

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SZ DJI TECHNOLOGY CO., LTD.,
Petitioner,

v.

AUTEL ROBOTICS USA LLC,
Patent Owner.

Case IPR2019-00846
Patent 9,260,184 B2

Before JENNIFER MEYER CHAGNON and AVELYN M. ROSS,
Administrative Patent Judges.

CHAGNON, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Information and Guidance on Motions to Amend
37 C.F.R. §§ 42.5, 42.121(a)

On January 3, 2020, a conference call was held among counsel for the parties and Judges Chagnon and Ross to discuss guidance for motions to amend, in general, and under the Board's Motion to Amend Pilot Program, specifically. Additional details regarding motions to amend and the pilot program are provided below.

General Guidance for Motions to Amend

The requirements for a motion to amend are set forth in 37 C.F.R. § 42.121. Regarding the burden of persuasion that the Board applies when considering the patentability of proposed substitute claims presented in a motion to amend, we refer the parties to *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), *Bosch Automotive Service Solutions, LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017), *Bosch Automotive Service Solutions, LLC v. Iancu*, Order on Petition for Panel Rehearing, No. 2015-1928 (Fed. Cir. Mar. 15, 2018), and the Board's Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) (available at https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf).

We also refer the parties to additional guidance on motions to amend discussed in the following cases: *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, 01130, Paper 15 (PTAB Feb. 25, 2019) (precedential); and *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019) (precedential).

As set forth in 37 C.F.R. § 42.24, Patent Owner's motion to amend and Petitioner's opposition are each limited to twenty-five pages. 37 C.F.R. §§ 42.24(a)(1)(vi), 42.24(b)(3). Patent Owner's reply and Petitioner's sur-reply are limited to twelve pages. *Id.* § 42.24(c)(3).

Specific Guidance for the Motion to Amend Pilot Program

The Board's pilot program for motions to amend practice and procedures in AIA trial proceedings became effective on March 15, 2019. Practices and procedures for the pilot program are set forth in the *Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9467 (Mar. 15, 2019) ("Notice"). The pilot program applies to all AIA trial proceedings instituted on or after the March 15, 2019, effective date. Because this proceeding was instituted on September 23, 2019, the pilot program is applicable to a motion to amend filed in this proceeding. Even so, Patent Owner has an opportunity to proceed with a motion to amend "in effectively the same way as current practice by not electing to either receive preliminary guidance [from the Board on a first motion to amend] or to file a revised [motion to amend]." 84 Fed. Reg. 9467, 9499. Under the pilot program, receiving preliminary guidance on a motion to amend is not automatic. Rather, ***if Patent Owner seeks preliminary guidance on its motion to amend, it must make such request explicitly in its first motion to amend*** filed by Due Date 1. *Id.*

If Patent Owner requests preliminary guidance in its first motion to amend, the Board will respond to Patent Owner's request by issuing preliminary, non-binding guidance to the parties on Patent Owner's first motion to amend. *Id.* Such guidance will be provided approximately four weeks after Petitioner files an opposition to the motion to amend (or after the due date for the opposition, Due Date 2, if none is filed). Information regarding such guidance is set forth in the Notice.

Regardless of whether Patent Owner requests preliminary guidance, Patent Owner may elect to file a revised motion to amend on Due Date 3. A revised motion to amend would be in lieu of a reply to Petitioner's opposition to motion to amend, and in place of the first motion to amend. *See also L&P Property Management Co. v. Remacro Machinery and Technology (Wujiang) Co.*, IPR2019-00255, Paper 15 at 12–14 (PTAB June 18, 2019) (Section IV.3, providing information about Patent Owner's options under the pilot program). Further instructions and guidance for a revised motion to amend under the pilot program are set forth in the Notice. If Patent Owner files a revised motion to amend, the Board will issue a revised scheduling order to accommodate briefing relating to the revised motion to amend. 84 Fed. Reg. at 9499 and Appendix 1B (Revised MTA Timeline).

In consideration of the foregoing, it is hereby:

ORDERED that the conference requirement under 37 C.F.R. § 42.121(a) is hereby satisfied.

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For PETITIONER:

Lori Gordon
Steve Peters
KING & SPALDING LLP
lgordon@kslaw.com
speters@kslaw.com

For PATENT OWNER:

Timothy Bickham
John Abramic
Matthew Bathon
Harold Fox
Gretchen Miller
STEPTOE & JOHNSON LLP
tbickham@steptoe.com
jabramic@steptoe.com
mbathon@steptoe.com
hfox@steptoe.com
gmiller@steptoe.com