

Patent Owner Tip #16 for Surviving an Instituted IPR: Improve Your Chances of Getting Amendments

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In our earlier blogs, we previously discussed [when to file an amendment](#), [when not to file an amendment](#), and the [procedural guidelines for filing amendments](#) pursuant to 35 U.S.C. § 316(d)(1). Below are four tips for improving your chances of convincing PTAB to grant a motion to amend your claims:

- **Participate in the PTAB's Pilot Program:** PTAB's pilot program for amendments is optional, but it's an option that Patent Owners must strongly consider. As previously discussed, the pilot program allows a patent owner to: (1) request preliminary guidance from the PTAB on its first motion to amend, and/or (2) file a revised motion to amend. The opportunity to both receive initial guidance from the Board on a proposed amendment and then address and fix any problems identified by the Board has proven invaluable—for patent owners seeking to amend claims who have taken advantage of the pilot program, motions have been granted or granted-in-part about 36% of the time, whereas motions by patent owners who did not participate had a success rate of only about 9%.
- **Don't Give PTAB an Excuse to Deny Your Motion:** While the petitioner now bears the burden of persuasion of the unpatentability of all substitute claims, a patent owner should be careful not to give the PTAB any additional excuses to deny a motion to amend. To this end, pursuant to 37 C.F.R. § 42.121(2), it is usually advisable to include in your motion a detailed explanation of how your proposed amendments (1) are responsive to a ground of unpatentability; (2) do not seek to enlarge the scope of the claims; and (3) do not introduce new subject matter. And a patent owner should always include a detailed identification of the prior written support for any new or amended claims that are proposed.
- **Make Sure the Substitute Claims Include a Group of Narrow Claims that Accomplish Your Goals:** Although the petitioner bears the burden of proving the unpatentability of any proposed substitute claims, patent owners should not alleviate that burden by seeking the broadest claims possible (which sometimes is a patent prosecutor's natural inclination). Instead, patent owners should consider drafting the claims as narrowly as possible in view of the ultimate strategic goals (e.g., infringement reads or covering competitors' products).
- **Keep *Uniloc* in Mind:** In [Uniloc 2017 LLC v. Hulu, LLC](#), 966 F.3d 1295 (Fed. Cir. 2020), the Federal Circuit held that proposed substitute claims must meet all general patentability requirements, not just those raised in the petition. Thus, while an IPR petition's unpatentability grounds are restricted to certain anticipation and obviousness arguments, the PTAB may reject proposed substitute claims on additional grounds, including lack of written description, unpatentable subject matter under § 101, and indefiniteness. Therefore, when drafting and submitting any proposed substitute claims, careful consideration must be given to not only overcoming the prior art, but also to not creating or perpetuating any indefiniteness, written description, or other patentability issues that a petitioner could not raise in the original petition, but which may now be raised in light of the motion to amend.

Once a patent owner has determined that conditionally moving to amend its claims is the best route to surviving an instituted IPR, the above four tips may significantly increase the chances of getting the amended claims granted. Patent owners should avail themselves of all resources, including PTAB's pilot program, be cognizant of the burdens of proof, keep *Uniloc* in mind when drafting substitute claims, and draft as narrowly as possible to achieve their goals.

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