

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KINGSTON TECHNOLOGY COMPANY, INC.,  
Petitioner,

v.

POLARIS INNOVATIONS LTD.,  
Patent Owner.

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IPR2016-01621 (Patent 6,438,057 B1)  
IPR2016-01622 (Patent 6,850,414 B2)  
IPR2016-01623 (Patent 7,315,454 B2)<sup>1</sup>

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Before SALLY C. MEDLEY, JEAN R. HOMERE, and  
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order addresses issues identical in all three cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers

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A conference call in the above proceedings was held on May 2, 2017, among respective counsel for the parties and Judges Medley, Homere, and Clements. Patent Owner requested the conference call to satisfy the “to confer” requirement of 37 C.F.R. § 42.121(a) with regard to the filing of a motion to amend claims. We provided the parties with verbal guidance. For the convenience of the parties, additional guidance regarding the requirements of a motion to amend is provided below.

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

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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, 1303–05 (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

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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. *Microsoft v. Proxyconn*, 789 F.3d at 1306–08 (affirming the Board’s denial of a motion to amend claims where the patent owner failed to establish the patentability of the substitute claims over the prior art of record); *see also MasterImage 3D, Inc. v. RealD, Inc.*, Case IPR2015-00040, slip op. at 1–2 (PTAB July 15, 2015) (Paper 42) (precedential) (explaining that prior art of record includes any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review, as well as material art in the prosecution of the patent).

The motion should provide sufficient underlying facts regarding any feature added by the proposed substitute claim. For instance, it should be revealed whether the feature was previously known anywhere, in whatever setting, and whether or not the feature was known in combination with any

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of the other elements in the claim. If any such combination was known, the motion should explain the surrounding facts in that regard, and why it would not have been obvious for one with ordinary skill in the art to adapt that knowledge for use with the rest of the claim elements.

Patent Owner is not expected to know everything that a hypothetical person of ordinary skill in the art is presumed to know, but Patent Owner is expected to reveal what it does know, to the extent that it is relevant. For instance, the motion to amend should include a discussion of the ordinary skill in the art, with particular focus on the feature added to provide the basis of patentable distinction. In that regard, it would not be meaningful to say that a person of ordinary skill in the art possesses certain years of education and certain years of experience. Rather, the discussion should be specific about the technical knowledge pertaining to the feature added. Testimony filed with the motion also can explain the level of ordinary skill in the art and distinguish the substitute claims over the known art. Conclusory statements to the effect that no prior art known to Patent Owner renders obvious the proposed substitute claims, or that the closest prior art is the references in the record, are not meaningful. In addition, the motion to amend may not incorporate by reference arguments made in Patent Owner's response to the petition. *See* 37 C.F.R. § 42.6(a)(3).

We remind the parties that 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

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