

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

IPR2024-00958
Patent 8,482,638 B2

Before KRISTEN L. DROESCH, GEORGE R. HOSKINS, and
KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

Information and Guidance on Patent Owner's Proposed Motion to Amend
37 C.F.R. §§ 42.5(a), 42.121

On March 10, 2025, Patent Owner advised the Board by email that it wished to file a motion to amend in this proceeding. On March 21, 2025, the Panel held a conference call with counsel for the parties. 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 panel prior to filing a motion to amend. This Order summarizes the discussion with the parties on the call regarding Patent Owner's proposed motion to amend.

As we informed the parties during the call, the USPTO recently published changes to the rules concerning motions to amend to codify the MTA Pilot Program in effect since March 15, 2019. *See* "Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board," 89 Fed. Reg. 76,421 (effective Oct. 18, 2024).

During the call, counsel for Patent Owner stated that Patent Owner intended to file a non-contingent motion to amend and request preliminary guidance from the Board on the proposed amended claim(s). *See* 89 Fed. Reg. 76,421; 37 C.F.R. § 42.121(a)(1)(ii), (e).

This Order provides information and guidance regarding Patent Owner's proposed motion to amend, as discussed during the call.

As provided by Congress, a patent owner is entitled to file a motion to amend in an *inter partes* review. Specifically, 35 U.S.C. § 316(d) states:

(d) Amendment of the Patent. –

(1) IN GENERAL. – During an *inter partes* review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

* * * *

(3) SCOPE OF CLAIMS. – An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

Congress also authorized the Director to “set[] forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims.” 35 U.S.C. § 316(a)(9).

I. RULES AND GUIDANCE

The regulation directed to filing a motion to amend claims in an *inter partes* review is 37 C.F.R. § 42.121. *See also* 37 C.F.R. § 42.24 (setting page limits for motions to amend, oppositions, and replies). We direct the parties to *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, 01130, Paper 15 (PTAB February 25, 2019) (precedential) which contains guidance regarding the motion to amend process before us. Additional information on recent rule changes concerning motions to amend can be found in “Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board,” 89 Fed. Reg. 76,421 (effective Oct. 18, 2024). Further, the Office’s November 2019 Consolidated Trial Practice Guide provides useful information that is still relevant to current motion to amend practice. 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

II. TIMING AND DEFAULT PAGE LIMITS

Unless the parties stipulate otherwise, a motion to amend must be filed by DUE DATE 1 as set forth in the Scheduling Order (Paper 7). In accordance with 37 C.F.R. § 42.24(a)(vi), the motion to amend is limited to 25 pages. Unless the parties stipulate otherwise, an opposition to the motion to amend must be filed by DUE DATE 2 as set forth in the Scheduling Order. Scheduling Order, 11. In accordance with 37 C.F.R. § 42.24(b)(3), the opposition to the motion to amend is limited to 25 pages. As noted in the Scheduling Order, the parties may not stipulate to a different date for the portion of DUE DATE 2 related to Petitioner's opposition to a motion to amend, or for the portion of DUE DATE 3 related to Patent Owner's reply to an opposition to a motion to amend (or Patent Owner's revised motion to amend) "without prior authorization from the Board." Scheduling Order, 8.

If the Patent Owner requests in its motion to amend that the Board provide preliminary guidance, then we will provide this preliminary guidance approximately four weeks after DUE DATE 2. We remind the parties that the Board's consideration of the substitute claims is not limited to unpatentability under 35 U.S.C. §§ 102 and 103. *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019) (precedential).

Patent Owner may then, by DUE DATE 3, file a revised motion to amend or a Patent Owner reply in response to the Petitioner's opposition and/or the Board's preliminary guidance. As set forth in the Scheduling Order, if the Patent Owner timely files a revised motion to amend, then the Board will issue a revised scheduling order setting forth the briefing

schedule for the revised motion and adjusting other due dates as needed. An example timeline for briefing following a revised motion to amend is set forth in the Federal Register notice for the MTA Pilot Program. *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, 9,507 (Mar. 15, 2019). If Patent Owner timely files a reply instead of a revised motion to amend, then the original Scheduling Order does not change, and Petitioner’s sur-reply is due by DUE DATE 5 as set forth in the Scheduling Order. In accordance with 37 C.F.R. § 42.24(c)(3), Patent Owner’s reply is limited to twelve pages. Petitioner’s sur-reply also is limited to twelve pages. *See Lectrosonics*, IPR2018-01129, 01130, Paper 15 at 9. The parties may contact the Board to request additional pages for any paper or additional briefing – this should be done after meeting and conferring and as soon as possible.

New evidence (including declarations) may be submitted with every paper in the motion to amend process, with the exception of a sur-reply or a petitioner’s reply to preliminary guidance in a situation in which Patent Owner does not file either a reply or a revised motion to amend after receiving preliminary guidance from the Board. *See* 37 C.F.R. § 42.121(e)(3)-(4).

III. REQUIREMENTS OF A MOTION TO AMEND

A. Reasonable Number of Substitute Claims

A motion to amend claims may cancel claims and/or propose substitute claims. 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3). If proposing substitute claims, a reasonable number of substitute claims must

be proposed. 35 U.S.C. § 316(d)(1)(B). There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim. 37 C.F.R. § 42.121(a)(3). A patent owner may rebut this presumption upon demonstration of a need to present more than one substitute claim per challenged claim. *Id.* Thus, to the extent a patent owner seeks to propose more than one substitute claim for each cancelled claim, the patent owner should explain in the motion to amend the need for the additional claims and why the number of proposed substitute claims is reasonable. The determination of whether the number of proposed substitute claims is reasonable is made on a claim-by-claim basis, consistent with the statutory language that refers to a reasonable number of substitute claims for “each” challenged claim. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R.

§ 42.121(a)(3). To help the Board determine whether a motion to amend meets the requirement, the motion should, for each proposed substitute claim, specifically identify the challenged claim that it is intended to replace. All proposed claims should be traceable to an original challenged claim as a proposed substitute claim for that challenged claim.

B. Responding to a Ground of Unpatentability Involved in the Trial

37 C.F.R. § 42.121(a)(2)(i) states that “[a] motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” Thus, in considering the motion, we review the entirety of the record to determine whether a patent owner’s amendments respond to a ground of unpatentability involved in the trial. The rule does not require, however, that every word added to or removed from a claim in a motion to amend be solely for the purpose of overcoming an instituted ground. *Lectrosonics*, IPR2018-01129, 01130, Paper 15 at 5.

Additional modifications that address potential 35 U.S.C. § 101 or § 112 issues, for example, are not precluded by rule or statute. *Id.* at 5–6. Thus, once a proposed substitute claim includes amendments to address a prior art ground in the trial, a patent owner also may include additional limitations to address potential § 101 or § 112 issues, if necessary. *Id.* at 6. Allowing an amendment to address such issues, when a given claim is being amended already in view of a 35 U.S.C. § 102 or § 103 ground, serves the public interest by helping to ensure the patentability of amended claims. *Id.* In addition, allowing such amendments helps ensure a “just” resolution of the proceeding and fairness to all parties. 37 C.F.R. § 42.1(b).

C. Scope of the Substitute Claims

A motion to amend may not present substitute claims that enlarge the scope of the claims of the challenged patent or introduce new subject matter. *See* 35 U.S.C. § 316(d)(3) (“An amendment . . . may not enlarge the scope of the claims of the patent or introduce new matter.”); *see also* 37 C.F.R. § 42.121(a)(2)(ii) (“A motion to amend may be denied where . . . [t]he amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.”).

D. Claim Listing

A motion to amend must include a claim listing reproducing each proposed substitute claim. *See* 37 C.F.R. § 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 should have a new claim number. This includes any dependent claim that a patent owner intends to be depending from a proposed substitute independent claim. For each proposed substitute claim, the motion must show clearly the changes in the proposed

substitute claim with respect to the original patent claim that it is intended to replace.

No particular form is required, but use of brackets to indicate deleted text and underlining to indicate inserted text is strongly suggested. The claim listing may be contained in an appendix to the motion. 37 C.F.R. § 42.121(b). The appendix, however, shall not contain any substantive briefing, and shall not count toward the page limit for the motion.

Lectrosonics, IPR2018-01129, 01130, Paper 15 at 8. The motion itself must set forth the support in the original disclosure of the patent for each proposed substitute claim, and support in any earlier-filed disclosure for any claim for which the benefit of that earlier-filed disclosure is sought. 37 C.F.R. § 42.121(b)(1), (2).

E. Duty of Candor

Under 37 C.F.R. § 42.11, all parties have a duty of candor, which includes a patent owner's duty to disclose to the Board information of which the patent owner is aware that is material to the patentability of substitute claims, if such information is not already of record in the case. When considering the duty of candor in connection with a proposed amendment, Patent Owner should consider each added limitation. Information about an added limitation may be material even if it does not include the rest of the claim limitations.

Likewise, Petitioner should keep in mind that it has a duty of candor in relation to relevant information that is inconsistent with a position advanced by the Petitioner during the proceeding. *Cf.* 37 C.F.R. § 42.51(b)(1)(iii). For example, such information could include objective evidence of non-obviousness of proposed substitute claims, if Petitioner is

aware that such evidence is inconsistent with a position it has advanced during the proceeding, and the evidence is not already of record in the case.

IV. ADDITIONAL INFORMATION

A. Preliminary Guidance

As indicated above, if Patent Owner wishes to receive preliminary guidance from the Board 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. 37 C.F.R. § 42.121(a)(1)(ii). The Board will not issue preliminary guidance unless a request is included in Patent Owner's initial motion to amend.

The preliminary guidance sets forth the Board's initial, preliminary views on the original motion to amend, including whether the parties have shown a reasonable likelihood of meeting their respective burdens of persuasion as set forth under paragraphs (d)(1) and (2) of 37 C.F.R. § 42.121 and notice of any ground of unpatentability discretionarily raised by the Board under paragraph (d)(3). 37 C.F.R. § 42.121(e)(1). "In general, the Board's preliminary guidance will address the proposed substitute claims in a patent owner's original MTA in light of the amendments presented in those claims and will not address the patentability of the originally challenged claims." 89 Fed. Reg. 76,425.

Preliminary guidance is "an initial discussion" and does not bind the Board. *Id.*; see *Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

B. Revised Motion to Amend

If Patent Owner files a revised motion to amend, that revised motion must be responsive to issues raised in the preliminary guidance or in

Petitioner's opposition to the motion to amend and must include one or more new proposed substitute claims in place of previously presented substitute claims, where each new proposed substitute claim presents a new claim amendment. 37 C.F.R. § 42.121(f)(2). With respect to a revised motion to amend, that revised motion to amend replaces the original motion to amend, and therefore, Patent Owner cannot make the claims proposed in the revised motion to amend contingent on the unpatentability of the claims proposed in the original motion to amend. *See* 37 C.F.R. § 42.121(f)(3).

C. Additional Motion to Amend

As discussed above, a motion to amend and revised motion to amend are provided in the regulations. No additional motion to amend may be filed without Board authorization, which may be authorized when there is a good cause showing, or a joint request of the parties to materially advance a settlement. 37 C.F.R. § 42.121(c).

D. Burden of Persuasion

Patent Owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the statutory and regulatory requirements for such a motion. 37 C.F.R. § 42.121(d)(1). Petitioner bears the burden of persuasion with respect to the unpatentability of the proposed substitute claims. 37 C.F.R. § 42.121(d)(2).

Irrespective of these burdens, the Board may exercise discretion to grant or deny a motion to amend or raise a new ground of unpatentability in connection with a proposed substitute claim. 37 C.F.R. § 42.121(d)(3). Where the Board exercises its discretion, the Board must determine unpatentability based on a preponderance of the evidence. 37 C.F.R. § 42.121(d)(4).

E. Additional Options for Amendments by Patent Owner

It is worth noting that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

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