

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION, SONY ELECTRONICS INC.,  
SONY MOBILE COMMUNICATIONS AB, and  
SONY MOBILE COMMUNICATIONS (USA) INC.,  
Petitioner,

v.

MEMORY INTEGRITY, LLC,  
Patent Owner.

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Case IPR2015-00158  
Patent 7,296,121 B2

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Before JENNIFER S. BISK, NEIL T. POWELL, and  
KERRY BEGLEY, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

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A conference call in the above proceeding was held on July 21, 2015, between counsel for Patent Owner, counsel for Petitioner in this case, counsel for Petitioner in IPR2015-00159 and IPR2015-00163,<sup>1</sup> and Judges Bisk, Powell, and Begley. Patent Owner initiated the conference call to confer with us regarding filing a motion to amend in this case and in IPR2015-00159 and IPR2015-00163.

#### DISCUSSION

In the call, we explained that a motion to amend under 37 C.F.R. § 42.121 may cancel claims and/or propose substitute claims. As we further explained, a motion to amend may propose only a reasonable number of substitute claims, and there is a rebuttable presumption that only one proposed substitute claim will generally be needed to replace each challenged claim. 37 C.F.R. § 42.121(a)(3). We also noted that our rules were amended on May 19, 2015 to change the page limits for certain papers associated with a motion to amend. *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,565 (May 19, 2015).

Additionally, we noted that further 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.

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<sup>1</sup> In IPR2015-00159 and IPR2015-00163, a different set of petitioners challenge the patent that is at issue in this case.

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Patent Owner inquired whether it should 1) prepare substantively identical motions for this case and IPR2015-00159 and IPR2015-00163, or 2) prepare substantively unique motions for this case and each of the others. We advised that Patent Owner should do the latter, taking care that any amendments in proposed substitute claims in one case do not conflict with amendments in proposed substitute claims in other cases.

### 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).

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