

PTAB Grants Rare Motion to Amend in Decision for IPR Filed against Rothwell Figg Client LG Chem

The Patent Trial and Appeal Board (PTAB) granted a rare Motion to Amend in a Final Written Decision for an IPR filed against Rothwell Figg client LG Chem, Ltd.

Reactive Surfaces Ltd., LLP filed an IPR against an LG Chem patent related to anti-fingerprint coatings for surfaces such as display device touch screens. Following institution of the IPR, LG Chem filed a Motion to Amend to obtain substitute claims that are patentable in view of the cited prior art. This proved successful, as the PTAB ultimately granted the Contingent Motion to Amend, replacing the issued claims of the patent with the proposed substitute claims. In particular, the PTAB found that (1) no undue experimentation is required to practice the substitute claims, (2) the substitute claims are not indefinite, and (3) the substitute claims are not obvious in view of either prior art combination proposed by Reactive Surfaces.

Although there have been an increasing number of successful motions to amend following the Federal Circuit's decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), such motions are still infrequently granted, having increased to around 10 percent of Motions to Amend decided during USPTO Fiscal Year 2018 from less than 3 percent of all Motions to Amend decided from 2012 through USPTO Fiscal Year 2017. Consequently, the PTAB's decision here is a significant victory for LG Chem.

The Rothwell Figg team representing LG Chem was comprised of Joseph Hynds and Joo Mee Kim.

The case is *Reactive Surfaces LTD., LLP v. LG Chem LTD.*, IPR2018-01520.

Key Contacts

Joseph A. Hynds

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Related Areas of Practice

Inter Partes Review (IPR) and Post Grant Review (PGR)

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Chemicals & Materials