

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISPERSIVE NETWORKS, INC.
Petitioner

v.

NICIRA, INC.
Patent Owner

Case PGR2018-00063
Patent 9,722,815

PATENT OWNER'S CONTINGENT MOTION TO AMEND

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I. INTRODUCTION AND RELIEF REQUESTED

Pursuant to 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221, Patent Owner Nicira, Inc. (“Nicira” or “Patent Owner”) moves to amend (“Motion”) U.S. Patent No. 9,722,815 (“the ’815 patent”), contingent upon the outcome of the present trial. If any of Claims 1, 6 or 8 are deemed unpatentable by the Board, Nicira requests that the Board grant this Motion to Amend and issue the corresponding substitute claim presented herein.

The substitute claims meet all of the requirements of 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221. Each amendment is responsive to a ground of unpatentability involved in this proceeding, does not seek to enlarge the scope of the claims or introduce new subject matter, proposes a reasonable number of substitute claims, sets forth detailed written description support for each proposed substitute claim, and includes a claim listing which clearly identifies the proposed changes.

Moreover, this Motion follows the guiding principles set forth in *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018–00082, –00084 (Paper 13), designated as informative by the Board. In this regard, although Nicira is required to demonstrate that it has met each of the statutory and procedural obligations set forth in 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221, Nicira does not bear the burden of persuasion with respect to the patentability of the substitute claims presented in this motion. *Aqua Products Inc. v. Matal*, 872 F.3d 1290, 1306 (Fed.

Cir. 2017) (*en banc*). Because the requirements set forth in 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221 have clearly been satisfied, Petitioner bears the burden to establish by a preponderance of the evidence that the Motion should be denied on grounds of unpatentability of the substitute claims. *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027, 1040 (Fed. Cir. 2017). Because the substitute claims contain at least all of the same elements as the original claims, the substitute claims are patentable for at least the same reasons explained in detail in the concurrently filed Patent Owner Response (“POR”).

Should the Board find any issued claim unpatentable in this proceeding, Nicira respectfully requests that the Board grant this Motion to Amend with respect to each corresponding substitute claim presented herein. More specifically: (i) contingent upon a finding of unpatentability of claim 1, cancel claim 1 and substitute claim 12 therefor, and cancel claims 2–5 and substitute claims 13–16 therefor (to adjust dependencies only); (ii) contingent upon a finding of unpatentability of claim 6, cancel claim 6 and substitute claim 17 therefor; and (iii) contingent upon a finding of unpatentability of claim 8, cancel claim 8 and substitute claim 18 therefor, and cancel claims 9–11 and substitute claims 19–21 therefor (to adjust dependencies only). For any claim that the Board finds Petitioner failed to meet its burden to demonstrate unpatentability, the Board need not consider the amendments of any such claim(s) addressed in this Motion.

II. THE SUBSTITUTE CLAIMS MEET ALL THE REQUIREMENTS OF 37 C.F.R. § 42.221

As indicated in its Order of December 19, 2018, this Motion has been authorized by the Board upon consultation during a conference call on December 7, 2018. Thus, Patent Owner's obligations under 37 C.F.R. § 42.221(a) are satisfied. This Motion is being filed, consistent with the Scheduling Order, concurrently with Patent Owner's Response. Therefore, the timeliness requirement of 37 C.F.R. § 42.221(a)(1) is satisfied.

A. Nicira Proposes a Reasonable Number of Substitute Claims

Nicira proposes only one substitute claim for each original claim it seeks to replace, and is thus presumptively reasonable in number. 37 C.F.R. § 42.221(a)(3).

B. The Claim Amendments Are Responsive to at Least One Ground of Unpatentability Involved in the Trial

The proposed substitute claims are responsive to one or more grounds of patentability at issue in this proceeding. Petitioner has challenged the patentability of claims 1–6 and 8–11 on 35 U.S.C. § 112(b) grounds. Petition, pp. 17–25. More specifically, Petitioner alleges that claims 1, 6 and 8 are indefinite. The Board instituted trial on all grounds, as required by *SAS*¹. Decision on Institution, Paper 25 (“DI”), pp. 17–25. The proposed amendments seek to further clarify the claim language, and remove any arguable doubt regarding the definiteness of these

¹ *SAS Inst. Inc. v. Iancu*, 584 U.S. ____, 138 S. Ct. 1348 (2018).

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