

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORPORATION
Petitioner,

v.

EMCORE CORPORATION
Patent Owner.

Case IPR2012-00005 (JYC)
Patent 6,653,215

Before MICHAEL P. TIERNEY, KEVIN F. TURNER, and
JONI Y. CHANG, *Administrative Patent Judges*.

Chang, *Administrative Patent Judge*

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

On May 30, 2013, a telephone conference call was held between respective counsel for the parties and Judges Tierney, Turner, and Chang. The telephone conference call was initiated by Nichia, seeking clarification on whether Emcore's motion to amend (Paper 26) complies with the requirement that the patent owner must confer with the Board before filing the motion (37 C.F.R. § 42.121(a)).

During the conference call, Emcore asserted that it has met that requirement. As support, Emcore directed our attention to: (1) its list of contemplated proposed motions filed prior to the initial conference call (Paper 16); and (2) the Board's Order entered after the initial conference call (Paper 17). Emcore noted that the first item on its motion list includes a motion to amend claims. Emcore further pointed out that during the initial conference call it indicated that it may file a motion to amend claims. (Paper 17, p. 2.)

The Board explained that the purpose of that requirement is to provide the patent owner an opportunity to obtain guidance from the Board before filing a motion to amend. As the moving party, the patent owner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. § 42.20(c). This procedure enhances efficiency by saving the patent owner's time and resources to prepare a motion that would otherwise be denied because of certain reasons, such as an unreasonable number of substitute claims or an amendment that does not respond to a ground of unpatentability.¹ When conferring with the

¹ See *Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48680, 48704-05 (Aug. 14, 2012) (final rule).

Board, the patent owner is not required to identify a fully developed claim set. Accordingly, Emcore has complied with the requirement in that it conferred with the Board before filing of its motion to amend.

Upon further discussion, the Board noted that a motion to amend claims must clearly identify the written description support for the proposed substitute claims. In particular, 37 C.F.R. § 42.121(b)(1) requires the patent owner to set forth the support in the *original disclosure* of the patent for each proposed substitute claim. Emcore sought clarification as to whether citations to U.S. Patent 6,653,215 (“the ’215 patent”), or citations to the provisional application, would be sufficient to meet that requirement.

The Board explained that the citations to the ’215 patent or the provisional application may be insufficient for several reasons. At the outset, the Board noted that the written description test is whether the original disclosure of the application relied upon reasonably conveys to a person of ordinary skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Therefore, the written description support must be shown in the *original disclosure of the application* (Application No. 09/971,965) that issued as the ’215 patent, unless Emcore indicates, in its motion, that there was no change to the original disclosure when the patent issued.

The Board further clarified that the citations to the provisional application are relevant only for the benefit claim under 35 U.S.C. § 119(e), and not for the written description support for the proposed substitute claims.

See Reiffin v. Microsoft Corp., 214 F.3d 1342, 1345 (Fed. Cir. 2000). More precisely, the citations to the provisional application are relevant to a different requirement that is set forth in 37 C.F.R. § 42.121(b)(2) (the “support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought”).

The Board also explained that merely indicating where each claim limitation *individually* described in the original disclosure may be insufficient to demonstrate support for the claimed subject matter *as a whole*. For instance, the statement “Proposed claim 21: *See, e.g.* existing claims 6, 14, and 15” without any explanation is on its face inadequate for the patent owner to meet its burden, as each of claims 6, 14, and 15 separately depends from claim 1.

Moreover, the Board recognized that the proposed substitute claims need not be described “*in haec verba*” in the original disclosure in order to satisfy the written description requirement. However, should the claim language does not appear *in ipsius verbis* in the original disclosure, a mere citation to the original disclosure without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole may be similarly inadequate.

Emcore indicated that it may seek authorization to file a supplemental motion or an additional motion to amend. The Board responded that an additional motion to amend may be authorized when there is a good cause showing or a joint request of the parties to advance materially a settlement (37 C.F.R. § 42.121(c)).

Case IPR2012-00005
Patent 6,653,215

Lastly, Nichia indicated that, in its opposition, it may raise the issue of whether the scope of the amendment is appropriate.

It is

ORDERED that the parties may contact the Board to set up a conference call should either party wish to seek further guidance or authorization to file an additional motion to amend under 37 C.F.R. § 42.121(c).

PETITIONER:

Matthew A. Smith
Foley & Lardner LLP
MSmith-PRPS@foley.com

PATENT OWNER:

Michael A. Tomasulo
Michael J. Scheer
Winston & Strawn LLP
PTABTeam@winston.com