

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CONNEXIONS LOYALTY, INC.,
Petitioner,

v.

MARITZ HOLDINGS INC.,
Patent Owner.

Case CBM2018-00037
Patent 7,134,087 B2

Before MICHAEL R. ZECHER, JUSTIN T. ARBES, and
JON B. TORNQUIST, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

A conference call in the above proceeding was held on March 6, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Zecher, Arbes, and Tornquist. The call was requested by Patent Owner to satisfy the requirement of 37 C.F.R. § 42.221(a) to confer with the Board before filing a motion to amend.

We referred the parties to *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Western Digital Corporation v. SPEX Technologies, Inc.*, Case IPR2018-00082 (PTAB Apr. 25, 2018) (Paper 13) (informative); and the Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) (available at https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf). We also provide the following guidance.

Pursuant to 37 C.F.R. § 42.221(a)(2)(i), “[a] motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” This trial involves an assertion that the claims of the challenged patent do not recite patent-eligible subject matter under 35 U.S.C. § 101. Paper 12, 7, 36. In that regard, we refer the parties to the recently published 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019), regarding the application of 35 U.S.C. § 101.

A claim listing, reproducing each proposed substitute claim, is required. 37 C.F.R. § 42.221(b). The claim listing may be filed as an appendix to the motion to amend, and shall not count toward the page limit for the motion. *See* 37 C.F.R. §§ 42.24(a)(1), 42.221(b). 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.

This includes any dependent claim that Patent Owner intends as dependent from a proposed substitute independent claim. For each proposed substitute claim, the motion should identify specifically the original claim that it is intended to replace and show clearly the changes of the proposed substitute claim with respect to the original claim.

Patent Owner may only propose a reasonable number of substitute claims. 35 U.S.C. § 326(d)(1)(B). To the extent Patent Owner seeks to propose more than one substitute claim for an original claim, Patent Owner shall explain in the motion to amend the need for the additional claims and why the number of proposed substitute claims is reasonable. *See* 35 U.S.C. § 326(d)(1)(B); 37 C.F.R. § 42.221(a)(3).

Finally, Patent Owner must show sufficient written description support in the original specification for each proposed substitute claim. 37 C.F.R. § 42.221(b)(1). Citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued. Also, Patent Owner must show sufficient written description support for the entire proposed substitute claim and not just the features added by the amendment. This applies equally to independent claims and dependent claims, even if the only amendment to the dependent claims is in the identification of the claim from which it depends. Also, the motion to amend itself, not the claim listing, must set forth the written description support.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied the conference requirement of 37 C.F.R. § 42.221(a).

CBM2018-00037
Patent 7,134,087 B2

PETITIONER:

Richard Wydeven
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
rwydeven@rfem.com

PATENT OWNER:

Robert M. Evans, Jr.
Michael J. Hartley
Micah T. Uptegrove
STINSON LEONARD STREET LLP
revans@senniger.com
mhartley@senniger.com
muptegrove@senniger.com