

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC., ZTE (USA) INC. and ZTE CORPORATION,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

IPR2020-01159
Patent 7,596,375 B2

Before AMANDA F. WIEKER, MONICA S. ULLAGADDI, and
RUSSELL E. CASS, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

PATENT OWNER'S CONTINGENT MOTION TO AMEND

I. INTRODUCTION

On February 17, 2021, we instituted trial as to claims 1–15 of U.S. Patent No. 7,596,375 B2 (Ex. 1001, “the ’375 patent”). Paper 11. After institution, Patent Owner filed a Contingent Motion to Amend. Paper 22 (“Motion” or “Mot.”). Should we, in a final written decision, find that the challenged claims are unpatentable, Patent Owner proposes substitute claims 23 and 24, which correspond to respective challenged claims 6 and 7. Mot. 1. Petitioner filed an Opposition to the Motion. Paper 28 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requests that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* 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. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it satisfies the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, 01130, Paper 15 (PTAB February 25, 2019) (precedential); *see also* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides

preliminary, non binding guidance from the Board to the parties about the [motion to amend].”).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We have considered, however, our Institution Decision in determining whether the amendments “respond to a ground of unpatentability involved in the trial.” *Lectrosomics*, Paper 15 at 5. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion that might be filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See* Notice, 84 Fed. Reg. at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))

Yes.

Patent Owner proposes no more than one substitute claim for each of challenged claims 23 and 24 of the '375 patent. *See* Mot. 1; *id.* at 16, App. A. Petitioner does not argue otherwise. *See generally* Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes.

Patent Owner responds to the grounds of unpatentability at pages 10–14 of the Motion. Petitioner does not argue otherwise. *See generally* Opp.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

Yes.

Patent Owner asserts that “[p]roposed substitute claims 23 and 24 narrow the scope of claims 6 and 7, respectively,” because “[e]ach substitute claim imposes additional limitations” Mot. 4.

Petitioner argues that proposed substitute claims 23 and 24 “negate the steps of independent claim 1 in circumstances where there is no HPLMN [(home public land mobile network)] list” and thus “impermissibly enlarge the scope of the claims of the patent.” Opp. 15.

At this stage of the proceeding, Petitioner appears to have the better position.

Each of original claims 6 and 7, and proposed substitute claims 23 and 24, depend from independent claim 1. Proposed substitute claims 23 and 24 contain the newly added limitation “implementing the steps of claim 1” “*only if* the HPLMN list is stored in [contained on (claim 24)] the mobile wireless terminal’s SIM or in its memory” (emphasis added). Mot. 16, App. A. Thus, proposed substitute claims 23 and 24, as written, call for “implementing the steps of claim 1” *only if* the necessary condition is met. If the necessary condition is not met, then proposed substitute claims 23

and 24 call for *not* implementing the steps of claim 1. In other words, each of proposed substitute claims 23 and 24, as written, covers at least two methods: one that requires implementing the steps of claim 1 (necessary condition is met) and one that requires *not* implementing the steps of claim 1 (necessary condition is not met). *Cf. Ex Parte Schulhauser*, No. 2013-007847, 2016 WL 6277792 (PTAB 2016) (precedential) (discussing conditional limitations in the context of *ex parte* appeals).

Therefore, each of proposed substitute claims 23 and 24—which depend from claim 1—indicates that the steps of claim 1 are *not* performed under certain conditions, i.e., if the HPLMN list is not contained on the mobile station’s SIM or in its memory. Thus, proposed substitute claims 23 and 24, unlike original claims 6 and 7, cover situations where none of the steps of independent claim 1 are performed.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

For the limitation “determine whether the HPLMN list, containing a plurality of home network MCC and MNC pairs, is stored on a Subscriber Identity Module (SIM), in its memory, or neither” in proposed substitute claims 23 and 24.

Yes.

Patent Owner asserts that this limitation of proposed substitute claims 21 and 22 is supported by the original disclosures in U.S. Application No. 12/235,132 (“the ’132 Application”)—the application that issued as the ’375 patent—and European Application No. 03255483, to which the ’375 patent claims priority. Mot. 5–10; Ex. 1001, codes (21), (30). Patent Owner provides a chart including citations to the ’132 and European Applications to support the limitations of proposed substitute claims 23 and 24. *Id.*

Petitioner argues that the phrase “or neither” in proposed substitute claims 23 and 24 implies that “the HPLMN list may be present in ‘neither’ the SIM nor the mobile station memory.” Opp. 6. According to Petitioner, the written description of the ’375 patent does not support the

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