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Paper No. 17
Entered: January 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

IPR2018-00809 (Patent 9,530,137 B2)
IPR2018-00810 (Patent 9,100,826 B2)
IPR2018-00813 (Patent 9,100,826 B2)[1]

Before PATRICK R. SCANLON, GEORGIANNA W. BRADEN, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

[1] This Decision addresses issues pertaining to multiple proceedings. The Parties are not authorized to use this style heading for any subsequent papers.

Patent Owner, Universal Secure Registry, LLC, requested a conference to discuss a request for modified briefing page limits for Patent Owner's expected motion to amend. The panel conducted a conference with counsel for the parties on January 7, 2019.

Patent Owner proposes swapping the page limits for its opening brief and reply brief, such that Patent Owner would file a 12-page opening brief and then file a 25-page reply brief following Petitioner's 25-page opposition brief. Patent Owner argues that *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc) held that patent owners do not bear a burden to show patentability, beyond the requirements of 35 U.S.C. § 316(d), therefore providing a reason to depart from our prior practice as defined by 37 C.F.R. § 42.24. Patent Owner argues further that our scheduling order in this case provides for a surreply by Petitioner, indicating that we are willing to depart from the default rules.

Petitioner, Apple Inc., opposes Patent Owner's request on the basis that Patent Owner insufficiently justifies a departure from the page limits set in 37 C.F.R. § 42.24. Petitioner submits that reducing the length of Patent Owner's opening brief will increase the likelihood that Patent Owner will fall short of the requirements for a motion to amend and then improperly seek to recover any shortcoming in Patent Owner's reply brief.

With its proposed page limits, Patent Owner assumes the risk that it will not have sufficient space to make the preliminary showing required in a motion to amend. *Cf.* 35 U.S.C. § 316(d)(3); 37 C.F.R. §§ 42.121(a)(2), (b). In light of Patent Owner's willingness to assume that risk and the total page limit remaining unchanged under Patent Owner's proposal, we conclude that

the proposal is a reasonable approach to the burden allocation prescribed by *Aqua Products*. Accordingly, we grant Patent Owner's request.

Counsel for each party indicated familiarity with motions to amend. Additional guidance may be found in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766–48,767 (Aug. 14, 2012), the Office Patent Trial Practice Guide, August 2018 Update (available at https://go.usa.gov/xPCKP), our guidance memorandum on motions to amend, titled "Guidance on Motions to Amend in view of *Aqua Products*," dated Nov. 21, 2017 (available at https://go.usa.gov/xET3C), and the guidance on motions to amend as set forth in *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018-00082, -00084 (PTAB Apr. 25, 2018) (Paper 13) (available at https://go.usa.gov/xET32).

A motion to amend claims may cancel claims and/or propose a reasonable number of 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 treated as contingent, but a request to substitute claims will be treated as contingent, which means a proposed substitute claim will only be considered if the original patent claim it is meant to replace is deemed unpatentable. Proposed substitute claim amendments that result in no more than one substituted claim for each challenged claim are a presumptively reasonable number of substitute claims. 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 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.").

We reminded Patent Owner that any proposed amendments may not enlarge the scope of the claims of the patent or introduce new matter. *See* 35 U.S.C. § 316(d)(3), 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner must show written-description support in the original specification for each proposed substitute claim. *See* 37 C.F.R. § 42.121(b); *see MLB Advanced Media, L.P. v. Front Row Techs., LLC*, Case IPR2017-01127, slip op. at 2–4 (PTAB Jan. 16, 2018) (Paper 24). Citations should be made to the original disclosure of the as-filed application, rather than to the patent as issued. Patent Owner must show written-description support for the entire proposed substitute claim and not just the features added by amendment. This applies equally to independent and dependent claims, even if the only amendment to the dependent claims is in the identification of the claim from which it depends.

Our rules require a claim listing that reproduces each proposed substitute claim. *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 should 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 clearly show the changes of the proposed substitute claim with respect to the original patent claim that 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. The required claim list may be contained in an appendix, which does not count toward the page limit for the motion. *See* 37 C.F.R. §§ 42.24(a)(1).

We further reminded the parties that "a motion to amend may be denied where . . . [t]he amendment does not respond to a ground of

unpatentability involved in the trial." 37 C.F.R. § 42.121(a)(2)(i). In considering the motion, we will consider the entirety of the record to determine whether Patent Owner's amendments respond to the grounds of unpatentability involved in this trial.

ORDER

In consideration of the foregoing, it is:

ORDERED that the following page limits apply: Patent Owner's Motion to Amend, 12 pages; Petitioner's Opposition to Patent Owner's Motion to Amend, 25 pages; Patent Owner's Reply to Petitioner's Opposition, 25 pages; Petitioner's Surreply to Patent Owner's Reply, 12 pages.

FURTHER ORDERED that Patent Owner has satisfied the requirement of conferring with us prior to filing a motion to amend under 37 C.F.R. § 42.121(a).

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