

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON
Patent Owner

Case No. IPR2022-00459
Patent No. 8,798,658

PATENT OWNER'S NON-CONTINGENT MOTION TO AMEND

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I. INTRODUCTION

Patent Owner Telefonaktiebolaget LM Ericsson (“Ericsson”) moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to amend U.S. Patent No. 8,798,658 (“the ‘658 Patent”). To more clearly define the scope of the claims and address the invalidity grounds set forth by Petitioner, Patent Owner respectfully requests that the Board grant this Non-Contingent Motion to Amend (the “Motion to Amend”) and issue the corresponding substitute claims presented herein.

Substitute independent claims 31, 36, 41, and 44 retain the features of original independent claims 1, 12, 22, and 26, respectively. The substitutions add narrowing features, such as by including limitations from dependent claims. The proposed substitute claims are responsive to the grounds of unpatentability at issue in this proceeding and are supported by the application as originally filed.

II. PRELIMINARY GUIDANCE FROM THE BOARD

Patent Owner requests preliminary guidance from the Board on this Motion to Amend pursuant to the Motion to Amend (MTA) Pilot Program. 86 Fed. Reg. 51656.

III. LEGAL STANDARD FOR AMENDING CLAIMS

“Before considering the patentability of any substitute claims, ... the Board first must determine whether the motion to amend meets the statutory and regulatory requirement set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.” *Lectrosonics*,

Inc. v. Zaxcom, Inc., IPR2018-01129, -01130, Paper 15 at 4 (PTAB Feb. 25, 2019).

The substitute claims must be i) presented in a claim listing; ii) reasonable in number; iii) responsive to a ground of unpatentability involved in the trial; iv) non-broadening; and v) supported by the written description. *Id.* at 4-8. The substitute claims of this Motion to Amend satisfy these requirements.

A. The Substitute Claims are Provided in a Claims Listing

The claim listing is attached as Appendix A. The claim listing cancels original claims 1-5, 12-16, 22-24, 26-28, and 30 and includes substitute claims 31-47. The substitute claims include annotations pursuant to 37 C.F.R. § 1.121(c)(2). Moreover, as stated herein, the remaining statutory and regulatory requirements for a motion to amend are met. A chart showing the substitute claims compared to the original claims is attached as Appendix B.

B. The Number of Substitute Claims is Reasonable

Pursuant to 37 C.F.R. § 42.121(a)(3), the number of substitute claims is reasonable. “There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim.” *Lectrosonics*, Paper 15 at 4. Patent Owner proposes 17 non-contingent substitute claims, each of which corresponds to a challenged claim. The number of substitute claims is presumptively reasonable based on the one-to-one relationship. *Id.* Patent Owner does not seek to

amend claims that have not been challenged in the petition. *See* Paper 1 (Pet.) at 1 (defining the “Challenged Claims” as claims 1-5, 12-16, 22-24, 26-28, and 30).

C. The Amendments Are Responsive

The proposed substitute claims are responsive to the grounds at issue in this proceeding, because they further distinguish the claims from the art of record. More specifically, the substitute claims provide clarity over the context of use of logged measurements, reporting, and indicators of additional logged measurements. Furthermore, the substitute claims also recite features not disclosed in the prior art of record.

By way of non-limiting example, independent Substitute Claims 31 and 36 are amended to recite that “the deciding is based on radio condition measurements experienced in a cell.” Dr. Valenti admitted that there is “probably not” any disclosure in Zhou (Ex. 1005) of this claim limitation. Ex. 2001 at 35:13-36:6. Nor is this limitation present in Wu (Ex. 1006) or Wu Provisional (Ex. 1007).

Independent Substitute Claims 31, 36, 41, and 44 are amended to recite that “the logged measurements comprise measurement time stamps for each performed measurement.” Dr. Valenti was not aware of any disclosure of time stamps in Zhou. Ex. 2001 (Valenti Dep. Tr.) at 40:5-16. Nor do Wu or Wu Provisional disclose time stamps for each measurement. The prior art of record also does not disclose the other features added to the independent claims, such as logged measurements that

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