THINK FORWARD

The Patent Trial And Appeal Board Extended One Year Pendency Of An Inter Parte Review For Considering The Impact Of Aqua Products, Inc. V. Matal

The Patent Trial and Appeal Board (PTAB) issued a first decision extending one year pendency of an *inter partes* review <u>for good cause</u>. *Minerva Surgical, Inc. v. Hologic, Inc.*, IPR2016-00868, Paper No. 57 (P.T.A.B. October 5, 2017). *See* also the related blog posting, <u>PTAB Adjusts Deadline For Final Decisions In Rare Cases BLOG POST - JUNE 28, 2017</u>.

Under 35 U.S.C. §§316(a)(11) and 42.100(c), the Director may, for good cause shown, extend the 1 year period for issuing a final determination by not more than 6 months. In particular, 37 C.F.R. §42.100(c) states that the Chief Administrative Judge can extend the time to issue a final written decision of an *inter partes* review for good cause.

In this case, the PTAB determined that good cause exists for considering the impact of *Aqua Products, Inc. v. Matal*, No. 2015-1177 (Fed. Cir. Oct. 4, 2017). In *Aqua*, the leading plurality opinion of the Federal Circuit held that the burden of persuasion with respect to the patentability of amended claims falls <u>on the petitioner</u> and not on the patentee. *See* also related blog posting, <u>Aqua Products, Inc. v. Matal: En Banc Decision on Motions to Amend Claims in AIA Post-Grant Proceedings Issues BLOG POST - OCTOBER 06, 2017</u>. During the present proceeding, the patentee filed a motion to amend claims and the petitioner filed an opposition arguing that the patentee failed to demonstrate that its substitute claims are patentable over the prior art.

The PTAB's decision as to the patentee's motion to amend in this proceeding provides helpful guidance in understanding the impact of *Aqua* on a motion to amend during an *inter partes* review, in particular, how to place the burden of persuasion as to the patentability of amended claims on the petitioner.

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