

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO. LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC., and APPLE INC.,  
Petitioner,

v.

ROSETTA-WIRELESS CORPORATION,  
Patent Owner.

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Case IPR2016-00622<sup>1</sup>  
Patent 7,149,511 B1

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Before JUSTIN T. ARBES, PATRICK R. SCANLON, and  
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5(a)*

On October 10, 2017, Patent Owner sent an email to  
[Trials@uspto.gov](mailto:Trials@uspto.gov) requesting a conference call to “to seek permission, for  
good cause, to file a motion to amend the patent at issue.” A conference call  
to discuss this request was held on October 13, 2017, among respective

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<sup>1</sup> Case IPR2016-00616 has been consolidated with this proceeding.

counsel for Petitioner and Patent Owner, and Judges Arbes, Scanlon, and Hudalla. For the reasons that follow, Patent Owner's request for authorization to file a motion to amend is *denied*.

The Final Written Decision in this case was issued on August 21, 2017.<sup>2</sup> Paper 48. Despite the posture of the case, and despite the fact Patent Owner chose not to file a motion to amend during trial, Patent Owner now seeks authorization to file a motion to amend. Patent Owner contends its request is supported by good cause because the recent decision in *Aqua Products, Inc. v. Matal*, No. 2015-1177, --- F.3d ---, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017) (en banc) materially changed the law regarding motions to amend in *inter partes* reviews. According to Patent Owner, it did not previously have a "real" opportunity to amend the challenged patent during trial, whereas the holding of *Aqua Products* fundamentally changes the amendment process in a way that provides Patent Owner such an opportunity. Patent Owner further contends we have the authority to allow a motion to amend at this stage under the "good cause showing" provision in 37 C.F.R. § 42.121(c).

Petitioner contends that 35 U.S.C. § 316(d)(1) only permits motions to amend "[d]uring an inter partes review," and 37 C.F.R. § 42.121(c) does not govern motions to amend in the first instance. Petitioner further contends that the Court of Appeals for the Federal Circuit granted the petition for rehearing *en banc* in *Aqua Products* prior to institution of the instant *inter*

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<sup>2</sup> On September 19, 2017, Patent Owner filed a request for rehearing. Paper 49. Patent Owner's request does not include any arguments that are relevant to the instant Order. A decision denying Patent Owner's request is being entered concurrently with this Order.

*partes* review, so Patent Owner could have, but did not, file a motion to amend under 37 C.F.R. § 42.121(a) to preserve its rights in the event of a change in the law.

We are not persuaded that a motion to amend should be authorized under the particular factual circumstances of this case. The provision Patent Owner relies upon to support the instant request, § 42.121(c), pertains to “[a]dditional” motions to amend, not a first motion to amend. In contrast, § 42.121(a) provides for a first motion to amend that must be filed by the time that the patent owner response is filed, or a due date during trial set by the Board. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (relating § 42.121(a) to a “First Motion to Amend” and § 42.121(c) to an “Additional Motion to Amend”). In this case, Patent Owner did not file a motion to amend by the due date for doing so. *See* Paper 13, 6; Paper 26 (stipulating to a deadline of November 30, 2016). Due dates such as this are important in *inter partes* review proceedings because they “account[] for the complexity of the proceeding but ensur[e] that the trial is completed within one year of institution.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765 (Aug. 14, 2012); *see also* Paper 13 (setting deadlines for an opposition to the motion to amend to be filed by Petitioner and a reply to the opposition to be filed by Patent Owner). Accordingly, we do not agree that § 42.121(c) allows for a first motion to amend at this late juncture, regardless of whether Patent Owner shows good cause. In addition, we agree that Patent Owner did not avail itself of its opportunity to amend under § 42.121(a) during the pendency of this case.

Although Patent Owner contends that “the central point” of this case relates to the claim term “downstream data,” and that disputes regarding this

term “could be directly addressed by a claim amendment,” the importance of the term “downstream data” has been known since at least the time of Patent Owner’s Preliminary Response and the Decision on Institution. *See, e.g.*, Paper 8, 18–20; Paper 12, 11–14. This predates the time that a motion to amend would have been due under § 42.121(a). Patent Owner could have, but did not, address the disputes regarding the term “downstream data” under the normal amendment process.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request for authorization to file a motion to amend is *denied*.

Case IPR2016-00622

Patent 7,149,511 B1

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