

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

LBT IP I LLC,

Patent Owner

Case IPR2020-01192
U.S. Patent No. 8,421,618

PATENT OWNER'S MOTION TO AMEND

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A. wherein the at least one portion of the transceiver circuitry and the location tracking circuitry is deactivated by placing the at least one portion of the transceiver circuitry and the location tracking circuitry in a low power mode in which the at least one portion of the transceiver circuitry and the location tracking circuitry consumes at least reduced power. (proposed substitute independent claims 25 and 39).....19

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PATENT OWNER'S EXHIBIT LIST

Exhibit Number	Description
2001	Declaration of Brian S. Seal in support of Patent Owner's Unopposed Motion For <i>Pro Hac Vice</i> Admission
2002	Revised Declaration of Brian S. Seal in support of Patent Owner's Unopposed Motion For <i>Pro Hac Vice</i> Admission
2003	Transcript of deposition of Scott Andrews
2004	U.S. Pub. No. 2009/0174603 (Appl. No. 11/969,905)
2005	Sun, U.S. Patent Number 7,612,663
2006	Syrjarinne et al., U.S. Pub. No. 2005/0113124
2007	Suprun et al., U.S. Patent Number 7,292,223
2008	Croyle et al., U.S. Patent Number 5,862,511
2009	Lau et al., U.S. Patent Number 5,592,173
2010	Tsai, U.S. Pub. No. 2007/0057068
2011	Huang et al., U.S. Patent Number 7,826,968
2012	File history of U.S. Patent Number 8,421,619
2013	U.S. Pub. No. 2009/0189807 (Appl. No. 12/419,451)

I. INTRODUCTION

Patent Owner LBT IP I LLC (“Patent Owner”) respectfully moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to amend U.S. Patent No. 8,421,618 (“the ‘618 Patent”), contingent on the outcome of this trial. In the event the Board finds any of claims 1-24 unpatentable, Patent Owner respectfully requests that the Board grant this motion to amend and issue the corresponding proposed substitute claims presented herein.

As this motion demonstrates, this motion and the proposed substitute claims meet all of the requirements of 37 C.F.R. § 42.121. Namely, each contingent amendment is responsive to a ground of unpatentability involved in this proceeding, none of the amendments seeks to enlarge the scope of the claims or introduce new subject matter, each amendment proposes only one proposed substitute claim for each conditionally canceled claim, and the motion clearly shows the changes sought and the support in the original disclosure of the patent for each claim that is added or amended.

Moreover, although Patent Owner should not bear the burden of either persuasion or production regarding the patentability of the amended claims as a condition of allowance, and the Board may not *sua sponte* question the patentability of the proposed amended claims, *see In re Aqua Products, Inc.*, 872 F.3d 1290, 1296 (Fed. Cir. 2017), the instant motion demonstrates that the proposed amended claims

are patentable over the references at issue in this proceeding and the material prior art at issue during prosecution.

II. STATEMENT OF RELIEF REQUESTED

Patent Owner respectfully requests preliminary guidance from the Board regarding the proposed substitute claims.

To 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. The Board should not consider this motion for each original claim it finds patentable.

III. THE PROPOSED SUBSTITUTE CLAIMS MEET ALL THE REQUIREMENTS OF 37 C.F.R. § 42.121.

As shown in the attached claims appendix, proposed substitute independent claims 25 and 39 retain all features of the original claims and do not enlarge the scope of the claims in any way. Rather, the contingent amendments add only narrowing features. Specifically, the proposed substitute claims add the following limitation to the original claims: wherein the at least one portion of the transceiver circuitry and the location tracking circuitry is deactivated by placing the at least one portion of the transceiver circuitry and the location tracking circuitry in a low power mode in which the at least one portion of the transceiver circuitry and the location

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