



Federal Circuit Vacates PTAB's Denial of Motion to Amend

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In April 2014, the PTAB instituted *inter partes* review of U.S. Patent No. 7,024,527 (the “527 patent”), which is directed to processes for restoring computer data. The petitioner, Veeam Software Corp. (“Veeam”), challenged the patentability of Veritas’s patent based on prior art that disclosed block-level restoration processes. Veritas, however, argued that the challenged claims did not encompass such processes and were more narrowly limited to file-level background restoration processes. Veritas also filed a contingent motion to amend the claims if the PTAB ultimately found the challenged claims to be unpatentable. Veritas’s claim amendments sought to expressly limit the claims to file-level background restoration processes.

In its April 2015 final written decision, the PTAB construed the challenged claims to encompass block-level restoration processes and rejected all of the challenged claims as obvious in view of the prior art. The PTAB also denied Veritas’s contingent motion to amend, ruling that its motion was deficient for failure to discuss how Veritas’s claim amendments would render the claims patentable over the prior art. Specifically, the PTAB explained that Veritas “offer[ed] no discussion of whether the newly added features” in its claim amendments were “separately known in the art.” Instead, according to the PTAB, Veritas only discussed how “the newly added feature[s] in combination with other known features [were] not in the prior art.”

On appeal, the Federal Circuit affirmed the PTAB’s obviousness determination, but held that the PTAB erred in denying Veritas’s motion to amend. The Federal Circuit stated that the PTAB’s basis for denying the motion to amend was “unreasonable and hence must be set aside as arbitrary and capricious.” The court explained that it had “been shown no reason to

doubt that it is only the combination that was the ‘new feature,’ a scenario recognized in a long line of Supreme Court and Federal Circuit cases noting that novel and nonobvious inventions often are only a combination of known individual features.” The court further noted that it failed “to see how describing the combination is meaningfully different from describing what is new about the proposed claims, even in comparison to the unamended claims.” Therefore, the Federal Circuit “d[id] not see how the Board could reasonably demand more from Veritas in this case” and vacated and remanded the case for a determination of the patentability of the proposed amended claims.

Notably, the Federal Circuit rendered its opinion “independently of any resolution of [the] [C]ourt’s recently initiated *en banc* proceeding in *In re Aqua Products*.”

“*Veritas Techs. LLC v. Veeam Software Corp.*, No. 2015-1894 (Fed. Cir. Aug. 30, 2016)”

Categories

Federal Circuit

Inter Partes Review

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