or § 42.221, as applicable. That is, a motion to amend must set forth written description support and support for the benefit of a filing date in relation to each substitute claim, and respond to grounds of unpatentability involved in the trial. Likewise, under 37 C.F.R. § 42.11, all parties have a duty of candor, which includes a patent owner's duty to disclose to the Board information that the patent owner is aware of that is material to the patentability of substitute claims, if such information is not already of record in the case.

The Board will continue its current briefing practice as to the types, timing, and page-limits of briefs, as set forth in the rules governing trial practice before the Board and the Office Patent Trial Practice Guide. *See, e.g.*, 37 C.F.R. §§ 42.22–42.25; Office Patent Trial Practice Guide, 77 F.R. 48756, 48766-48767 (Aug. 14, 2012). The Board's

standard Scheduling Order will remain the same in that a patent owner may file a motion to amend the claims of the challenged patent, in accordance with 37 C.F.R. § 42.121 or § 42.221, on Due Date 1. A patent owner also must continue to confer with the Board before filing a motion to amend. *See* 37 C.F.R. §§ 42.121(a), 42.221(a).

The above guidance notwithstanding, if any party in a matter involving a pending motion to amend believes there is need to discuss the impact of *Aqua Products* with the Board in a particular case, the party may contact the Board to arrange a conference call. The Board already has contacted, or soon will contact, parties with motions to amend pending at the time that the *Aqua Products* decision issued to let them know that a request for a conference call is appropriate in this regard. During such a call, any party may request briefing changes or additional briefing. The Board generally will permit supplemental briefing regarding the patentability of substitute claims proposed in a motion to amend, if requested.

In an instituted proceeding where a patent owner still has an opportunity to file a motion to amend, any party may contact the Board before Due Date 1 (as designated in a Scheduling Order) in relation to briefing questions. If a patent owner wishes to file a new or substitute motion to amend in a trial that has proceeded past Due Date 1, the patent owner must contact the Board to arrange a conference call as soon as reasonably possible.