

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

BLACKBERRY LIMITED,
Patent Owner.

Case IPR2019-00714 (Patent 8,825,084 B2)
Case IPR2019-00715 (Patent 8,326,327 B2)

Before MICHAEL R. ZECHER, MIRIAL L. QUINN, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.¹

QUINN, *Administrative Patent Judge*.

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

¹ Administrative Patent Judges Quinn, Zecher, and Weinschenk are paneled on IPR2019-00714, whereas Administrative Patent Judges Aaron W. Moore, Zecher, and Quinn are paneled on IPR2019-00715.

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I. DISCUSSION

A conference call in this proceeding was held on November 13, 2019, among respective counsel for Petitioner, Patent Owner, and Judges Zecher, Quinn, and Weinschenk. The call was requested by Patent Owner, Blackberry Limited (“Blackberry”), to satisfy the requirement of 37 C.F.R. § 42.121(a) to confer with us before filing a motion to amend.

Patent Owner’s counsel indicated familiarity with the Board’s procedures, the requirements for the Motion to Amend under the New Pilot Program, and the various options under the Pilot. Neither party had any questions.

To memorialize the guidance that we give parties under these circumstances, the parties are directed to *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); the Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) (*available at* https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129 Paper 15, and IPR2018-01130, Paper 14 (PTAB Feb. 25, 2019) (discussing Information and Guidance on Motions to Amend) (precedential); and *Amazon.com Inc. v. Uniloc Luxembourg, S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019) (clarifying that a ground based on 35 U.S.C. § 101 can be raised against proposed substitute claims) (precedential). Additional information concerning motions to amend under the pilot program is provided in the Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497

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(Mar. 15, 2019) (“MTA Pilot Program Notice”). We also provide the following guidance.

A. Requirements of a Motion to Amend

Pursuant to 37 C.F.R. § 42.121(a)(2)(i), “[a] motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” The motion to amend also may be denied if “[t]he 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)(ii).

A claim listing, reproducing each proposed substitute claim, is required. 37 C.F.R. § 42.121(b). The claim listing may be filed as an appendix to the motion to amend, and shall not count toward the page limit for the motion. *See* 37 C.F.R. §§ 42.24(a)(1), 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 have a new claim number. This includes any dependent claim that Blackberry proposes as dependent from a proposed substitute independent claim. For each proposed substitute claim, the motion should identify specifically the original claim that it is intended to replace and show clearly the changes of the proposed substitute claim with respect to the original claim.

Blackberry may only propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B). To the extent Blackberry seeks to propose more than one substitute claim for an original claim, Blackberry shall explain in the motion to amend the need for the additional claims and why the number of proposed substitute claims is reasonable. *See* 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3).

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Finally, Blackberry must show sufficient written description support in the original specification for each proposed substitute claim. 37 C.F.R. § 42.121(b)(1). Citation should be made to the original disclosure of the application, as filed, rather than to the patent, as issued. Also, Blackberry must show sufficient written description support for the entire proposed substitute claim and not just the features added by the amendment. This applies equally to independent claims and dependent claims, even if the only amendment to the dependent claims is in the identification of the claim from which it depends. Also, the motion to amend itself, not the claim listing, must set forth the written description support.

B. Pilot Program Considerations

The guidance in this section is taken from the MTA Pilot Program Notice.

1. Requirement for a Request for Preliminary Guidance

If Blackberry wishes to receive preliminary guidance from us on the initial motion to amend, it must include an *explicit request* for such preliminary guidance in its motion to amend filed on DUE DATE 1. We will not issue preliminary guidance unless a request is included in Blackberry's initial motion to amend.

2. Board's Preliminary Guidance

Generally, we will provide preliminary, nonbinding guidance on Blackberry's initial motion to amend approximately four weeks after the due date for the opposition to the motion to amend. Our preliminary guidance will focus on the limitations added in Blackberry's initial motion to amend and will not address the patentability of the originally challenged claims. The preliminary guidance will provide an initial discussion about whether

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there is a reasonable likelihood that the motion to amend meets statutory and regulatory requirements for a motion to amend. The preliminary guidance also will provide an initial discussion about whether Petitioner (or the record then before the Office, including any opposition to the MTA and accompanying evidence) establishes a reasonable likelihood that the newly proposed substitute claims are unpatentable.

3. Blackberry's Options Under Pilot Program

Under the pilot program, after receiving the opposition to the motion to amend and/or our preliminary guidance (if requested), Blackberry has four options.

Under the first option, Blackberry may file a reply to the opposition to MTA and/or the preliminary guidance (if requested). This reply is due by DUE DATE 3. The reply may include new evidence, including declarations. Under this first option, the current Scheduling Order will remain in effect. Thus, Petitioner may file a sur-reply in response to Blackberry's Reply. This sur-reply is due by DUE DATE 5. Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. Trial Practice Guide August 2018 Update, 15 (*available at* https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf). A petitioner's sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. *Id.* at 14. A petitioner's sur-reply should only respond to arguments made in a reply, comment on reply declaration testimony, or point to cross-examination testimony. *Id.*

Under the second option, Blackberry may file a revised motion to amend. This revised motion is due by DUE DATE 3. The revised motion to

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