

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ZHONGSHAN BROAD OCEAN MOTOR CO., LTD.,  
BROAD OCEAN MOTOR LLC, and  
BROAD OCEAN TECHNOLOGIES, LLC,  
Petitioners,

v.

NIDEC MOTOR CORPORATION,  
Patent Owner.

---

Case IPR2014-01121<sup>1</sup>  
Patent 7,626,349 B2

---

Before BENJAMIN D. M. WOOD, JAMES A. TARTAL, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER

*Conduct of the Proceeding*  
*37 C.F.R. §§ 42.5, 42.121*

---

<sup>1</sup> Case IPR2015-00762 has been joined with this proceeding.

IPR2014-01121  
Patent 7,626,349 B2

On December 10, 2015, a conference call was held with the parties, initiated by Patent Owner to comply with the requirement of conferring with the Board prior to filing a Motion to Amend.

Entry of proposed substitute claims is not automatic, but only upon Patent Owner demonstrating the patentability of each proposed substitute claim. *See* 37 C.F.R. § 42.20(c). The Motion to Amend (1) may propose substitute claims that only narrow, not broaden, the scope of a claim; (2) may propose a reasonable number of substitute claims; and (3) should respond to a ground of unpatentability in the trial. 37 C.F.R. § 42.121(a)(3). Guidance regarding the mechanics and substance of motions to amend appears in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB June 11, 2013) (Paper 26), as well as *MasterImage 3D, Inc. v. RealD Inc.*, IPR2015-00040 (PTAB July 15, 2015) (Paper 42). The latter paper clarifies certain guidance provided in the former. We also directed the parties to the Federal Circuit's recent decision in *Prolitec, Inc. v. Scentair Techs., Inc.*, --- F.3d ---, 2015 WL 7873637 (Fed. Cir. 2015).

Patent Owner explained that it intends to file a conditional Motion to Amend the three challenged independent claims of the subject patent. Patent Owner further confirmed that such amendment will be responsive to the Hideji ground added to this proceeding on October 5, 2015. Paper 67. In light of Patent Owner's intention to file a Motion to Amend, some modification of the Supplemental Scheduling Order (Paper 70) may be warranted. The parties will confer to discuss stipulation of an adjustment to

IPR2014-01121  
Patent 7,626,349 B2

the schedule with respect to DUE DATES 3 and/or 4, as authorized by the Supplemental Scheduling Order. Paper 70, 2.

The Motion to Amend should demonstrate that each proposed substitute claim is supported by the written description of the application upon which the substitute claims rely, and should address the patentability of each proposed substitute claim over the prior art of record and the prior art known to Patent Owner, accounting for the basic knowledge and skill possessed by a person of ordinary skill in the art, even without reliance on any particular prior-art reference. *See* 37 C.F.R. § 42.121(b). Although the Motion to Amend should thus address the prior art involved in the proceeding before the addition of the Hideji ground, the Motion to Amend is not to be used as an opportunity to reargue positions as earlier developed with respect to that prior art. Further, the Motion to Amend should include claim constructions for any new term used in a proposed substitute claim where the meaning of such terms reasonably can be anticipated to be disputed. The plain and ordinary meaning of terms should be provided in the Motion, together with the supporting evidence.

It is

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

IPR2014-01121  
Patent 7,626,349 B2

PETITIONER:

Steven Meyer  
[ptopatentcommunication@lockelord.com](mailto:ptopatentcommunication@lockelord.com)

Charles Baker  
[cbaker@lockelord.com](mailto:cbaker@lockelord.com)

Joseph Farco  
[JFarco@lockelord.com](mailto:JFarco@lockelord.com)

PATENT OWNER:

Scott Brown  
[jcrawford@hovewilliams.com](mailto:jcrawford@hovewilliams.com)

Matthew Walters  
[mwalters@hovewilliams.com](mailto:mwalters@hovewilliams.com)