

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner

v.

PI-NET INTERNATIONAL, INC.
Patent Owner

Case CBM2013-00013
Patent 8,037,158

Before KARL D. EASTHOM, JONI Y. CHANG, and
BRIAN J. McNAMARA

McNAMARA, *Administrative Patent Judge.*

SUMMARY OF CONFERENCE CONCERNING PROPOSED MOTION TO
AMEND

Conduct of the Proceeding
37C.F.R. § 42.5

On January 7, 2014, the Board conducted a conference with the parties to discuss the requirements for a possible motion to amend by Patent Owner. Patent Owner stated that it was considering amending one claim, by adding claim elements, in each the following proceedings: IPR2013-00194, IPR2013-00195 and CBM2013-00013. In preparing its motion to amend, the Board recommends that Patent Owner review the guidance provided by the Board in the proceedings cited in this paper.

A motion to amend claims in an *inter partes* review is not itself an amendment. Unlike a claim amendment in patent prosecution, amendments proposed by a motion to amend are not entered as a matter of right. The applicable presumption is that only one substitute claim would be needed to replace each challenged claim, although the presumption may be rebutted by a demonstration of need. 37 C.F.R. § 42.121(a)(3). Absent special circumstances, a challenged claim can be replaced by only one claim, and a motion to amend should, for each proposed substitute claim, specifically identify the challenged claim that it is intended to replace. A proposed claim should be traceable to an original challenged claim as a proposed substitute claim for the challenged claim. A desire to obtain a new set of claims having a hierarchy of different scope typically would not constitute sufficient special circumstances because an *inter partes* review is an adjudicatory proceeding, rather than an examination. *See, Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013). If the patent owner desires to remodel its claim structure according to a different strategy, it may consider pursuing another type of proceeding before the Office.

A motion to amend may be denied where (i) the amendment does not respond to a ground of unpatentability involved in the trial or (ii) the amendment seeks to enlarge the scope of the claims of the patent or introduce new subject

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matter. 37 C.F.R. § 42.121(a)(2). These conditions are evaluated for each substitute claim traceable to a challenged claim that the substitute claim is intended to replace. A proper substitute claim under 37 C.F.R. § 42.121(a)(2) must only narrow the scope of the challenged claim it replaces and may not enlarge the scope of the challenged claim by eliminating any feature or limitation. A proposed substitute claim is not responsive to an alleged ground of patentability if it does not either include or narrow each feature of the challenged claim being replaced. *See, Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26.

Unlike patent application proceedings, in an *inter partes* review a proposed amendment to the claims is not authorized unless the movant has shown that the proposed substitute claims are patentable. In all circumstances the patent owner must make a showing of patentable distinction over the prior art. A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those features including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior order of record, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner, as the moving party, to show patentable distinction over the prior art of record and other prior art known to the patent owner. 37 C.F.R. § 42.20(c). A showing of patentable distinction may rely on the declaration testimony of a technical expert about the level of ordinary skill in the art and about the significance and usefulness of features added by the proposed claim.

A mere conclusory statement by counsel in the motion to amend that one or more added features are not described in any prior art or would not have been suggested or rendered obvious by the prior art is facially inadequate. *Id.* It also is insufficient for the movant simply to explain why the proposed substitute claims

are patentable in consideration of the challenges on which the Board instituted review. Limiting the discussion either to the references already in the proceeding, or to the narrow combination specifically recited in the claim, does not provide a meaningful analysis. *See, Corning Gilbert, Inc. V. PPC Broadband, Inc.*, IPR2013-00347, Paper No. 20. In explaining why it believes the claimed subject matter is patentable, the movant must address issues of nonobviousness, meaningfully. The movant should discuss the level of ordinary skill in the art, explaining the basic knowledge and skill set already possessed by one of ordinary skill in the art, especially with respect to the particular feature or features the patent owner has added to the original patent claims. The movant should identify in what context the added feature, or something close to it, was already known, albeit not in the specific combination recited in the claims at issue. *Id.*

A motion to amend claims must clearly identify the written description support for the proposed substitute claims. The written description test is whether the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). 37 C.F.R. § 42.121(b)(1) requires the patent owner to set forth the support in the *original disclosure* of the patent for each proposed substitute claim i.e., the patent owner must clearly identify the written description support in the disclosure corresponding to the earliest date upon which the patent owner seeks to rely.

Merely indicating where each claim limitation individually is described in the original disclosure may be insufficient to demonstrate support for the claimed subject matter as a whole. While the proposed substitute claims need not be described verbatim in the original disclosure in order to satisfy the written description requirement, should the claim language not appear in the same words

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in the original disclosure, a mere citation to the original disclosure without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole may be inadequate. *See, Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27.

As agreed in a stipulation filed on December 24, 2013, a patent owner response and motion to amend in this proceeding are due on January 10, 2014. Paper No. 26. During the call, the parties made arrangements to discuss a further adjustment of the due date for the patent owner response and motion to amend. The parties should file a stipulation with the Board, should they agree to modify the due date.

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