

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WESTERN DIGITAL CORPORATION,  
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,  
Patent Owner.

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Cases IPR2018-00082 (Patent 6,088,802)  
IPR2018-00084 (Patent 6,003,135)<sup>1</sup>

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Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

ORDER

*Information and Guidance on Motions to Amend*  
37 C.F.R. § 42.5

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<sup>1</sup> This Order applies to each referenced case. The parties are not authorized to use this heading style.

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IPR2018-00084 (Patent 6,003,135)

This Order provides information and guidance on motions to amend to Patent Owner in the event Patent Owner elects to file a motion to amend.

This information is being provided as general guidance only, and should not be interpreted as a suggestion or request to file a motion to amend. If Patent Owner chooses to file a motion to amend, Patent Owner still must confer with the Board regarding a motion to amend. 37 C.F.R. § 42.121(a). Unless the parties stipulate otherwise, a motion to amend must be filed by DUE DATE 1 set forth in the Scheduling Order.

As provided by Congress, patent owners are entitled to file a motion to amend in *inter partes* reviews. Specifically, 35 U.S.C. § 316(d) 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.

Congress also authorized the Director to set forth “standards and procedures” for allowing a patent owner to move to amend, to cancel a challenged claim, or propose a reasonable number of substitute claims. 35 U.S.C. § 316(a)(9). A regulation directed to filing motions to amend claims in an *inter partes* review is 37 C.F.R. § 42.121.

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### 1. *Contingent Motions to Amend*

A motion to amend claims may cancel claims and/or propose substitute claims. 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 ordinarily treat a request to substitute claims as contingent. That means a proposed substitute claim normally will be considered only if a preponderance of the evidence establishes that the original patent claim it replaces is unpatentable. A patent owner should adopt a claim-by-claim approach to specifying the contingency of substitution, e.g., which claim for which claim and in what circumstance.

### 2. *Burden of Persuasion*

In October 2017, the U.S. Court of Appeals for the Federal Circuit issued an *en banc* decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (“*Aqua Products*”), addressing the burden of persuasion that the Board applies when considering the patentability of substitute claims presented in a motion to amend. In November 2017, the Board issued a memorandum providing further guidance on motions to amend in view of that decision. See Memorandum “Guidance on Motions to Amend in view of *Aqua Products*” (Nov. 21, 2017) ([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)) (“Board’s Memorandum”). Subsequent to the issuance of *Aqua Products* and the Board’s Memorandum, the Federal Circuit issued a decision in *Bosch Automotive Service Solutions, LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017) (“*Bosch*”), as well as a follow-up Order amending that decision on

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rehearing. *See Bosch Auto. Serv. Sols., LLC v. Iancu*, Order on Petition for Panel Rehearing, No. 2015-1928 (Fed. Cir. Mar. 15, 2018).

In accordance with *Aqua Products*, the Board's Memorandum, and *Bosch*, a patent owner does not bear the burden of persuasion to demonstrate the patentability of substitute claims presented in a motion to amend. Rather, as a result of the current state of the law and USPTO rules and guidance, the burden of persuasion will ordinarily lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence. The Board itself also may justify any finding of unpatentability by reference to evidence of record in the proceeding, as it must do when a petitioner ceases to participate, as further noted in *Aqua Products* and *Bosch*. *Bosch*, 878 F.3d at 1040 (citing *Aqua Products*, 872 F.3d at 1311 (O'Malley, J.)). Thus, the Board determines whether substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner.

Before considering the patentability of any substitute claims, however, the Board first must determine whether the motion to amend meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. Those requirements and other guidance are discussed below.

### 3. *Reasonable Number of Substitute Claims*

By statute, in a motion to amend, a patent owner may cancel challenged claims or propose a reasonable number of substitute claims for each challenged claim. 35 U.S.C. § 316(d)(1)(B). There is a rebuttable presumption that a reasonable number of substitute claims per challenged

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claim is one (1) substitute claim. 37 C.F.R. § 42.121(a)(3). A patent owner may rebut this presumption upon demonstration of a need to present more than one substitute claim per challenged claim. *Id.* (“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.”). Thus, to the extent a patent owner seeks to propose more than one substitute claim for each cancelled claim, the patent owner should explain in the motion to amend the need for the additional claims and why the number of proposed substitute claims is reasonable.

The determination of whether the number of proposed substitute claims is reasonable is made on a claim-by-claim basis, consistent with the statutory language that refers to a reasonable number of substitute claims for “each” challenged claim. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). To help the Board determine whether a motion to amend meets the requirement, the motion should, for each proposed substitute claim, specifically identify the challenged claim that it is intended to replace. All proposed claims should be traceable to an original challenged claim as a proposed substitute claim for that challenged claim.

#### *4. Respond to a Ground of Unpatentability Involved in the Trial*

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.” Thus, in considering the motion, we review the entirety of the record to determine whether a patent owner’s amendments respond to a ground of unpatentability involved in the trial.

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