

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANDUS FLOORING, INC.,
Petitioner,

v.

INTERFACE, INC.,
Patent Owner.

Case No. IPR2013-00333
Patent 8,831,473 B2

Before BRIAN J. McNAMARA, TRENTON A. WARD and
MIRIAM L. QUINN, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION DECLINING TO AUTHORIZE PATENT OWNER'S FILING OF
AN ADDITIONAL MOTION TO AMEND
37 C.F.R. § 42.121(c)

On August 5, 2014, E.J. Joswick, counsel for Interface, Inc. (“Patent Owner”) requested a conference to discuss obtaining authorization for Patent Owner to supplement Patent Owner’s motion to amend claims to expressly claim priority to an earlier-filed patent application and to identify support for the subject matter of the substitute claims in that application. A conference was held on August 7, 2014 during which Tandus Flooring, Inc. (“Petitioner”) opposed Patent Owner’s request.

Patent Owner filed its Motion To Cancel Claims And Contingent Motion To Amend Claims, Paper 41 (“Motion to Amend”), on April 30, 2014. During the August 7, 2014 teleconference, Patent Owner noted that its Motion to Amend identifies support for the proposed amended claims in application 12/270,129 (“the ’129 Application”) that led to the issuance of U.S. Patent No. 8,381,473 B2 (the ’473 Patent). Although the ’129 Application is a continuation of prior application 11/018,947, published as US2005/0229534 (“the ’534 Application”), and purportedly contains the exact same disclosure as the ’534 Application, in its Motion to Amend Patent Owner did not identify the ’534 Application as supporting the proposed amended claims.

Petitioner’s Opposition to Patent Owner’s Contingent Motion to Amend, Paper 51, (“Pet. Opp.”) was filed on June 24, 2014 and refers to the ’534 Application by the inventor’s name as “Scott.” Petitioner’s Opposition argues that the Motion to Amend should be denied because the disclosure in the published ’534 Application not cited by Patent Owner in the Motion to Amend renders the subject matter of the proposed amended claims unpatentable under 35 U.S.C. § 102 and/or 35 U.S.C. § 103. Pet. Opp. 6-9.

Patent Owner filed a Reply to Petitioner’s Opposition on July 17, 2014. Paper 56. Patent Owner’s Reply argues that the claims are entitled to the benefit of

the '534 Application and that its citation to the '129 Application was consistent with guidance it received during a motion to amend conference. We note that the Summary of the Motion to Amend Conference, Paper 38, at page 5 states "Pursuant to 37 C.F.R. § 42.121(b)(1), Patent Owner must set forth the support in the *original disclosure* of the patent for each proposed substitute claim, i.e., Patent Owner must identify clearly the written description support in the disclosure corresponding to the earliest date upon which Patent Owner seeks to rely."

Patent Owner now seeks to supplement its Motion to Amend to cite what it argues is the exact same disclosure in the earlier '534 Application as that cited in the '129 Application in support of the proposed amended claims. Petitioner argued during the teleconference that none of the considerations for authorizing an additional motion to amend favor Patent Owner because the circumstances do not involve supplemental information that was not known to Patent Owner when it filed its Motion to Amend, and because there is only a short time remaining before the oral hearing requested by both parties. Papers 58 and 59. The oral argument is scheduled for September 2, 2014.

We do not authorize Patent Owner to file an additional motion to amend. An additional motion to amend would delay the proceeding, in which all evidence has been presented and oral hearing is about to occur. In addition, Patent Owner's proposed additional motion to amend would have no effect on the outcome of this proceeding. Even if Patent Owner could claim an earlier disclosure as providing a written description under 35 U.S.C. § 112 that supports its proposed amended claims, Patent Owner's failure to do does not change the fact that the '129 Application is a continuation of the '534 Application and that the '129 Application is entitled to the priority date afforded the '534 Application under 35 U.S.C. § 120. Patent Owner's reliance on the '129 Application for § 112 support

in the Motion to Amend is not a disclaimer of the claim to priority asserted in the '129 Application that led to the '473 Patent. Thus, Patent Owner's disclosure in the '534 Application is not available as prior art to the '129 Application. Any analysis of the Motion to Amend will consider whether the '129 Application supports a conclusion under 35 U.S.C. §112 that the Patent Owner possessed the invention in the proposed amended claims as of the filing date of the '129 Application, but we do not apply the parent '534 Application against the proposed amended claims as prior art.

In consideration of the above, Patent Owner's request for authorization to file an additional motion to amend is DENIED.

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PETITIONER: (via electronic transmission)

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