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Paper 11
Entered: August 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

WEST VIEW RESEARCH, LLC,
Patent Owner.

Case IPR2016-00125 (Patent 8,290,778 B2)[1]
Case IPR2016-00156 (Patent 8,296,146 B2)

Before MICHAEL R. ZECHER, KEVIN W. CHERRY, and JASON J. CHUNG, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

[1] This Order addresses issues that are identical in both cases. We exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On July 28, 2016, a conference call was held in these proceedings between counsel for Volkswagen Group of America, Inc. ("Petitioner"), counsel for West View Research, LLC ("Patent Owner"), and Judges Easthom, Chung, Cherry, and Zecher. Patent Owner requested the call to discuss Patent Owner's plan to file a motion to amend in these proceedings.

Patent Owner informed us during the conference call that it intends to file a non-contingent Motion to Amend seeking to amend all of the challenged claims in each of these proceedings. Patent Owner noted that, because there are large number of proceedings involving U.S. Patent No. 8,290,778 B2, U.S. Patent No. 8,296,146 B2, and other related patents, as well as the extensive prosecution history for these patents, the prior art known to Patent Owner is voluminous. Patent Owner requested guidance as to what prior art it should focus on in each Motion to Amend. Although we declined to provide any specific directions, Patent Owner should focus, at a minimum, on the prior art of record in these *inter partes* review proceedings and prior art known to Patent Owner that it discerns is the most relevant to each added limitation. *See MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. 3 (PTAB July 15, 2015) (Paper 42) (precedential). We directed Patent Owner to the *MasterImage 3D* case for further details regarding the duty to disclose in the context of a motion to amend.

Patent Owner also should be aware that a non-contingent motion to amend means that its original claims will be cancelled, and we will consider only the patentability of the amended claims in our Final Written Decisions. Entry of proposed amendments is not automatic, but occurs only upon Patent Owner demonstrating the patentability of each proposed substitute claim. *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1303–05 (Fed. Cir.

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2015). To meet this requirement, Patent Owner must show that the proposed amendments are narrowing in scope, that each proposed substitute claim is supported by the written description of the application upon which the substitute claims rely, addressing the patentability of each proposed substitute claim over the prior art of record and the prior art known to Patent Owner, and accounting for the basic knowledge and skill set 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). As we advised Patent Owner, these showings must be made for each claim that Patent Owner seeks to amend. For further guidance on a motion to amend, we directed the parties to the following representative decisions: (1) *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (informative); (2) *Corning Optical Commc'n RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00441 (PTAB Oct. 20, 2014) (Paper 19); (3) *MasterImage 3D*, Case IPR2015-00040, Paper 42; (4) *Toyota Motor Corp. v. American Vehicular Sciences LLC*, Case IPR2013-00422 (PTAB Mar. 7, 2014) (Paper 25); and (5) *Riverbed Tech., Inc. v. Silver Peak Sys., Inc.*, Case IPR2013-00402 (PTAB Dec. 30, 2014) (Paper 35).

In consideration of the foregoing, it is hereby ORDERED that Patent Owner has satisfied the conference requirement of 37 C.F.R. § 42.121(a) for these proceedings.

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