

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DISPERSIVE NETWORKS, INC.,  
Petitioner

v.

NICIRA, INC.,  
Patent Owner

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Case PGR2018-00063  
Patent 9,722,815 B2

Before DEBRA K. STEPHENS, GARTH D. BAER, and  
KAMRAN JIVANI, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

ORDER  
Conduct of Proceeding  
35 U.S.C. § 42.5

## I. INTRODUCTION

### A. *Background*

Dispersive Networks, Inc.<sup>1</sup> (“Petitioner”) filed a Petition (Paper 1 (“Pet.”)) requesting a post-grant review of claims 1–11 of U.S. Patent No. 9,722,815 (Ex. 1001 (hereinafter “815 Patent”)) (35 U.S.C. § 321). Nicira, Inc.<sup>2</sup> (“Patent Owner”) timely filed a Preliminary Response (Paper 17 (“Prelim. Resp.”)) to the Petition. An Institution of Post-Grant Review was decided on November 15, 2018 (Paper 25).

A conference call was held on December 7, 2018 between the parties and Judges Stephens, Baer, and Jivani. Patent Owner requested the conference call to comply with 37 C.F.R. § 42.121 (a) prior to filing a motion to amend claims. The parties additionally wanted to discuss a proposed altering of the schedule dates set forth in the Scheduling Order (Paper 26) to accommodate multiple motions to amend claims. For the parties’ convenience, we summarize the parties’ representations and our guidance provided during the call. Additional guidance may be found in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766–48,767 (Aug. 14, 2012).

As a preliminary matter, we advised the parties to periodically check the United States Patent and Trademark Office’s official website, [uspto.gov](http://uspto.gov), for up-to-date information regarding our operational status in the event of a government shutdown.

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<sup>1</sup> Dispersive Networks, Inc. identifies Dispersive Technologies, Inc. as an additional real party in interest (Paper 11, 3).

<sup>2</sup> Nicira, Inc. identifies VMware, Inc. as an additional real party in interest (Paper 5, 3).

B. *Request for Authorization to File Motion to Amend*

We informed the parties that a memorandum detailing our guidance on motions to amend is available on the uspto.gov website and is titled: “Guidance on Motions to Amend in view of *Aqua Products*,” dated Nov. 21, 2017 (discussing *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)). Counsel for each party indicated familiarity with our guidance memorandum. As stated therein:

[T]he 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. Rather [if a motion to amend] . . . meets the requirements of 35 U.S.C. § 316(d) . . ., 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

(*id.* at 2).

Patent Owner indicated during the conference that it wishes to bring conditional amendments to independent claims 1 and 8, and to dependent claim 6; however, no specific proposed amendments were discussed. We granted Patent Owner’s request to file a Motion to Amend.

A motion to amend claims may only cancel claims or propose a reasonable number of substitute claims (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, but we will treat a request for consideration of substitute claims as contingent. That means a proposed substitute claim will be considered only if the original patent claim it is meant to replace is determined unpatentable. Here, Patent Owner requested a

contingent motion to cancel the claims and requested a consideration of substitute claims as contingent.

With regard to the statutory requirements of 35 U.S.C. § 316(d), we reminded Patent Owner that it may only propose a reasonable number of substitute claims for each challenged claim (35 U.S.C. § 316(d)(1)(B)). Patent Owner indicated that it intends to propose one substitute claim for each of claims 1, 6, and 8, which is a presumptively reasonable number of substitute claims (37 C.F.R. § 42.121(a)(3) (“*A reasonable number of substitute claims. A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.*”)). To the extent Patent Owner seeks to propose more than one substitute claim for each cancelled claim, Patent Owner shall explain in the motion to amend the need for the additional claims and why the number of proposed amended claims is reasonable (35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3)).

In our conference call, we stated the requirement of 35 U.S.C. § 316(d)(3) that proposed amendments may not enlarge the scope of the claims of the patent or introduce new matter (*see* 35 U.S.C. § 316(d)(3)). We further specified Patent Owner must show written description support in the original specification for each proposed substitute claim (*see* 37 C.F.R. § 42.121(b)) and citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued. We reminded Patent Owner that it 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.

Our rules require a claim listing reproducing each proposed substitute claim (*see* 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 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. The required claim listing may be contained in an appendix, which does not count toward the page limit for the motion (*see* 37 C.F.R. §§ 42.24(a)(1)(vi), (b)(3), (c)(3); 37 C.F.R. § 42.121(b) (limiting a motion to amend and an opposition to twenty-five pages and a reply to twelve pages)).

We further reminded the parties that a “motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial” (37 C.F.R. § 42.121(a)(2)(i)). As we stated, there is no specific format for complying with this rule. In considering the motion, we will consider the entirety of the record to determine whether Patent Owner’s amendments respond to the single ground of unpatentability involved in this trial.

### *C. Request to Modify Scheduling Order*

During the conference call, Patent Owner requested that we modify the Scheduling Order (Paper 26) in this proceeding to permit time for a

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