

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 20, 2017, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Begley, and McMillin. The call was held to discuss two issues regarding Patent Owner's Motion to Amend (Paper 14).

First, Patent Owner stated that, to comply with its duty of candor under 37 C.F.R. § 42.11(a), it 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 explained that the references were cited in related litigation and various reexaminations of patents related to the challenged patent in this proceeding. Patent Owner inquired as to whether it also should file copies of the United States patents on the list or whether there is another procedural mechanism Patent Owner should follow to ensure that it complies with its duty of candor.

Petitioner sought authorization to file a motion to strike the exhibits because none of them are cited or substantively discussed in the Motion to Amend. Petitioner also stated that it could not determine how to object to the exhibits, if necessary, because it was unknown how Patent Owner intended to use them. Petitioner requested that the deadline for objecting to the exhibits under 37 C.F.R. § 42.64(b)(1) be extended until after a decision on whether the exhibits will remain in the record.

Second, Patent Owner's Motion to Amend itself is 24 pages. The Motion, however, also includes Appendices A–C, which show clean and modified versions of Patent Owner's proposed substitute claims, and Appendices D–F, which are approximately 282 pages of claim charts

purportedly showing written description support for the proposed substitute claims in various applications as filed. Petitioner sought authorization to file a motion to strike the Motion to Amend for violating the 25-page limit set forth in 37 C.F.R. § 42.24(a)(1)(vi), when counting the Motion itself and Appendices D–F, and for improperly incorporating arguments in Appendices D–F by reference under 37 C.F.R. § 42.6(a)(3). Patent Owner responded by citing 37 C.F.R. § 42.24(a)(1), which provides that the word count for a motion to amend does not include a “claim listing,” and 37 C.F.R. § 42.121(b), which provides that “[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 . . . [t]he support in the original disclosure of the patent for each claim that is added or amended” (emphasis added).¹ Patent Owner read § 42.121(b) as providing that the claims “and” the written description support are part of the required “claim listing.” Patent Owner also argued that Appendices D–F are merely quoted excerpts from the earlier applications and do not constitute “arguments” that are incorporated by reference in the Motion, and requested permission to re-file if the Motion to Amend was improper. Petitioner disagreed with Patent Owner’s reading of § 42.121(b).

We took both matters under advisement. After further consideration, we determine that briefing from the parties is appropriate. *See* 37 C.F.R. § 42.20(d). First, Petitioner is authorized to file a motion to strike Exhibits

¹ *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,562 (May 19, 2015) (describing the final rule amending § 42.121(b) “to permit an appendix for the claim listing accompanying a motion to amend that is not counted toward the 25-page limitation”).

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2001–2036, and Patent Owner is authorized to file an opposition. The parties should address in their papers whether Patent Owner’s list of references and accompanying documents should remain in the record, as well as the proper mechanism(s) for patent owners to comply with the duty of candor when filing a motion to amend. We will extend the deadline for filing objections to the exhibits until after we decide whether the exhibits should remain in the record.

Second, Petitioner is authorized to file a motion to strike the Motion to Amend, and Patent Owner is authorized to file an opposition. If Patent Owner desires to re-file its Motion to Amend in the event the motion to strike is granted, Patent Owner should explain in its opposition why it should be permitted to do so after the deadline for filing such a motion.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a motion to strike Exhibits 2001–2036, limited to five pages, by December 29, 2017, and Patent Owner is authorized to file an opposition, limited to five pages, by January 8, 2018;

FURTHER ORDERED that the deadline to object to Exhibits 2001–2036 under 37 C.F.R. § 42.64(b)(1) is extended until further notice; and

FURTHER ORDERED that Petitioner is authorized to file a motion to strike Patent Owner’s Motion to Amend, limited to five pages, by December 29, 2017, and Patent Owner is authorized to file an opposition, limited to five pages, by January 8, 2018.

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