

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.

IPR2021-00375
Patent 8,265,096 B2

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
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 was granted.

I. INTRODUCTION

On July 19, 2021, we instituted trial of claims 1–4 and 6–8 of U.S. Patent No. 8,265,096 B2 (the “’096 Patent”). Paper 14 (“Inst. Dec.”). After institution, UNM Rainforest Innovations (“Patent Owner”) filed a Motion to Amend. Paper 37 (“Motion” or “Mot.”). In its Motion, Patent Owner requests amendment of the ’096 Patent to replace challenged claims 1–4, 6, and 7² with proposed substitute claims 44–47, 49, and 50³. *See id.* at 1–2, 13, 15–16 (App. A). Patent Owner submitted a Supplemental Declaration of Branimir Vojcic, D.Sc., in support of the Motion. Ex. 2013. Qualcomm Incorporated and ZyXEL Communications Corporation (“Petitioner”) filed an Opposition to Patent Owner’s Motion to Amend. Paper 41 (“Opposition” or “Opp.”). Petitioner submitted a Supplemental Declaration of Sumit Roy, Ph.D., in support of the Opposition. Ex. 1039.

Patent Owner requests preliminary guidance regarding the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *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.

² With respect to challenged claim 8, Patent Owner indicates that claim 8 is “not amended.” *See* Mot. 15 (App. A).

³ Patent Owner uses non-consecutive numbering for its proposed substitute claims that skips the number 48. *See* Mot. 13, 15–16 (App. A).

In this Preliminary Guidance, we provide information indicating our initial, preliminary, and non-binding views on whether Patent Owner shows 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 Feb. 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].”).

For the purpose 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 parties’ substantive papers and arguments addressing the patentability of the original challenged claims. *See 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 does not clearly articulate whether the Motion is 1) contingent upon a finding in a final written

decision that the challenged claims are unpatentable, or 2) non-contingent. “A motion to amend claims may cancel claims and/or propose substitute claims.” *Lectrosonics* at 3 (citing 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3)). A request to substitute claims ordinarily will be treated as contingent. *Id.* “In other words, a proposed substitute claim normally will be considered only if a preponderance of the evidence establishes that the original patent claim that it replaces is unpatentable.” *Id.* A patent owner should adopt a claim-by-claim approach to specifying the contingency of substitution, e.g., which claim is to be substituted for which claim, and under what circumstances. *Id.*

Here, the Motion refers to “replacing” original claims 1–4, 6, and 7 with “proposed substitute claims” 44–47, 49, and 50. *See* Mot. 2, 13, 15 (App. A). For example, Patent Owner notes that “a motion to amend may propose a reasonable number of substitute claims for each challenged claim,” and “proposes only one substitute claim [44] for challenged independent claim 1,” with “[d]ependent claims 2–4, 6, and 7 [] amended only by virtue of depending from proposed amended independent claim 1.” Mot. 2; *see id.* at 13 (referring to “the proposed substitute claims”), 15 (App. A) (discussing “Proposed Amended Claim 44 (replacing claim 1)” (emphasis omitted)). Patent Owner further “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.” Mot. 1.

Because Patent Owner indicates a desire to “substitute” claims, for purposes of this Preliminary Guidance, we treat the Motion as *contingent* upon a finding in a final written decision that the challenged claims are

unpatentable. *Lectrosonics* at 3 (“[A] request to substitute claims ordinarily will be treated as contingent.”). We invite Patent Owner to confirm that the Motion is contingent in its reply to Petitioner’s Opposition or in a revised motion to amend.

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 not 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 1 substitute claim for each of challenged claims 1–4, 6, and 7. Mot. 2, 15–16. Petitioner does not argue otherwise. *See generally* Opp.

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 a ground of unpatentability on which we instituted trial. Mot. 2–13. Upon review of Patent Owner’s arguments, we agree that proposed substitute independent claim 44 recites new limitations that directly respond to a ground of unpatentability involved in the trial. *See* Mot. App. A. And Patent Owner’s proposed substitute claims 45–47, 49, and 50 merely change the dependency of the original claims they replace. Petitioner does not argue otherwise. *See generally* Opp.

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