

Petitioner's Presentation

IPR2016-01600

U.S. Patent No. 7,834,605



The substitute claims are improper

- Patent Owner's substitute claims are improper under 35 U.S.C. § 316(d)(3)
 - Under proper construction of "first state," the "portion" limitation is new matter and broadens the claims
 - Under alternative construction of "first state," the "first state and second state" limitation is new matter
- Patent Owner presents an unreasonable number of substitute claims
 - PO's request to cancel claims 1 and 2 is mooted by judgment of invalidity
 - PO proposes more than one substitute claim per challenged claim, but did not explain any special circumstances

Procedural history

- Timeline
 - August 11, 2016: Petitioner challenged claims 1, 2, 5, and 9 of the '605 Patent
 - December 12, 2016: Claims 1 and 2 found invalid by Federal Circuit
 - Final judgment
 - March 12, 2017: Window for further Fed Cir or Supreme Court appeal closed
 - May 17, 2017: Patent Owner moved to amend claims 1, 2, 5, and 9
 - Substituted amended claim 13 for original claim 1
 - Claims 2, 5, and 9 replaced with claims 14-16, which depend from claim 13
- Patent Owner's motion to amend is not contingent on determination that the original claims are unpatentable
 - Paper 16, PO MTA at 1

The substitute claims are
improper under 35 U.S.C.
§ 316(d)(3)



“An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.”

35 U.S.C. § 316(d)(3)

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