

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

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**PETITIONER APPLE INC.'S OPPOSITION  
TO PATENT OWNER'S MOTION TO AMEND**

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## I. INTRODUCTION

LBT's Motion to Amend should be denied because the amended claims lack written description support, are indefinite, and are unpatentable under § 103.

## II. THE AMENDED CLAIMS ARE UNPATENTABLE UNDER § 112

### A. Written Description Support Is Required for the Amended Claims

The specification must describe the claimed invention in sufficient detail that a POSITA can reasonably conclude that the inventor had possession of the claimed invention as of the filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010); *Veeam Software Corp. v. Veritas Technologies, LLC*, IPR2014-00090, Paper 48 at 17 (July 17, 2017). A motion to amend may not propose substitute claims that introduce new subject matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). “[I]t is inadequate to show written description support for just the feature added by the proposed substitute claim. Instead, the Patent Owner must show written description support for the entire claim.” *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00441, Paper 19 at 3 (Oct. 30, 2014).

### B. Original Limitation: “Battery Power Monitor”

There is not adequate written description support for the limitation of a “battery power monitor” as claimed in Claim 25. Substitute Claim 25 recites a “battery power monitor,” which is a term not recited in the specification, except for the abstract and claims. Patent Owner cites ¶ [0029] for support, which states, “Battery level detection circuitry (e.g. battery level monitor 116) detect a battery

level of battery 118....” (Paper 16, *Patent Owner Response*, 6-7). However, battery level monitor 116 merely *detects* the battery level and is not described as performing any of the claimed functions. None of LBT’s cited sections of the specification (¶¶ [0031], [0032], and [0036]) provides adequate written description for a *battery power monitor* that performs the claimed functions. Although these paragraphs refer to certain elements being “placed in” a sleep or standby mode or low power mode, none of these sections, or any other portion of the disclosure, provides adequate written description for a *battery power monitor* that is “configured to” do anything with respect to modes.

For at least the above reasons, substitute Claim 25 and dependent claims therefrom, are invalid under 35 U.S.C. 112, ¶ 1.

### **III. LBT’S CONSTRUCTION IMPORTS LIMITATIONS INTO THE CLAIMS**

The plain and ordinary meaning of the amended claims requires deactivating the at least one portion of the transceiver circuitry and the location tracking circuitry by placing them in a low power mode consuming at least reduced power. The claims do not require that power to the at least one portion of the transceiver circuitry and the location tracking circuitry is “not eliminated” or “not shut off,” as LBT contends. (Paper 17, 19-20). Components maintaining a low power mode where the GPS receiver is periodically activated, such that the low power mode consumes at least reduced power relative to a mode of operation that activates at a higher frequency,

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