

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.¹

Patent Owner

IPR2018-01664

PATENT 8,872,646

**PATENT OWNER MOTION TO AMEND CLAIM 22
OF U.S. PATENT NO. 8,566,960 UNDER 37 C.F.R. § 42.121**

¹ The owner of this patent is Uniloc 2017 LLC.

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I. STATEMENT OF RELIEF REQUESTED

Uniloc 2017 LLC (the “Uniloc” or “Patent Owner”) moves to amend U.S. Patent No. 8,872,646 (“the ’646 patent” or “EX1001”) by replacing challenged claim 22 with proposed substitute claim 23. *See* 37 C.F.R. §§ 42.22(a)(2) and 42.121; *see also* 35 U.S.C. § 316(d).

II. INTRODUCTION

This motion to amend involves cancelling the *only* challenged claim (claim 22) and replacing it with *one* proposed substitute claim 23. 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3). The claim language originally recited in claim 22, and in claim 20 from which claim 22 depends, is recited verbatim in proposed substitute claim 23, which is written in independent form. Proposed substitute claim 23 further recites certain clarifying amendments, as explained further below.

Proposed substitute claim 23 satisfies the statutory and regulatory requirements. It does not enlarge claim scope and does not introduce new matter. 37 C.F.R. § 42.221(a)(2)(ii); 35 U.S.C. § 316(d)(3). The amendment simply clarifies the meaning of certain limitations in a manner that is consistent with the written description in the specification as originally filed. The amendment is responsive to a ground of unpatentability involved in the trial. 37 C.F.R. § 42.121.

Petitioner bears the burden of proof with respect to substitute claim 23. *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1324-25 (Fed. Cir. 2017) (“the burden of proving the unpatentability of all claims in an IPR—both original and amended—is on the petitioner.”); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15, at 3-4.

III. CLAIM LISTING

Pursuant to 37 C.F.R. § 42.121(b), Appendix A attached hereto provides a claim listing reproducing proposed substitute claim 23. The claim listing in Appendix A shows clearly “the changes in the proposed substitute claim with respect to the original patent claim that it is intended to replace.” *Lectrosonics*, IPR2018-01129, Paper 15, at 8.

IV. SUBSTITUTE CLAIM 23 DOES NOT ENLARGE CLAIM SCOPE

Proposed substitute claim 23 does not enlarge claim scope. 37 C.F.R. § 42.121(a)(2)(ii); 35 U.S.C. § 316(d)(3). The claim language originally recited in claim 22, and in claim 20 from which claim 22 depends, is recited verbatim in the proposed substitute claim 23, which is written in independent form. *See* Appendix A, *infra*.

In addition, proposed substitute claim 23 further recites a number of clerical and clarifying amendments. First, the word “generation” is clerically amended to recite “generate”. Second, clarifying amendments are recited as “the one or more glitches each indicating a respective detected motion that is both within an operational range of the motion sensor and outside an acceptable range, the motion data containing less data as a result of the removal of the one or more glitches from the motion data”. Finally, a clarifying amendment explicitly confirms that the “dominant axis logic . . . determine[s] a dominant axis”.

To the extent scope is changed at all by these amendments, the scope can only be *narrowed*. Accordingly, the proposed amendment does not “enlarge the scope of the claims of the patent.” 37 C.F.R. § 42.121(a)(2)(ii); 35 U.S.C. § 316(d)(3).

V. SUPPORT FOR PROPOSED SUBSTITUTE CLAIM 23

Proposed substitute claim 23 is supported by the specification of the application as originally filed (Appl. No. 12/247,950; *see* Exhibit 1002, pp. 6-36).²

The test for compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether “the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that set forth fully the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The claimed invention does not have to be described *in ipsius verbis* in the specification to satisfy the written description requirement. *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000).

The following table satisfies the requirement that “the written description support must be set forth in the motion to amend itself.” *Lectrosomics*, IPR2018-01129, Paper 15, at 8; *see also* 37 C.F.R. § 42.221(a)(2)(ii); 35 U.S.C. § 316(d)(3). The example citations listed in the table below are sufficient to meet the legal requirement and are not intended to be exhaustive. Citations to figures are intended to encompass the original written description corresponding to those figures, and *vice versa*. The table below is also reproduced in Appendix A for ease of reference.

² In addressing the patent application as originally filed, citations are made herein to Samsung’s Exhibit 1002 (vol. 1 of the prosecution history), using either the paragraph numbers of the original specification or the page numbering Samsung appended to its exhibit at the bottom left of each page.

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