

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GREENE'S ENERGY GROUP, LLC, INC.,  
Petitioner,

v.

OIL STATES ENERGY SERVICES, LLC,  
Patent Owner.

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Case IPR2014-00216  
Patent 6,179,053 B1

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SCOTT E. KAMHOLZ, *Administrative Patent Judge.*

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

On August 13, 2014, Patent Owner requested a conference concerning a Motion to Amend that it intends to file. The Board conducted a conference with both parties on August 14, 2014. Patent Owner indicated that it intended to propose one substitute claim for each of the two claims under review. Patent Owner declined the Board's invitation to discuss the proposed motion to amend in further detail. The Board offered the parties some guidance on the content and procedure for a Motion to Amend, which guidance is repeated and expanded upon below.

A motion to amend claims in an *inter partes* review is not itself an amendment. Unlike a claim amendment in patent prosecution, amendments proposed by a motion to amend are not entered as a matter of right.

A motion to amend is limited to 15 pages, as is the opposition. A reply to an opposition is limited to 5 pages.

A motion to amend may be denied where (i) the amendment does not respond to a ground of unpatentability involved in the trial or (ii) the amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter. 37 C.F.R. § 42.121(a)(2). These conditions are evaluated for each substitute claim traceable to a challenged claim that the substitute claim is intended to replace. A proper substitute claim under 37 C.F.R. § 42.121(a)(2) must only narrow the scope of the challenged claim it replaces and may not enlarge the scope of the challenged claim by eliminating any feature or limitation. A proposed substitute claim is not responsive to an alleged ground of patentability if it does not either include or narrow each feature or limitation of the challenged claim being replaced. *See Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014).

Unlike patent prosecution, in an *inter partes* review a proposed amendment to the claims is not authorized unless the movant has shown that the proposed substitute claims are patentable. In all circumstances, Patent Owner must make a showing of patentable distinction over the prior art. Patent Owner should identify specifically the feature(s) or limitation(s) added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s) or limitation(s), including the construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record, but known to Patent Owner. The burden is not on Petitioner to show unpatentability, but on the Patent Owner, as the moving party, to show patentable distinction over the prior art of record and other prior art known to Patent Owner. 37 C.F.R. § 42.20(c). A showing of patentable distinction may rely on the declaration testimony of a technical expert about the level of ordinary skill in the art and about the significance and usefulness of feature(s) or limitation(s) added by the proposed claim. *Idle Free Systems*, Paper No. 26.

A mere conclusory statement by counsel in the motion to amend that one or more added features or limitations are not described in any prior art or would not have been suggested or rendered obvious by the prior art is facially inadequate. *Id.* It also is insufficient for the movant simply to explain why the proposed substitute claims are patentable in consideration of the challenges on which the Board instituted review. Limiting the discussion either to the references already in the proceeding, or to the narrow combination specifically recited in the claim, does not provide a meaningful analysis. *See Corning Gilbert, Inc. v. PPC Broadband, Inc.*, IPR2013-00347, Paper No. 20 (January 2, 2014). In explaining why it believes the claimed subject matter is patentable, the movant must address issues of

nonobviousness, meaningfully. The movant should discuss the level of ordinary skill in the art, explaining the basic knowledge and skill set already possessed by one of ordinary skill in the art, especially with respect to the particular feature(s) or limitation(s) that the movant has added to the original patent claims. The movant should identify in what context the added feature or limitation, or something close to it, was already known, albeit not in the specific combination recited in the claims at issue. *Id.*; *Idle Free Systems*, Paper No. 66.

A motion to amend claims must clearly identify the written description support for the proposed substitute claims. The written description test is whether the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Pursuant to 37 C.F.R. § 42.121(b)(1), Patent Owner must set forth the support in the *original disclosure* of the patent for each proposed substitute claim, i.e., Patent Owner must identify clearly the written description support in the disclosure corresponding to the earliest date upon which Patent Owner seeks to rely.

Merely indicating where each claim limitation individually is described in the original disclosure may be insufficient to demonstrate support for the claimed subject matter as a whole. While the proposed substitute claims need not be described verbatim in the original disclosure in order to satisfy the written description requirement, if the claim language does not appear in the same words in the original disclosure, a mere citation to the original disclosure, without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole, may be inadequate. *See Nichia Corporation v. Emcore Corporation*, IPR2012-00005,

Case IPR2014-00216  
Patent 6,179,053 B1

Paper No. 27 (June 3, 2013); *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00050,  
Paper No. 77, 42-47 (May 1, 2014).

In preparing its motion to amend, the Board recommends that Patent Owner review the guidance provided by the Board in the proceedings cited in this paper. Patent Owner should also consider the guidance provided in *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013). The parties should request a conference if any further questions need to be addressed.

It is

ORDERED that Patent Owner has satisfied its obligation under 37 C.F.R. § 42.121(a) to confer with the Board before filing the Motion to Amend.

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