

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MLB ADVANCED MEDIA, L.P.,
Petitioner,

v.

FRONT ROW TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-01127
Patent 8,583,027 B2

Before JUSTIN T. ARBES, KERRY BEGLEY, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motions to Strike and
Authorizing Re-Filing of Motion to Amend
37 C.F.R. § 42.5

Pursuant to our authorization (Paper 18), Petitioner filed a Motion to Strike Patent Owner's Motion to Amend (Paper 19), to which Patent Owner filed an Opposition (Paper 22), and a Motion to Strike Patent Owner's Exhibits 2001–2036 (Paper 20), to which Patent Owner also filed an Opposition (Paper 21). For the reasons stated below, Petitioner's Motions are *granted*, but Patent Owner is permitted to re-file its Motion to Amend.

Motion to Strike Patent Owner's Motion to Amend

Patent Owner's Motion to Amend (Paper 14) includes 24 pages of substantive argument, Appendices A–C showing clean and modified versions of Patent Owner's proposed substitute claims, and Appendices D–F with claim charts listing the limitations of the proposed substitute claims in one column and quotations from various patent applications (with a number of explanatory parenthetical citations) in another column. Patent Owner relies on the cited excerpts in Appendices D–F to show written description support for the proposed substitute claims in the applications. *See* Paper 14, 6–8.

Petitioner argues that, including Appendices D–F, Patent Owner's Motion to Amend exceeds the 25-page limit set forth in 37 C.F.R. § 42.24(a)(1)(vi). Paper 19, 1. Patent Owner responds that Appendices D–F are part of a "claim listing," which is not included in the page count under § 42.24(a)(1)(vi). Paper 22, 1–2. Patent Owner cites 37 C.F.R. § 42.121(b), which provides:

A motion to amend claims must include a claim listing, which claim listing may be contained in an appendix to the motion, show the changes clearly, and set forth:

- (1) The support in the original disclosure of the patent for each claim that is added or amended; and
- (2) The support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.

According to Patent Owner, “everything after ‘must include a claim listing’” in § 42.121(b), including written description support for the proposed substitute claims, “necessarily describes characteristics of the claim listing itself.” Paper 22, 3–4. Patent Owner further relies on *Cisco Systems, Inc. v. Focal IP, LLC*, Case IPR2016-01257 (PTAB Mar. 21, 2017) (Paper 24) (“*Cisco*”), as allegedly supporting its reading of the rule. Paper 22, 1.

A “claim listing,” as specified in § 42.121(b), is a listing of claims, in either original or modified form. A “claim listing” does not include argument or material from any other sources, such as patent applications or prior art; it merely reproduces claims. *See* Paper 13, 3 (advising the parties that “[a] claim listing, reproducing each proposed substitute claim, is required” for a motion to amend); 37 C.F.R. § 1.121(c) (describing a “claim listing” in the examination context as including “the text of the claims” with status indicators and markings identifying any changes). Claim charts, by contrast, “identify[] key features of a claim and compar[e] those features with specific evidence.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764 (Aug. 14, 2012). Claim charts submitted as part of a motion “count towards applicable page limits.” *Id.* Also, *Cisco* does not support Patent Owner’s position, as the patent owner in that case “requested ten additional pages [for its motion to amend] or, in the alternative, *authorization* to address the requirement to show written description support” in an appendix that would not count toward the page limit, and the

panel authorized the latter. *Cisco* at 2–3 (emphasis added). Patent Owner never sought or obtained such authorization in this proceeding.

Accordingly, Appendices D–F are included in the page count of Patent Owner’s Motion to Amend, and the Motion exceeds the 25-page limit set forth in 37 C.F.R. § 42.24(a)(1)(vi) and will be stricken.

In its Opposition, Patent Owner requests permission to re-file its Motion to Amend if the Motion is found defective, and submits Exhibit 2038, which is a revised 33-page version of the Motion with “no changes beyond moving the citations from [Appendices D–F] into the body of the Motion.”¹ Paper 22, 5. Under the particular factual circumstances of this case, we are persuaded that allowing Patent Owner to re-file its Motion in the manner it proposes is appropriate, rather than merely striking the Motion, which would prevent Patent Owner from attempting to amend its claims in this proceeding. We also are persuaded that a limited extension of the page limit is warranted so that Patent Owner may include its alleged written description support in the Motion. Petitioner will be given an equal number of pages to respond. *See* 37 C.F.R. § 42.5(a).

We note that Petitioner’s opposition to the Motion to Amend and Patent Owner’s reply currently are due on March 2 and April 2, 2018, respectively. Paper 10, 6. Should there be a need to adjust these dates given

¹ Patent Owner also filed, with its Opposition to the Motion to Strike, a second revised version of the Motion to Amend with “corrected” Appendices D–F removing “a few brief explanatory parentheticals.” *See* Paper 22, 2 n.1; Ex. 2037. Patent Owner did not obtain authorization to file either revised version of the Motion to Amend with its Opposition. Although we permit the first revised version, for future reference, the parties must obtain authorization before filing any paper that is not already authorized by rule or Board order. *See* 37 C.F.R. § 42.7(a).

our decision herein to permit the revised Motion to Amend, the parties are reminded that they may stipulate to different dates for DUE DATES 2 through 5 in the Scheduling Order (provided the dates are no later than DUE DATE 6) and, if they do so, the parties shall file promptly a notice of the stipulation.

Motion to Strike Patent Owner's Exhibits 2001–2036

Patent Owner filed with its Motion to Amend and shortly thereafter a list of approximately 1,100 references (Exhibit 2001) and copies of a large subset of the foreign patents and non-patent literature references on the list that were in Patent Owner's possession (Exhibits 2002–2036). Patent Owner states that the references are “art that has been identified or cited against [the challenged patent in this proceeding] and related applications, over the course of the fifteen year history of prosecution of the patent, associated litigation with Petitioner, and Petitioner-initiated *inter partes* reexaminations.” Paper 21, 1–2.

As Petitioner points out, however, none of the materials are cited in Patent Owner's Motion to Amend or any other paper in this proceeding, and thus there is no need to keep them in the record at this time. *See* Paper 20, 1. The list of references was provided to Petitioner. Should Petitioner refer to any of the references in its opposition to the Motion to Amend, or Patent Owner refer to any of them in its reply, those references should be filed as exhibits with the respective paper. *See* 37 C.F.R. 42.6(c) (“Each exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.”).

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