

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC., SAMSUNG TELECOMMUNICATIONS  
AMERICA, LLC, SAMSUNG ELECTRONICS AMERICA, INC.,  
and SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

MICROGRAFX, LLC,  
Patent Owner.

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Case IPR2014-00532  
Patent 5,959,633

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Before SALLY C. MEDLEY, RICHARD E. RICE, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

ORDER  
Conduct of Proceeding  
37 C.F.R. §§ 42.5, 42.121(a)

## I. INTRODUCTION

On November 13, 2014, a telephone conference was held between respective counsel for the parties and Judges Medley, Rice, and Parvis. Patent Owner initiated the telephone conference pursuant to 37 C.F.R. § 42.121(a) to confer with the panel with regard to filing a motion to amend one or more of the claims of U.S. Patent No. 5,959,633 (Ex. 1001, “the ’633 Patent”). Patent Owner briefly outlined, in broad terms, the nature of the contemplated motion/amendments, and the panel provided some general guidance with regard to both the mechanics and substance of a motion to amend claims under 37 C.F.R. § 42.121.

## II. DISCUSSION

The following items were discussed:

1. As noted above, Patent Owner briefly outlined, in broad terms, the nature of the contemplated motion/amendments. In particular, Patent Owner stated that it contemplated filing a contingent motion to amend independent claims 1 and 8 of the ’633 Patent to add one or more limitations to each claim.

2. We advised that 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. For example, as the ’633 Patent has 28 claims, Patent Owner can give new claim numbers 29 and 30 to its two proposed substitute claims. Using new claim numbers for substitute claims avoids confusion as to whether a dependent claim depends from a claim in its form prior to the

amendment or subsequent to the amendment. We clarified, in that regard, that an unchanged dependent claim, which depends from a canceled claim, still retains its same scope and does not need to be rewritten.

3. We advised that a motion to amend claims only may cancel claims or propose substitute claims. A request to cancel claims will not be regarded as contingent. A request to substitute claims, however, 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 canceled.

4. We advised that 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, Patent Owner must show patentability over the prior art that is relevant to the substitute claims, and not just over the references applied by Petitioner against the original patent claims.

5. In other words, explaining patentability over references applied by Petitioner against the original patent claims is not the main issue. 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.

6. Patent Owner will not be expected to know everything that a hypothetical person of ordinary skill in the art is presumed to know, but Patent Owner will be 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. A prior art search and/or expert declaration may be useful to demonstrate the scope and content of the prior art, but neither is required.

7. If there is any new term used in a proposed substitute claim, the meaning of which reasonably can be anticipated as subject to dispute, Patent Owner should provide a proposed claim construction in the motion to amend. If a proposed substitute claim adds a means-plus-function element, the corresponding structure, material, or acts described in the Specification should be identified. With regard to claim construction, a statement that a certain term should be construed according to its plain and ordinary meaning

is unhelpful. That plain and ordinary meaning should be provided in the motion, together with the supporting evidence.

8. We direct attention of the parties to *International Flavors & Fragrances Inc. v. The United States of America*, Case IPR2013-00124 (PTAB May 20, 2014) (Paper 12) (granting-in-part motion to amend), along with the other cases cited in our Order below, with regard to the requirements for a motion to amend. The decision is available at: [http://www.uspto.gov/ip/boards/bpai/representative\\_orders\\_and\\_opinions.jsp](http://www.uspto.gov/ip/boards/bpai/representative_orders_and_opinions.jsp).

In addition to the subjects discussed specifically during the telephone conference, the panel provides the following additional guidance:

9. 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 that 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.

10. Although there is a presumption that only one substitute claim is needed for each original patent claim, that does not mean 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 proposed substitute claim must be traceable back to the original patent claim that it is intended to replace. In general, claim X is

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