



Burden of Proving Unpatentability of Amended Claims Placed on IPR Petitioners

In an *en banc* decision, the Federal Circuit in *Aqua Products, Inc. v. Matal* addressed the question of who bears the burden of proving that claims amended during *inter partes* review ("IPR") proceedings are or are not patentable. The sprawling, 148-page decision, including five separate opinions, held that the petitioner bears the burden of persuasion concerning the patentability of such amended claims. The 11-judge *en banc* panel produced no majority opinion, so the "judgment is narrow." Nonetheless, the court's holding that patent owners no longer bear the burden of persuading the Patent Trial and Appeal Board ("PTAB") that their amended claims are patentable is significant: To date, the PTAB has been reluctant to grant motions to amend, and the shifted burden is expected to make it easier for patent owners to amend claims. Patent owners engaged in pending IPRs may benefit from the decision, as the PTAB must now follow the new practice set forth by the court.

Six judges, spanning three opinions, believe the Patent Act does not clearly address who bears the burden of persuading (meaning "proving," in this context) the PTAB that claims amended during IPR proceedings are or are not patentable. Seven judges, spanning four opinions, believe the Patent Office did not do enough to merit deference on the question of the burden of persuasion. These seven judges believe that the burden of persuasion should be placed on the petitioner.

What little was decided in *Aqua Products* could change in the future. First, the highly fractured opinion could encourage the U.S. Supreme Court to review the case. Second, the court left open the possibility that the Patent Office could place the burden of persuasion on the patent owner if the Patent Office engages in proper notice and comment rulemaking and the result is consistent with the statute.

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