

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL SHADE CORPORATION,
Petitioner,

v.

WITH-U E-COMMERCE (SHANGHAI) CO., LTD.,
Patent Owner.

IPR2023-00580
Patent 10,669,738 B2

Before PATRICK R. SCANLON, BARRY L. GROSSMAN, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

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

I. INTRODUCTION

At the request of Patent Owner, on October 25, 2023, a conference call was conducted among respective counsel for the parties, and Judges Scanlon, Grossman, and Hoskins. The purpose of the call was to allow Patent Owner to satisfy the requirement under 37 C.F.R. § 42.121(a) to confer with the Board prior to filing a motion to amend and to discuss the parties' request for authorization to stipulate to different due dates.

II. DISCUSSION

A. *Guidance for Motions to Amend*

During the conference call, the Panel provided guidance with respect to motions to amend, particularly discussing the requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. Although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute claims,¹ a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018- 01129, Paper 15 (PTAB Feb. 25, 2019) (precedential), *Amazon.com Inc. v. Uniloc Luxembourg S.A.*, IPR2017- 00948, Paper 34 (PTAB Jan. 18, 2019) (precedential), and the Office's November 2019 Consolidated Trial Practice Guide.²

A motion to amend must be responsive to a ground of patentability involved in the trial. 37 C.F.R. § 42.121(a)(2)(i). A motion to amend may cancel challenged claims or propose a reasonable number of substitute claims. *Id.* § 42.121(3). A request to substitute claims ordinarily will be

¹ See *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Automotive Services Solutions, LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017).

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

treated as contingent, meaning that it normally will be considered only if a preponderance of the evidence establishes that the original claim it replaces is unpatentable. A request to cancel claims will not be treated as contingent.

Patent Owner can only propose substitute claims, not amendments to original claims, and Patent Owner can propose only substitute claims for challenged claims, not unchallenged claims. In addition, a motion to amend must not include more than a reasonable number of substitute claims per challenged claim. There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one substitute claim. 37 C.F.R. § 42.121(a)(3).

In addition, a motion to amend must not seek to enlarge the scope of the claims or introduce new subject matter. 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner must show sufficient written description support in the original specification for each proposed substitute claim. *Id.* § 42.121(b)(1). Citation should be made to the original disclosure of the application as filed, rather than to the patent as issued. Patent Owner must also 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 claim is in the identification of the claim from which it depends. The written description support must be set forth in the motion to amend itself, not in an appendix.

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. *Id.* §§ 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 Patent Owner intends to depend from a proposed substitute independent claim. For each proposed substitute claim, the motion to amend 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.

As set forth in 37 C.F.R. § 42.24, Patent Owner's motion to amend and Petitioner's opposition are each limited to twenty-five pages. 37 C.F.R. §§ 42.24(a)(1)(vi), 42.24(b)(3). Patent Owner's reply and Petitioner's sur-reply are limited to twelve pages. *Id.* § 42.24(c)(3).

Prior to the conference call, Patent Owner indicated that it intends to seek preliminary guidance under the Board's Motion to Amend Pilot Program. Practices and procedures for the pilot program are set forth 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 (Mar. 15, 2019) ("Notice").

Under the pilot program, receiving preliminary guidance on a motion to amend is not automatic. Importantly, if Patent Owner desires preliminary guidance from the Board on a motion to amend, an explicit request for preliminary guidance must be included in the first motion to amend filed no later than DUE DATE 1. If Patent Owner requests preliminary guidance in its first motion to amend, the Board will respond to Patent Owner's request by issuing non-binding preliminary guidance to the parties on Patent Owner's first motion to amend. Such guidance will be provided approximately four weeks after Petitioner files an opposition to the motion

to amend (or after the due date for the opposition (DUE DATE 2), if none is filed). Information regarding such guidance is set forth in the Notice.

Patent Owner has several options for addressing the Board's preliminary guidance and/or Petitioner's opposition, including filing a revised motion to amend on DUE DATE 3. Notice, 9,499–9,502. A revised motion to amend may include one or more new proposed substitute claims in place of previously presented substitute claims; Patent Owner cannot make the claims proposed in the revised motion to amend contingent on the unpatentability of the claims proposed in the first motion to amend. In addition, a revised motion to amend may include substitute claims, arguments, or evidence previously presented in the first motion to amend, but may not incorporate any material by reference from the first motion to amend. A revised motion to amend may not include new amendments, arguments, or evidence unrelated to issues raised in the preliminary guidance or Petitioner's opposition to the motion to amend. Further instructions and guidance for a revised motion to amend under the pilot program are set forth in the Notice. Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing relating to the revised motion to amend. *Id.* at 9,501.

B. Changes to Due Dates

As stated in the Scheduling Order (Paper 10), the deadlines for the portions of DUE DATE 2 and DUE DATE 3 related to motion to amend briefing cannot be changed by party agreement and stipulation, absent authorization from the Board (*id.* at 8). Prior to the call, the parties had reached agreement to extend DUE DATES 1, 2, 3, and 5 by two weeks, including extending the deadlines associated with the motion to amend

briefing as follows: DUE DATE 2 from January 24, 2024 to February 7, 2024, and DUE DATE 3 from March 11, 2024 to March 25, 2024.

During the conference call, Mr. Jeffrey W. Johnson, counsel for Patent Owner, indicated that the extensions were being requested because he had only recently been appointed lead counsel and the previous lead counsel had recently passed away, which created difficulties for the transition. Mr. Johnson also indicated that it had taken him longer than expected to secure an expert witness and that he had unavoidable travel obligations recently arise.

The parties were cautioned that, if a revised motion to amend is filed, the resulting revision of the schedule will compress deadlines such that the requested two-week extension could be problematic. After discussion, the parties agreed that a one-week extension would be sufficient. Accordingly, the Panel granted the parties' request for a one-week extension to DUE DATES 1, 2, 3, and 5, including the portions of DUE DATE 2 and DUE DATE 3 related to motion to amend briefing. Specifically, the Board reschedules DUE DATES 1, 2, 3, and 5 as follows:

DUE DATE 1	November 13, 2023
DUE DATE 2	January 31, 2024
DUE DATE 3	March 18, 2024
DUE DATE 5	April 29, 2024

In addition, the Panel noted during the call that these changes, particularly the change to DUE DATE 5, could impact DUE DATE 6 and directed the parties to confer as to whether DUE DATE 6, which can be changed by party agreement and stipulation (Paper 10, 8), should be rescheduled. The parties should contact the Board if they are unable to agree with respect to DUE DATE 6.

In consideration of the foregoing, it is hereby:

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

FURTHER ORDERED that DUE DATES 1, 2, 3, and 5 are rescheduled as set forth above; and

FURTHER ORDERED that the parties shall confer as to whether DUE DATE 6 should be rescheduled.

IPR2023-00580
Patent 10,669,738 B2

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