

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00315 (Patent 8,929,965 B2)
Case IPR2017-00317 (Patent 8,989,830 B2)
Case IPR2017-00318 (Patent 8,886,269 B2)
Case IPR2017-00319 (Patent 8,923,941 B2)
Case IPR2017-00321 (Patent 8,923,941 B2)¹

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

AMENDED SCHEDULING ORDER

¹ This order is to be filed in each case. The parties are not authorized to use this style heading in any subsequent papers.

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INTRODUCTION

On August 28, 2017, as requested by Patent Owner, we conducted a teleconference concerning the requirements associated with filing a Motion to Amend. Ex. 1068, Transcript of Motion to Amend Conference (“Conf. Tr.”) 5². At the beginning of the teleconference, we reminded the parties that a decision from the Court of Appeals for the Federal Circuit in *Aqua Products v. Matal*, at that time being considered *en banc*, was pending and that should such a decision supersede our guidance, the parties should read the *Aqua Products* decision and follow the appropriate guidance from the Federal Circuit concerning motions to amend. Conf. Tr., 5–6. As discussed below, on October 4, 2017, the Federal Circuit issued a decision in *Aqua Products v. Matal*, 872 F.3d 1290 (Fed. Cir 2017), and circumstances have changed.

In our August 28, 2017 teleconference, we advised the parties that a Motion to Amend must present substitute claims amended to respond to a ground of unpatentability involved in the trial and is not an opportunity to amend the claims in some other way that does not relate to the issues pending before the panel (Conf. Tr., 7); that the amendment cannot seek to enlarge the scope of the claims or introduce any new subject matter, but can only narrow the scope of the claims (*id.* at 8); and that the duty of candor and good faith is applicable (*id.* at 8–9). Consistent with Guidance recently issued by the Chief Judge, we note now that the statutory and regulatory

² References to Paper Numbers in this Revised Scheduling Order are to papers in IPR2017-00315.

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requirements for a motion to amend under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, as well as the duty of candor under 37 C.F.R. § 42.11, remain applicable. *See* “Guidance on Motions to Amend in view of *Aqua Products*” (https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf) (Nov. 21, 2017).

During our August 28, 2017 teleconference, we also advised the parties that because a Motion to Amend is a motion, the burden of proof is on the movant, i.e., the Patent Owner, to show some kind of patentable distinction over the prior art of record and not on the Petitioner to show unpatentability. *Id.* at 6, 8. Patent Owner filed its Motion to Amend on September 25, 2017. Paper 23.

The Federal Circuit’s *Aqua Products* decision now instructs us to “assess[] the patentability of the proposed substitute claims without placing the burden of persuasion on the patent owner.” *Aqua Products*, 872 F.3d at 1328; *see also* “Guidance on Motions to Amend in view of *Aqua Products*” (“In light of the *Aqua Products* decision, the Board will not place the burden of persuasion on a patent owner with respect to the patentability of substitute claims presented in a motion to amend.”).

In view of this directive from our reviewing court, we conducted a teleconference with the parties on October 13, 2017 to discuss modifying the present Revised Scheduling Order³ to accommodate briefing that addresses how the Federal Circuit’s decision applies to the present proceedings.

³ On August 30, 2019, prior to the *Aqua Products* decision, the parties stipulated to a Revised Scheduling Order. Paper 19.

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During the conference, we advised the parties that our objective is to accommodate appropriate briefing of the relevant issues in due course by both parties without disrupting the on-going trial. On October 23, 2017, the parties contacted the Board by e-mail, having agreed upon dates proposed during the conference on October 13, 2017. To that end, we enter this amended Scheduling Order in IPR2017-00315 and co-pending cases IPR2017-00317, IPR2017-00318, IPR2017-00319, and IPR2017-00321.

A. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. The parties may stipulate to different dates for DUE DATES 2 through 5 (earlier or later, but no later than DUE DATE 7). A notice of the stipulation, specifically identifying the changed due dates, must be filed promptly. The parties may not stipulate to an extension of DUE DATES 6 and 7.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony (*see* section B, below).

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D), apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony

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Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

1. DUE DATE 2

Petitioner must file any Reply to Patent Owner's Response and Opposition to a Motion to Amend by DUE DATE 2.

2. DUE DATE 3

Patent Owner must file any Reply to Petitioner's Opposition to Patent Owner's Motion to Amend by DUE DATE 3.

3. DUE DATE 4

Petitioner must file any Sur-reply to Patent Owner's Reply to Petitioner's Opposition to a Motion to Amend

4. DUE DATE 5

a. Each party must file any motion for an observation on the cross-examination testimony of a reply or sur-reply witness (*see* section C, below) by DUE DATE 5.

b. Each party must file any motion to exclude evidence (37 C.F.R § 42.64(c)) and any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 5.

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