

UNITED STATES PATENT AND TRADEMARK OFFICE  
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BEFORE THE PATENT TRIAL AND APPEAL BOARD  
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UNIFIED PATENTS INC.,  
Petitioner

v.

BRADIUM TECHNOLOGIES LLC  
Patent Owner  
\_\_\_\_\_

Case IPR2018-00952  
Patent 9,253,239 B2  
\_\_\_\_\_

Before BRYAN F. MOORE, BRIAN J. McNAMARA, and  
MINN CHUNG, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

SUMMARY OF CONFERENCE CONCERNING PROPOSED MOTION TO AMEND  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5

In response to a request by Bradium Technologies LLC (“Patent Owner”), on March 6, 2019 we conducted a conference concerning Patent Owner’s option of filing a motion to amend U.S. Patent No. 9,253,239 B2, which is the subject of this proceeding. Michael Shanahan participated in the conference on behalf of Patent Owner, and David Cavanaugh participated in the conference on behalf of United Patents Inc. (“Petitioner”). Judges McNamara, Moore, and Chung also participated. During the conference, the following matters were discussed.

A motion to amend the patent in an *inter partes* review is not itself an amendment. Unlike an amendment in patent prosecution, amendments proposed by a motion to amend are not entered as a matter of right. In an *inter partes* review a patent owner may cancel a challenged claim or propose a reasonable number of substitute claims. 35 U.S.C. § 316(d), 37 C.F.R. § 42.121(a)(3). There is no provision for amending an existing claim.

There is a rebuttable presumption that only one substitute claim is needed to replace each challenged claim. 37 C.F.R. § 42.121(a)(3). Absent special circumstances, a challenged claim can be replaced by only one claim, and a motion to amend should identify specifically, for each proposed substitute claim, the challenged claim that it is intended to replace. *See, ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013). A proposed claim should be traceable to an original, challenged claim as a proposed substitute claim for the challenged claim.

A desire to obtain a new set of claims having a hierarchy of different scope typically would not constitute sufficient special circumstances because an *inter partes* review is an adjudicatory proceeding, rather than an examination. *See, Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013). Replacing a claim with a substitute claim does not change claims depending from the claim that

is the subject of the substitution. For example, if the movant proposes a substitute for claim 1, those claims which depend from claim 1 continue to depend from claim 1 as originally written. They do not incorporate the language of the substitute claim. If Patent Owner desires to remodel its claim structure according to a different strategy, it may consider pursuing another type of proceeding before the Office.

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. 37 C.F.R. § 42.121(a)(2). Thus, a substitute claim cannot be broader than the broadest original patent claim and cannot remove a limitation from its corresponding original claim. Such a claim would not be responsive to the grounds of alleged unpatentability. These conditions are evaluated for each substitute claim traceable to a challenged claim that the substitute claim is intended to replace. A proper substitute claim under 37 C.F.R. § 42.121(a)(2) must only narrow the scope of the challenged claim it replaces and may not enlarge the scope of the challenged claim by eliminating any feature or limitation. A proposed substitute claim is not responsive to an alleged ground of patentability if it does not either include or narrow each feature or limitation of the challenged claim being replaced

Although we do not place the burden of persuasion on the Patent Owner, in evaluating the patentability of proposed substitute claims we consider the entire IPR record. *Aqua Products v. Matal*, 872 F.3d. 1290, 1326–27 (Fed. Cir. 2017). *See also, Western Digital Corp. v. SPEX Technologies, Inc.*, Case IPR2018-00082, slip op. at 4 (PTAB Apr. 25, 2018) (Paper 13) (Informative). To that end, Patent Owner should identify specifically the feature(s) or limitation(s) added to each

substitute claim, as compared to the challenged claim it replaces, and discuss technical facts and reasoning about those feature(s) or limitation(s), including the construction of new claim terms.

The prior art of record refers to (a) any material prior art in the prosecution history of the patent, (b) any material prior art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and (c) any material art of record in any other proceeding before the Office involving the patent. *MasterImage 3D, Inc. and MasterImage 3D Asia LLC, v. RealD Inc.*, Case IPR2015-00040, slip op. at 2 (PTAB July 15, 2015). The “prior art known to the patent owner” is no more than the material prior art that the Patent Owner makes of record in the current proceeding pursuant to its duty of candor and good faith to the Office under 37 C.F.R. § 42.11, in light of the Motion to Amend. *Id.* at 3.

Our current practice is to consider a proposed substitute claim after the corresponding patent claim is determined unpatentable. Thus, Patent Owner’s addition of a limitation to render the claim as a whole patentable places the initial focus on the added limitation. When considering the duty of candor and good faith under 37 C.F.R. § 42.11, Patent Owner should recognize that information about the added limitation can be material even if the information does not include all of the rest of the claim limitations. *Id.* (citing *VMWare, Inc. v. Clouding Corp.*, Case IPR2014-01292, slip op. at 2 (PTAB Apr. 7, 2015) (Paper 23), concerning a Patent Owner’s duty to disclose not just the closest primary reference, but also the closest secondary references the teachings of which sufficiently complement those of the closest primary reference to be material).

Arguments supporting patentable distinction may rely on the declaration testimony of a technical expert about the level of ordinary skill in the art and about

the significance and usefulness of feature(s) or limitation(s) added by the proposed claim.

A mere conclusory statement by counsel in the motion to amend that one or more added features or limitations are not described in any prior art or would not have been suggested or rendered obvious by the prior art is facially inadequate. *Id.* It also is insufficient for the movant simply to explain why the proposed substitute claims are patentable in consideration of the challenges on which the Board instituted review. Limiting the discussion either to the references already in the proceeding, or to the narrow combination specifically recited in the claim, does not provide a meaningful analysis. *See, Corning Gilbert, Inc. v. PPC Broadband, Inc.*, IPR2013-00347, Paper No. 20 (January 2, 2014).

In explaining why it believes the claimed subject matter is patentable, the movant must address issues of nonobviousness, meaningfully. Although the choice of how to approach the discussion of patentability of the substitute claims is one for the movant, a narrative form may be useful. The movant should discuss the level of ordinary skill in the art, explaining the basic knowledge and skill set already possessed by one of ordinary skill in the art, especially with respect to the particular feature(s) or limitation(s) that the movant has added to the original patent claims. The movant should identify in what context the added feature or limitation, or something close to it, was already known, albeit not in the specific combination recited in the claims at issue. *Id.*

A motion to amend must include a claim listing, which claim listing may be contained in an Appendix to the motion. 37 C.F.R. §42.121(b). A motion to amend claims must clearly identify the written description support for the proposed substitute claims. The written description test is whether the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the

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