

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION and CAVIUM, INC.,  
Petitioner,

v.

ALACRITECH, INC.,  
Patent Owner.

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Cases IPR2017-01391 (Patent 7,237,036 B2)  
IPR2017-01392 (Patent 7,337,241 B2)  
IPR2017-01393 (Patent 9,055,104 B2)  
IPR2017-01405 (Patent 7,124,205 B2)  
IPR2017-01406 (Patent 7,673,072 B2)  
IPR2017-01409 (Patent 8,131,880 B2)  
IPR2017-01410 (Patent 8,131,880 B2)<sup>1</sup>

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Before STEPHEN C. SIU, DANIEL N. FISHMAN, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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<sup>1</sup> Cavium, Inc., which filed petitions in Cases IPR2017-01707, IPR2017-01714, IPR2017-01718, IPR2017-01728, IPR2017-01735, IPR2017-01736, and IPR2017-01737, has been joined as a petitioner in these proceedings. This Order applies to each referenced case. The parties are not authorized to use this heading style.

IPR2017-01391 (Patent 7,237,036 B2)  
IPR2017-01392 (Patent 7,337,241 B2)  
IPR2017-01393 (Patent 9,055,104 B2)  
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IPR2017-01410 (Patent 8,131,880 B2)

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

By email message dated January 23, 2018, Patent Owner, Alacritech, Inc., requested the Board's permission to file contingent motions to amend pursuant to 37 C.F.R. § 42.121 in each of the above-captioned cases and proposed a briefing schedule therefor. Patent Owner represented in its email message that it conferred with Petitioner, Intel Corporation and Cavium, Inc., and that, although Petitioner intends to oppose the motions to amend, Petitioner does not oppose Patent Owner's proposed briefing schedule. Patent Owner also represented that the parties have agreed to different due dates for Patent Owner's Response to the Petition and for Petitioner's Reply to Patent Owner's Response than those set forth in the Scheduling Order entered in each case, as expressly permitted in each Scheduling Order (*see, e.g.*, IPR2017-01391, Paper 9, 2 (PTAB Nov. 28, 2017)).

In view of the parties' agreement as to the briefing schedule for Patent Owner's motions to amend and as to the due dates for Patent Owner's Response and Petitioner's Reply, we grant Patent Owner's request. In particular:

Patent Owner is authorized to file a Motion To Amend, not to exceed 12 pages, in each case, by January 29, 2018;

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IPR2017-01406 (Patent 7,673,072 B2)  
IPR2017-01409 (Patent 8,131,880 B2)  
IPR2017-01410 (Patent 8,131,880 B2)

Petitioner is authorized to file an Opposition to Patent Owner's Motion To Amend, not to exceed 25 pages, in each case, by April 4, 2018;

Patent Owner is authorized to file a Reply to Petitioner's Opposition to Patent Owner's Motion To Amend, not to exceed 25 pages, in each case, by May 18, 2018; and

Petitioner is authorized to file a Sur-reply to Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion To Amend, not to exceed 12 pages, in each case, by June 1, 2018.

Further, the due date for Patent Owner's Response to the Petition, currently set for February 5, 2018, is changed to February 14, 2018; and the due date for Petitioner's Reply to Patent Owner's Response to the Petition, currently set for April 18, 2018, is changed to April 27, 2018. All other due dates set forth in the respective Scheduling Orders remain unchanged.

We additionally provide the following guidance with respect to the proposed motions to amend in accordance with 37 C.F.R. § 42.121. First, Patent Owner is reminded that each Motion To Amend must be responsive to a ground of unpatentability on which trial was instituted in the respective case and may not seek to enlarge the scope of the claims of the respective patent or introduce new subject matter. *Id.* § 42.121(a)(2). Further, a motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims, where a "reasonable" number is presumed to be only one substitute claim per challenged claim. *Id.* § 42.121(a)(3). This presumption may be rebutted upon demonstration of a need to present more

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than one substitute claim per challenged claim. *Id.* Each Motion To Amend also must include a claim listing, which may be included as an appendix to the Motion,<sup>2</sup> that shows clearly the changes made to the claim or claims for which substitute claims are presented and that sets forth the support in the original disclosure (or in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought) for each substitute claim. *Id.* § 42.121(b). We further direct the parties to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766–67 (Aug. 14, 2012) and the Office’s Memorandum Re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 17, 2017) (available at [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf)) (discussing *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)) for additional guidance. Pursuant to the guidance set forth in the latter Memorandum, the Board will not place the burden of persuasion on Patent Owner with respect to the patentability of substitute claims presented in a Motion To Amend, but rather will determine whether substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any Opposition made by Petitioner.

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<sup>2</sup> Such appendix shall not count against the page limit for the Motion To Amend.

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IPR2017-01409 (Patent 8,131,880 B2)  
IPR2017-01410 (Patent 8,131,880 B2)

## ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied the requirement of conferring with the Board prior to filing a Motion To Amend under 37 C.F.R. § 42.121(a) in each of the above-captioned cases;

FURTHER ORDERED that Patent Owner is authorized to file a Motion To Amend in each case, not to exceed 12 pages, by January 29, 2018;

FURTHER ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's Motion To Amend in each case, limited to 25 pages in length, by April 4, 2018;

FURTHER ORDERED that Patent Owner is authorized to file a Reply to Petitioner's Opposition to Patent Owner's Motion To Amend in each case, limited to 25 pages in length, by May 18, 2018;

FURTHER ORDERED that Petitioner is authorized to file a Sur-reply to Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion To Amend in each case, limited to 12 pages in length, by June 1, 2018;

FURTHER ORDERED that Patent Owner's due date for filing its Response to the Petition, currently set for February 5, 2018, is changed to February 14, 2018;

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