

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

TOYOTA MOTOR CORPORATION,  
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner.

---

Case IPR2013-00417  
Patent 8,036,788

---

Before JAMESON LEE, BARBARA A. PARVIS, and  
GREGG I. ANDERSON, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Order  
Conduct of Proceedings  
37 C.F.R. § 42.5

## Introduction

On June 25, 2014, a telephone conference call was held between respective counsel for the parties and Judges Lee, Anderson, and Parvis. Patent Owner (“AVS”) initiated the conference call to discuss three issues. First, it sought clarification with regard to its Motion to Amend Claims, which was filed on March 24, 2014 (Paper 24), over 3 months ago. According to counsel for Patent Owner, the parties disagree as to whether Patent Owner is required, in its Motion to Amend and with regard to entitlement to an earlier filing date, to point to supporting disclosure in each ancestral application that is in the chain of applications leading to the application with the earliest filing desired by the Patent Owner. Second, it sought authorization to file an additional Motion to Amend Claims to render moot Petitioner’s argument that Patent Owner’s proposed substitute claims are indefinite under 35 U.S.C. § 112, second paragraph. Third, it sought authorization to file supplemental evidence.

## Discussion

### 1.

With regard to a Motion to Amend Claims, the Patent Owner bears the burden of proof. 37 C.F.R. § 42.20(c). The effective filing date is highly pertinent to the level of ordinary skill in the art and what prior art is applicable against the Patent Owner’s proposed substitute claims. If the Patent Owner desires an effective filing date that is prior to the actual filing date of its involved patent, it is incumbent upon the Patent Owner to make the necessary showing in that regard.

If any application in the priority chain fails to make the requisite disclosure of the claimed subject matter under 35 U.S.C. § 112, first paragraph, the later-filed application is not entitled to the benefit of the filing date preceding the break in disclosure within the priority chain. *Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed.

Cir. 2012). To gain the benefit of the filing date of an earlier-filed application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written-description requirement of 35 U.S.C. § 112, first paragraph. *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997); *In re Hogan*, 559 F.2d 595, 609 (CCPA 1977); *In re Schneider*, 481 F.2d 1350, 1356 (CCPA 1973).

Counsel for Patent Owner identified the pertinent chain of continuity to be as follows: Application 08/476,077 → Application 09/137,918 → Application 09/356,314 → Application 09/925,062 → Application 10/701,361 → Application 11/082,739 → Application 11/836,274 (issued as Patent Owner's involved patent in this proceeding). The earliest ancestral application in the chain is Application 08/476,077. There are five intervening applications between Patent Owner's involved patent and Application 08/476,077. Yet, Patent Owner's Motion to Amend Claims discussed supporting disclosure only of the application that issued as the involved patent and Application 08/476,077, not including the disclosures of the five intermediate applications, which are each in the chain of continuity as a continuation-in-part of another application in the chain.

Counsel for Patent Owner inquired whether Patent Owner can, in its Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims, address the supporting disclosure of the five intermediate applications. Counsel for Petitioner objected to such action, noting that Petitioner would be prejudiced both because Patent Owner should have addressed that issue initially in the Motion to Amend Claims, and because Petitioner is now without opportunity to respond. Counsel for Petitioner also pointed out that there are numerous continuity paths leading back to Application 08/476,077, and Patent Owner should not be able to pick which path to

take, after having seen Petitioner's Opposition to the Motion to Amend Claims. Although counsel for Patent Owner states that Petitioner in its Opposition does not point out exactly what element is not supported in the disclosure of Application 08/476,477, the Opposition does assert that Patent Owner did not establish entitlement to the filing date of Application 08/476,477.

Counsel for Patent Owner further represented that the disclosures to be relied on in the intervening applications would be essentially the same as that which was relied on in Application 08/476,077, but fell short of representing that such disclosures are exactly the same. Note that the intervening applications are continuation-in-part applications of the immediately previous application in the chain and do not share the same disclosure. Petitioner does not accept the assertion that the disclosures are the same. In any event, even assuming that the disclosures are the same, Petitioner did not waive the right to oppose and challenge Patent Owner's assertions, if made, with respect to the intervening applications.

Petitioner had two months to prepare an opposition to Patent Owner's Motion to Amend Claims. Oral Argument has been scheduled for August 14, 2014. At this late stage in the proceeding, there is insufficient time, in any event, to provide Petitioner sufficient time to respond to Patent Owner's Reply. In that regard, counsel for Petitioner indicated that it would want to submit declaration evidence on the subject, if Patent owner is allowed to address the subject.

For all of the foregoing reasons, we determined that it would be improper for Patent Owner, in its Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims, to address and account for the supporting disclosures, if any, in any of the five intervening ancestral applications.

Counsel for Patent Owner then asked permission to file another Motion to Amend Claims, in which it would make all the necessary showings with regard to

the intermediate applications. We explained that that would be equally improper, for the same reasons why the matter should not be addressed in Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims.

2.

As explained by counsel for Patent Owner, Petitioner argued that Patent Owner's proposed substitute claims are indefinite under 35 U.S.C. § 112, second paragraph, and that certain claim term is subject to two competing interpretations. Counsel for Patent Owner stated that Patent Owner would like to file a second Motion to Amend Claims to cover the contingency that the Board concludes Petitioner's indefiniteness argument is persuasive. It is represented by counsel for Patent Owner that the Second Motion to Amend Claims simply would make more clear which interpretation was intended.

The Patent Owner's proposal is inconsistent with the overall framework of this proceeding. There would be no end to this proceeding if the Patent Owner is permitted to keep filing further proposed amendments on the contingency that the Board concludes in favor of the Petitioner with regard to an earlier Motion to Amend claims. Counsel for Patent Owner represents that Patent owner will not ask to file any further Motions to Amend on the contingency that the second Motion to Amend Claims still fails, but even that does not justify the filing of the second Motion to Amend Claims.

A Patent Owner has no right to file a second Motion to Amend Claims. The possibility that the Board may rule in favor of the Petitioner on the Patent Owner's first Motion to Amend Claims is insufficient justification for authorizing the filing of a second Motion to Amend Claims. In the absence of extraordinary or special circumstance, the consequences of a failed Motion to Amend Claims is that the Patent Owner is not entitled to any substitute claim, not that the Patent Owner is

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.