

Seyfarth PTAB Blog

A legal look at Patent Trial and Appeal Board decisions and trends



PTAB Grants Rare Motion to Amend

By Patrick T. Muffo

Unlike reexamination proceedings, *inter partes* review (IPR) proceedings rarely allow amendments to the claims to overcome a prior art invalidity challenge. In nearly all cases, the challenged claims of an IPR remain the same from start to finish. Recently, however, the PTAB allowed the patent owner to cancel all original claims of the patent in favor of five brand new claims never existing prior to the IPR.

The case of *Shinn Fu Co. of America, et al. v. The Tire Hanger Corp.*, (Case IPR2015-00208, Final Written Decision, April 22, 2016) involves perhaps the most far reaching amendment ever allowed by the PTAB. Patent Owner Tire Hanger sued Shinn Fu, asserting each of the five claims of its patent. When faced with an IPR petition, Tire Hanger did not file a patent owner's response and in fact admitted the claims were "not patentable" in light of the prior art asserted in the petition. Instead, Tire Hanger moved the PTAB to allow an amendment that would add five additional claims that Tire Hanger believed were patentable over the prior art.

The PTAB granted the Motion despite Shinn Fu's opposition. In particular, Shinn Fu opposed the motion by first arguing the new claims enlarge the scope of the patent in contravention of 37 C.F.R. §42.121. The PTAB disagreed and found Tire Hanger simply moved features from the dependent claims into the independent claims, which does not broaden the dependent claims as a matter of law.

Shinn Fu also argued the addition of a "human" actor to the claims impermissibly broadened the claims beyond the scope of the specification, which only supported a "worker" performing the various steps. The PTAB again disagreed and found Shinn Fu's proposed construction of "human" to be unreasonable. Specifically, the PTAB found "human" to mean "individuals handling tire/wheel assemblies when mounting and removing them from vehicles" rather than including "newborns, toddlers, children, disabled people, and decrepit people," as proposed by Shinn Fu.

Instead, the PTAB focused on why the new claims were patentable over the prior art as opposed to the procedural standard for allowing a Motion to Amend: "We also determine that Tire Hanger has met its burden of

showing that substitute claims 6-10, as proposed in its Motion to Amend, are patentably distinct over the prior art of record, and thus, we *grant* the Motion to Amend.” (Emphasis in original).

Takeaway

Tire Hanger made a bold decision to abandon any hope for each of the claims of the challenged patent and instead move to amend the patent with new claims. Here, that strategy was successful in part because Tire Hanger focused its arguments on the patentability of the new claims. Although still rarely granted, Motions to Amend can therefore be helpful tools when faced with strong invalidity challenges and where infringement can still be found with new or amended claims.

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