

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*.

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

A conference call in the above proceeding was held on December 5, 2017, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Begley, and McMillin. The call was requested by Patent Owner to satisfy the requirement of 37 C.F.R. § 42.121(a) to confer with the Board before filing a motion to amend.

During the call, Patent Owner requested authorization to file a motion seeking (1) a limit on the number of prior art references that Petitioner may introduce in opposition to Patent Owner's motion to amend, and (2) an increase in the page limit for Patent Owner's reply to Petitioner's opposition. *See* 37 C.F.R. § 42.20(a). Petitioner opposed both requests as premature, and stated that it may seek authorization later in the proceeding to file a sur-reply to Patent Owner's reply. We informed the parties that all requests for relief regarding the opposition, reply, and any additional briefing are premature at this time, as Patent Owner has not yet filed its motion to amend with proposed substitute claims. Once Patent Owner does so, should either party believe that a departure from the usual procedures and page limits for motion to amend briefing is warranted, the party should request a conference call promptly to address the matter.

We also discussed with the parties the related litigation involving the challenged patent. Specifically, the U.S. Court of Appeals for the Federal Circuit recently affirmed the district court's decision concluding that all of the asserted claims are invalid under 35 U.S.C. § 101. Patent Owner stated that it had not yet determined whether it would file a petition for a writ of certiorari. We instructed the parties to notify the Board of any change in status of the related litigation, including if and when the judgment of invalidity becomes final.

Finally, regarding the motion to amend, we refer the parties to *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), and the Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) (available at https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf). We also provide the following guidance.

A motion to amend only may cancel claims or propose substitute claims. *See* 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3). A request to cancel claims will not be regarded as contingent. However, we shall treat a request to substitute claims as contingent. That means that a proposed substitute claim will be considered only if the original claim it replaces is determined to be unpatentable.

A claim listing, reproducing each proposed substitute claim, is required. 37 C.F.R. § 42.121(b). Any claim with a changed scope, subsequent to the amendment, should be included in the claim listing as a proposed substitute claim and have a new claim number. This includes any dependent claim that Patent Owner intends as dependent from a proposed substitute independent claim. For each proposed substitute claim, the motion must show, clearly, the changes of the proposed substitute claim with respect to the original patent claim which it is intended to replace. No particular form is required, but use of brackets to indicate deleted text and underlining to indicate inserted text is suggested.

Patent Owner may only propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B). To the extent Patent Owner seeks to propose more than one substitute claim for each original claim, Patent Owner shall explain in the motion to amend the need for the additional

claims and why the number of proposed substitute claims is reasonable. *See* 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Any proposed amendment may not enlarge the scope of the claims of the patent or introduce new matter. 35 U.S.C. § 316(d)(3).

Finally, Patent Owner must show written description support in the original specification for each proposed substitute claim, and support in any earlier-filed disclosure for each proposed substitute claim for which benefit of the filing date of the earlier filed disclosure is sought. 37 C.F.R. § 42.121(b). Citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued. Also, Patent Owner must show written description support for the entire proposed substitute claim and not just the features added by the amendment. This applies equally to independent claims and dependent claims, even if the only amendment to the dependent claims is in the identification of the claim from which it depends.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied the conference requirement of 37 C.F.R. § 42.121(a);

FURTHER ORDERED that Patent Owner's request for authorization to file a motion seeking a limit on the number of prior art references that Petitioner may introduce in opposition to Patent Owner's motion to amend, and an increase in the page limit for Patent Owner's reply to Petitioner's opposition, is denied without prejudice; and

FURTHER ORDERED that the parties shall notify the Board promptly of any change in status of the related litigation, by filing updated mandatory notice information under 37 C.F.R. § 42.8.

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