

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RICHOH AMERICAS CORPORATION and XEROX CORPORATION  
Petitioner  
v.

MPHJ TECHNOLOGY INVESTMENTS, LLC  
Patent Owner

Case IPR2013-00302  
Patent 7,986,426 B1

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Before SALLY C. MEDLEY, MICHAEL P. TIERNEY, and KARL D.  
EASTHOM, *Administrative Patent Judges*.

TIERNEY, *Administrative Patent Judge*.

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

An initial conference call in the above proceeding was held on December 17, 2013, between respective counsel for Petitioner and Patent Owner, and Judges Tierney, Medley, and Easthom. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 9) and any motions that the parties intend to file. The following issues were discussed.

1. Schedule

Patent Owner and Petitioner agreed to discuss the Due Dates and possible modifications to Due Dates 1 through 3.

2. Motion to Amend

Counsel for Patent Owner indicated that they intend to file a motion to amend. The Board directed the parties' attention to IPR2012-00027 (Paper 26), and IPR2013-00136 (Paper 33), both of which give guidance on the proper content of a motion to amend claims. The Board explained that the Patent Owner has the burden of proof in demonstrating patentability of each proposed substitute claim. That task is different from responding to an *ex parte* rejection of claims by an Examiner. The Patent Owner is expected to explain the level of ordinary skill with respect to each feature it relies on for patentable distinction of the claimed invention as a whole, including providing information on whether the feature was known outside of the specific combination claimed.

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