

Aydin Harston Quoted in Law360 Article on Federal Circuit Ruling on Proposed Amended Patent Claims

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Partner Aydin Harston is quoted in a Law360 article on the ramifications of a July 22, 2020 Federal Circuit ruling that the Patent Trial and Appeal Board (PTAB) can reject proposed amended patent claims under Alice.

In the ruling, "the Federal Circuit affirmed a PTAB *inter partes* review decision that Uniloc could not amend its software license patent because challengers Hulu and Netflix had shown the proposed new claims cover only a patent-ineligible abstract idea. As a result, the board can now reject amendments for reasons it cannot use to invalidate original patent claims."

As a result, Aydin says petitioners "*are going to look at any proposed claim amendments with a fine-tooth comb and challenge anything they can come up with.*"

"The decision came in a case where Hulu and Netflix challenged a patent Uniloc accused them of infringing, which covers technology for allowing a software license to cover multiple devices. The PTAB ruled Uniloc's proposed new claims covered nothing more than the abstract idea of such adjustable licenses.

The PTAB has been issuing eligibility rejections to proposed amendments for over a year, so the decision will not change the status quo. But attorneys said a decision that prohibited the board from considering whether new claims are patent-eligible could have caused problems for litigants and the patent system."

"If the board were forced to issue new claims it believed were invalid, those claims would inevitably be challenged in a future proceeding," he said. "You want to write good claims; you don't want to push something past the board that is then going to fall in the next tribunal, wherever it goes."

The article, "3 Takeaways As Fed. Circ. Boosts PTAB Amendment Scrutiny," by Ryan Davis for Law360 Analysis on July 27, 2020, can be read [here](#).

Key Contact

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