

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

LBT IP I LLC,  
Patent Owner.

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IPR2020-01189 (Patent 8,497,774 B2)  
IPR2020-01190 (Patent 8,542,113 B2)  
IPR2020-01191 (Patent 8,102,256 B2)  
IPR2020-01192 (Patent 8,421,618 B2)  
IPR2020-01193 (Patent 8,421,619 B2)<sup>1</sup>

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Before JOHN A. HUDALLA, SHEILA F. McSHANE, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 U.S.C. §§ 42.5, 42.121(a)

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<sup>1</sup> We exercise our discretion to issue a single Order, to be filed in each case.  
The parties are not authorized to use this caption for subsequent papers.

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## I. INTRODUCTION

A conference call in the above proceedings was held on May 20, 2021, between respective counsel for the parties and Judges Hudalla, McShane, and Dirba. The purpose of the call was to allow Patent Owner to satisfy the requirement under to 37 C.F.R. § 42.121(a) to confer with the panel prior to filing motions to amend. This Order reiterates the discussion with the parties on the call and provides additional information and guidance regarding any proposed motions to amend.

## II. DISCUSSION

During the call, Patent Owner stated that it intended to file motions to amend in each case and, further, that it intended to elect the option under the MTA Pilot Program to receive preliminary guidance from the Board on the substance of any amended claims in its motions to amend. *See* 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. 9497 (Mar. 15, 2019) (“MTA Pilot Program Notice”).

We remind the parties that, although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute claims,<sup>2</sup> a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*,

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<sup>2</sup> *See Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017) (as amended Mar. 15, 2018)).

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IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential). *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. Patent Owner should follow the guidance provided in *Lectrosonics* and the Office's November 2019 Consolidated Trial Practice Guide to ensure that the motions to amend comply with all relevant statutory and regulatory requirements. 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. We also note that Patent Owner may only propose substitute claims, not amendments to original claims. Additionally, Patent Owner may propose only substitute claims for challenged claims, not unchallenged claims.

Because this *inter partes* review was instituted after March 15, 2019, the Motion to Amend Pilot Program applies. The details of the Motion to Amend Pilot Program are set forth in the MTA Pilot Program Notice. *See* 84 Fed. Reg. 9497, as noted above. Importantly, if Patent Owner elects to seek non-binding preliminary guidance from the Board on its motions to amend, an explicit request for preliminary guidance must be included in each motion to amend filed no later than DUE DATE 1. Patent Owner has several options for addressing the Board's preliminary guidance and/or Petitioner's opposition in each case, including filing a revised motion to amend. *See id.* at 9499–9502. We note that a request for preliminary guidance is not a prerequisite for filing a revised motion to amend, and Patent Owner may file a revised motion to amend regardless of whether it requests preliminary guidance. *See id.* at 9501. Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order

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to allow additional briefing. *See id.* The parties should carefully consult the MTA Pilot Program Notice for further details and guidance.

As stated in the Scheduling Order for these cases, the parties may not stipulate to a different date for DUE DATE 2 related to Petitioner's oppositions to the motions to amend, or for DUE DATE 3 related to Patent Owner's replies to Petitioner's oppositions to the motion to amend (or Patent Owner's revised motions to amend), without prior authorization from the Board.

Finally, the parties remain subject to a duty of candor under 37 C.F.R. § 42.11. In particular, we remind Patent Owner that it has a duty to disclose information that is material to the patentability of any proposed substitute claims.

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