

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

LBT IP I LLC,
Patent Owner.

IPR2020-01192
Patent 8,421,618 B2

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

McSHANE, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On March 4, 2021, we instituted trial as to claims 1–24 of U.S. Patent No. 8,421,618 B2. Paper 9 (“Decision”). After institution, Patent Owner filed a Motion to Amend that proposes substitute claims 25–48 for original claims 1–24. 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 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

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. Patent Owner proposes no more than one substitute claim for each challenged claim. 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. 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 25–48 retain all the features of the corresponding original claims while only adding additional limitations. Mot. 2–3. Petitioner does not argue otherwise. *See generally* Opp. Thus, the amendment does not seek to enlarge the scope of the claims.

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))

No. On this record, Patent Owner appears to have identified adequate written description support for proposed substitute claims 25–48. Mot. 4–18.

The '618 patent issued from Application Ser. No. 13/356,599 (“the '599 application”), which is a division of Application Ser. No. 11/969,905 (“the '905 application”). Ex. 1001, codes (21), (62); *see also* Mot. 4. To show support for the substitute claims, Patent Owner cites the published version of the '905 application—U.S. Pub. No. 2009/0174603 A1 (“the '603 publication”)—rather than the '905 application or the '599 application. *See* Mot. 4 (citing Ex. 2004). Patent Owner, however, was required to cite to the '905 application itself as well as the '599 application. *See Lectrosonics*, IPR2018-01129, Paper 15 at 7 (requiring that a motion to amend set forth written description support in the originally filed disclosure of the subject patent and an earlier filed disclosure for which benefit of the filing date of that disclosure is sought). Here the '603 publication appears to be substantially identical to the '599 and '905 applications, and Petitioner does not identify any differences. As a result,

and to provide further guidance to the parties, we address Patent Owner's citations as if Patent Owner had cited to the '905 and the '599 applications. In the event that Patent Owner files either a reply to Petitioner's Opposition or a revised motion, Patent Owner should conform to *Lectrosomics* and include citations to the '599 application as well as the '905 application.

Petitioner contends Patent Owner has not shown that the '905 application adequately supports "battery power monitor," as recited in substitute claim 25. Opp. 1. Specifically, Petitioner contends the term "battery power monitor" is not recited in the '905 application, except for the abstract and claims. *Id.* Petitioner further contends paragraph 29 of the '905 application states that battery level monitor 116 merely detects a battery level, but it does not disclose battery level monitor 116 as performing any of the claimed functions (i.e., selectively activating/deactivating circuitry). *Id.* at 1–2 (citing Ex. 2004 ¶ 29). Petitioner additionally contends paragraphs 31, 32, and 36 merely describe certain elements being placed in "a sleep or standby mode or low power mode," but do not disclose that a battery power monitor is configured to do anything with respect to modes. *Id.* at 2.

At this stage of the proceeding, we disagree with Petitioner's contention. Paragraph 29 states that "[b]attery level detection circuitry (e.g., battery level monitor 116) detects a battery level of battery 118." Ex. 2004 ¶ 29. In addition, paragraph 14 of the '905 application states that, "[i]n response to measured signal strength level, a power management circuitry (e.g., battery monitor) controls power levels associated with [a] tracking device to reduce or increase power consumption of transceiver and its associated circuitry." *Id.* ¶ 14 (emphasis added). In light of the aforementioned paragraphs, at this stage of the proceeding, we determine that the '905 application adequately supports "battery power monitor," as recited in substitute claim 25.

Thus, at this stage of the proceeding, on the record before us, Patent Owner has shown a reasonable likelihood that there is adequate written description support for proposed substitute claims 25–48.

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