

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZHONGSHAN BROAD-OCEAN MOTOR CO. LTD.,
Petitioner,

v.

NIDEC MOTOR CORPORATION,
Patent Owner.

Case IPR2015-00465
Patent 8,049,459 B2

Before BENJAMIN D. M. WOOD and JAMES A. TARTAL,
Administrative Patent Judges.

TARTAL, *Administrative Patent Judge.*

ORDER

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

A conference call was held on September 3, 2015, between respective counsel for Petitioner Zhongshan Broad-Ocean Motor Co. Ltd., Patent Owner Nidec Motor Corporation, and Judges Wood and Tartal. Patent Owner initiated the conference call to confer with us in regard to filing a motion to amend.

Patent Owner began the conference call by explaining that it intends to file a conditional motion to amend claim 18 in response to certain unpatentability contentions at issue in the proceeding.

Entry of proposed substitute claims is not automatic, but only upon Patent Owner demonstrating the patentability of each proposed substitute claim. *See* 37 C.F.R. § 42.20(c). During the call, we explained that a motion to amend proposing substitute claims (1) may only narrow, not broaden, the scope of a claim, (2) may only propose a reasonable number of substitute claims, and (3) should respond to a ground of unpatentability involved in the trial. 37 C.F.R. § 42.121(a)(3). We also noted that our rules were amended on May 19, 2015, to change the page limits for certain papers associated with a motion to amend. *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,565 (May 19, 2015).

Guidance regarding the mechanics and substance of motions to amend appears in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB June 11, 2013) (Paper 26), as well as *MasterImage 3D, Inc. v. RealD Inc.*, IPR2015-00040 (PTAB July 15, 2015) (Paper 42). The latter paper clarifies certain guidance provided in the former. A motion to amend should demonstrate that each proposed substitute claim is supported by the written

description of the application upon which the substitute claims rely, and should address the patentability of each proposed substitute claim over the prior art of record and the prior art known to Patent Owner, accounting for the basic knowledge and skill set possessed by a person of ordinary skill in the art, even without reliance on any particular prior art reference. *See* 37 C.F.R. § 42.121(b). Further, a motion to amend should include claim constructions for any new term used in a proposed substitute claim where the meaning of such terms reasonably can be anticipated to be disputed. The plain and ordinary meaning of terms should be provided in the motion, together with the supporting evidence.

ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner has satisfied the requirement of conferring with us prior to filing a Motion to Amend under 37 C.F.R. § 42.121(a).

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PETITIONER:

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