

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T MOBILITY LLC, AT&T SERVICES INC., ERICSSON INC.,
NOKIA OF AMERICA CORPORATION, and T-MOBILE USA, INC.
Petitioner,

v.

DAINGEAN TECHNOLOGIES LTD.,
Patent Owner.

IPR2024-00402
Patent 10,841,958 B2

Before CHRISTOPHER L. OGDEN, JOHN R. KENNY, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

HOFFMAN, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

37 C.F.R. § 42.121(e)

I. INTRODUCTION

On July 16, 2024, we instituted trial as to claims 1–4 of U.S. Patent No. 10,841,958 B2 (Ex. 1001, “the ’958 patent”). Paper 12. After institution, Patent Owner filed a Motion to Amend that is not contingent on the patentability of claims 1–4. Paper 20 (“Mot.”). Petitioner filed an Opposition on December 31, 2024. Paper 22. Petitioner’s Opposition is supported by the Second Expert Declaration of Dr. Wayne Stark (Ex. 1010).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with 37 C.F.R. § 42.121(a)(1)(ii). Mot. 1; *see* 37 C.F.R. § 42.121(e)(1); *see also Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024) (“Final Rule”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner establishes a reasonable likelihood that the substitute claims are unpatentable. 37 C.F.R. § 42.121(e)(1), (2); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121(a)(2), (a)(3), (b) (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). The reasonable likelihood standard this Preliminary Guidance applies is different than the preponderance of the evidence standard applied when ultimately deciding the Motion. *Compare*

37 C.F.R. § 42.121(e)(1) *with* § 42.121(d). Finally, this Preliminary Guidance is not a “decision” for purposes of rehearing under 37 C.F.R. § 42.71(d). 37 C.F.R. § 42.121(e)(2).

For this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. We do not address the patentability of the originally challenged claims. *See 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 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 filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision or any other subsequent decision in this proceeding. 37 C.F.R. § 42.121(e)(2); *see Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

Patent Owner bears the ultimate burden to show that its motion to amend complies with the requirements of 35 U.S.C. § 316(d)(1), (3) and 37 C.F.R. § 42.121(a)(2), (a)(3), (b)(1), and (b)(2). 37 C.F.R. § 42.121(d)(1). 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. *See* 37 C.F.R. § 42.121(e)(1).

1. Reasonable Number of Substitute Claims

A motion to amend must propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Patent Owner has shown it proposes a reasonable number of substitute claims. Patent Owner proposes four substitute claims (claims 7–10) to replace four challenged claims (claims 1–4). Mot. 1. Thus, Patent Owner proposes no more than 1 substitute claim for each challenged claim. Petitioner does not argue otherwise. *See generally* Opp.

2. Respond to Ground of Unpatentability

A motion to amend must respond to a ground of unpatentability involved in the proceeding. 37 C.F.R. § 42.121(a)(2)(i). Patent Owner has responded to a ground of unpatentability involved in this proceeding, namely Grounds 1 and 2 in the Petition. Mot. 7. Petitioner does not argue otherwise. *See generally* Opp.

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner does not appear to have met its burden to show that the Motion does not enlarge the scope of the claims of the patent.

Petitioner contends that the proposed amendments “changed the meaning of the claims so that the Substitute Claims now cover subject matter excluded from the original claims.” Opp. 2. Petitioner notes that “limitations 1g and 3e of the original claims required that ‘whether or not the second type [system information block (SIB)] has changed [be] determined based on a value tag, associated with the second type SIB.’” *Id.* According to Petitioner, the quoted original claim language

required a 1:1 relationship between the value tag and the second type SIB, so that if the second type SIB changed, the value tag would indicate that the change had occurred, and if the second type SIB had not changed, then the value tag would likewise indicate that no change had occurred. As a result, whether the second type SIB had changed could be determined by checking a single value tag, and a system that did not indicate whether a particular second type SIB had changed through its corresponding value tag would fall outside the scope of the claim.

Id. (citing Ex. 1010 ¶ 27). Thus, according to Petitioner, “systems that indicate whether one of a group of second type SIBs has changed without indicating which second type SIB changed are within the scope of the Substitute Claims even though they would be excluded from the original claims.” *Id.* at 3 (citing Ex. 1010 ¶¶ 28–30).

As a preliminary matter of interpreting the original claims, we agree with Petitioner that claims 1 and 3 require that the value tag be associated with a *particular* second type SIB. Challenged claim 1 requires “upon a change of a second type SIB” (limitation 1c) and “whether or not *the* second type SIB has changed is determined based on a value tag associated with *the* second type SIB” (limitation 1g) (emphasis added). The recitations of “the second type SIB” in limitation 1g refer back to “a second type SIB” in limitation 1c. Thus, “the second type SIB” of limitation 1g relies on limitation 1c for antecedent basis, and “the second type SIB” of limitation 1g must be the same second type SIB that underwent “a change” in limitation 1c. Thus, the determination of limitation 1g must involve the particular second type SIB identified in limitation 1c. Challenged claim 3 recites similar limitations.

We also preliminarily agree with Petitioner that proposed substitute claims 7–10 no longer require the “relationship between the value tag and the second type

SIB”¹ of the original claims discussed above. Proposed substitute independent claims 7 and 9 introduce the new limitation of “a group of *plural* second type system information blocks” (emphasis added). So, the “group” of claims 7 and 9 includes *at least* the original second type SIB as well as other second type SIBs. Thus, the proposed substitute claims recite a broader relationship between a value tag and a group. For example, proposed substitute claim 7 recites “upon a change of a second type SIB belonging to the group” (limitation 7c) and “whether or not *the group containing the second type SIB* has changed is determined based on a value tag, associated with *the group containing the second type SIB*” (limitation 7g). Thus, unlike claim 1, the particular “second type SIB” of limitation 7c need not change in order to determine that “the group containing the second type SIB has changed” in limitation 7g. All that is required to meet limitation 7g is that the determination is based on whether or not *the group* has changed, and the group contains, at least, “plural second type system information blocks.” Thus, unlike claim 1, the determination of proposed substitute claim 7 is no longer based on one particular SIB.

Additionally, to illustrate the shift in scope from original claim 1 to substitute claim 7, it may be helpful to refer to Figures 7 and 15 of the ’958 patent. As Patent Owner acknowledges, claim 1 encompasses the embodiment of Figure 7, and substitute claim 7 reads on the embodiment of Figure 15. Prelim Resp. 7; Mot. 2. However, claim 1, specifically the claim language “*whether or not* the second type SIB has changed is determined based on a value tag, associated with the

¹ The issue of whether claim 1 requires a “1:1” relationship, and the relevance of that issue, can be addressed by the parties in further briefing (assuming the same proposed substitute claims or similar proposed substitute claims are presented for trial).

second type SIB” (limitation 1g) (emphasis added), does not appear to read on Figure 15. In Figure 15, it cannot be determined “whether or not” *the* second type SIB has changed based on the value tag, because in Figure 15, the value tag indicates a change of *any* second type SIB in the group. For example, if the second type SIB changes, the value tag changes; if the second type SIB remains the same, the value tag still changes when any other second type SIB in the group changes. Thus, the embodiment of Figure 15 was not encompassed by original claim 1.

Thus, we agree with Petitioner that proposed substitute claim 7 encompasses systems that were not encompassed by original claim 1. For similar reasons, we agree proposed substitute claim 9 encompasses systems not encompassed by original claim 3. Accordingly, our preliminary view is that the proposed substitute claims enlarge the scope of the claims of the patent.

4. New Matter

A motion to amend may not introduce new subject matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). New subject matter is any addition to the claims that lacks sufficient support in the subject patent’s original disclosure. *See TurboCare Div. of Demag Delaval Turbomach. Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) (“When [an] applicant adds a claim . . . , the new claim[] . . . must find support in the original specification.”). Patent Owner also is required to show written description support in “the original disclosure of the patent for each proposed substitute claim,” and in “an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” 37 C.F.R. §§ 42.121(b)(1), 42.121(b)(2).

Patent Owner provides a table ostensibly showing written description support for each limitation of proposed substitute claims 7–10 in each of the 16/597,325, 15/659,060, and 62,368,126 applications. Mot. 6–7. Petitioner does

not argue that Patent Owner’s Motion has introduced new subject matter. Our initial, non-binding view is that Patent Owner has shown a reasonable likelihood that it has satisfied the requirements of 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii).

B. Unpatentability Arguments by Petitioner

Petitioner bears the ultimate burden to show that any proposed substitute claims are unpatentable. 37 C.F.R. § 42.121(d)(2). For the reasons discussed below, at this stage of the proceeding, and based on the current record,² it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 7–10 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

We note that Patent Owner will have the opportunity to respond to the evidence cited in Petitioner’s Opposition and this Preliminary Guidance in a Reply or in a Revised Motion in this proceeding.

1. Indefiniteness

The definiteness requirement of § 112(a) is satisfied when “a patent’s claims, viewed in light of the specification and prosecution history, in form those skilled in the art about the scope of the invention with reasonable clarity.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014); *see* 37 C.F.R. § 42.100(b) (the claim construction standard used to review a claim proposed in a motion to amend is the “same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b)”).

² We express no view on the patentability of original claims 1–4 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in Patent Owner’s Motion to Amend.

Petitioner contends that “the requirement that the ‘group of plural second type [SIBs]’ be ‘fewer than the total number of second type [SIBs],’ combined with the claims’ lack of any requirements for the second type SIBs and the open nature of the claims, renders the [proposed substitute] claims indefinite.” Opp. 3–4. According to Petitioner, “the Substitute Claims recite two types of information block – a first type SIB and a second type SIB – but only impose limitations on the first type SIB.” *Id.* at 4 (citing Ex. 1010 ¶¶ 31–32). In contrast, “the second type SIB could include any kind of information, and the claim would permit other kinds of SIBs to also exist, and for SIBs to be of more than one type.” *Id.* Petitioner argues that “[t]here could be third or fourth type SIBs, or the first type SIB could also be a second type SIB,” and further that “[b]ecause the claims fail to define what is or is not a ‘second type SIB,’ the requirement that the recited ‘group of plural second type [SIBs]’ be ‘fewer than the total number of second type [SIBs]’ is subjective and arbitrary.” *Id.* (citing Ex. 1010 ¶ 33). Petitioner contends that,

in a system with many types of SIBs, each with its own value tag, this limitation can be satisfied by asserting that all of those types of SIBs are second-type SIBs, or can be avoided by asserting that each SIB corresponding to a different value tag is its own type of SIB, so that value tag A corresponded to SIBs of type A, value tag B corresponded to SIBs of type B, and so on. Ex. 1010 ¶ 33. In other words, the exact same arrangement of system information may or may not practice this limitation based solely on an [arbitrary] classification of SIBs into groups or sub-groups.

Id. at 5.

At this preliminary stage, without the benefit of evidence and argument from Patent Owner on this issue, we tend to agree with Petitioner that proposed substitute claims 7–10 lack reasonable clarity regarding the claimed “second type SIB” and “the total number of second type information blocks.”

A term is not unclear merely because it is broad, so long as the boundaries can be ascertained with reasonable certainty. *See BASF Corp. v. Johnson Matthey Inc.*, 875 F.3d 1360, 1367 (Fed. Cir. 2017) (“[T]he inference of indefiniteness simply from the scope finding is legally incorrect: ‘breadth is not indefiniteness.’” (quoting *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005))). Here, we are concerned that the breadth of the term “a second type SIB” in proposed substitute claims 7 and 9 cannot be ascertained with reasonable certainty, particularly with respect to “the total number of second type information blocks.” We do not see how a person skilled in the art would be able to ascertain the “number of second type information blocks” to arrive at “the total” number with any reasonable certainty. As Petitioner points out (Opp. 4), the claims do not exclude overlap between the first and second types of SIB. Although proposed substitute claims 7 and 9 recite “the first type SIB being required for the wireless terminal to perform an initial access to the radio access network,” the scope of the claimed “second type SIB” could also encompass information that is “required for the wireless terminal to perform an initial access to the radio access network.” The possible overlap between the first and second type SIBs leaves open the question of whether to include other first type SIBs when ascertaining the total number of second type SIBs. Also, as Petitioner points out, “[t]here could be third or fourth type SIBs” (Opp. 4), and a person skilled in the art would not know how to differentiate between the second type SIB and the third or fourth types. Although the Specification discloses a “SIB type classifier 60” that “defines the plural categories or types of system information,” the proposed substitute claims do not recite a classifier or classifying. Ex. 1001, 8:20–22.

2. Obviousness

On the current record, Petitioner appears to have shown a reasonable likelihood that proposed substitute claims 7–10 would have been obvious over Lee (Ex. 1004) and Agiwal (Ex. 1008). Opp. 10–15.

We previously addressed Petitioner’s mapping of original claims 1–4 onto Lee in our decision granting institution (Paper 12). In this Preliminary Guidance, we focus on limitations added to the claims in Patent Owner’s Motion to Amend.

i. Lee

In its Opposition to the Motion to Amend, Petitioner provides a detailed, limitation-by-limitation analysis explaining how Lee discloses every newly added limitation of proposed substitute claims 7–10. Opp. 5–10. Notably, regarding the newly added limitation of “[value tags] associated with a group of plural second type system information blocks fewer than the total number of second type information blocks, wherein each of the second type information blocks in the group has different sibIDs and the group has a group identifier” (limitations 7b and 9a), Petitioner contends that Lee teaches second type SIBs having a sibID, grouping second type SIBs according to different services (such as MBMS, D2D, V2X, or WLAN), and identifying SIBs by the service with which they are associated, where value tags apply to the SIBs for a particular service. *Id.* at 6–7 (citing Ex. 1010 ¶¶ 42–45; Ex. 1004 ¶¶ 71, 118, 168, 175–178).

On this preliminary record, Petitioner’s contentions regarding the disclosure of Lee appear to be reasonably well-supported by the evidence.

ii. Lee and Agiwal

In addition, Petitioner introduces a new reference, Agiwal (Ex. 1008), and argues that Agiwal also discloses, *inter alia*, the concept of “grouping system

information blocks to use one value tag across a group of blocks to indicate changes in system information.” Opp. 11. We now focus our analysis on Petitioner’s proposed combination of Lee and Agiwal.

Agiwal is titled “Apparatus and Method for Signaling System Information” and “relates to a wireless communication system” and “[m]ore particularly, the present disclosure relates to an apparatus and method for transmitting and receiving system information.” Ex. 1008, code (54), ¶ 2. Agiwal provides “a method for receiving system information (SI) by a UE in a wireless communication system.” *Id.* ¶ 16. Agiwal’s method includes “receiving, from a base station (BS), first type SI associated with SI which is essential for communication with the BS,” and “transmitting, to the BS, a physical random access channel (PRACH) preamble based on the first type SI.” *Id.* The method further includes “receiving, from the BS, a random access response (RAR) message, and receiving, from the BS, second type SI associated with at least one SI which the UE needs.” *Id.*

Petitioner contends that the proposed combination of Lee and Agiwal discloses each limitation of proposed substitute claims 7–10. Opp. 10–15. Based on the current preliminary record, Petitioner also provides a reasonable motivation for the combination of Lee and Agiwal, namely “conserving resources.” *Id.* at 12 (citing Ex. 1010 ¶ 40).

Regarding the newly added limitation of “[value tags] associated with a group of plural second type system information blocks fewer than the total number of second type information blocks, wherein each of the second type information blocks in the group has different sibIDs and the group has a group identifier” (limitations 7b and 9a), Petitioner contends Agiwal teaches groups of second-type SIBs with associated individual and group identifiers. Opp. 13 (citing Ex. 1008

¶¶ 66–68, 256, Fig. 3; Ex. 1010 ¶¶ 46–47). Petitioner further contends that “Agiwal’s teaching of second-type SIBs in more than one group indicates that at least some of Agiwal’s groups include two or more second-type SIBs, and less than all second-type SIBs.” *Id.* at 13 (citing Ex. 1010 ¶ 46). Thus, according to Petitioner, “a [person of ordinary skill in the art (POSITA)] combining Lee and Agiwal would include in the combined system’s first-type SIB an identification of second-type SIBs and SIB groups with their associated distribution information and value tags.” *Id.* (citing Ex. 1010 ¶¶ 48, 58).

Regarding amended limitations 7c and 9b, Petitioner contends that “Agiwal teaches both that updated system information may be broadcast for a defined period and that, in response to receiving many requests for on-demand system information, the system may switch system information from on demand to broadcast.” Opp. 14 (citing Ex. 1008 ¶¶ 79, 263; Ex. 1010 ¶ 50).

Regarding amended limitations 7g and 9e, Petitioner contends that “Agiwal teaches the organization of system information blocks into groups with corresponding value tags that, when changed, indicate a change in the corresponding group of system information blocks.” Opp. 14 (citing Ex. 1008 ¶ 256).

Regarding proposed substitute dependent claims 8 and 10, Petitioner contends that “Agiwal teaches the transmission of the supported groups of system information blocks as well as the value tag corresponding to each group.” Opp. 15 (citing Ex. 1008 ¶¶ 67, 256).

On this preliminary record, Petitioner’s contentions regarding the disclosure of Agiwal appear to be reasonably well-supported by the evidence.

Again, we note that Patent Owner will have an opportunity to respond to Petitioner’s contentions in a Reply or in a Revised Motion in this proceeding.

III. CONCLUSION

This concludes our Preliminary Guidance. Patent Owner has the option to reply to this Preliminary Guidance *or* to file a revised MTA by DUE DATE 3. 37 C.F.R. § 42.121(e)(3), (f); Paper 13. Patent Owner's reply or revised MTA may only respond to this Preliminary Guidance or Petitioner's Opposition and may be accompanied by new evidence (including declarations). 37 C.F.R. § 42.121(e)(3). Petitioner has the option to file a sur-reply responsive to this Preliminary Guidance, Patent Owner's reply, or Patent Owner's revised MTA but may not present new evidence in any case. 37 C.F.R. § 42.121(e)(3). Petitioner may also file a reply to the preliminary guidance in the case Patent Owner does not file a reply or revised MTA. 37 C.F.R. § 42.121(e)(4).

In addition, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

IPR2024-00402
Patent 10,841,958 B2

FOR PETITIONER:

Scott Hejny
Eric Hansen
McKOO SMITH P.C.
shejny@mckoolsmith.com
ehansen@mckoolsmith.com

FOR PATENT OWNER:

Joshua Wyde
ALAVI & ANAIPAKOS PLLC
jwyde@aatriallaw.com

Christopher Limbacher
HEIM, PAYNE & CHORUSH, LLP
climbacher@hpcllp.com