Trials@uspto.gov
Tel: 571-272-7822

Paper 10
Entered: March 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DONGHEE AMERICA, INC. and DONGHEE ALABAMA, LLC,
Petitioner,

v.

PLASTIC OMNIUM ADVANCED INNOVATION AND RESEARCH,
Patent Owner.

Case IPR2017-01633 (Patent 6,866,812 B2)
Case IPR2017-01647 (Patent 6,814,921 B1)

Before MITCHELL G. WEATHERLY, CHRISTOPHER M. KAISER, and ROBERT L. KINDER, *Administrative Patent Judges.*

KAISER, *Administrative Patent Judge*.

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

As required under 37 C.F.R. § 42.121(a), Patent Owner requested a conference call to confer with the Board regarding its desire to file a motion to amend. The panel conducted the conference call on March 22, 2018. Patent Owner indicated that it intends to file a contingent motion to amend by no later than Due Date 1 set forth in the Case Management and Scheduling Order.

DISCUSSION

In the call, we explained that a motion to amend under 37 C.F.R. § 42.121 may cancel claims and/or propose substitute claims. As we further explained, a motion to amend may propose only a reasonable number of substitute claims, and there is a rebuttable presumption that only one proposed substitute claim will generally be needed to replace each challenged claim. 35 U.S.C. § 316(d); 37 C.F.R. § 42.121(a)(3).

On October 4, 2017, the Federal Circuit issued an *en banc* decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017). In light of the *Aqua Products* decision, the Board will not place the burden of persuasion on a patent owner with respect to the patentability of substitute claims presented in a motion to amend. *Aqua Products*, 872 F.3d at 1327. A motion to amend still must meet the statutory requirements of 35 U.S.C. § 316(d) and the procedural requirements of 37 C.F.R. § 42.121.

Pursuant to 35 U.S.C. § 316(d)(3), "[a]n amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter." Similarly, 37 C.F.R. § 42.121(a)(2)(ii) provides that a motion to amend may be denied where the amendment seeks to enlarge the scope of the claims of the patent or introduces new subject matter. Patent Owner must establish that each proposed substitute claim is supported by the written description of the application upon which the proposed substitute claims rely, and citations should be to this original application – not the issued patent.[1] *See* 37 C.F.R. § 42.121(b).

[1] Patent Owner may also establish that the original application and the issued patent are the same, and if that is the case, citations may be to the issued patent.

Additionally, we noted that further guidance regarding the mechanics and substance of motions to amend appears in the memorandum titled, "Guidance on Motions to Amend in view of Aqua Products" (Nov. 21, 2017) (https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf) ("Guidance"). If Patent Owner files a motion to amend that meets the requirements of 35 U.S.C. § 316(d) (i.e., proposes a reasonable number of substitute claims, and the substitute claims do not enlarge scope of the original claims of the patent or introduce new matter), the Board will proceed to determine whether the substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the Petitioner.

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 as well as to allow a claims appendix. *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,565–66 (May 19, 2015).

Finally, the panel informed the parties that it would set forth a briefing schedule for the parties to present issues related to Patent Owner's motion to amend. The panel proposed a series of four briefs, which the parties agreed to during the conference call. The panel generally described the schedule set forth below. Except as otherwise stated in this Paper, the Case Management and Scheduling Order entered January 18, 2018, remains in effect.

A. DUE DATES

This order sets due dates for the parties to take action from this point forward in the proceeding. The parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of

the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 6 or 7. Any stipulated extension of DUE DATE 4 shall not modify the deadline set forth in this Order by which a party must request oral argument.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony.

1. DUE DATE 1

The patent owner may file—

a. A response to the petition (37 C.F.R. § 42.120), and

b. A motion to amend the patent (37 C.F.R. § 42.121).

The patent owner must file any such response or motion to amend by DUE DATE 1. Any motion to amend need only address those issues set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. The motion to amend shall be limited to 6,000 words, which shall be counted as set forth in 37 C.F.R. § 42.24.

If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

2. DUE DATE 2

The petitioner must file any reply to the patent owner's response and opposition to the motion to amend by DUE DATE 2. The opposition to the motion to amend shall address any arguments set forth in the motion to amend and may present any evidence and argument relating to the patentability of substitute claims

that Patent Owner proposes in its motion to amend. The opposition to the motion to amend shall be limited to 12,000 words, which shall be counted as set forth in 37 C.F.R. § 42.24.

3. DUE DATE 3

Patent Owner must file any reply to Petitioner's opposition to Patent Owner's motion to amend by DUE DATE 3. Patent Owner's reply may respond to arguments raised by Petitioner relating to Patent Owner's compliance with the requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 and present Patent Owner's opposition to Petitioner's arguments regarding the patentability of Patent Owner's proposed substitute claims. Patent Owner's reply shall be limited to 12,000 words, which shall be counted as set forth in 37 C.F.R. § 42.24.

3.5 DUE DATE 3.5

Petitioner must file any surreply in support of its arguments relating to the patentability of Patent Owner's proposed substitute claims by DUE DATE 3.5. Petitioner's surreply may respond to Patent Owner's arguments for patentability as presented in Patent Owner's reply. Petitioner's surreply shall be limited to 6,000 words, which shall be counted as set forth in 37 C.F.R. § 42.24.

4. DUE DATE 4

a. Each party must file any observations on the cross-examination testimony of a reply witness (*see* section A.7 of Paper 24) by DUE DATE 4.

b. Each party must file any motion to exclude evidence (37 C.F.R § 42.64(c)) by DUE DATE 4.

c. Each party must file any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.