

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF, LLC,
Petitioner,

v.

PPC BROADBAND, INC.,
Patent Owner.

Case IPR2014-00441
Patent 8,562,366 B2

Before JAMESON LEE, JOSIAN C. COCKS, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
On Motion to Amend Claims
37 C.F.R. § 42.121

Introduction

On October 28, 2014, a telephone conference was held between respective counsel for the parties and Judges Lee, Cocks, and Bonilla. The Patent Owner initiated the conference call to satisfy the “to confer” requirement of 37 C.F.R. § 42.121(a) with regard to the filing of a motion to amend claims. We provided the parties with verbal guidance. A Court Reporter was present to record the content of the conference call. For the convenience of the parties, additional guidance regarding the requirements of a motion to amend is provided below. We also authorized Patent Owner to place its proposed substitute claims in an appendix, such that it does not count toward the 15-page limit for a motion to amend claims.

Discussion

A motion to amend claims only may cancel claims or propose substitute claims. The request to cancel claims will not be regarded as contingent. However, the request to substitute claims is always contingent. That means a proposed substitute claim will be considered only if the original patent claim it replaces is determined unpatentable or is cancelled by the Patent Owner.

A proposed substitute claim should be responsive to the ground of unpatentability applicable to the original patent claim for which it is a substitute. See 37 C.F.R. § 42.221(a)(2)(i). A claim listing is required. See 37 C.F.R. § 42.221(b). Each proposed substitute claim must be reproduced in the claim listing. Any claim with a changed scope, subsequent to the amendment, should be included in the claim listing as a proposed substitute claim, and have a new claim number.

The presumption is that only one substitute claim is needed for each original patent claim. Compliance is not achieved merely by maintaining the same total number of claims before and after the amendment. The requirement is viewed on a per claim basis. In other words, the Patent Owner may not designate arbitrarily a proposed substitute claim as being a substitute claim for whichever original patent claim the Patent Owner desires to name. The proposed substitute claim must be traceable back to the original patent claim that it is intended to replace. Generally, the proposed substitute claim should not eliminate any feature or element of the original patent claim which it is intended to replace. For instance, claim X is properly named as a substitute claim for claim Y if claim X includes all of the features of claim Y. If the Patent Owner needs more than one substitute claim for a particular patent claim, the motion should articulate a special circumstance to justify the request.

Also, for each proposed substitute claim, the motion must show, clearly, the changes of the proposed substitute claim with respect to the original patent claim which it is intended to replace. No particular form is required, but use of brackets to indicate deleted text and underlining to indicate inserted text is suggested.

The Patent Owner bears the burden of proof to establish that it is entitled to the relief requested in the motion to amend. See 37 C.F.R. § 42.20(c). If the motion is granted, the proposed substitute claims will be added to the involved patent, without examination. Accordingly, the Patent Owner must show patentability, in general.

In the motion to amend, the Patent Owner also must show written description support in the specification for each proposed substitute claim.

See 37 C.F.R. 42.221(a)(2)(ii). **Importantly, citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued.** Also, it is inadequate to show written description support for just the feature added by the proposed substitute claim. Instead, the Patent Owner must show written description support for the entire claim.

If a new term is used in a proposed substitute claim, the meaning of which reasonably can be anticipated as subject to dispute, the Patent Owner should provide a proposed claim construction in the motion to amend. If a proposed substitute claim adds a means-plus-function element, the corresponding structure, material, or acts described in the specification should be identified. With regard to claim construction, a statement that a certain term should be construed according to its plain and ordinary meaning is unhelpful. That plain and ordinary meaning should be provided in the motion, together with the supporting evidence.

Additionally, **at least with respect to any claim the Patent Owner proposes as a substitute for a patent claim on which trial has been instituted on a ground of patentability over prior art, the Patent Owner must show patentability over the prior art,** in general, and not just over the references applied by the Petitioner against the original patent claims. Explaining patentability over references applied by the Petitioner against the original patent claims is not the main event. The motion should provide sufficient underlying facts regarding any feature added by the proposed substitute claim. For instance, it should be revealed whether the feature was previously known anywhere, in whatever setting, and whether or not the feature was known in combination with any of the other elements in the claim. If any such combination was known, the motion should explain the

surrounding facts in that regard, and why it would not have been obvious for one with ordinary skill in the art to adapt that knowledge for use with the rest of the claim elements.

The Patent Owner is not expected to know everything that a hypothetical person of ordinary skill in the art is presumed to know, but the Patent Owner is expected to reveal what it does know, to the extent that it is relevant. **For instance, the motion to amend should include a discussion of the ordinary skill in the art, with particular focus on the feature added to provide the basis of patentable distinction.** In that regard, it would not be meaningful to say that a person of ordinary skill in the art possesses this many years of education and that many years of experience. Rather, the discussion should be specific about the technical knowledge pertaining to the feature added. It would be useful to know, for example, whether there are textbooks or conventional practices relating to the feature, and what basic skill set would be possessed by one with ordinary skill in the art. **A conclusory statement to the effect that the closest prior art are the references in the record is not meaningful.**

Patent Owner inquired to what extent it must account for written description support in ancestral applications to be entitled to the filing date of those earlier filed applications with respect to its proposed substitute claims, where each application, starting with the involved application, is a continuation of the one earlier in the chain of continuing applications and all applications in the chain have the same substantive content.

We suggested that Patent Owner (1) file a copy of each application in the chain of priority applications, as originally filed, as exhibits; (2) attempt to seek agreement with Petitioner that each application in the priority chain

has identical substantive disclosure with respect to the application, as filed, which issued as the involved patent; (3) indicate in the motion to amend that all applications in the chain of priority applications have identical substantive disclosure (if true) and all are continuation applications rather than continuation-in-part applications of the application one earlier in the chain; and that the parties have stipulated to these facts (if true). In the circumstance outlined above, we authorized Petitioner to cite specifically only to the application, as filed, which issued as the involved patent, when discussing entitlement to the earlier effective filing date of an application in the chain of priority applications. Petitioner voiced no objection. Patent Owner, of course, has to make a separate showing with regard to the co-pendency and common-inventor requirements of 35 U.S.C. § 120 with respect to each ancestral application in the chain of priority applications.

Order

It is

ORDERED that the requirement of a “to confer” conference pursuant to 37 C.F.R. § 42.121(a) has been satisfied; and

FURTHER ORDERED that attention of the parties is directed to *Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB) (Papers 26 and 66), *Nichia Corp. v. Emcore Corp.*, IPR2012-00005 (PTAB) (Papers 27 and 68), and *ZTE Corp. v. ContentGuard Holdings, Inc.*, IPR2013-00136 (PTAB) (Papers 32 and 33), with regard to the requirements of a motion to amend.

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FOR PETITIONER:

Todd Walters
Roger Lee
todd.walters@bipc.com
roger.lee@bipc.com

FOR PATENT OWNER:

Dennis Sullivan
dsullivan@hblaw.com