

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 April 4, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Zecher, Arbes, and Tornquist.¹ The call was requested by Petitioner to seek authorization to file a motion to strike a portion of Patent Owner's Motion to Amend (Paper 17) for violating the 25-page limit set forth in 37 C.F.R. § 42.24(a)(1)(vi). During the call, Petitioner pointed out that the Motion to Amend includes 25 pages of text, with one paragraph referencing an attached "Appendix A." Appendix A is a claim listing of Patent Owner's proposed substitute claims (18 pages) and a chart showing alleged written description support for the limitations of the proposed substitute claims (85 pages). Petitioner argued that the latter portion of Appendix A causes the Motion to Amend to exceed the 25-page limit. Patent Owner responded that it believed the written description support chart was proper according to the language of 37 C.F.R. § 42.221(b), but if not, Patent Owner requested authorization to file a corrected motion to amend removing the written description support chart and replacing it with five pages of citations in the motion itself. Patent Owner argued that Petitioner would not be prejudiced by doing so because the original written description support chart does not include any arguments, only quotations from U.S. Patent Application No. 10/117,309 ("the '309 application"), which is the application that issued as U.S. Patent No. 7,134,087 B2.

As explained during the call, we agree with Petitioner that Patent Owner's Motion to Amend exceeds the 25-page limit. A motion to amend

¹ A court reporter, retained by Petitioner, was present on the call. Petitioner shall file the transcript of the call as an exhibit when it is available. *See* 37 C.F.R. § 43.63(a).

must include a “claim listing,” which may be filed as an appendix to the motion and does not count toward the page limit for the motion. *See* 37 C.F.R. §§ 42.24(a)(1), 42.221(b); Paper 15, 2. Thus, the first portion of Patent Owner’s Appendix A is proper and does not count toward the 25-page limit. A “claim listing,” however, is merely a listing of claims, in either original or modified form; it does not include argument or material from any other sources, such as patent applications or prior art. *See* 37 C.F.R. § 42.221(b); *MLB Advanced Media, L.P. v. Front Row Techs., LLC*, Case IPR2017-01127, slip op. at 3 (PTAB Jan. 16, 2018) (Paper 24). “The written description support must be set forth in the motion to amend itself, not the claim listing” *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, slip op. at 8 (PTAB Feb. 25, 2019) (Paper 15) (precedential); Paper 15, 3. Therefore, the second portion of Appendix A is part of the Motion to Amend itself, and the length of the Motion to Amend is 110 pages.

As we noted on the call, we are not persuaded that a motion to strike is warranted under the particular factual circumstances of this case. We are persuaded that allowing Patent Owner to re-file its Motion to Amend in the manner it proposes is appropriate, rather than merely striking the portion containing the written description support chart as Petitioner requests, which would prevent Patent Owner from attempting to demonstrate written description support for its proposed substitute claims under 37 C.F.R. § 42.221(b). We also are persuaded that a five-page extension of the page limit is appropriate to do so. Petitioner will be given an equal number of pages to respond. *See* 37 C.F.R. § 42.5(a).

Finally, Patent Owner noted that it included in its written description support chart full quotes from the '309 application as filed (Ex. 1002, 10–36), in part, because the application did not include line numbers. To facilitate our review and assist the parties in making arguments in their papers, Patent Owner is authorized to file a marked-up version of the '309 application adding line numbers only.

In consideration of the foregoing, it is hereby:

ORDERED that no motion to strike the written description support chart in Appendix A of Patent Owner's Motion to Amend (Paper 17) is authorized;

FURTHER ORDERED that Patent Owner instead is authorized to file, by April 10, 2019, (1) a marked-up version of the '309 application (Ex. 1002, 10–36) labeled with line numbers and making no other alterations to the document, and (2) a corrected motion to amend removing the written description support chart in Appendix A and in its place adding a list of citations in the motion itself of up to five additional pages;

FURTHER ORDERED that the corrected motion shall not make any other additions or changes to the originally filed Motion to Amend;

FURTHER ORDERED that, once Patent Owner files its corrected motion to amend, the original Motion to Amend shall be expunged from the record of this proceeding pursuant to our authority under 37 C.F.R.

§ 42.7(a); and

FURTHER ORDERED that the page limit for Petitioner's opposition to the Motion to Amend is 30 pages.

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Patent 7,134,087 B2

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