

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAME SHOW NETWORK, LLC, and WORLDWINNER.COM, INC.
Petitioners

v.

JOHN H. STEPHENSON
Patent Owner

Case IPR2013-00289
Patent 6,174,237

Before SALLY C. MEDLEY, KEVIN F. TURNER, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

On January 16, 2014, a conference call was held between counsel for the
respective parties and Judges Medley, Turner, and Wood.

The purpose of the conference call was for Patent Owner to confer with the

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Board prior to filing a motion to amend.¹

For guidance on motions to amend, Patent Owner is directed to the Office Patent Trial Practice Guide motion to amend guidelines, along with the guidelines provided in *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2013-00027, Paper 26 (June 11, 2013); and *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings Inc.*, IPR2013-00136, Paper 33 (November 7, 2014).

A discussion was had regarding whether Patent Owner may file a request for a reexamination or reissue of the involved patent during the trial. The Board directed attention to prior Board decisions which suggest that a Patent Owner may pursue new claims in another type of proceeding before the Office during the trial.

For example, on page 6 of the *Idle Free* decision cited above, the Board explained:

If a patent owner desires a complete remodeling of its claim structure according to a different strategy, it may do so in another type of proceeding before the Office. For instance, a patent owner may file a request for *ex parte* reexamination, relying on the Board's conclusion of a petitioner's having shown reasonable likelihood of success on certain alleged grounds of unpatentability as raising a substantial new question of unpatentability. In appropriate circumstance, it may also seek to file a reissue application.

Upon such explanation, counsel for Patent Owner represented that Patent Owner may elect to file a request for reexamination of its involved patent instead of filing a motion to amend. If Patent Owner elects to do so, it must notify the

¹ 37 C.F.R. § 42.121(a) provides that a patent owner may file one motion to amend, but only after conferring with the Board.

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Board. Counsel for Patent Owner indicated that it would do so in its Patent Owner Response. Upon further consideration, if Patent Owner files a request for reexamination or reissue, Patent Owner must file an updated mandatory notice with the Board. *See* 37 C.F.R. § 42.8(a)(3). To the extent that Patent Owner elects to file a motion to amend in this proceeding, the conference call satisfies Patent Owner's requirement to confer with the Board prior to filing its motion to amend.

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