

Askeladden Defends USPTO Rule Regarding Claim Amendments in *Inter Partes* Reviews
Argues Integrity of Inter Partes Review is at Stake

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Askeladden LLC, through its Patent Quality Initiative, filed an *amicus curiae* brief with the Federal Circuit this week in *In re Aqua Products* in support of the U.S. Patent and Trademark Office's (USPTO) rulemaking authority with respect to amending claims in *inter partes* reviews (IPRs). Aqua Products, Inc. is challenging the USPTO's regulation assigning the burden of persuasion for substitute claims in IPRs to the patent owner.

Aqua Products, whose substitute patent claims were rejected by the Patent Trial and Appeal Board (PTAB), argues that the patent statute assigns the burden of proof to the petitioner in an IPR on all aspects of patentability regarding both original claims and substitute claims.

Askeladden defended the USPTO's power to prescribe standards and procedures for the amendment of patents that are subject to IPR. Askeladden argues in the brief that the regulation at the center of Aqua Products' claims is in line with Congress's intent expressed in the America Invents Act and well within the rulemaking authority of the USPTO.

"The integrity of the inter partes review process—established by Congress in the America Invents Act—is at stake in this appeal," said Sean Reilly, General Counsel of Askeladden. "Upholding the USPTO's rule regarding amendments is essential to maintaining *inter partes* review proceedings as an efficient alternative to district court litigation for addressing poor-quality patents."

In its brief to the court, Askeladden explains the profound impact a reversal on this decision would have on American businesses and innovation:

"Overturning the Patent Office regulation so that the patent owner no longer has to establish that substitute claims are patentable would subvert the purposes that *inter partes* review was designed to serve. It would lead to an increase in the survival of weak patents, and thereby stifle the efficacy and utility of *inter partes* review as a relatively low-cost and prompt alternative to litigation for invalidating low-quality patents. Certain patent owners that file the abusive patent infringement actions that plague the technology and financial services industries would welcome and abuse an enhanced ability to substitute slightly narrower claims that survive *inter partes* review."

Askeladden's brief reminds the court that *inter partes* reviews are not examinations or reexaminations. IPRs are a separate, adjudicative proceeding conducted before the PTAB, which conducts a trial and rules on a record that is established by the parties. The PTAB is not

designed to examine patents or conduct prior art research. Therefore, the USPTO's rule placing the burden of persuasion on the patent owner to demonstrate the patentability of substitute claims is the only approach consistent with the capabilities of the PTAB.

About Patent Quality Initiative

Askeladden is an education, information and advocacy organization that launched an initiative to improve the understanding, use and reliability of patents in financial services and other industries. As part of its Patent Quality Initiative, Askeladden strives to improve the quality of issued patents and discourage the improper assertion of patents by filing amicus briefs, petitioning for Inter Partes Review and engaging in educational activities. For more information, visit patentqualityinitiative.com.