

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2013-00417
Patent 8,036,788

Before JAMESON LEE, BARBARA A. PARVIS, and
GREGG I. ANDERSON, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

Order
Conduct of Proceedings
37 C.F.R. § 42.5

Introduction

On June 25, 2014, a telephone conference call was held between respective counsel for the parties and Judges Lee, Anderson, and Parvis. Patent Owner (“AVS”) initiated the conference call to discuss three issues. First, it sought clarification with regard to its Motion to Amend Claims, which was filed on March 24, 2014 (Paper 24), over 3 months ago. According to counsel for Patent Owner, the parties disagree as to whether Patent Owner is required, in its Motion to Amend and with regard to entitlement to an earlier filing date, to point to supporting disclosure in each ancestral application that is in the chain of applications leading to the application with the earliest filing desired by the Patent Owner. Second, it sought authorization to file an additional Motion to Amend Claims to render moot Petitioner’s argument that Patent Owner’s proposed substitute claims are indefinite under 35 U.S.C. § 112, second paragraph. Third, it sought authorization to file supplemental evidence.

Discussion

1.

With regard to a Motion to Amend Claims, the Patent Owner bears the burden of proof. 37 C.F.R. § 42.20(c). The effective filing date is highly pertinent to the level of ordinary skill in the art and what prior art is applicable against the Patent Owner’s proposed substitute claims. If the Patent Owner desires an effective filing date that is prior to the actual filing date of its involved patent, it is incumbent upon the Patent Owner to make the necessary showing in that regard.

If any application in the priority chain fails to make the requisite disclosure of the claimed subject matter under 35 U.S.C. § 112, first paragraph, the later-filed application is not entitled to the benefit of the filing date preceding the break in disclosure within the priority chain. *Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed.

Cir. 2012). To gain the benefit of the filing date of an earlier-filed application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written-description requirement of 35 U.S.C. § 112, first paragraph. *Zenon Env'tl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997); *In re Hogan*, 559 F.2d 595, 609 (CCPA 1977); *In re Schneider*, 481 F.2d 1350, 1356 (CCPA 1973).

Counsel for Patent Owner identified the pertinent chain of continuity to be as follows: Application 08/476,077 → Application 09/137,918 → Application 09/356,314 → Application 09/925,062 → Application 10/701,361 → Application 11/082,739 → Application 11/836,274 (issued as Patent Owner's involved patent in this proceeding). The earliest ancestral application in the chain is Application 08/476,077. There are five intervening applications between Patent Owner's involved patent and Application 08/476,077. Yet, Patent Owner's Motion to Amend Claims discussed supporting disclosure only of the application that issued as the involved patent and Application 08/476,077, not including the disclosures of the five intermediate applications, which are each in the chain of continuity as a continuation-in-part of another application in the chain.

Counsel for Patent Owner inquired whether Patent Owner can, in its Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims, address the supporting disclosure of the five intermediate applications. Counsel for Petitioner objected to such action, noting that Petitioner would be prejudiced both because Patent Owner should have addressed that issue initially in the Motion to Amend Claims, and because Petitioner is now without opportunity to respond. Counsel for Petitioner also pointed out that there are numerous continuity paths leading back to Application 08/476,077, and Patent Owner should not be able to pick which path to

take, after having seen Petitioner's Opposition to the Motion to Amend Claims. Although counsel for Patent Owner states that Petitioner in its Opposition does not point out exactly what element is not supported in the disclosure of Application 08/476,477, the Opposition does assert that Patent Owner did not establish entitlement to the filing date of Application 08/476,477.

Counsel for Patent Owner further represented that the disclosures to be relied on in the intervening applications would be essentially the same as that which was relied on in Application 08/476,077, but fell short of representing that such disclosures are exactly the same. Note that the intervening applications are continuation-in-part applications of the immediately previous application in the chain and do not share the same disclosure. Petitioner does not accept the assertion that the disclosures are the same. In any event, even assuming that the disclosures are the same, Petitioner did not waive the right to oppose and challenge Patent Owner's assertions, if made, with respect to the intervening applications.

Petitioner had two months to prepare an opposition to Patent Owner's Motion to Amend Claims. Oral Argument has been scheduled for August 14, 2014. At this late stage in the proceeding, there is insufficient time, in any event, to provide Petitioner sufficient time to respond to Patent Owner's Reply. In that regard, counsel for Petitioner indicated that it would want to submit declaration evidence on the subject, if Patent owner is allowed to address the subject.

For all of the foregoing reasons, we determined that it would be improper for Patent Owner, in its Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims, to address and account for the supporting disclosures, if any, in any of the five intervening ancestral applications.

Counsel for Patent Owner then asked permission to file another Motion to Amend Claims, in which it would make all the necessary showings with regard to

the intermediate applications. We explained that that would be equally improper, for the same reasons why the matter should not be addressed in Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend Claims.

2.

As explained by counsel for Patent Owner, Petitioner argued that Patent Owner's proposed substitute claims are indefinite under 35 U.S.C. § 112, second paragraph, and that certain claim term is subject to two competing interpretations. Counsel for Patent Owner stated that Patent Owner would like to file a second Motion to Amend Claims to cover the contingency that the Board concludes Petitioner's indefiniteness argument is persuasive. It is represented by counsel for Patent Owner that the Second Motion to Amend Claims simply would make more clear which interpretation was intended.

The Patent Owner's proposal is inconsistent with the overall framework of this proceeding. There would be no end to this proceeding if the Patent Owner is permitted to keep filing further proposed amendments on the contingency that the Board concludes in favor of the Petitioner with regard to an earlier Motion to Amend claims. Counsel for Patent Owner represents that Patent owner will not ask to file any further Motions to Amend on the contingency that the second Motion to Amend Claims still fails, but even that does not justify the filing of the second Motion to Amend Claims.

A Patent Owner has no right to file a second Motion to Amend Claims. The possibility that the Board may rule in favor of the Petitioner on the Patent Owner's first Motion to Amend Claims is insufficient justification for authorizing the filing of a second Motion to Amend Claims. In the absence of extraordinary or special circumstance, the consequences of a failed Motion to Amend Claims is that the Patent Owner is not entitled to any substitute claim, not that the Patent Owner is

free to file another Motion to Amend Claim or to have a second Motion to Amend Claims considered. It does not matter that in this case, Petitioner's Opposition to Patent owner's Motion to Amend Claims already addressed both possible interpretations insofar as prior art is concerned. Indefiniteness itself is a basis of unpatentability. Counsel for Petitioner also correctly points out that it would be inequitable to the Petitioner to allow the Patent Owner to pick which one of two interpretations to adopt by way of a further Motion to Amend Claims, after the indefiniteness issue has been identified and explained by the Petitioner.

Although a second Motion to Amend Claims perhaps renders moot the deficiencies of a first Motion to Amend Claims, that does not justify authorizing the filing of a second Motion to Amend Claims, in the absence of good reasons why the Patent Owner should get an opportunity to cure the deficiencies in its first Motion to Amend Claims. Moreover, counsel for Patent Owner does not admit to any deficiency in the Patent Owner's first Motion to Amend Claims. That does not add to any justification for allowing a second Motion to Amend Claims.

3.

Petitioner applied a prior art reference "Fry" (Ex. 1005) against the Patent Owner's claims. According to the Patent owner, however, Petitioner has not sufficiently shown that Fry constitutes prior art. Counsel for Patent Owner indicates that Patent Owner has received, recently, from Petitioner 12 copies of the "Fry" reference, each with a date stamp that is subsequent to the effective filing date of Patent Owner's involved patent. The Patent Owner would like to submit those 12 copies as supplemental evidence. The subject then turned to what introduction would Patent Owner submit with the 12 copies.

We proposed and the parties agreed that the Patent Owner is authorized to submit the 12 copies of the “Fry” reference, together with a single introductory paragraph containing a joint statement as to what are the 12 copies of “Fry.”

Order

It is

ORDERED that Patent Owner is not authorized, in Patent Owner’s Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend Claims, to address the disclosure of the five intermediate applications in the continuity chain leading back to Application 08/476,077;

FURTHER ORDERED that Patent Owner is not authorized to file a second Motion to Amend Claims; and

FURTHER ORDERED that by July 3, 2014, Patent Owner is authorized to file supplemental evidence in the form of the 12 copies of “Fry” discussed above, together with a joint statement of the parties which introduces the supplemental evidence, limited to one paragraph no more than one page in length; the 12 copies of “Fry” should be submitted as separate exhibits each with a different exhibit number.

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