

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA, INC.  
Petitioner

v.

PI-NET INTERNATIONAL, INC.  
Patent Owner

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Case No. IPR2013-00194  
Patent 8,108,492 B2

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Before, KARL D. EASTHOM, WILLIAM V. SAINDON and  
BRIAN J. McNAMARA, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER DENYING PETITIONER'S REQUEST TO FILE MOTION TO STRIKE  
AND EXPUNGING EXHIBIT 2075

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

This proceeding involves Petitioner's challenges to claims 1-8 and 10-12 of U.S. Patent 8,108,492 B2 (the '492 Patent). A telephone conference was conducted on April 29, 2014 to address Petitioner's request for authorization to file a motion to strike Patent Owner's Exhibit 2075 and to compel inventor Dr. Lakshmi Arunachalam to appear for deposition, if Exhibit 2075 is not stricken.<sup>1</sup> Petitioner was represented by Michael Lee and Lori Gordon. Patent Owner was represented by Colby Springer and Tam Pham.

Relevant Exhibit 2075 is a 91 page chart that lists support in Provisional Application Ser. No. 60/006,634 for the limitations in "amended claim 4" in Patent Owner's Corrected Motion to Amend (Paper 37). Relevant Exhibit 2074<sup>2</sup> is a declaration from the inventor, ("Arunachalam Decl."), stating that "[Relevant] Exhibit 2075 is a true and correct copy of the claim support for Substitute Claim 4 that was previously provided in this proceeding." Relevant Ex. 2074, 1.

We previously determined that the document in Relevant Exhibit 2075 ("Claim Support Chart"), originally filed as Exhibit C to Patent Owner's Motion to Amend (Paper 31), is not proper in this proceeding, and on February 3, 2014, we ordered Patent Owner to file a corrected motion to amend. Paper 33, Order To

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<sup>1</sup> There are two exhibits designated Ex. 2075. The first Ex. 2075 is All-State's responses to interrogatories served by Plaintiff WebXchange in C.A. No. 08-131 in the District of Delaware. The second Ex. 2075 is titled "Support for Amended Claim 4 in the '492 Patent. We understand this issue before us to refer to the second Ex. 2075. We refer herein to the second Ex. 2075 as "Relevant Exhibit 2075."

<sup>2</sup> There are two exhibits designated Ex. 2074. The first Ex. 2074 is titled "Declaration Of Dr. Lakshmi Arunachalam In Support Of Reply To Petitioner's Opposition To Patent Owner's Corrected Motion To Amend." The second Ex. 2074 is titled "Transweb Patent Application" and is labeled Pi-Net Proprietary and Confidential. We note that no Protective Order has been entered in this proceeding and the document is publicly available. We understand the matter before us to refer to the first Ex. 2074, which we refer to herein as "Relevant Ex. 2074."

Correct Papers, 4. Patent Owner's Corrected Motion to Amend (Paper 37, "Corrected Motion to Amend") did not include this Claim Support Chart, but instead stated that the "new elements" in the proposed substitute claim find support in the '492 Patent at various locations identified by column and line number in the parent patent (U.S. Patent No. 5,778,178) and at various pages in parent provisional application 60/006,634. Corrected Motion to Amend, 5-6.

Petitioner's Opposition to Patent Owner's Corrected Motion to Amend (Paper 48, "Petitioner's Opposition") contends that Patent Owner has not established support for the proposed substitute claim. Petitioner's Opposition, 2-3, 6-7. Responding to Petitioner's Opposition, the Arunachalam Declaration states that the Claim Support Chart is being submitted again because Petitioner, who previously objected to this document, "now demands the very same information set forth in this chart." Relevant Ex. 2074, 1.

Petitioner's Opposition does not change the nature of the Claim Support Chart or render it appropriate in this proceeding. In the pages allotted for a motion to amend, Patent Owner was required to establish written description support for the proposed substitute claim and demonstrate its patentability over the prior art. In view of the length of the proposed substitute claim, we allowed Patent Owner to exceed the page limit for such motions by three pages. There is no justification for Patent Owner's 91 page Claim Support Chart, nor does it address the salient issues.

Pages 4-5 of our Summary of Conference Concerning Proposed Motion to Amend (Paper 27) discussed the requirements concerning written description support for a motion to amend. There we referred Patent Owner to our decision in *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27. *Nichia* explains that merely indicating where each claim limitation is *individually* described in the original disclosure, as appears to be the case with Relevant Exhibit

2075, may be insufficient to demonstrate support for the claimed subject *as a whole*. *Id.* at 4. The focus of our inquiry is whether the original disclosure conveys to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.* at 3. *Nichia* also explains that citations to a provisional application, as in Relevant Exhibit 2075, may be insufficient because they are relevant only for the benefit claimed under 35 U.S.C. § 119(e) and not for written description support for proposed substitute claims. *Id.* at 3-4. *Nichia* notes that written description support must be shown in the original disclosure of the application that issued as a patent, unless the Patent Owner indicates in its motion that there was no change to the original disclosure when the patent issued. *Id.*

We will address the merits of Patent Owner's Motion to Amend and Petitioner's opposition in due course. In Paper 49, Patent Owner replied to Petitioner's Opposition to the Motion to Amend. Patent Owner will have another opportunity to address the issues raised in this proceeding during oral argument.

In consideration of the above circumstances, we order that Relevant Exhibit 2075 be expunged. As the issue is now moot, we do not authorize Petitioner to file a motion to strike Relevant Exhibit 2075 or to compel the inventor's deposition.

We also take this opportunity to note that the Motion to Amend incorrectly numbers the substitute claim as claim 4. In an *inter partes* review a patent owner may cancel a challenged claim or propose a reasonable number of substitute claims. 35 U.S.C. § 316(d); 37 C.F.R. § 42.121(a)(3). Although the proposed substitute claim must be traceable to a challenged claim, there is no provision for amending an existing claim. Thus, for purposes of this proceeding, the claim proposed in the Motion to Amend should be referred to as claim 14.

We further note that page 6 of Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend (Paper 44, "Reply") lists Exhibits 2072 through 2077. Each of these exhibit numbers was previously used in this proceeding to designate a different document. Patent Owner is required to file a Corrected Reply and Exhibits with proper exhibit designations and a request to expunge improperly designated exhibits. Recognizing that Relevant Ex. 2075 has been expunged, the Corrected Reply should not include a substitute for the expunged document.

In consideration of the above, it is

ORDERED that Relevant Exhibit 2075 be expunged,

FURTHER ORDERED that Patent Owner file a Corrected Reply and Exhibits with proper exhibit designations not later than May 2, 2014;

FURTHER ORDERED that Patent Owner file a Request to Expunge Improperly Designated Exhibits that identifies improperly designated documents to be expunged not later than May 2, 2014;

FURTHER ORDERED that Petitioner is not authorized to file a motion to strike Relevant Exhibit 2075, and

FURTHER ORDERED, that Petitioner is not authorized to file a motion to compel the deposition of inventor Dr. Lakshmi Arunachalam.

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