

Askeladden Advocates for Patent Trial and Appeal Board Consideration of Subject Matter Eligibility with Respect to Amended Claims in IPRs

Argued that considering whether amended claims are patent eligible is required.

For Immediate Release:

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New York, NY — Askeladden filed an amicus brief today with the United States Court of Appeals for the Federal Circuit in *Uniloc 2018 LLC v. Hulu, LLC et al.* advocating for the Court to uphold the ability of the Patent Trial and Appeal Board (PTAB) to consider patent subject matter eligibility under 35 U.S.C. § 101 with respect to proposed amended claims in *inter partes* review (IPR) proceedings.

In its brief, Askeladden argues that such an outcome aligns with the intent of Congress:

“Second, reversing the Board’s decision would lead to a number of unintended and unwanted consequences. These include allowing parties to manipulate the PTO by inserting *ineligible* claims during an *inter partes* review that could not have been included (or that were rejected) during the initial prosecution of the patent. In such circumstances, review for subject-matter eligibility would not occur until after the patent were amended, through post-grant review or district court litigation, and only after the patent had reissued with new claims that had never been properly reviewed for all aspects of patentability. There is simply no way Congress intended to allow a patent owner to insert a patent claim that the Board can plainly see is *ineligible* under § 101 using the *inter partes* review process.”

Askeladden filed the briefs as part of its Patent Quality Initiative, which seeks to improve patent quality and promote innovation by challenging poor quality patents, addressing questionable patent practices, and regularly filing amicus briefs in cases concerning important issues of patent law.

Askeladden is represented by Kilpatrick Townsend and Stockton LLP.

About the Patent Quality Initiative

Askeladden is an education, information and advocacy organization with the goal of improving the understanding, use and reliability of patents in financial services and other industries. As part of its Patent Quality Initiative, Askeladden strives to promote better patents and patent holder behaviors by regularly filing amicus briefs, Inter Partes Reviews (IPRs) and engaging in educational activities.