

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HTC CORPORATION, HTC AMERICA, INC.,
SAMSUNG ELECTRONICS CO. LTD,
SAMSUNG ELECTRONICS AMERICA, INC., and
AMAZON.COM, INC.,
Petitioner,

v.

MEMORY INTEGRITY, LLC,
Patent Owner.

Cases IPR2015-00159 and IPR2015-00163
Patent 7,296,121 B2¹

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

¹ This Decision addresses issues pertaining to each of these cases. The parties are not authorized to use this style heading for any subsequent papers.

A conference call in the above proceedings was held on July 21, 2015, between counsel for Patent Owner, counsel for Petitioner in these cases, counsel for Petitioner in IPR2015-00158,² and Judges Bisk, Powell, and Begley. Patent Owner initiated the conference call to confer with us regarding filing a motion to amend in these cases and in IPR2015-00158.

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.

Patent Owner inquired whether it should 1) prepare substantively identical motions for these cases and IPR2015-00158, or 2) prepare

² In IPR2015-00158, a different set of petitioners challenge the patent that is at issue in these cases.

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substantively unique motions for each of the cases. 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.

Petitioner inquired about provisions for potentially changing due dates related to responding to any motions to amend that Patent Owner may file. We reminded the parties that they are authorized to stipulate changes to due dates 1 through 5 in our scheduling order. IPR2015-00158, Paper 8, 1; IPR2015-00159, Paper 13, 1; IPR2015-00163, Paper 19, 1. We encouraged the parties to cooperate to resolve any issues that may arise regarding due dates. Additionally, we noted that if the parties should have a due date issue they cannot resolve after collaborating, they may contact us to address the issue.

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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