

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION¹,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

PTAB Case No. IPR2021-00375

Patent 8,265,096 B2

PATENT OWNER'S MOTION TO AMEND

¹ ZyXEL Communications Corporation was joined as a petitioner in this proceeding based on a petition and motion for joinder filed in IPR2021-00734, which were granted.

UPDATED LIST OF EXHIBITS

Exhibit No.	Descriptions
2001	Declaration of Dr. Branimir Vojcic
2002	'096 Provisional
2003	2018 Economic Impact Report
2004	'096 claim chart
2005	Dell litigation scheduling order
2006	Dell litigation amended scheduling order
2007	Dell litigation notice of withdrawn claims
2008	Asus litigation notice of withdrawn claims
2009	Apple litigation joint motion to dismiss with prejudice
2010	Apple litigation order of dismissal
2011	Asus ROG Phone 3 Home Page
2012	Asus litigation Qualcomm subpoena
2013	Supplemental Declaration of Dr. Branimir Vojcic
2014	12/06/21 excerpts from rough draft depo transcript of Sumit Roy, Ph.D.
2015	Final Transcript of 12/06/21 Deposition of Sumit Roy, Ph.D.

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	MOTION TO AMEND PILOT PROGRAM.....	1
III.	A REASONABLE NUMBER OF CLAIMS ARE AMENDED.	2
IV.	THE PROPOSED AMENDMENT RESPONDS TO A GROUND OF UNPATENTABILITY INVOLVED IN THIS TRIAL	2
V.	PROPOSED AMENDED CLAIMS.....	3
A.	The Proposed Amended Claims Do Not Broaden Claim Scope.....	3
B.	The Proposed Amended Claims Do Not Introduce New Matter And Are Supported By The Original Specification.	3
C.	The Proposed Amended Claims Are Patentable.	12
VI.	CONCLUSION.....	13
	APPENDIX A.....	15
A.	AMENDED CLAIM 44 REPLACING ORIGINAL CLAIM 1	15
B.	AMENDED CLAIMS 2-4, 6 AND 7	16

TABLE OF AUTHORITIES

Cases

UNM Rainforest Innovations v. Apple Inc., No. 1-20-cv-00351 (W.D. Tex)5

Statutes

35 U.S.C. § 1022

35 U.S.C. § 1031, 2

Regulations

37 C.F.R § 42.121(a)(3)2

37 C.F.R. § 42.121(a)(2)(i)2

37 C.F.R. § 42.121(a)(3)2

I. INTRODUCTION

Patent Owner UNM Rainforest Innovations (hereinafter “UNM” or “Patent Owner”) respectfully submits this Motion to Amend (“Motion”) to request amendment of certain claims of U.S. Patent 8,265,096 B2 (EX1001, “’096 Patent”).

Petitioner asserts that claims 1-4 and 6-8 of the ’096 Patent are unpatentable on two grounds based solely on 35 U.S.C. § 103:

Ground 1 – Claims 1-4, 6, and 7 are unpatentable as obvious over *Talukdar* and *Li*.

Ground 2 – Claim 8 is unpatentable as obvious over *Talukdar* and *Nystrom*.

Patent Owner requests amendment of independent claim 1 to provide further limitation and clarification of its claimed invention and reflect the proper scope of this claims considering the specification.

II. MOTION TO AMEND PILOT PROGRAM

Pursuant to 84 FR 9497, Patent Owner requests that this Motion to Amend be subject to the MTA Pilot Program. This IPR was instituted on July 19, 2021, *see* Paper 14, and, therefore, it qualifies for the MTA Pilot Program effective on March 15, 2019. Patent Owner requests preliminary guidance from the Board on this Motion to Amend and reserves the right to file a revised Motion to Amend subject to the Board’s preliminary guidance.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.