

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION and GOOGLE INC.  
Petitioner

v.

B.E. TECHNOLOGY, L.L.C.  
Patent Owner

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Case IPR2014-00039<sup>1</sup>  
Patent 6,628,314 B1

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Before SALLY C. MEDLEY, *Administrative Patent Judge*.

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

On July 3, 2014, a conference call was held between counsel for the respective parties and Judge Medley. The purpose of the call was for Patent Owner to meet its requirement that it confer prior to filing a motion to amend. 37 C.F.R. § 42.121(a).

Counsel for Patent Owner indicated that Patent Owner intends to file a

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<sup>1</sup> Case IPR2014-00738 has been joined with this proceeding.

contingent motion to amend in this proceeding, as well as in IPR2014-00038, -00052, and -00053. Specifically, Patent Owner proposes to substitute an independent claim 23 for independent claim 11.<sup>2</sup> Patent Owner further seeks to present substitute dependent claims for each involved dependent claim for the sole purpose of ensuring dependency from the proposed substitute claim 23. As understood, each dependent claim would not be altered in any way from the original dependent claim it replaces, besides being renumbered to depend from proposed substitute claim 23.

Guidance was provided to Patent Owner regarding motions to amend, including directing attention to the following orders: *Nichia Corporation v. Emcore Corporation*, Case IPR2012-00005, Paper 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013); and *Int'l Flavors & Fragrances Inc. v. The United States of America*, IPR2013-00124, Paper 12 (May 20, 2014).

Patent Owner also is directed to *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings Inc.*, IPR2013-00136, Paper 33 (November 7, 2013), which, at pages 3-4, explains the scenario of substituting dependent claims for the sole purpose of changing the dependency from the proposed substitute claim. Those claims would need to be listed and included in Patent Owner's motion to amend.

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<sup>2</sup> Counsel for Patent Owner indicated that the same substitute claim 23 will be presented in each motion to amend in each of IPR2014-00038, -00039, -00052, and -00053.

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