



# THINK FORWARD

## Brinks Gilson & Lione attorney: "New Patent Office study confirms motions to amend in PTAB proceedings have been largely unsuccessful"

May 12, 2016

**ANN ARBOR** – James Cleland, a shareholder in the Ann Arbor office of Brinks Gilson & Lione, one of the nation's largest intellectual property law firms, says a United States Patent Office's (USPTO) study released May 9 on the Patent Trial and Appeal Board ("PTAB") confirms that motions to amend have been largely unsuccessful.

In response to claims by patent owners that PTAB has raised the bar too high to amend claims of a patent in response to validity challenges under the America Invents Act ("AIA"), the USPTO conducted a detailed study of all motions to amend in post-grant proceedings to date. The study found that of 4,850 total petitions filed since September 16, 2012, 1,539 have resulted in completed trials and 743 have trials pending. Of those 1,539 completed trials, a patent owner has filed a motion to amend in 192 of the completed trials. Of those 743 cases that are still pending trial, a patent owner has filed a motion to amend in 34 instances.

Accordingly, of the 2,282 total instances in which the PTAB instituted trial in an AIA challenge, a motion to amend has only been filed in approximately 10% of the cases.

"The data establishes that patent owners are not attempting to amend their claims very often," Cleland said. "Further data provided by the USPTO may suggest why: only approximately 5% of all motions to amend have been at least partially successful and led to the issuance of at least one new amended claim. However, it is also worth noting that of the six motions that were granted at least in part, most of those successful motions have been adjudicated in the last year or two."

Cleland is referring to data provided by the USPTO that shows that of the 192 motions to amend in trials already completed, the PTAB has rendered a substantive decision on the motion to amend in 118 cases. The other cases either settled before a decision on the motion or involved the cancellation of claims, not the amendment of claims. Of the 118 cases involving a PTAB ruling, two of the motions to amend were granted in full, four were granted in part, and 112 were denied.

Cleland says the USPTO's study suggests that it is still difficult to amend claims during post-grant proceedings, and that it is not a tool frequently used by patent owners.

"Despite the study results, though, the PTAB is still encouraging patent owners to file motions to amend," Cleland said. "This may suggest that the PTAB judges will start to be more receptive to motions to amend and that we may see an uptick in the success rates of these motions in the near future."

At Brinks, Cleland's practice focuses on patent, trademark, copyright, trade secret and unfair competition litigation in a broad range of technologies including the chemical, automotive, materials science, mechanical, electrical and medical device arts, as well as in client counseling, opinion and licensing work in those same areas. His litigation experience includes trials, preliminary injunction

hearings, Markman hearings summary judgment proceedings and all aspects of fact and expert witness discovery, spanning federal courts across the country. Cleland also specializes in post grant review proceedings before the Patent Trial and Appeal Board.

### **Brinks Gilson & Lione**

*The attorneys, scientific advisors and patent agents at Brinks Gilson & Lione focus their practice in the field of intellectual property. Brinks is one of the largest intellectual property law firms in the U.S. Clients around the world use Brinks to help them protect and enforce their intellectual property rights. Brinks lawyers provide counseling in all aspects of patent, trademark, unfair competition, trade secret and copyright law. More information is at [www.brinksgilson.com](http://www.brinksgilson.com).*