

PTAB Grants Late Motion to Amend, But Amended Claims Fail to Breathe Life into Patent

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Addressing the standards for a motion to amend claims during an *inter partes* review (IPR) proceeding, the Patent Trial and Appeal Board (PTAB or Board) granted a motion to amend the claims in an IPR, but ultimately denied entry of the substitute claims as unpatentable. *Alcohol Monitoring Systems, Inc. v. Soberlink, Inc.*, Case No. IPR2015-00556 (PTAB, May 3, 2016) (McKone, APJ).

The challenged patent relates to remote sobriety monitoring using a breath testing and identification device. Several claims of the patent-in-question were challenged in an earlier related IPR and found to be unpatentable. Claims not addressed in the earlier IPR were at issue in this proceeding. Following the PTAB's decision to institute IPR, instead of filing a response defending the challenged claims, the patent owner filed a motion to amend, requesting cancellation of all claims and entry of substitute claims. Requests solely to cancel claims typically are granted without substantive review. A request that seeks to substitute claims is not entered automatically, but only upon the patent owner demonstrating the patentability of the substitute claims. Amendments may not seek to enlarge the scope of the claims or introduce new matter.

In response to the patent owner's motion to amend, the petitioner argued that the substitute claims were impermissibly broadened. As a result of the patent owner's failure to provide substantive argument or evidence to the contrary, the PTAB found that the original motion to amend failed to meet the requirements of a proper amendment under § 316(d)(3). The patent owner then filed a reply, accompanied by a revised set of proposed substitute claims alleged to address the petitioner's arguments. Under § 316(d)(1)(B), a patent owner is authorized to file one motion to amend; additional motions to amend are unauthorized and may only be permitted at the PTAB's discretion. Although the patent owner did not comply with the rules in pursuing the second amendment, the PTAB ruled that the amendment should nevertheless be considered, as it eliminated one of the disputes between the parties by restoring in some respects the claim language to its original scope.

When seeking entry of an amendment to the claims in an IPR, the patent owner bears the burden of proof to establish that it is entitled to the relief requested. In considering the substitute claims, the PTAB first reviewed whether the substitute claims introduced new subject matter. In its reply to the petitioner's opposition, the patent owner admitted that it had attached an incorrect version of its claim chart in its motion to amend, and provided an amended version that the PTAB declined to consider.

The PTAB concluded that the patent owner's evidence (even if considered in view of the amended claim chart) was insufficient to demonstrate written description support for the substitute claims. The PTAB then turned to the prior art, finding that the patent owner failed to meet its burden to demonstrate that any of the substitute claims were patentable over the prior art. For these reasons, the PTAB denied entry of the substitute claims.

Note: In its decision, the PTAB pointed to certain failures in the patent owner's arguments, including its attacks on the prior art references individually rather than collectively, expert testimony without citation to evidence, and failure to establish a nexus between the objective evidence presented and the merits of the claimed invention.

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