

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01427
Case IPR2017-01428
Patent 8,995,433 B2

Before MIRIAM L. QUINN, KERRY BEGLEY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Conference Regarding Motion to Amend

37 C.F.R. § 42.121

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Patent Owner requested a conference call to satisfy the requirement of 37 C.F.R. § 42.121(a) for a conference with the Board before filing a motion to amend claims. During a conference call with the parties on February 22, 2018, the panel provided guidance consistent with this Order.

I. Motion to Amend

Congress provided an opportunity for a patent owner to file a motion to amend claims in an *inter partes* review. For example, 35 U.S.C. § 316(d), as amended by the Leahy-Smith America Invents Act (Pub. L. 112-29, 125 Stat. 284 (2011)) (“AIA”), states:

(d) Amendment of the Patent. –

(1) IN GENERAL. – During an *inter partes* review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

- (A) Cancel any challenged patent claim.
- (B) For **each** challenged claim, propose a reasonable number of substitute claims.

* * * *

(3) SCOPE OF CLAIMS. – An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(emphasis added).

Congress also gave the Director authority to set forth “standards and procedures” for moving to amend to cancel a challenged claim or propose a reasonable number of substitute claims. 35 U.S.C. § 316(a)(9). The resulting regulation for filing motions to amend claims in an *inter partes* review is 37 C.F.R. § 42.121.

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II. Regulatory Requirements for Motion to Amend

Subsection (a) of 37 C.F.R. § 42.121 reiterates that a patent owner may file “one motion to amend” and adds that such filing may occur “only after conferring with the Board.” Rule 121 describes further the scope and content of the motion. Each is discussed below.

In addition, subsection (a)(2) of 37 C.F.R. § 42.121 states:

(2) *Scope*. A motion to amend may be denied where:

- (i) The amendment does not respond to a ground of unpatentability involved in the trial; or
- (ii) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

An *inter partes* review is a focused proceeding, unlike *ex parte* patent prosecution or patent reexamination. For instance, a final determination must be issued not later than one year after the date on which the Director notices the institution of review, except that the Director, for good cause, may extend the period by not more than six months. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). All portions of Part 42, Title 37, Code of Federal Regulations, are construed to secure the just, speedy, and inexpensive resolution of every proceeding, 37 C.F.R. § 42.1(b), including determining what constitutes a substitute claim for a challenged claim, what is deemed responsive to an alleged ground of unpatentability, and whether an amendment seeks to enlarge the scope of claims.

A. Reasonable Number of Substitute Claims

The statute provides that, in a motion to amend, Patent Owner may cancel challenged claims and that for each challenged claim, Patent Owner

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may only propose a reasonable number of substitute claims. *See* 35 U.S.C. § 316(d)(1)(B). Subsection (a)(3) of 37 C.F.R. § 42.121 reiterates this statutory provision, and then provides: “The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.” Therefore, to the extent Patent Owner seeks to propose more than one substitute claim for each cancelled claim, Patent Owner shall explain in the motion to amend the need for the additional claims and why the number of proposed amended claims is reasonable. *See* 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3) (“A reasonable number of substitute claims. A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims. The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.”).

B. Contingent Motion to Amend

A motion to amend claims may cancel claims or propose substitute claims. *See* 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3). A request to cancel claims will not be regarded as contingent. However, we shall treat a 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.

C. Responds to a Ground of Unpatentability Involved in the Trial

We note that 37 C.F.R. § 42.121(a)(2)(i) states that “[a] motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” There is no specific format

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for complying with this rule. In considering the motion, we will consider the entirety of the record to determine whether Patent Owner's amendments respond to at least one ground of unpatentability involved in this trial, in compliance with 37 C.F.R. § 42.121(a)(2)(i).

Generally, a motion to amend is not an opportunity to amend the claims in some other way, wholly unrelated to addressing unpatentability of the challenged claims. The broad language of 37 C.F.R. § 42.121(a)(2)(i), however, does not preclude proposed amendments that address potential 35 U.S.C. § 101 or § 112 issues. Specifically, if a patent owner proposes amendments addressing the prior art in the trial, other proposed amendments may address potential § 101 or § 112 issues. Allowing an amendment in a motion to amend under 37 C.F.R. § 42.121 to address potential 35 U.S.C. § 101 or § 112 issues, when a given claim is being amended already in view of a 35 U.S.C. § 102 or § 103 ground, serves the public interest by ensuring issuance of valid and clear patents. *See* Final Written Decision, *Veeam Software Corp. v. Veritas Techs., LLC*, Case IPR2014-00090, slip op. at 26–29 (PTAB July 17, 2017) (Paper 48).

D. Scope of the Claims

The motion to amend must not present substitute claims that enlarge the scope of the pending claims or introduce new subject matter. 35 U.S.C. § 316(d); 37 C.F.R. § 41.121(a)(2)(ii). Thus, the Board requires that the motion to amend set forth written description support of the subject patent for the substitute claims, and if priority is sought to the filing date of an earlier filed application, must set forth the written description support for the substitute claims in the earlier filed application. *See* 37 C.F.R. § 42.121(b).

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