

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

LBT IP I LLC,
Patent Owner.

IPR2020-01189
Patent 8,497,774 B2

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

HUDALLA, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On March 4, 2021, we instituted trial as to claims 1, 4–6, 8, 10, 13, and 15 of U.S. Patent No. 8,497,774 B2. Paper 9 (“Decision”). After institution, Patent Owner filed a Motion to Amend in which it proposes substitute claims 20–34 to replace original claims 1–15. Paper 16 (“Motion” or “Mot.”). Specifically, “[t]o the extent the Board finds any original claim unpatentable in this proceeding, Patent Owner respectfully requests that the Board grant this motion to amend with respect to each corresponding proposed substitute claim presented herein.” Mot. 2. Petitioner filed an Opposition to the Motion. Paper 26 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 2; *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 information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied 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 proposed substitute claims are unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, 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].”); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020).

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 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 filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

As a threshold matter, Patent Owner proposes substitute claims 20–34 to replace original claims 1–15, but claims 1, 4–6, 8, 10, 13, and 15 are the only challenged claims in this proceeding. Section 316(d) states that a patent owner may file one motion to “[c]ancel any *challenged* claim” or “[f]or each *challenged* claim, propose a reasonable number of substitute claims.” 35 U.S.C. § 316(d) (emphases added). Accordingly, Section 316(d) does not permit Patent Owner to cancel or propose substitutes for non-challenged claims. *See also Apple Inc. v. Uniloc 2017 LLC*, IPR2018-01092, Paper 25 at 45 (Dec. 13, 2019) (holding the same). Thus, we only consider the Motion with respect to the proposed substitute claims that correspond to the challenged claims (i.e., proposed substitute claims 20,

23–25, 27, 29, 32, and 34, which correspond to original claims 1, 4–6, 8, 10, 13, and 15).

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 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. As discussed above, we are only considering proposed substitute claims 20, 23–25, 27, 29, 32, and 34. Each of these proposed substitute claims corresponds to one of the challenged claims. *See* Mot. 4. Petitioner does not argue otherwise. *See generally* Opp. Thus, Patent Owner proposes a reasonable number of substitute claims.

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 at least one ground of unpatentability from the Decision. Mot. 3–4. Petitioner does not argue otherwise. *See generally* Opp. Thus, the Motion responds to a ground of unpatentability.

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))

No. Proposed substitute claims 20, 23–25, 27, 29, 32, and 34 retain all the features of the corresponding original claims while only adding further limitations. Mot. 2–3. Thus, the amendment does not seek to enlarge the scope of the claims.

Petitioner contends that proposed substitute claims 20, 23–25, 27, 29, 32, and 34 impermissibly attempt to broaden the scope of corresponding original claims 1, 4–6, 8, 10, 13, and 15. Opp. 3. Specifically, Petitioner contends that proposed substitute claims 20 and 27 require “an updated set of network communication signaling protocols associated with at least one of a request rate representing a repeating time interval for location coordinate packets to be communicated to a target host and a listen rate representing a repeating time interval for receipt of the location coordinate packets from a satellite navigation system,” where corresponding original claims 1 and 8 require that the request rate and listen rate actually be for the corresponding packets. *Id.* (citing Mot. 25–26). According to Petitioner, a system where a refresh rate merely “represent[s]” (but does not include) an actual transmission or reception rate for a corresponding type of packet would satisfy proposed substitute claims 20 and 27, but would not satisfy corresponding original claims 1 and 8. *Id.* at 3–4.

Proposed substitute claims 20 and 27 require that the recited “request rate” and “listen rate” represent “a repeating timing interval.” Corresponding original claims 1 and 8 do not recite such a requirement, so these proposed amendments appear to represent a narrowing of the claims. At this stage of the proceeding, we also do not agree with Petitioner’s argument that the use of word “representing” in the proposed amendments works to broaden the proposed substitute claims. Petitioner’s argument is premised on the notion that the word “of” in the challenged claims means “includes.” *See* Opp. 3–4. But Petitioner does not support its argument with any record evidence, and we are not persuaded at this juncture that the word “representing” meaningfully changes the scope of the proposed substitute claims compared to the word “of” in the original claims. Petitioner’s argument also does not account for the significant narrowing of claim scope caused by the added “repeating time interval” limitations. Thus, the scope of proposed substitute claims 20 and 27 does not appear exceed the scope of the original claims.

Thus, at this stage of the proceeding, on the record before us, Patent Owner has shown a reasonable likelihood that the amendment regarding proposed substitute claims 20, 23–25, 27, 29, 32, and 34 does not seek to enlarge the scope of the original claims.

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