



Federal Circuit: Claim Amendments During IPR That Respond to Grounds of Unpatentability May Also Make Changes Unrelated to the IPR

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In *American National Manufacturing, Inc. v. Sleep Number Corp*, the appellant-petitioner American National argued that the PTAB erred in its application of 37 C.F.R. § 42.121 when it permitted Sleep Number to include certain claim amendments to “achieve consistency and accuracy in terminology and phrasing throughout the patent family.” Section 42.121 specifies that a motion to amend may be denied where “[t]he amendment does not respond to a ground of unpatentability involved in the trial.” In applying this regulation, the PTAB determined that any claim amended to address a ground of unpatentability **could also be amended** for other reasons, including potential § 101 and § 112 issues.

On appeal, American National argued the Board violated due process and the APA by allowing additional amendments in the context of an IPR. More specifically, American National argued it would be unfair and asymmetrical to allow patentees to use an IPR as a vehicle to amend claims to address § 101 or § 112 issues when petitioners cannot challenge claims on those grounds.

The Federal Circuit, however, disagreed. Citing previous decisions, the court noted that petitioners are free to challenge **amended** claims on grounds that go beyond § 102 and § 103, including on § 101 and § 112. Thus, it discerned no asymmetry between patentees and petitioners in the context of a motion to amend. And because each of the amended claims contained an amendment responsive to a ground of unpatentability raised in the IPR proceeding, Sleep Number’s additional amendments were not improper.

Practice Tip: For patentees facing co-pending litigation and IPR proceedings, there may be an opportunity to amend claims to defeat both the IPR petition and live defenses in the litigation. It is important, however, to weigh that value of such a result against the risk of possible invalidation or intervening rights. And, similarly, defendants considering filing an IPR petition must weigh the possibility that the Patent Owner might use a motion to amend to remedy potential § 112 deficiencies.

American National Manufacturing, Inc. v. Sleep Number Corporation, Case Nos. 2021-1321

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