

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioner,

v.

FOCAL IP, LLC,  
Patent Owner.

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Case: IPR2016-01257<sup>1</sup>  
Patent 8,457,113 B2

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Before SALLY C. MEDLEY, JONI Y. CHANG, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER  
Guidance on Motion to Amend Claims  
*37 C.F.R. § 42.121*

On March 16, 2017, a conference call was held with Judges Medley, Chang, and Parvis and counsel for the parties in attendance. Patent Owner requested the conference call to satisfy the requirement of

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<sup>1</sup> This Order addresses the same issues in the *inter partes* reviews listed in the Appendix. Therefore, we issue one Order to be filed in all of the cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

37 C.F.R. § 42.121(a) that it confer with the Board prior to filing of a motion to amend claims. Additionally, Patent Owner requested ten additional pages in each motion to amend or, in the alternative, authorization to address the requirement to show written description support under 37 C.F.R. § 42.121(b) in a claim listing appendix.

We provided the parties with verbal guidance regarding a motion to amend claims and, for the reasons discussed below, granted only Patent Owner's request for authorization to address the requirement to show written description support under 37 C.F.R. § 42.121(b) in a column of a claim chart in an appendix to the motion to amend. The aforementioned appendix must contain only citations and exact text of the specification showing written description in the specification for each claim limitation of each proposed substitute claim in accordance with 37 C.F.R. § 42.121(b). For the convenience of the parties, additional guidance regarding the requirements of a motion to amend also is provided below.

*Page Limits and Appendices*

The motion to amend, as well as any opposition to the motion to amend, each are limited to twenty-five (25) pages; Patent Owner's reply to an opposition to the motion to amend is limited to twelve (12) pages; and the required claim listing may be contained in an appendix to the motion to amend, and does not count toward the page limit of the motion.

See 37 C.F.R. § 42.24(a)(1)(vi), (b)(3), (c)(3); 37 C.F.R. § 42.121(b). Patent Owner requested ten additional pages or, in the alternative, authorization to address the requirement to show written description support for each proposed substitute claim under 37 C.F.R. § 42.121(b) in a claim listing appendix to the motion to amend that does not count against the page limit.

Patent Owner argued that the petitions collectively include numerous prior art of record, requiring a lengthier explanation in a motion to amend. Patent Owner suggested that either the ten additional pages or a claim listing/written description support appendix would provide sufficient relief. Petitioner opposed Patent Owner's request for additional pages, but did not oppose Patent Owner's request for the aforementioned appendix.

During the call, upon consideration of the foregoing, we authorized Patent Owner to address the requirement to show written description support for each proposed substitute claim in accordance with 37 C.F.R. § 42.121(b) in a claim listing appendix to the motion to amend that does not count toward the page limit of the motion. We cautioned that Patent Owner should not include in its appendix any argument or characterizations in support of written description. Patent Owner may reproduce only exact text of the specification alongside the corresponding citations. We deny Patent Owner's request for additional pages as no longer needed in light of our authorization of Patent Owner's alternative request for filing the appendix.

*Guidance Regarding Requirements of a Motion to Amend*

A motion to amend claims only may cancel claims or propose substitute claims. *See* 37 C.F.R. § 42.121(a)(3). A request to cancel claims will not be regarded as contingent. However, we shall treat the request to substitute claims as contingent. That means a proposed substitute claim will be considered only if the original patent claim it replaces is determined unpatentable or is canceled by Patent Owner.

A proposed substitute claim should be responsive to the ground of unpatentability applicable to the original patent claim for which it is a substitute, and may not enlarge the scope of the claim or introduce new

matter. *See* 37 C.F.R. § 42.121(a)(2). The presumption is that only one substitute claim is needed for each original patent claim. *See* 37 C.F.R. § 42.121(a)(3). This requirement is viewed on a per claim basis, and the proposed substitute claim must be traceable back to the original patent claim that it is intended to replace. Generally, the proposed substitute claim should not eliminate any feature or element of the original patent claim which it is intended to replace. If the Patent Owner proposes more than one substitute claim for a particular patent claim, the motion should articulate a special circumstance to justify the request.

A claim listing, reproducing each proposed substitute claim, is required. *See* 37 C.F.R. § 42.121(b). Any claim with a changed scope, subsequent to the amendment, should be included in the claim listing as a proposed substitute claim, and have a new claim number. This includes any dependent claim Patent Owner intends as dependent from a proposed substitute independent claim. For each proposed substitute claim, the motion must show, clearly, the changes of the proposed substitute claim with respect to the original patent claim which it is intended to replace. No particular form is required, but use of brackets to indicate deleted text and underlining to indicate inserted text is suggested.

As the moving party, Patent Owner bears the burden of proof to establish that it is entitled to the relief requested in the motion to amend. *See* 37 C.F.R. § 42.20(c). 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, 1303–08 (Fed. Cir. 2015). If the motion is granted, the proposed substitute claims will be added to the involved patent, without examination.

Accordingly, Patent Owner must show patentability, in general.

In the motion to amend, Patent Owner must show written description support in the specification for each proposed substitute claim. *See* 37 C.F.R. § 42.121(b). Importantly, citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued. Also, it is inadequate to show written description support for just the feature added by the proposed substitute claim. Instead, Patent Owner must show written description support for the entire proposed substitute claim.

If a new term is used in a proposed substitute claim, the meaning of which reasonably can be anticipated as subject to dispute, Patent Owner should provide a proposed claim construction in the motion to amend. With regard to claim construction, a mere statement that a certain term should be construed according to its plain and ordinary meaning is unhelpful. That plain and ordinary meaning should be provided in the motion, together with the supporting evidence.

Additionally, Patent Owner must show patentability over the prior art that is relevant to the substitute claims, including prior art of record and prior art known to Patent Owner, and not just over the references applied by the Petitioner against the original patent claims. Prior art of record includes any material art in the prosecution history of the patent; any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and any material art of record in any other proceeding before the Office involving the patent. *See MasterImage 3D, Inc. v. RealD, Inc.*, Case IPR2015-00040, slip op. at 2–3 (PTAB July 15, 2015) (Paper 42) (precedential). The reference to “prior art known to the patent owner” should be understood as no more than the material prior art

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