

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DELL, INC.,  
ZTE (USA) INC.,  
and  
ZTE CORPORATION,  
*Petitioners*

v.

3G LICENSING S.A.,  
*Patent Owner*

Case IPR2020-1157  
Patent No. 7,274,933

**PATENT OWNER'S MOTION TO AMEND**  
**AND REQUEST FOR PRELIMINARY GUIDANCE**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
*Submitted Electronically via PTAB E2E*

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<b>Exhibit</b>	<b>Description</b>
2001	Declaration of Stu Lipoff in Support of Patent Owner
2002	Affidavit of Stephanie Berger
2003	Affidavit of Neil Benchell
2004	Affidavit of Andrew DeMarco
2005	Second Declaration of Stu Lipoff in Support of Patent Owner
2006	3rd Generation Partnership Project; Technical Specification Group Core Network; NAS Functions related to Mobile Station (MS) in idle mode (Release 7) (3GPP TS 23.122 V7.0.0) ("TS 23.122 V7.0.0")
2007	3rd Generation Partnership Project; Universal Mobile Telecommunications (UMTS); Characteristics of the USIM application (Release 6) (3GPP TS 31.102 V6.8.0) ("TS-31.102 V6.8.0")
2008	<i>"The North American Official Cellular User's Guide" Available to Help Cellular Telephone Users, Business Wire, December 18, 1990</i>
2009	<i>Amy Zuckerman, Those Black Holes in Your Mobile Phone Service, New York Times, December 24, 2000</i>
2010	<i>Nancy Gohring, Falling Short of Replacement: Wireless Carrier Plans Compete with Landline but Don't Cut it Out of the Equation, Telephony, April 27, 1998</i>
2011	<i>Judy Strausbaugh, Oh, Give me a Cell Phone Where the Signals Won't Roam, Sunday News (Lancaster, PA), May 19, 2002</i>

## I. INTRODUCTION

Patent Owner, Sisvel International S.A. (“Sisvel”) respectfully submits this Motion to Amend under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 contingent upon a finding of unpatentability with respect to the original challenged claims 2 and 3 (the “Challenged Claims”) of U.S. Patent No. 7,274,933 (“the ’933 patent”) (Ex. 1001). In addition, Patent Owner requests that the Patent Trial and Appeal Board (“PTAB”) provide preliminary guidance in accordance with the pilot program.

Patent Owner attaches the proposed substitute claims as Appendix A. Patent Owner proposes to substitute claims 2 and 3 with claims 20 and 21, respectively. Proposed substitute claims 20 and 21 include additional limitations not found in the prior art. The proposed substitute claims are presented on a contingent basis in the event the Board finds that the original claims are unpatentable.

As this motion and the First and Second Declaration of Stuart Lipoff in Support of Patent Owner (Ex. 2001; Ex. 2005) demonstrate, the substitute claims meet all of the requirements of 37 C.F.R. § 42.121. Namely, each amendment is responsive to a ground of unpatentability involved in this proceeding, none of the amendments seek to enlarge the scope of the claims or to introduce new subject matter, and the motion shows the changes that are sought and the support in the original disclosure of the patent for each substitute claim.

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