

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC. and MOTOROLA MOBILITY LLC,  
Petitioners,

v.

ARENDI S.A.R.L.,  
Patent Owner.

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Case IPR2014-00452  
Patent 6,323,853 B1

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Before MICHAEL R. ZECHER, NEIL T. POWELL, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

A conference call in the above proceeding was held on October 20, 2014, between respective counsel for Petitioners and Patent Owner, and Judges Zecher, Powell, and Cherry. Patent Owner initiated the conference call to satisfy the requirement of conferring with us prior to filing a Motion to Amend under 37 C.F.R. § 42.121(a).

#### DISCUSSION

In the call, Patent Owner indicated that it sought to present in its Motion to Amend an independent claim containing all of the current limitations of independent claim 1 plus certain additional words. We informed Patent Owner that the proper way to do so is to present a proposed substitute independent claim 80 with all of the limitations of independent claim 1 and the desired additional words. We further informed Patent Owner that the proposed substitute independent claim 80 must show the words added compared to independent claim 1, and must appear within the Motion to Amend, itself.

After receiving this advice, Patent Owner sought guidance regarding how it might structure the Motion to Amend in order to preserve the substance of dependent claims 2–79 if independent claim 1 ultimately gets replaced with proposed substitute independent claim 80. We informed Patent Owner that it could propose substitute dependent claims that include the same limitations as dependent claims 2–79 but depend from proposed substitute independent claim 80. We further informed Patent Owner that, if it proposes substitute dependent claims that are the same as claims 2–79 but are amended only to depend from proposed substitute independent claim 80, Patent Owner may list such proposed substitute dependent claims in a claims appendix. We indicated that, if Patent Owner files such a claims appendix,

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the claims appendix will not count toward the fifteen page limit for a Motion to Amend. *See* 37 C.F.R. § 42.24(a)(v). We noted, however, that Patent Owner must list and address proposed substitute independent claim 80 within the Motion to Amend, itself.

In view of this discussion, Petitioners asked certain questions regarding how any proposed substitute dependent claims listed in a claims appendix would be treated on the merits. We took this opportunity to remind the parties that Patent Owner bears the burden of proof to establish the patentability of any proposed substitute claim. *See* 37 C.F.R. § 42.20(c); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 2 (PTAB June 11, 2013) (Paper 26). For further guidance regarding the substance and mechanics of a Motion to Amend under 37 C.F.R. § 42.121, we directed the parties to *Toyota Motor Corp. v. American Vehicular Sciences LLC*, Case IPR2013-00423 (PTAB March 7, 2014) (Paper 27).

#### ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner has satisfied the requirement of conferring with us prior to filing a Motion to Amend under 37 C.F.R. § 42.121(a); and

FURTHER ORDERED that Patent Owner must address any proposed substitute independent claim in the Motion to Amend, itself, but it may provide a claims appendix that lists proposed substitute dependent claims, each of which is amended only to depend from the proposed substitute independent claim. A claims appendix satisfying this requirement will not count toward the fifteen page limit for the Motion to Amend.

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PETITIONER:

Matthew A. Smith  
Zhuanjia Gu  
TURNER BOYD LLP  
smith@turnerboyd.com  
gu@turnerboyd.com

PATENT OWNER:

Robert M. Asher  
Bruce D. Sunstein  
SUNSTEIN KANN MURPHY & TIMBERS LLP  
rasher@sunsteinlaw.com  
bsunstein@sunsteinlaw.com