

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KATUN CORPORATION,  
Petitioner,

v.

TOSHIBA TEC CORPORATION and  
TOSHIBA AMERICA BUSINESS SOLUTIONS, INC.,  
Patent Owner.

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Case IPR2016-01010  
Patent 9,098,015 B2

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Before STACEY G. WHITE, JENNIFER MEYER CHAGNON, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

## INITIAL CONFERENCE CALL SUMMARY

On December 19, 2016, the initial conference call for this proceeding was held between respective counsel for the parties and Judges White, Chagnon, and Wormmeester.

### A. *Scheduling Order*

The parties have already filed a joint stipulation as to different dates for DUE DATES 1–3. Paper 12. During the call, the parties indicated no other concerns at this time with the Scheduling Order.

### B. *Motion to Amend*

We instructed Patent Owner that if it decides to file a motion to amend claims, it must request a conference call with the Board at least two weeks prior to the date of such a motion, so that the parties will have sufficient time to consider any guidance we may provide. We also directed the parties to four cases that discuss and clarify the requirements for a motion to amend: (1) *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 3–10 (June 11, 2013) (Paper 26); (2) *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. at 3 (July 15, 2015) (Paper 42) (Precedential); (3) *Nichia Corp. v. Emcore Corp.*, Case IPR2012-00005, slip op. at 3–4 (June 3, 2013) (Paper 27); and (4) *ZTE Corp. and ZTE (USA) Inc. v. ContentGuard Holdings Inc.*, Case IPR2013-00136, slip op. at 2–4 (Nov. 7, 2013) (Paper 33).

We noted that with respect to any feature the Patent Owner proposes to add by way of a substitute claim, Patent Owner should be aware of the duty of candor requirement under 37 C.F.R. § 42.11. We explained that the

initial focus should be on the individual features proposed to be added, and that secondary references making up deficiencies of a primary reference are pertinent. *MasterImage 3D*, one of the cases to which we directed the parties, states:

Thus, when considering its duty of candor and good faith under 37 C.F.R. § 42.11 in connection with a proposed amendment, Patent Owner should place initial emphasis on each added limitation. Information about the added limitation can still be material even if it does not include all of the rest of the claim limitations. *See VMWare, Inc. v. Clouding Corp.*, Case IPR2014-01292, slip op. at 2 (PTAB Apr. 7, 2015) (Paper 23) (“With respect to the duty of candor under 37 C.F.R. § 42.11, counsel for Patent Owner acknowledged a duty for Patent Owner to disclose not just the closest primary reference, but also closest secondary reference(s) the teachings of which sufficiently complement that of the closest primary reference to be material.”).

*Id.* at 3.

#### *C. Other Motions*

Neither party indicated that it intends to file motions other than those discussed in this Order.

#### *D. Protective Order*

The parties were advised that a protective order will not be entered in this case unless the parties request one.

#### *E. Settlement*

The parties did not report anything regarding settlement.

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*F. Related Proceedings*

The parties are reminded to notify the Board of any changes in related proceedings.

ORDER

It is

ORDERED that any conference call to discuss a motion to amend claims by the Patent Owner shall take place at least two weeks prior to the due date of such a motion.

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