

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORPORATION
Petitioner,

v.

MOBILEMEDIA IDEAS LLC
Patent Owner.

Case IPR2013-00016 (JYC)
Patent 6,441,828

Before SALLY C. MEDLEY, KEVIN F. TURNER, and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge*

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

On May 14, 2013, a telephone conference call was held between
respective counsel for the parties and Judges Medley, Turner, and Chang.
While prior authorization is not required for filing a first motion to amend

claims that is timely filed no later than Due Date 1 set forth in the Scheduling Order (Paper 17), counsel for MobileMedia initiated the conference call to seek the Board's guidance prior to filing its motion to amend claims.

During the conference call, MobileMedia informed the Board that, rather than filing a patent owner response, it intends to file a motion to amend claims that will cancel all of the challenged claims (claims 6, 7, 15, 17, and 18), and propose only one substitute claim to replace each challenged claim. MobileMedia also indicated that the proposed substitute claims will not add new matter or enlarge the scope of existing claims. MobileMedia further stated that, in support of its motion to amend claims, it intends to file an expert declaration and an English language translation of a foreign priority application.

In response to MobileMedia's inquiry, the Board explained that although only one challenged claim is independent, MobileMedia may propose more than one independent claim in certain situations, such as rewriting a dependent claim in independent form and then incorporating a new claim limitation into the new independent claim. The Board further clarified that the claim listing in a motion to amend claims should not list the non-challenged claims. The Board encouraged MobileMedia, for each proposed substitute claim that bears a strong resemblance to an original claim, to identify that original claim and show the relative changes with respect to the original claim, *e.g.*, denoting text deleted by one notation such as bracketing and text inserted by another notation such as underlining.

As explained during the conference call, any substitution must be made to respond to a ground of unpatentability involved in the trial. *See* 37 C.F.R. § 42.121(a)(2)(i). The Board pointed out that in a motion to amend, MobileMedia must explain how the proposed substitute claims obviate the grounds of unpatentability authorized in this trial, and why they are patentable over the prior art of record. That explanation should include a claim construction of the proposed substitute claims. The Board noted that the original challenged claims contain several means-plus-function limitations. *See* Decision on Institution, Paper 16 at pages 7-16. Should any proposed substitute claim include a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6¹, MobileMedia must include a claim construction for each means-plus-function limitation identifying the corresponding structure disclosed in the specification that performs the claimed function, including any computer or microprocessor, computer program, and algorithm.

In addition, the Board noted that for each proposed substitute claim, MobileMedia must also set forth the support in the original disclosure of the involved patent, and the support in an earlier-filed disclosure for which benefit of the filing date of the earlier filed disclosure is sought, including any foreign priority application. 37 C.F.R. § 42.121(b). Any English

¹ Section 4(c) of the AIA re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). Because the '828 patent has a filing date before September 16, 2012 (effective date), we refer to the pre-AIA version of 35 U.S.C. § 112 in this Order.

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language translation must be filed with an affidavit attesting to the accuracy of the translation. 37 C.F.R. § 42.63(b).

Counsel for Research In Motion requested an extension of time for filing an opposition to MobileMedia's motion to amend. The Board explained that because MobileMedia has not filed a motion to amend, such a request is premature, and also noted that the Scheduling Order (Paper 17) permits the parties to stipulate to different dates for Due Dates 1 through 3 (earlier or later, but no later than Due Date 4).

It is

ORDERED that MobileMedia should note the above guidance in filing its motion to amend claims under 37 C.F.R. § 41.121; and

FURTHER ORDERED that, at this time, no extension of time is authorized for filing an opposition to a motion to amend.

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