

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GAIN CAPITAL HOLDINGS, INC.,  
Petitioner,

v.

OANDA CORPORATION,  
Patent Owner.

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CBM2020-00023  
Patent 7,496,534 B2

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Before SALLY C. MEDLEY, JUSTIN T. ARBES, and  
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE  
PATENT OWNER'S MOTION TO AMEND

## I. INTRODUCTION

On March 18, 2021, we instituted trial as to claims 1–12 of U.S. Patent No. 7,496,534 B2 (Ex. 1001, “the ’534 patent”). Paper 10 (“Dec. on Inst.”). After institution, Patent Owner filed a Contingent Motion to Amend. Paper 17 (“Mot.”). Should we find in a final written decision that challenged claim 1 is unpatentable, Patent Owner proposes substitute claim 13, which corresponds to challenged claim 1. Mot. 1. Petitioner filed an Opposition to the Motion. Paper 19 (“Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in a covered business method patent review and whether Petitioner (or the record) establishes a reasonable likelihood that the proposed substitute claim is unpatentable. *See* 35 U.S.C. § 326(d); 37 C.F.R. § 42.221; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential); *see also* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides

preliminary, non-binding guidance from the Board to the parties about the [motion to amend].”); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claim, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

## II. PRELIMINARY GUIDANCE

### A. *Statutory and Regulatory Requirements*

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

#### 1. *Reasonable Number of Substitute Claims*

<b>Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 326(d)(1)(B))</b>
<b>Yes.</b> Patent Owner proposes one substitute claim for one challenged claim. Mot. App’x A. Petitioner does not argue otherwise.

2. *Respond to Ground of Unpatentability*

**Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.221(a)(2)(i))**

**Yes.** Patent Owner responds to the sole ground of unpatentability, arguing that proposed substitute claim 13 addresses the instituted ground of unpatentability that claim 1 does not recite patent-eligible subject matter under 35 U.S.C. § 101. Mot. 4–6. Petitioner does not argue otherwise.

3. *Scope of Amended Claims*

**Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.221(a)(2)(ii))**

**No.** Proposed substitute claim 13 includes narrowing limitations and does not remove any limitation from challenged claim 1.<sup>1</sup> *See* Mot. App’x A. Petitioner does not argue otherwise.

4. *New Matter*

**Does the amendment seek to add new subject matter? (35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.221(a)(2)(ii))**

**No.** Although the amendment does not seek to add new subject matter, the amendment does not meet the regulatory requirements of 37 C.F.R. § 42.221(b).

Our Order setting forth guidance for the motion to amend instructs that (1) citations for written description support should be made to the *original disclosure* of the application as filed (i.e., Ex. 1002, 202–283), not the patent as issued; (2) written description support must be shown for *the entire proposed substitute claim*, not just the features added by the

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<sup>1</sup> Patent Owner argues in the Motion that “[s]ince all claims are dependent on claim 1 (proposed claim 13), all remaining dependent claims are narrowed. . . . All other amendments update the dependencies of certain dependent claims to depend from a corresponding substitute claim.” Mot. 3. Patent Owner, however, proposed only one substitute claim in the Motion: claim 13. If Patent Owner intends to amend any of claims 2–12 to depend from proposed substitute claim 13 (rather than claim 1), amendments to that effect would need to be submitted in a revised motion to amend.

amendment; and (3) written description support must be set forth *in the motion to amend itself*, not in the claim listing. Paper 15, 2–3; *see* 37 C.F.R. § 42.221(b). Patent Owner’s Motion does not meet any of these requirements. *See* Mot. App’x A. Should Patent Owner file a reply or a revised motion to amend, we encourage Patent Owner to address this issue and follow the requirements set forth in the Order.

Patent Owner’s Motion further lists only pin cites to alleged written description support for the added limitations in the issued patent, without explanation. Should Patent Owner file a revised motion to amend, we encourage Patent Owner to provide explanation for alleged written description support for the entire proposed substitute claim, in addition to citations to the original application.

### *B. Patentability*

For the reasons discussed below, at this stage of the proceeding, and based on the current record,<sup>2</sup> it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claim 13 is unpatentable.

### **Does the record establish a reasonable likelihood that the proposed substitute claim is unpatentable?**

#### **1. Indefiniteness**

**No.** On this record, Petitioner has not established a reasonable likelihood that proposed substitute claim 13 is unpatentable for failure to comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph. “[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014); *see* USPTO Memorandum on the Approach to Indefiniteness Under 35 U.S.C. § 112 in AIA Post-Grant Proceedings (Jan. 6, 2021), *available at* <https://www.uspto.gov/sites/default/files/documents/>

<sup>2</sup> We express no view on the patentability of original claims 1–12 in this Preliminary Guidance. Instead, we focus on proposed substitute claim 13, which adds certain limitations to challenged claim 1.

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