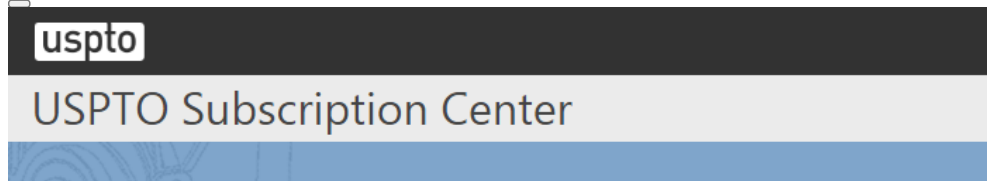


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## New informative order providing guidance on motions to amend

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# Patent Trial and Appeal Board



## PTAB de-designates *Idle Free* and *Master Image* and designates new informative order providing guidance on motions to amend

In view of the decision from the United States Court of Appeals for the Federal Circuit in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), regarding motion to amend practice and procedure in AIA trials, PTAB has de-designated as precedential *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) and has de-designated as informative *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (June 11, 2013) (Paper 26). Both decisions have been removed from PTAB's Precedential and Informative Decisions web page.

Concurrently, PTAB has designated as informative the following order in *Western Digital Corp. v. SPEX Techs., Inc.*, which provides guidance on motion to amend practice in AIA trials.

**[Western Digital Corp. v. SPEX Techs., Inc., Case IPR2018-00082, -00084 \(PTAB Apr. 25, 2018\) \(Paper 13\)](#)**. This order provides guidance and information regarding statutory and regulatory requirements for a motion to amend in light of Federal Circuit case law, as well as the de-designation of *MasterImage* as precedential and *Idle Free* as informative at the Board. Specifically, the order sets forth guidance, such as: (1) contingent motions to amend; (2) the burden of persuasion that the Office applies when considering the patentability of substitute claims; (3) the requirement that a patent owner propose a reasonable number of substitute claims; (4) the requirement that the amendment respond to a ground of unpatentability involved in the trial; (5) the scope of the proposed substitute claims; (6) the requirement that a patent owner provide a claim listing with its motion to amend; (7) the default page limits that apply to motion to amend briefing; and (8) the duty of candor.

A copy of the informative order can be found on the PTAB's [Precedential and Informative Decisions](#) web page.



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