

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00459
Patent 8,798,658 B2

Before SHARON FENICK, STEVEN M. AMUNDSON, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. §§ 42.5, 42.121(a)

I. INTRODUCTION

A conference call in the above proceeding was held on September 30, 2022, between respective counsel for the parties and Judges Fenick, Amundson, and Belisle. The purpose of the call was to allow Patent Owner to satisfy the requirement under 37 C.F.R. § 42.121(a) to confer with the panel prior to filing a motion to amend. This Order reiterates the discussion with the parties on the call and provides additional information and guidance regarding any proposed motion to amend.

II. DISCUSSION

During the call, Patent Owner stated that it intended to file a motion to amend but did not yet indicate whether it intended to elect the option under the MTA Pilot Program to receive preliminary guidance from the Board on the substance of any amended claims in its motion to amend. *See* 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) (“MTA Pilot Program Notice”).¹

We remind the parties that, although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute claims,² a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*,

¹ The MTA Pilot Program has been extended until September 16, 2024. *See* <https://www.federalregister.gov/public-inspection/2022-21472/extension-of-the-patent-trial-and-appeal-board-motion-to-amend-pilot-program>.

² *See Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017) (as amended Mar. 15, 2018)).

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IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). *See* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend). Patent Owner should follow the guidance provided in *Lectrosonics* and the Office's November 2019 Consolidated Trial Practice Guide to ensure that the motion to amend complies with all relevant statutory and regulatory requirements. 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. We also note that Patent Owner may only propose substitute claims, not amendments to original claims. Additionally, Patent Owner may propose only substitute claims for challenged claims, not unchallenged claims.

As we informed the parties during the call, because this *inter partes* review was instituted after March 15, 2019, the Motion to Amend Pilot Program applies. The details of the Motion to Amend Pilot Program are set forth in the MTA Pilot Program Notice. *See* 84 Fed. Reg. 9,497, as noted above. Importantly, if Patent Owner elects to seek non-binding preliminary guidance from the Board on its motion to amend, an explicit request for preliminary guidance must be included in the motion to amend filed no later than DUE DATE 1. Patent Owner has several options for addressing the Board's preliminary guidance and/or Petitioner's opposition, including filing a revised motion to amend. *See id.* at 9,499–502. We note that a request for preliminary guidance is not a prerequisite for filing a revised motion to amend, and Patent Owner may file a revised motion to amend regardless of whether it requested preliminary guidance. *See id.* at 9,501. Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing. *See id.* The parties should

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carefully consult the MTA Pilot Program Notice for further details and guidance.

As stated in our Scheduling Order, the parties may not stipulate to a different 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. Paper 9, 8.

Finally, we again remind the parties of their duty of candor pursuant to 37 C.F.R. § 42.11.

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