UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ERICSSON AB,
Patent Owner.

Case IPR2022-00618
Patent No. 9,313,178

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 *Pro Hac Vice*
Ex. 2002	U.S. Patent Publ. No. 2014/0237243 (publication of U.S. Application No. 14/266,368 filed April 30, 2014)
Ex. 2003	U.S. Provisional Application Ser. No. 61/500,316, filed Jun. 23, 2011
Ex. 2004	U.S. Patent Publ. No 2012/0331293(Publication of U.S. Application Ser. No.: 13/530,997, filed on Jun. 22, 2012)

I. Introduction

Ericsson AB ("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 1-5, 7-11, 16-19 of the '178 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 1-5, 7-11, and 16-19 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 clarifying amendments. The proposed claims thus do not enlarge the scope of the corresponding original claims in any way. Rather, the clarifying amendments simply render more explicit the claim scope discussed in Patent Owner's Response. Thus, although Patent Owner believes the original claims, properly construed, already contain the requirements set forth in the contingent amended claims presented herein, Patent Owner provides the contingent amended claims in the event the Board declines to so construe the original claims.

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