

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING GILBERT INC.
Petitioner,

v.

PPC BROADBAND, INC.
Patent Owner.

Case IPR2013-00347
Patent 8,287,320

Before JAMESON LEE and JOSIAH C. COCKS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

Introduction

An initial conference call was held on December 30, 2013, between respective counsel for the parties and Judges Lee and Cocks. The patent owner (“PPC”) did not file a proposed motions list. The petitioner (“Corning”) filed a proposed motions list (Paper 19), but indicated that Corning is not contemplating the filing of any motion. The subject matter of discussion turned to Corning’s expert witness, who currently is undergoing chemotherapy.

Counsel for Corning offered a proposal, in the event that Corning must obtain another expert witness in place of Dr. Mroczkowski, who may not recover sufficiently well in time to be cross-examined by PPG. Specifically, in this instance, counsel proposed that Corning file a declaration by a second expert, outlining that person’s credentials and simply declaring that the second expert agrees with the opinions set forth in Dr. Mroczkowski’s declaration.

Discussion

The Board answered that if Corning files such a declaration of a second witness, that action, by itself, will not remove Corning’s reliance on the testimony of Dr. Mroczkowski. The proposal appears to leave, still, Dr. Mroczkowski’s testimony on the table for consideration, which is inappropriate if he cannot be cross-examined.

The Board inquired why the new expert could not execute a declaration literally having the same wording as in Dr. Mroczkowski’s declaration. Counsel for Corning replied that because the two experts will have different qualifications, paragraph numbers as referenced in Corning’s petition, directed to Dr. Mroczkowski’s declaration, likely will not match paragraph numbers in the declaration executed by the second expert witness.

To maintain the same paragraph numbers in the second declaration, however, Corning may present qualifications of its second expert witness in a separate exhibit or in later paragraphs, and then use blank spaces to occupy the paragraphs which, in the first expert declaration, express the qualifications of Dr. Mroczkowski. If such a substitute expert declaration is filed, however, Corning also should file a substitute petition that refers to the declaration by the substitute expert witness, and not the declaration of Dr. Mroczkowski.

The Board asked the parties to try to reach agreement as to the various specifics about Corning's potentially filing of a substitute declaration from another expert witness, to replace that of Dr. Mroczkowski, before contacting the Board with a proposal.

The conference call continued on two additional topics raised by the Board: (1) Motion to Exclude Evidence; and (2) Motion to Amend Claims.

1. Motion to Exclude Evidence

The Board explained that a motion to exclude evidence is not intended as the vehicle for use by a party to raise the issue of a reply exceeding the proper scope of a reply, or reply evidence exceeding the proper scope of reply evidence, in the sense of going beyond what reasonably can be deemed as responding to an opposition. If an issue arises on the proper scope of a reply or reply evidence, the parties shall contact the Board in a joint telephone conference call, and are not authorized to use the motion to exclude evidence as a vehicle for addressing the issue.

2. Motion to Amend Claims

The Board explained that a motion to amend claims, filed in an *inter partes* review, is very different from an applicant's amending claims in a pending patent application. In the former case, the proposed amendment is not authorized unless

the movant has shown that the “proposed” substitute claims are patentable, whereas in the latter case, new claims proposed prior to final rejection are automatically entered and presumed patentable. It is insufficient for the movant, in a motion to amend claims, simply to explain why the proposed substitute claims are patentable on the basis of which the Board instituted review. Apart from the particular prior art references cited in a decision to institute, the movant must explain why it believes the claimed subject matter is patentable. It would not be persuasive simply to say that none of the prior art references of record discloses the combination claimed, or that no such specific combination is known to the movant. Similarly, it would not be persuasive simply to say that the prior art of record would not have rendered the subject matter of the substitute claims obvious.

The movant must address the issue of nonobviousness, meaningfully. That should include a discussion of the level of ordinary skill in the art, apart from the disclosure of any specific reference in the record. Such discussion should explain the basic knowledge and skillset already possessed by one with ordinary skill in the art, especially with respect to the particular feature or features the patent owner has added to the original patent claims. For instance, the patent owner should identify in what contexts the added feature, or something very close to it, was known already, albeit not in the specific combination recited in the claims at issue. Limiting the discussion either to the references already in the case, or to the narrow combination specifically recited in the claim, would not provide a meaningful analysis.

The Board further directed attention of the parties to two papers on the subject of a proper motion to amend claims: (1) Paper 26 in Case IPR2012-00027; and (2) Paper 33 in Case IPR2013-00136.

Conclusion

It is ORDERED that Due Dates 4-7 remain as set in Paper 18.

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