

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.

TELEFONAKTIEBOLAGET LM ERICSSON,  
Patent Owner.

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IPR2022-00457  
Patent 9,509,440 B2

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Before SALLY C. MEDLEY, GEORGIANNA W. BRADEN, and  
NATHAN A. ENGELS, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

*Information and Guidance on Patent Owner Proposed Motion to Amend  
37 C.F.R. § 42.5(a)*

In a November 30, 2022 email to the Board, Patent Owner indicated that it seeks to file a motion to amend in the above-referenced proceeding, and requested a conference call to satisfy the requirement set forth in 37 C.F.R. § 42.121(a). Based on the facts of this proceeding, we determine that a conference call is not necessary, and the conference requirement is deemed satisfied. In this Order, we set forth general guidance for motions to amend and specific guidance for the Board's Motion to Amend Pilot Program.

*General Guidance for Motions to Amend*

The requirements for a motion to amend are set forth in 37 C.F.R. § 42.121. Although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute claims,<sup>1</sup> a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018- 01129, Paper 15 (PTAB Feb. 25, 2019) (precedential), *Amazon.com Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019) (precedential), and the Office's November 2019 Consolidated Trial Practice Guide.<sup>2</sup>

A claim listing, reproducing each proposed substitute claim, is required. 37 C.F.R. § 42.121(b). The claim listing may be filed as an appendix to the motion to amend, and shall not count toward the page limit for the motion. *Id.* §§ 42.24(a)(1), 42.121(b). Any claim with a changed scope subsequent to the amendment should be included in the claim listing

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<sup>1</sup> See *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Automotive Services Solutions, LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017).

<sup>2</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

as a proposed substitute claim and have a new claim number. This includes any dependent claim that Patent Owner intends to depend from a proposed substitute independent claim. For each proposed substitute claim, the motion to amend should identify specifically the original claim that it is intended to replace and show clearly the changes of the proposed substitute claim with respect to the original claim.

Additionally, Patent Owner must show sufficient written description support in the original specification for each proposed substitute claim. 37 C.F.R. §47.121(b)(1). Citation should be made to the original disclosure of the application as filed, rather than to the patent as issued. Patent Owner must also show sufficient written description support for the entire proposed substitute claim and not just the features added by the amendment. This applies equally to independent claims and dependent claims, even if the only amendment to the dependent claim is in the identification of the claim from which it depends. The written description support must be set forth in the motion to amend itself, not in the claim listing.

As set forth in 37 C.F.R. § 42.24, Patent Owner's motion to amend and Petitioner's opposition are each limited to twenty-five pages. 37 C.F.R. §§ 42.24(a)(1)(vi), 42.24(b)(3). Patent Owner's reply and Petitioner's sur-reply are limited to twelve pages. *Id.* § 42.24(c)(3).

*Specific Guidance for the Motion to Amend Pilot Program*

The Board's pilot program for motion to amend practice and procedure in AIA trial proceedings became effective on March 15, 2019. Practices and procedures for the pilot program are set forth in the *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. 9497 (Mar. 15, 2019)

(“Notice”).<sup>3</sup> The pilot program applies to all AIA trial proceedings instituted on or after the March 15, 2019 effective date. Because this proceeding was instituted on September 21, 2022, the pilot program is applicable to a motion to amend filed in this proceeding. Even so, Patent Owner has the opportunity to proceed with a motion to amend “in effectively the same way as current practice by not electing to either receive preliminary guidance [from the Board on a first motion to amend] or to file a revised [motion to amend].” *Id.* at 9497, 9499.

Under the pilot program, receiving preliminary guidance on a motion to amend is not automatic. Importantly, ***if Patent Owner seeks preliminary guidance from the Board on a motion to amend, an explicit request for preliminary guidance must be included in the first motion to amend*** filed no later than DUE DATE 1. If Patent Owner requests preliminary guidance in its first motion to amend, the Board will respond to Patent Owner’s request by issuing preliminary, non-binding guidance to the parties on Patent Owner’s first motion to amend. Such guidance will be provided approximately four weeks after Petitioner files an opposition to the motion to amend (or after the due date for the opposition (DUE DATE 2), if none is filed). Information regarding such guidance is set forth in the Notice.

Patent Owner has several options for addressing the Board’s preliminary guidance and/or Petitioner’s opposition, including filing a revised motion to amend on DUE DATE 3. *Id.* at 9,499–9,502. A revised motion to amend would be in lieu of a reply to Petitioner’s opposition to the motion to amend, and in place of the first motion to amend. *See L&P Property Management Co. v. Remacro Machinery and Technology*

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<sup>3</sup> The pilot program has been extended until September 16, 2024.

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*(Wujiang) Co., Ltd.*, IPR2019-00255, Paper 15 at 12–14 (PTAB June 18, 2019) (Section IV.3, providing information about Patent Owner’s options under the pilot program). Further instructions and guidance for a revised motion to amend under the pilot program are set forth in the Notice. A request for preliminary guidance is not a prerequisite for filing a revised motion to amend, and Patent Owner may file a revised motion regardless of whether it requests preliminary guidance. Notice, 9501. Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing relating to the revised motion to amend. *Id.*

The parties may not stipulate to a different due date for DUE DATE 2 related to Petitioner’s opposition to the motion to amend, or for DUE DATE 3 related to Patent Owner’s reply to the opposition to the motion to amend (or Patent Owner’s revised motion to amend), without prior authorization from the Board. *See* Paper 8, 8.

The parties should contact the Board in the event that they have any questions about the motion to amend process or require further guidance.

In consideration of the foregoing, it is hereby  
ORDERED that the conference requirement under 37 C.F.R.  
§ 42.121(a) has been satisfied.

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