

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLUME DISTRIBUTORS, INC.,
Petitioner,

v.

SIMPLEHUMAN LLC,
Patent Owner.

IPR2024-00050
Patent 10,683,165 B2

Before JAMESON LEE, KARL D. EASTHOM, and
KRISTEN DROESCH, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Conduct of Proceeding
37 C.F.R. §§ 42.5, 42.121(a)

I. INTRODUCTION

On July 25, 2024, a conference call was held between respective counsel for the parties and Judges Jameson Lee, Karl D. Easthom, and Kristen Droesch. The subject matter of discussion was Patent Owner's intent to file a Motion to Amend.

II. DISCUSSION

The panel reminded the parties of the following:

1. Petitioner's opposition to Patent Owner's motion to amend is still due on September 25, 2024, and Patent Owner's reply to Petitioner's opposition to Patent Owner's motion to amend is still due on November 6, 2024, notwithstanding the parties' stipulated changes to Due Dates 2 and 3.
2. It may take the Board up to 4 weeks from the time of filing of petitioner's opposition to patent Owner's motion to amend to issue a preliminary guidance, if requested by Patent Owner, which would leave Patent Owner less than two weeks to file its reply to Petitioner's opposition to Patent Owner's motion to amend, or its revised motion to amend.
3. Patent Owner would have the burden of persuasion on various statutory and regulatory requirements for a motion to amend whereas Petitioner would have the burden with respect to alleged unpatentability of the proposed substitute claims over prior art. During the call, we expressed no view on which party has the burden of persuasion, in the context of a motion to amend, with respect to indefiniteness, lack of enabling disclosure, and subject matter ineligibility.
4. The panel considers broadening of the original claim scope in any respect to be prohibited enlargement, even if there is narrowing of claim scope in other respects. Patent Owner may explain why that is not so in its motion to amend.

5. A claim listing is required which clearly points out the differences between each proposed substitute claim and the patent claim it substitutes. Additionally, the motion to amend should clearly indicate, for each proposed substitute claims, which patent claim it substitutes.

III. CONCLUSION

It is

ORDERED that the above-noted conference call satisfies the “to confer” requirement of 37 C.F.R. § 42.121(a); and

FURTHER ORDERED that the parties should be aware of *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential).

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PETITIONER:

Qi (Peter) Tong
James Milkey
Russ, August & Kabat
ptong@raklaw.com
lruss@raklaw.com
pkroegere@raklaw.com
rak_volumedistributors@raklaw.com

PATENT OWNER:

Ali S. Razai
Matthew S. Bellinger
Benjamin B. Anger
Christian D. Boettcher
2azr@knobbe.com
2msb@knobbe.com
2bba@knobbe.com
2cdb@knobbe.com