

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIVERBED TECHNOLOGY, INC.,
Petitioner,

v.

SILVER PEAK SYSTEMS, INC.,
Patent Owner.

Case IPR2014-00245
Patent 8,392,684 B2

Before DENISE M. POTHIER, JUSTIN T. ARBES, and HYUN J. JUNG,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

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

A conference call in the above proceeding was held on November 17, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Pothier, Arbes, and Jung. The call was requested by Patent Owner to seek authorization to file a revised motion to amend. Patent Owner filed its Motion to Amend (Paper 16, “Mot.”) on August 7, 2014, and Petitioner filed its Opposition (Paper 23, “Opp.”) on October 14, 2014. The deadline for Patent Owner’s Reply (DUE DATE 3) was November 18, 2014. *See* Paper 20 at 3. The following issues were discussed.

Motion to Amend

A patent owner in an *inter partes* review is permitted one motion to amend. 37 C.F.R. § 42.121(a). An additional motion to amend may be authorized by the Board, but only when “there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement.” 37 C.F.R. § 42.121(c). Factors that the Board considers in determining whether to authorize an additional motion to amend include “whether a petitioner has submitted supplemental information after the time period set for filing a motion to amend,” “the time remaining for the trial, the degree to which the additional evidence impacts the patentability of the claims being sought to be amended, and whether the additional evidence was known to the patent owner before the time period [for filing the motion to amend].” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“Trial Practice Guide”).

Patent Owner sought authorization to file a revised motion to amend to address two issues. First, Patent Owner argued that its proposed substitute claim 38 is written to correct a “printing error” in the challenged

patent, U.S. Patent No. 8,392,684 B2 (“the ’684 patent”). Specifically, claim 14, as issued, depends from claim 9. Patent Owner argued that this was a “printing error” in the patent and that claim 14 instead should depend from claim 8.¹ In its Motion to Amend, Patent Owner proposes claim 38 as a substitute for claim 14. Mot. 5. Claim 38 depends from claim 32 (the proposed substitute for claim 8), not claim 33 (the proposed substitute for claim 9). *Id.* Petitioner argued in its Opposition that claim 38 is improper under 37 C.F.R. § 42.121(a)(2)(ii) because it does not include all of the limitations of corresponding claim 14. Opp. 4. During the call, Patent Owner sought guidance on how the issue should be addressed. Patent Owner stated that, as one option, it could file a revised motion to amend changing the dependency for claim 38 from claim 32 to claim 33 to correspond to claim 14 as issued. We took the matter under advisement.

After further consideration and review of the ’684 patent prosecution history, we are not persuaded that a revised motion to amend is appropriate under the circumstances. The ultimate claim that Patent Owner seeks in its Motion to Amend allegedly corrects a “printing error” in the original corresponding claim. Rather than authorizing a revised motion to amend that would propose a claim different from what Patent Owner intends, we are persuaded that the better course of action is to receive additional briefing from the parties regarding proposed substitute claim 38 as written. The parties shall explain in their papers (1) why the dependency in original claim 14 is or is not a “printing error” as Patent Owner alleges, and (2) why proposed substitute claim 38, depending from claim 32 rather than claim 33,

¹ Patent Owner acknowledged during the call that it never filed a request for a certificate of correction under 37 C.F.R. § 1.322.

is or is not proper under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. No new evidence is permitted.

Second, Petitioner argued in its Opposition that all of Patent Owner's proposed substitute claims improperly enlarge the scope of the original claims under 37 C.F.R. § 42.121(a)(2)(ii) because the added language in the proposed substitute claims effectively eliminates the feature that "the data transmitted by the source-site appliance in the store instruction must be encrypted," which is a requirement of the original claims according to Petitioner. Opp. 1-4. During the call, Patent Owner stated that it disagrees with Petitioner's argument, but sought authorization to file a revised motion to amend to add language addressing Petitioner's concern. Patent Owner argued that good cause exists for doing so because it would eliminate the need for the Board to decide the issue. Petitioner opposed Patent Owner's request, arguing that additional briefing would be required to address the substance of any new language added in a revised motion to amend. We took the matter under advisement.

Again, after further consideration, we are not persuaded that good cause exists for a revised motion to amend. No supplemental information was submitted by Petitioner after Patent Owner filed its Motion to Amend. Rather, Patent Owner's request is based solely on the arguments made by Petitioner in its Opposition. Patent Owner has not articulated sufficiently why the instant situation is any different from the typical scenario contemplated by the rules where a patent owner files a motion to amend with added claim language, the petitioner files an opposition arguing that the new language is improper for some reason, and the patent owner files a reply responding to those arguments. The fact that Petitioner takes issue with

Patent Owner's proposed substitute claims is not reason by itself to permit Patent Owner an additional motion to amend. As set forth in the Scheduling Order, Patent Owner will have the opportunity to respond to Petitioner's arguments in its Reply. We also note that permitting Patent Owner an additional motion to amend could impose significant delay to this proceeding, as additional time potentially would be needed for another deposition of Patent Owner's declarant and a new opposition from Petitioner responding to the revised claims.

Finally, during the call, we extended the deadline for Patent Owner to file its Reply to November 19, 2014, so that the above issues could be resolved prior to Patent Owner's filing.

Motion to Seal

Patent Owner stated that it may file certain confidential information with its Reply, and requested guidance on how to do so. The parties are directed to the requirements of 37 C.F.R. § 42.54 and the instructions for filing documents in the Patent Review Processing System (PRPS) on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. The default rule is that all papers filed in an *inter partes* review are open and available for access by the public. *See* 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.14. If a party believes there is a need to file "confidential information" under seal, however, the party may file a concurrent motion to seal with a proposed protective order, and the information at issue is provisionally sealed pending the outcome of the motion. *See* 37 C.F.R. §§ 42.14, 42.54(a). The proposed protective order may be a copy of the Board's default protective order. *See* Trial Practice Guide, 77 Fed. Reg. at 48,771.

If not, the party's motion should identify specifically how the proposed protective order differs from the Board's default protective order, explain why every change is warranted, and include with the motion a separate redlined version of the proposed protective order showing the differences. The parties are reminded that they must confer with each other before filing any motion to seal, and are encouraged to agree on the terms of a proposed protective order if possible. *See* 37 C.F.R. § 42.54(a).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for authorization to file a revised motion to amend is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file a supplemental paper addressing proposed substitute claim 38, as explained above, limited to five pages, by November 24, 2014;

FURTHER ORDERED that Petitioner is authorized to file a response to Patent Owner's supplemental paper, limited to five pages, by December 2, 2014; and

FURTHER ORDERED that DUE DATE 3 in the Scheduling Order (Papers 13, 20) is changed to November 19, 2014, and all other due dates are unchanged.

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