

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**Oracle Corporation**  
Petitioner

v.

**Clouding IP, LLC**  
Patent Owner

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Case IPR2013-00073 (JL)  
Patent 6,738,799

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Before JAMESON LEE, JONI Y. CHANG, and MICHAEL W. KIM,  
*Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

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

On June 19, 2013, counsel for Clouding initiated a telephone conference call with the Board to confer about filing a motion to amend claims. Judges Lee, Chang, and Kim participated in the conference call with counsel of each party.

Counsel for Clouding indicated that in a contingent motion to amend claims, Clouding would seek to replace each of independent claims 1, 23, and 37. The

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Board directed attention of the parties to Paper 26 in IPR2012-00027, dated June 11, and Paper 27 in IPR2012-00005, dated June 3, 2013, with regard to the requirements of filing a motion to amend claims, and noted that Clouding would have to account for the level of ordinary skill in the art and the basic skill set possessed by one with ordinary skill, and may not limit its consideration to just the references over which this trial was instituted. The Board also noted that when indicating written description support in the specification, Clouding should make reference to the disclosure in the original application as filed, rather than to portions of the issued patent, and provide sufficient explanation in addition to citations to specification.

Counsel for Clouding inquired whether it can propose to substitute two claims for one independent claim. The Board replied that Clouding would have to present a special circumstance, *e.g.*, each of the two new claims present a feature, not present in the other, which provide the basis of patentable distinction over the prior art, and that the two substitute claims are patentably distinct from each other. Clouding may choose however it desires to utilize its authorized pages for the motion. The Board cautioned that a patent owner has much to do even in demonstrating patentability of just one substitute claim.

It is

**ORDERED** that Clouding has met the requirement to confer with the Board prior to filing a motion to amend claims under 37 C.F.R. § 42,121(a).

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