

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RIVERBED TECHNOLOGY, INC.  
Petitioner

v.

SILVER PEAK SYSTEMS, INC.  
Patent Owner

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Case IPR2013-00402 (Patent 8,312,226 B2)  
Case IPR2013-00403 (Patent 8,370,583 B2)<sup>1</sup>

Before DENISE M. POTHIER, JUSTIN T. ARBES, and  
MIRIAM L. QUINN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2013-00402 (Patent 8,312,226 B2)

Case IPR2013-00403 (Patent 8,370,583 B2)

A conference call in the above proceedings was held on March 25, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Pothier, Arbes, and Quinn. The call was requested by Patent Owner to discuss issues regarding proposed amendments it may submit in a motion to amend.

Patent Owner stated that it may propose, in its motion to amend in each proceeding, substitute claims for certain independent and dependent claims. Entry of proposed amendments is not automatic, but only upon Patent Owner having demonstrated the patentability of the proposed substitute claims. Patent Owner in its motion should state, as to each proposed substitute claim, whether the claim is contingent on the corresponding claim in the challenged patent being determined to be unpatentable. If Patent Owner requests that any existing claim be cancelled, it may make the request in the motion to amend. *See* 37 C.F.R.

§ 42.121(a)(3). Patent Owner is reminded that, if it chooses to file a motion to amend only and not a response, it will be deemed to have waived any argument as to the patentability of the challenged claims. *See, e.g.,* IPR2013-00402, Paper 17 at 2-3. Also, as explained during the call, Patent Owner's motions to amend will be decided at the conclusion of each proceeding, after all briefing on the challenged claims and proposed substitute claims is completed. The Board will reach a decision on the patentability of the challenged claims and then, if necessary, decide any motions to amend; the Board's rules do not provide for the reverse order. *See* 37 C.F.R. § 42.121(a)(3).

Patent Owner requested authorization to file one consolidated motion to amend, of more than 15 pages, in both of the instant proceedings.

Case IPR2013-00402 (Patent 8,312,226 B2)

Case IPR2013-00403 (Patent 8,370,583 B2)

According to Patent Owner, the proceedings involve common issues and filing one motion would avoid duplication. Petitioner opposed Patent Owner's request, arguing that the two challenged patents are directed to different inventions with different issues. As explained during the call, we are not persuaded that a consolidated motion to amend is appropriate under the circumstances. The instant proceedings involve different claims of different patents, and the motion to amend in each proceeding would request entry of proposed substitute claims that substitute for the claims of the respective patent, not the patent in the other proceeding. Thus, Patent Owner is authorized only to file separate motions to amend in the two instant proceedings.

Patent Owner also requested five additional pages for each of its motions, arguing that its proposed substitute claims occupy a significant portion of the 15 pages allotted. Petitioner did not oppose Patent Owner's request. Patent Owner's request was denied. We do not view the issues involved in these proceedings to be overly complex, or the claims to be so voluminous, such that it would be unreasonable for Patent Owner to meet the 15-page limit for motions to amend. *See* 37 C.F.R. § 42.24(a)(1)(v). Patent Owner is encouraged to propose focused amendments for a limited set of claims and use the bulk of its motion to explain why the motion should be granted.

The Board referred Patent Owner to *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013) ("*Idle Free*"), and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (Mar. 7, 2014) ("*Toyota*"), for guidance regarding motions to amend. In particular, Patent Owner should explain in its motions

Case IPR2013-00402 (Patent 8,312,226 B2)

Case IPR2013-00403 (Patent 8,370,583 B2)

why its proposed substitute claims are patentable over not just the prior art of record, but also prior art not of record but known to Patent Owner:

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner. Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims.

*Idle Free* at 7. This includes addressing the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular item of prior art. *Id.* at 7-8. Further, the relevant prior art under the circumstances includes, at minimum, the prior art cited in both of the instant proceedings.

Finally, to the extent Patent Owner's proposed substitute claims contain any means-plus-function limitations, Patent Owner must identify in the respective motion (1) the written description support for each claim, as a whole, including such a limitation, and (2) the specific portions of the specification that describe the structure, material, or acts corresponding to the claimed function(s). *See* 37 C.F.R. § 42.121(b); *Toyota* at 5.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied the conference requirement of 37 C.F.R. § 42.121(a) for both of the instant proceedings.

Case IPR2013-00402 (Patent 8,312,226 B2)

Case IPR2013-00403 (Patent 8,370,583 B2)

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