

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,  
Petitioner,

v.

3G LICENSING S.A.,  
Patent Owner.

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IPR2020-01157  
Patent 7,274,933 B2

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Before TERRENCE W. McMILLIN, AMANDA F. WIEKER, and  
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

PATENT OWNER'S CONTINGENT MOTION TO AMEND

## I. INTRODUCTION

On February 17, 2021, we instituted trial as to claims 1–4, 6–9, 11–14, and 19 of U.S. Patent No. 7,274,933 B2 (Ex. 1001, “the ’933 patent”). Paper 12. After institution, Patent Owner filed a Contingent Motion to Amend. Paper 24 (“Motion” or “Mot.”). Should we, in a final written decision, find that challenged claims 2 and 3 are unpatentable, Patent Owner proposes substitute claims 20 and 21, which correspond to challenged claims 2 and 3, respectively. Mot. 1. Petitioner filed an Opposition to the Motion. Paper 30 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requests that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* 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) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it satisfies the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129 Paper 15 (PTAB Feb. 25, 2019) (precedential); *see also* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary,

non-binding guidance from the Board to the parties about the [motion to amend].”).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We have considered, however, our Institution Decision in determining whether the amendments “respond to a ground of unpatentability involved in the trial.” *Lectrosomics*, Paper 15 at 5. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion that might be filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See* Notice, 84 Fed. Reg. at 9,500.

## II. PRELIMINARY GUIDANCE

### A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

#### 1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
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<b>Yes.</b>
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Patent Owner proposes no more than one substitute claim for each of challenged claims 2 and 3 of the '933 patent. *See* Mot. 1; *id.* at 16, App. A. Petitioner does not argue otherwise. *See generally* Opp.

## 2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

**Yes.**

Patent Owner responds to the grounds of unpatentability at pages 10–14 of the Motion. Petitioner does not argue otherwise. *See generally* Opp.

## 3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**Yes.**

Patent Owner asserts that “[p]roposed substitute claims 20 and 21 narrow the scope of claims 2 and 3, respectively,” because “[e]ach substitute claim imposes additional limitations.” Mot. 4.

Petitioner argues that proposed substitute claims 20 and 21 “negate the steps of independent claim 1 in circumstances where there is no HPLMN<sup>1</sup> list” and thus “impermissibly enlarge the scope of the claims of the patent.” Opp. 16.

At this stage of the proceeding, Petitioner appears to have the better position.

Each of original claims 2 and 3, and proposed substitute claims 20 and 21, depends from independent claim 1. Proposed substitute claims 20 and 21 contain the newly added limitation “implementing the method [or steps] of claim 1” “*only if* the HPLMN list is contained on the mobile station’s SIM or in its memory” (emphasis added). Mot. 16, App. A. Thus, proposed substitute claims 20 and 21, as written, call for “implementing the steps of

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<sup>1</sup> “HPLMN” refers to a home public land mobile network. Ex. 1001, 1:43–44.

claim 1” *only* if the necessary condition is met. If the necessary condition is not met, then proposed substitute claims 20 and 21 call for *not* implementing the steps of claim 1. In other words, each of proposed substitute claims 20 and 21, as written, covers at least two methods: one that requires implementing the steps of claim 1 (necessary condition is met) and one that requires *not* implementing the steps of claim 1 (necessary condition is not met). *Cf. Ex Parte Schulhauser*, No. 2013-007847, 2016 WL 6277792 (PTAB Apr. 28, 2016) (precedential) (discussing conditional limitations in the context of *ex parte* appeals).

Therefore, each of proposed substitute claims 20 and 21—which depends from claim 1—indicates that the steps of claim 1 are *not* performed under certain conditions, i.e., if the HPLMN list is not contained on the mobile station’s SIM or in its memory. Thus, proposed substitute claims 20 and 21, unlike original claims 2 and 3, cover situations where none of the steps of independent claim 1 are performed.

#### 4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

*For the limitation “determine whether the HPLMN list, containing a plurality of home network MCC and MNC pairs, is stored in the memory of the mobile station, in the SIM, or neither” in proposed substitute claims 20 and 21.*

**Yes.**

Patent Owner asserts that this limitation of proposed substitute claims 20 and 21 is supported by the original disclosures in U.S. Application No. 10/932,899 (“the ’899 Application”)—the application that issued as the ’933 patent—and in European Application No. 03255483, to which the ’933 patent claims priority. Mot. 5–11; Ex. 1001, codes (21), (30). Patent Owner provides a chart including citations to the ’899 and European Applications to support the limitations of proposed substitute claims 20 and 21. Mot. 5–11.

Petitioner argues that the phrase “or neither” in proposed substitute claims 20 and 21 implies that “the HPLMN list may be present in ‘neither’ the SIM nor the mobile station memory.” Opp. 6. According to

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