

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOYOTA MOTOR CORPORATION,  
Petitioner

v.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner

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Case IPR2013-00424  
Patent 5,845,000

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Before JAMESON LEE, TREVOR M. JEFFERSON, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

## Introduction

On March 11, 2014, a telephone conference call was held between respective counsel for the parties and Judges Lee, Jefferson, and Parvis. Patent owner (“AVS”) initiated the conference call to satisfy the confer requirement of 37 C.F.R. § 42.121(a) with regard to the filing of a motion to amend claims. Counsel for each party expressed that because both parties were participants in a conference call, held on March 5, 2014, in connection with related proceedings IPR2013-00419, IPR2013-00420, IPR2013-00421, IPR2013-00422, and IPR2013-00423, during which the Board gave detailed verbal guidance on the requirements of a motion to amend claims, a similar verbal guidance during this conference call would not be necessary in this case.

Instead, AVS had a question regarding the effects of a request for entry of adverse judgment, in general, not necessarily to be filed in this proceeding. Counsel for AVS indicated that AVS is contemplating such an action in at least one of the following 7 proceedings, IPR2013-00412, IPR2013-00413, IPR2013-00414, IPR2013-00415, IPR2013-00416, IPR2013-00417, and IPR2013-00424.

The Board indicated that in light of the preference of the parties, no detailed guidance would be given verbally during the call, but the Board will include such guidance, in written form, in the paper summarizing the conference call.

## Discussion

Counsel for AVS asked what claims may still be pursued by AVS in other proceedings of the USPTO, if it requests adverse judgment in this proceeding. We do not advise parties on what claims to pursue, or in which proceeding to pursue them. The estoppel effect of an adverse judgment on patent owner is governed by 37 C.F.R. § 42.73(d)(3).

The following applies to a motion to amend claims.

1. There should be no “amending in place.” Any claim with a changed scope, subsequent to the amendment, should be included in the claim listing as a proposed substitute claim, and have a new claim number. That would eliminate any confusion as to whether a claim depending from an amended claim depends from the claim in its form prior to the amendment or subsequent to the amendment. In that regard, an unchanged dependent claim, which depends from a cancelled claim, still retains its same scope and does not need to be rewritten.

2. A motion to amend claims only may cancel claims or propose substitute claims. The request to cancel claims will not be regarded as contingent. However, the request to substitute claims is always contingent. That means a proposed substitute claim will be considered only if the original patent claim it replaces is determined unpatentable or is cancelled by the patent owner.

3. A claim listing is required by 37 C.F.R. § 42.121(b). Each proposed substitute claim must be reproduced in the claim listing, and the claim listing should be set forth in the motion itself, and not a claim appendix. Also, for each proposed substitute claim, the motion must show, clearly, the changes of the proposed substitute claim with respect to the original patent claim which it is intended to replace. No particular form of showing changes is required, but use of brackets to indicate deleted text and underlining to indicate inserted text is suggested.

4. There is a presumption that only one substitute claim is needed for each original patent claim. But that does not mean the patent owner is in compliance so long as the total number of claims before and after the amendment remain the same. The requirement is viewed on a per claim basis, and the patent owner may not arbitrarily designate a proposed substitute claim as being a

substitute claim for whichever original patent claim the patent owner simply desires to name. The proposed substitute claim must be traceable back to the original patent claim that it is intended to replace. In general, claim X is properly named as a substitute claim for claim Y if claim X includes all of the features of claim Y. If the patent owner needs more than one substitute claim for a particular patent claim, the motion should articulate a special circumstance to justify the request. If the additional proposed substitute claim is patentably distinct from the first substitute claim, given the first substitute claim as prior art, that likely would be sufficient justification.

5. A proposed substitute claim should be responsive to the ground of unpatentability applicable to the original patent claim for which it is a substitute. 37 C.F.R. § 42.121(a)(2)(i). Generally, that means the proposed substitute claim should not eliminate any feature or element of the original patent claim which it is intended to replace. If there is a special circumstance to justify deviation from that general rule, the motion should provide adequate and persuasive explanation. A proposed substitute claim also is prohibited from enlarging the scope of the patent claims. 37 C.F.R. § 42.121(a)(2)(ii).

6. The patent owner bears the burden of proof to establish that it is entitled to the relief requested in the motion to amend. 37 C.F.R. § 42.20(c). If the motion is granted, the proposed substitute claims will be added to the involved patent, without examination. Accordingly, the patent owner must show patentability over the prior art in general, and not just over the references applied by the petitioner against the original patent claims.

Explaining patentability over references applied by the petitioner against the original patent claims is not the main event. The motion should provide sufficient underlying facts regarding any feature added by the proposed substitute claim. For

instance, it should be revealed whether the feature was previously known anywhere, in whatever setting, and whether or not the feature was known in combination with any of the other elements in the claim. If any such combination was known, the motion should explain the surrounding facts in that regard, and why it would not have been obvious for one with ordinary skill in the art to adapt that knowledge for use with the rest of the claim elements.

The patent owner is not expected to know everything that a hypothetical person of ordinary skill in the art is presumed to know, but the patent owner is expected to reveal what it does know, to the extent that it is relevant. For instance, there should be a discussion of the ordinary skill in the art, with particular focus on the feature added to provide the basis of patentable distinction. In that regard, it would not be meaningful to say that a person of ordinary skill in the art possesses this many years of education and that many years of experience. Rather, the discussion should be specific about the technical knowledge pertaining to the feature added. It would be useful to know whether there are textbooks or conventional practices relating to the feature, and what basic skillset would be possessed by one with ordinary skill in the art. A conclusory statement to the effect that the closest prior art are the references in the record is not meaningful.

7. In the motion to amend, the patent owner must show written description support in the specification for each proposed substitute claim. 37 C.F.R. 42.121(a)(2)(ii). In that connection, it is important to note that citation should be made to the original disclosure of the application as filed, rather than to the patent as issued. Also, it is inadequate to show written description support for just the feature added by the proposed substitute claim. Instead, the patent owner must show written description support for the entire combination claimed.

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