

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

Case IPR2022-00468
Patent No. 10,512,027

PATENT OWNER'S CONTINGENT MOTION TO AMEND

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EXHIBIT LIST

Ex. 2001	Declaration of Kayvan B. Noroozi in Support of Motion for Admission <i>Pro Hac Vice</i>
Ex. 2002	U.S Publication No. 2018/0302841 (Application No. 15/568,431 filed September 13, 2017)
Ex. 2003	International Application No. PCT/CN2017/101576 filed Sep. 13, 2017
Ex. 2004	PCT/CN2017/070130 filed Jan. 4, 2017

I. Introduction

Telefonaktiebolaget LM Ericsson (“Ericsson” or “Patent Owner”) respectfully moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to conditionally amend challenged claims 1-8, 10-18, and 20-21 of the ’027 patent. In the event the Board finds the challenged claims unpatentable, Ericsson respectfully requests that the Board grant this motion to amend with respect to the corresponding proposed substitute 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. As shown below, this motion and the substitute claims meet all requirements of 37 C.F.R § 42.121. Moreover, the motion confirms Patent Owner’s belief that the proposed substitute claims are patentable over all known prior art, whether alone or in combination.

In light of the Federal Circuit’s *en banc* decision in *Aqua Products v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), Patent Owner need not do more. Having met its

burdens, Patent Owner is entitled to the contingent substitute claim unless
Petitioner “prove[s] all propositions of unpatentability.” *Id.* at 1310.

II. Statement of Relief Requested

Pursuant to the Board’s Pilot Program, Patent Owner requests the Board’s
Preliminary Guidance as to this Motion to Amend.

To the extent the Board finds any of original claims 1-8, 10-18 and 20-21
unpatentable, Ericsson respectfully requests that the Board grant this motion to
amend with respect to the corresponding proposed substitute claim(s) presented
herein.

III. The Substitute Claims Satisfy 37 C.F.R. § 42.121(a)

A. The substitute claims are non-broadening.

As shown in the attached claims appendix, the proposed substitute claims
retain all features of the corresponding original claims, and only add narrowing
limitations. The proposed claims thus do not enlarge the scope of the
corresponding original claims in any way. The following table specifies how each
proposed substitute claim narrows the corresponding original claim.

Substitute claim #	Original claim #	Narrowing Amendments	Broadening Amendments
22	1	<ul style="list-style-type: none">• The preamble is associated with at least one system information block group;• The received system information block groups comprise only the at least one system information block	None

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