

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
ZTE (USA) INC.,
AND
ZTE CORPORATION,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

IPR2020-01157 (Patent 7,274,933 B2)
IPR2020-01158 (Patent 7,460,868 B2)
IPR2020-01159 (Patent 7,596,375 B2)
IPR2020-01160 (Patent 8,275,374 B2)
IPR2020-01161 (Patent 8,472,955 B2)
IPR2020-01162 (Patent 8,948,756 B2)

Before TERRENCE W. MCMILLIN, AMANDA F. WIEKER,
MONICA S. ULLAGADDI, and RUSSELL E. CASS,
*Administrative Patent Judges.*¹

WIEKER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This is not an expanded panel. A three-judge panel is assigned to each proceeding. The parties are not authorized to use this caption.

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A conference call was held on Tuesday, May 18, 2021, between Administrative Patent Judges Wieker, McMillin, and Ullagaddi, and counsel for the parties, including Brian Buroker, for Petitioner, and Timothy Devlin, for Patent Owner. The conference call was requested by Patent Owner, to discuss motions to amend.

During the call, Patent Owner indicated that it is considering filing motions to amend in the captioned proceedings and also requesting that the panel issue preliminary guidance on any such motion(s). Patent Owner has not yet made a final decision as to whether motions to amend will be filed, and in which proceedings.

The panel reminded the parties that a motion to amend is authorized by 35 U.S.C. § 316(d), and is further regulated in 37 C.F.R. § 42.121. Any motion to amend filed by Patent Owner in these proceedings must comply with these provisions. The panel also recommended that the parties ensure familiarity with the Board's additional guidance on motions to amend, as set forth in the Consolidated Trial Practice Guide,² the Board's precedential decisions on this topic,³ and the Federal Register notice regarding the motion

² Patent Trial and Appeal Board Consolidated Trial Practice Guide, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Consolidated TPG”).

³ *See Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, 01130, Papers 15, 14 (PTAB Feb. 25, 2019), *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, IPR2018-00600, Paper 67 (PTAB July 6, 2020, *available at* <https://www.uspto.gov/patents->

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to amend pilot program.⁴

Furthermore, the panel reminded the parties that Patent Owner's Motion to Amend and Petitioner's Opposition thereto, as well as any Revised Motion to Amend filed pursuant to the pilot program, are limited to twenty-five (25) pages. 37 C.F.R. §§ 42.24(a)(1)(vi), (b)(3); Consolidated TPG at 38, 66–73. Patent Owner's Reply, and Petitioner's Sur-Reply thereto, are limited to twelve (12) pages. *Id.* § 42.24(c)(3); Consolidated TPG at 38, 73–75. Pursuant to our Scheduling Order and the parties' stipulation to move Due Date 1,⁵ these papers must be filed by May 21, 2021 (Motion); August 6, 2021 (Opposition); September 17, 2021 (Reply or Revised Motion); and October 29, 2021 (Sur-Reply).⁶ *See, e.g.*, IPR2020-01161, Paper 12, 10; IPR2020-01161, Paper 17 (Notice of Stipulation to Move Deadlines).

application-process/patent-trial-and-appeal-board/precedential-informative-decisions (last visited May 19, 2021).

⁴ 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).

⁵ The parties also have stipulated to move the portion of Due Date 2 *not* directed to motion to amend filings. *See, e.g.*, IPR2020-01161, Paper 17.

⁶ As noted in our Scheduling Order, if Patent Owner files a Revised Motion to Amend, we will enter a revised scheduling order. IPR2020-01161, Paper 12, 5.

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Counsel for Patent Owner and counsel for Petitioner indicated that they did not have any questions for the panel regarding amendment practice.

ORDER

Accordingly, in consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied its obligation, pursuant to 37 C.F.R. § 42.121(a), to confer with the Board prior to filing a motion to amend.

PETITIONER:

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PATENT OWNER:

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