

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORD MOTOR COMPANY,  
Petitioner,

v.

SPEED MONITORING TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2014-01500  
Patent 7,389,198 B1

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Before KARL D. EASTHOM and LYNNE E. PETTIGREW,  
*Administrative Patent Judges.*

PETTIGREW, *Administrative Patent Judge.*

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

On June 18, 2015, a conference call was held between respective counsel for the parties and Judges Easthom and Pettigrew. Patent Owner requested the call to satisfy its requirement to confer with the Board before filing a motion to amend claims. *See 37 C.F.R. § 42.121(a).*

On the call, Patent Owner indicated it plans to file a contingent motion to amend proposing one to three substitute claims.

We reminded the parties of the recent amendments to our rules modifying the page limits for motions to amend, oppositions to motions to amend, and replies to oppositions to motions to amend. *See* 80 Fed. Reg. 28,561, 28,565 (May 19, 2015) (amending 37 C.F.R. § 42.24).

We also provided the following guidance regarding motions to amend. Generally, a challenged claim can be replaced by only one claim, and a motion to amend should, for each proposed substitute claim, specifically identify the claim it is intended to replace, and whether the proposed claim amendment is contingent on the corresponding challenged claim being determined to be unpatentable. In a motion to amend, a claim amendment may not enlarge the scope of the claims and must be responsive to a ground of unpatentability involved in the trial. 37 C.F.R. § 42.121(a)(2). The burden is on Patent Owner to demonstrate written description support in the originally filed disclosure, not just the issued patent, for each proposed substitute claim. Patent Owner also must show why the claims are patentable over the prior art of record, as well as prior art not of record but known to Patent Owner to be material to the amended claims at issue.

We refer the parties to the following orders, and orders cited therein, for additional guidance regarding the content of motions to amend: *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00441, Paper 19 (Oct. 30, 2014), and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (Mar. 7, 2014).

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ORDER

It is

ORDERED that Patent Owner has satisfied the requirement “to confer” with the Board pursuant to 37 C.F.R. § 42.121(a).

FOR PETITIONER:

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