Paper No. 44
Filed: April 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION[1],

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

PTAB Case No. IPR2021-00375
Patent 8,265,096 B2

PATENT OWNER'S REVISED 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.

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I. INTRODUCTION

Patent Owner UNM Rainforest Innovations (hereinafter "UNM" or "Patent Owner") respectfully submits this Revised 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's Original Motion to Amend requested amendment of independent claim 1 to provide further limitation and clarification of its claimed invention and reflect the proper scope of this claim considering the specification. Paper 37. Petitioner filed its Opposition thereto (Paper 41), and the Board issued its Preliminary Guidance (Paper 42). This revised Motion addresses certain shortcomings identified by the Board in its Preliminary Guidance. The amendments requested in this Motion are identical to those requested in Patent Owner's original Motion to Amend (Paper 37). Patent Owner's revised Motion is contingent upon a finding in a final written decision that the challenged claims are unpatentable. Specifically, Patent Owner requests the following contingencies:

- if Claim 1 is found unpatentable, substitute Proposed Amended Claim 44, and
  - substitute Proposed Amended Claim 45 for Claim 2,

- substitute Proposed Amended Claim 46 for Claim 4,
- substitute Proposed Amended Claim 47 for Claim 5,
- substitute Proposed Amended Claim 48 for Claim 6, and
- substitute Proposed Amended Claim 50 for Claim 7.

II. MOTION TO AMEND PILOT PROGRAM

Pursuant to 84 FR 9497, Patent Owner requested 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 requested preliminary guidance from the Board on this Motion to Amend and reserved the right to file a revised Motion to Amend subject to the Board's preliminary guidance. Patent Owner now submits this Revised Motion considering the Board's Preliminary Guidance.

III. A REASONABLE NUMBER OF CLAIMS ARE AMENDED

Pursuant to 37 C.F.R. § 42.121(a)(3), a motion to amend may propose a reasonable number of substitute claims for each challenged claim. Generally, it is presumed "that only one substitute claim would be needed to replace each challenged claim," but that challenge may be rebutted by a showing of need. 37 C.F.R. § 42.121(a)(3); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4-5 (PTAB Feb. 25, 2019). Petitioners challenge independent claims 1 and 8, and dependent claims 2-4, 6, and 7. Patent Owner now proposes only one substitute claim for challenged independent claim 1. Dependent claims 2-4, 6, and 7 are amended only by virtue of depending from proposed amended independent claim 1.

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