

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner,

v.

ATI TECHNOLOGIES ULC,
Patent Owner.

IPR2023-00687
Patent 8,854,381 B2

Before JAMES P. CALVE, BRIAN J. McNAMARA, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 U.S.C. §§ 42.5, 42.121(a)

I. INTRODUCTION

On January 2, 2024, Patent Owner e-mailed the Board to request a conference pursuant to 37 C.F.R. § 42.121(a) concerning its intent to file a contingent motion to amend claims of U.S. Patent No. 8,854,381 and seek preliminary guidance from the Board. This Order provides guidance for the parties regarding Patent Owner's motion to amend and obviates the need for a conference. If either party has questions about this Order or desires further guidance, the parties should contact the Board.

II. DISCUSSION

In its email, Patent Owner's states its intent to file a motion to amend the challenged claims and to seek preliminary guidance from the Board regarding its motion to amend. *See* 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. 9,497 (Mar. 15, 2019) ("MTA Pilot Program Notice").

Although Petitioner has the burden of showing the unpatentability of substitute claims proposed in a motion to amend,¹ Patent Owner has the burden of showing that the motion to amend complies with applicable statutory and regulatory requirements for such a motion, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential). *See* 37 C.F.R. § 42.121(d).

¹ *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027, 1040 (Fed. Cir. 2017) (as amended Mar. 15, 2018; corrected Mar. 28, 2018); 37 C.F.R. § 42.121(d)(2); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020).

Patent Owner should follow the guidance provided in *Lectrosonics* and the Office’s November 2019 Consolidated Trial Practice Guide (“CTPG”) to ensure that the motion to amend complies with all statutory and regulatory requirements. *See* CTPG, 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Patent Owner may cancel a challenged claim or propose a reasonable number of substitute claims. Patent Owner may propose only substitute claims, not amendments to original claims. Additionally, Patent Owner may propose only substitute claims for challenged claims, not any unchallenged claims. *See* 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3); CTPG 72.

Because this *inter partes* review was instituted after March 15, 2019, the Motion to Amend Pilot Program applies. The details of the Motion to Amend Pilot Program are set forth in the MTA Pilot Program Notice. *See* 84 Fed. Reg. 9,497, as noted above. If Patent Owner elects to seek non-binding preliminary guidance from the Board on its motion to amend, *an explicit request for preliminary guidance must be included in the motion* to amend filed no later than DUE DATE 1. Patent Owner has several options for addressing the Board’s preliminary guidance and/or Petitioner’s opposition, including filing a revised motion to amend. *See id.* at 9499–9502. We note that a request for preliminary guidance is not a prerequisite for filing a revised motion to amend, and Patent Owner may file a revised motion to amend regardless of whether it requested preliminary guidance. *See id.* at 9501. Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing. *See id.* The parties should carefully consult the MTA Pilot Program Notice for further details and guidance.

As indicated in our Scheduling Order, Patent Owner's motion to amend must be filed by DUE DATE 1, January 17, 2024, and the parties may not stipulate to a different date for DUE DATE 2 related to Petitioner's opposition to the motion to amend, or for DUE DATE 3 related to Patent Owner's reply to the opposition to the motion to amend (or Patent Owner's revised motion to amend), without prior authorization from the Board. Paper 8, 8–9. Patent Owner's motion to amend and Petitioner's opposition are limited to 25 pages. If Patent Owner files a reply to Petitioner's opposition, the reply is due by DUE DATE 3, May 22, 2024, and may not exceed 12 pages. Petitioner's sur-reply to Patent Owner's reply is due by DUE DATE 5, July 3, 2024, and may not exceed 12 pages.

Proposed amendments must respond to a ground of unpatentability, but Patent Owner may include additional limitations that address potential issues under § 101 or § 112. *See* 37 C.F.R. § 42.121(a)(2)(i); *Lectrosonics*, IPR2018-01129, Paper 15 at 5–6; CTPG 71. Petitioner may raise, and the Board may consider, other grounds of unpatentability including those raised under §§ 101 or 112 as to proposed substitute claims. CTPG 72–73. The proposed amendments may not seek to enlarge the scope of the claims or introduce new matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 41.121(a)(2)(ii).

The motion to amend must identify the challenged claim that a substitute claim is intended to replace and provide a claim listing that shows the changes made to each challenged claim in an appendix to the motion, e.g., by underline and line through. The motion must cite to the original disclosure in the application as filed (specification and drawings) that supports all limitations in the proposed substitute claim not just the features added by the proposed substitute claim. 37 C.F.R. § 42.121(b); CTPG 71.

Finally, we remind the parties of their duty of candor pursuant to
37 C.F.R. § 42.11.

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