

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RICOH AMERICAS CORPORATION and XEROX CORPORATION
Petitioner

v.

MPHJ TECHNOLOGY INVESTMENTS, LLC
Patent Owner

Case IPR2013-00302
Patent 7,986,426 B1

Before SALLY C. MEDLEY, MICHAEL P. TIERNEY, and
KARL D. EASTHOM, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

A conference call was held on March 7, 2014, involving respective counsel for Petitioner and Patent Owner, and Judges Medley, Tierney, and Easthom. The purpose of the call was to discuss the following issues raised by Petitioner: (1) the late filing of Patent Owner's motion to amend (Paper 29); (2) the substance of the

motion to amend, including whether Patent Owner met the requirement to confer prior to filing the motion to amend; (3) improper incorporation by reference of arguments made in a declaration; (4) improper citations to record evidence in the Patent Owner response (Paper 28); and (5) exhibits that were cited in the Glenn E. Weadock declaration (“the Weadock declaration”), submitted by Patent Owner, were not filed or served.

Patent Owner’s Motion to Amend

Patent Owner’s motion to amend was due Friday, February 28, 2014. Patent Owner filed and served its motion to amend Monday, March 3, 2014. Paper 29.¹ Counsel for Petitioner explained that, in addition to the lateness of the motion to amend, Patent Owner did not inform the Board of the nature of the extensive claim amendment and thus did not “confer” with the Board regarding the amendment. Counsel for Petitioner also discussed alleged substantive deficiencies. For example, the motion allegedly treats the prior art with respect to the proposed claim insufficiently. Another noted deficiency is that the Weadock declaration contains arguments, which are incorporated improperly by reference into the motion to amend. Based on all of the alleged deficiencies, Petitioner requests that the motion to amend be dismissed with prejudice.

A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.

¹ Counsel for both parties indicated that service did not occur on February 28, 2014, despite the Certificate of Service (attached to the motion to

IPR2013-00302
Patent 7,986,426

37 C.F.R. § 42.5(c)(3). Based on the facts presented, the Board determined that it is in the interests of justice to excuse the late filing of the Patent Owner's motion to amend. Counsel for Patent Owner explained that as soon as he realized that the filing and service did not take place on Friday, he contacted the Board the following Monday and was informed by Board personnel to file the motion. While timely filing is paramount, based on the facts presented, the late filing is excused.

We disagree that Patent Owner did not satisfy the requirement that it confer with the Board prior to filing a motion to amend. 37 C.F.R. § 42.121(a). Patent Owner did confer as indicated in the December 20, 2013 Order. Paper 10. No indication was provided by the Board that Patent Owner must confer again to discuss the specific proposed amended claim as Petitioner seems to suggest.

A party who incorporates arguments by reference from one document into another document runs the risk that an argument would be overlooked. 37 C.F.R. § 42.6(a)(3). Moreover, a Patent Owner bears the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20. To the extent that the Patent Owner's motion to amend is deficient with respect to these, or other, requirements, the Petitioner will have an opportunity to address any alleged deficiencies in an opposition to the motion to amend.

The Board has considered all of the issues raised by the Petitioner individually and together, but denies Petitioner's request to dismiss the Patent Owner's motion to amend with prejudice.

amend) indicating otherwise.

Exhibits Cited in Testimony

Counsel for Petitioner explained that the Weadock declaration refers to evidence that was neither filed nor served in violation of 37 C.F.R.

§ 42.51(b)(1)(i). Patent Owner agreed to file and serve, by March 10, 2014, the evidence referred to in the Weadock declaration. Petitioner will have five days from service of the exhibits to object, if necessary.

Incorrect Citations Made in the Patent Owner Response

Lastly, counsel for Petitioner argued that the citations made in the Patent Owner response to the Weadock declaration are incorrect. Counsel for Petitioner agreed that some of the citations to paragraphs of the Weadock declaration are incorrect and agreed to file a substitute Patent Owner response for the sole purpose of correcting the citations to the Weadock declaration. Patent Owner further agreed to serve a redlined version, showing the changes.

Order

It is

ORDERED that Petitioner's request to dismiss Patent Owner's motion to amend with prejudice is *denied*;

FURTHER ORDERED that Patent Owner shall, by March 10, 2014, file as exhibits the evidence referred to in the Weadock declaration; and

FURTHER ORDERED that Patent Owner shall, by March 10, 2014, file a substitute Patent Owner response for the sole purpose of correcting the citations

IPR2013-00302
Patent 7,986,426

made to the Weadock declaration and serve a redlined copy showing the changes made.

PETITIONER:

Michael Specht
Mspecht-PTAB@skgf.com

Jason Eisenberg
Jasone-PTAB@skgf.com

H. Keeto Sabharwal
Keetos-PTAB@skgf.com

Dennies Varughese
Dvarughe-PTAB@skgf.com

Richard Bemben
Rbemben-PTAB@skgf.com

PATENT OWNER:

Scott Horstemeyer
Scott.horstemeyer@thomashorstemeyer.com

Andrew Crain
Andrew.crain@thomashorstemeyer.com

Vivek Ganti
Vivek.ganti@thomashorstemeyer.com