



PTAB Grants Contingent Motion to Amend on Remand from Federal Circuit

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On remand, the Board authorized Patent Owner to supplement its motion to amend and analyzed the motion to make “a determination of the patentability of the proposed substitute claims.” In doing so, the Board considered the requirements of 35 U.S.C. §§ 101, 102, 103, 112. The motion was denied with respect to claim 26 because the Board found that the amendments introduced new matter, contrary to 35 U.S.C. § 316(d)(3).

The Board, however, granted the motion with respect to claim 27, because the amendments did not add new matter, were definite, and were nonobvious in view of the prior art. Notably, Patent Owner also amended claim 27 to recite a “non-transitory computer-accessible medium” in view of the Board’s decision in *Ex parte Mewherter*, Appeal 2012-007692, (PTAB 2013), which held that a claim for a “machine-readable storage medium” violates Section 101 unless it expressly excludes non-transitory media, such as carrier waves. Petitioner attempted to strike the amendment as not being responsive to a ground of unpatentability involved in the trial under 37 C.F.R. § 42.121(a)(2)(i). But the Board held that the requirement should not be construed so as to require that “every word added to or removed from a claim in a motion to amend must be solely for the purpose of overcome[ing] an instituted ground.” Accordingly, 37 C.F.R. § 42.121(a)(2)(i) does not “preclud[e] additional modifications that address potential 35 U.S.C. § 101 or § 112 issues.”

Historically, Patent Owners have had limited success in filing conditional motions to amend. This decision, together with the related Federal Circuit decision, provide guidance as to what such a motion should contain and what information the Board will consider.

Categories

Patent Trial & Appeal Board

35 U.S.C. § 103

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