

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner,

v.

BELDEN CANADA ULC,
Patent Owner.

Case No. IPR2024-01227
Patent 11,435,542 B2

**PATENT OWNER'S
MOTION TO AMEND**

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EXHIBIT LIST

EXHIBIT	DESCRIPTION
1001	U.S. Patent No. 11,435,542 B2 (“the ’542 Patent”)
1002	File history of the ’542 Patent (U.S. Patent Application No. 17/010,113) (“the ’113 Application”)
1004	U.S. Patent No. 10,101,551 (“Fukui”)
1006	U.S. Patent 9,690,064 (“Sauter”)
2001	Declaration of Dr. Charles A. Eldering In Support Of Patent Owner’s Motion to Amend (“Eldering”)
2002	U.S. Provisional Patent Application No. 62/567,339 (“the Provisional Application”)
2003	U.S. Patent Application No. 16/143,831 (“the ’831 Application”)
2004	Excerpts from file history of U.S. Patent Application No. 18/328,431

I. INTRODUCTION

Patent Owner Belden Canada ULC respectfully submits this Non-Contingent Motion to Amend under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to request amendment of certain claims of U.S. Patent No. 11,435,542 B2 (“the ’542 Patent”) (Ex. 1001) to more narrowly define the invention to patentably distinguish the prior art references identified in the invalidity grounds set forth in the Petition (Paper 1). The Board authorized this motion in an email dated May 1, 2025.

Patent Owner requests that the Board cancel all of the challenged claims (*i.e.*, claims 1-5 and 8-13) and amend and issue substitute claims 14-16 (“Substitute Claims”). *See* Appendix A (claim listing showing amendments). Because this Motion satisfies all the statutory and regulatory requirements for a motion to amend, Patent owner respectfully requests that the Board grant this Motion to Amend and issue each of the Substitute Claims.

II. STATEMENT OF RELIEF REQUESTED

First, Patent Owner requests preliminary guidance from the Board on this Motion to Amend pursuant to 37 C.F.R. § 42.121(a)(1)(ii).

Second, Patent Owner requests that the Board cancel all of the challenged

claims (*i.e.*, claims 1-5 and 8-13).¹

Third, Patent Owner requests that the Board grant this Motion to Amend and issue each of Substitute Claims 14-16.

III. THE SUBSTITUTE CLAIMS MEET ALL REQUIREMENTS OF 35 U.S.C. § 316 AND 37 C.F.R. § 42.121.

The Board “must determine whether the motion to amend meets the statutory and regulatory requirements 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) (precedential). The requirements are: (1) the motion must include a

¹ Mindful of the finite resources of the Board and seeking to efficiently reach conclusion of this Trial, Patent Owner is not concurrently filing a Response and this Motion is non-contingent. Accordingly, the Board need not address the patentability of the challenged claims. *See, e.g., Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-00933, Paper 31 at 3 n.5 (PTAB Dec. 3, 2019) (“Because we grant the Motion to Amend, which is a non-contingent motion, ... we need not address the patentability of [the challenged claims].”); *NXP USA, Inc. v. Impinj, Inc.*, IPR2020-00514, Paper 37 at 9 (PTAB Aug. 11, 2021) (“As Patent Owner’s non-contingent Revised Motion to Amend cancels all of the challenged claims, we address only Patent Owner’s proposed substitute claims”)

claim listing reproducing each substitute claim; (2) the motion proposes a reasonable number of substitute claims; (3) the amendments do not seek to enlarge the scope of the challenged claims; (4) the substitute claims are supported in the original disclosure and do not introduce new matter; and (5) the amendments respond to a ground of unpatentability involved in the trial. *Id.* at 4-8.

The Board must then assess the patentability of the proposed Substitute Claims “without placing the burden of persuasion on the patent owner.” *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1328 (Fed. Cir. 2017) (en banc); *see also Lectrosonics*, Paper 15 at 3–4. Rather, in a Motion to Amend, a patent owner need only satisfy its burden of production under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, which it has done as detailed below.

A. The Substitute Claims Are Provided In The Attached Claim Listing In Accordance With 37 C.F.R. § 42.121(b).

Patent Owner attaches the claim listing as Appendix A. As reflected in the claim listing, Patent Owner requests that the Board cancel claims 1-5 and 8-13 and enter Substitute Claims 14-16. Changes to the original claims are shown by underlining inserted text and bracketing deleted text in the Substitute Claims.

B. Patent Owner Proposes A Reasonable Number Of Substitute Claims In Accordance With 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3).

“There is a rebuttable presumption that a reasonable number of substitute

claims per challenged claim is one (1) substitute claim.” *Lectrosonics*, Paper 15 at 4; *see also* 37 C.F.R. § 42.121(a)(3) (“The presumption is that only one substitute claim will be needed to replace each challenged claim”). Patent Owner’s proposal of 3 non-contingent claims, which is less than the 11 challenged claims, is reasonable.

C. The Amendments Do Not Enlarge The Scope Of The Challenged Claims In Accordance With 35 U.S.C. § 316(d)(3) And 37 C.F.R. § 42.121(a)(2)(ii).

The Substitute Claims do not enlarge the scope of the original claims. Instead, substitute independent claim 14 introduces several additional limitations that narrow the scope of original claim 1 that it replaces. *Lectrosonics*, Paper 15 at 7 (“[A] proposed substitute claim adding a novel and nonobvious feature or combination to avoid the prior art ... will not enlarge the scope of the claims.”).

For example, substitute claim 14 is narrowed by further (i) requiring that the tray has a width dimensioned to receive at least twelve standard width units side by side, (ii) requiring that the tray is configured to be mounted in a 19-inch rack; (iii) requiring a tab portion configured to extend from a rear portion of the cassette to allow release of the cassette from the tray; and (iv) requiring that each of the cassettes *consists of* only four fiber optic plug receiving receptacles for each standard width unit.

Substitute dependent claims 15 and 16, which rewrite challenged dependent

claims 3 and 5, respectively, to ultimately depend from substitute independent claim 14, are also necessarily narrower than the challenged claims due to their dependency from the substitute independent claim.

As a result, none of the Substitute Claims enlarge the scope of the challenged claims.

D. The Substitute Claims Have Written Description Support And Do Not Introduce New Matter In Accordance With 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii), (b).

The application that eventually issued as the '542 Patent (U.S. Patent Application No. 17/010,113) ("the '113 Application") (Ex. 1002 pp. 16-40) claims priority to U.S. Provisional Patent Application No. 62/567,339) ("the Provisional Application") (Ex. 2002), filed October 3, 2017, which is the earliest claimed priority date, and the originally filed non-provisional application (U.S. Patent Application No. 16/143,831) ("the '831 Application") (Ex. 2003), filed September 27, 2018. The specification and figures of the '113 Application are nearly identical to the specifications and figures of the Provisional Application and the parent '831 Application. *Compare, e.g.*, Ex. 1002 pp 20-40, ¶¶ [0003], [0005]-[0024], FIGS. 1-7B; Ex. 2002 ¶¶ [0003]-[0023], FIGS. 1-7B; and Ex. 2003 ¶¶ [0003], [0006]-[0025], FIGS. 1-7B.

The proposed Substitute Claims have written description support in both the Provisional Application (Ex. 2002) and the parent '831 Application" (Ex. 2003). In

the table below, Patent Owner provides non-limiting citations to the exemplary portions of these applications confirming that they each provide written description support for the Substitute Claims. While the table quotes and recites the limitations added by amendment in the Substitute Claims and not the limitations from the original claims for space reasons, the cited support is provided for all limitations in the Substitute Claims.

Claim/ Element²	Limitations Added By Amendment	Support In Provisional Application (Ex. 2002)	Support In '831 Application (Ex. 2003)
14pre	-	<i>See, e.g.,</i> Title, ¶¶ [0001], [0003], [0011], [0016], [0018]-[0020], Claim 1, FIGS. 1-5C.	<i>See, e.g.,</i> Title, Abstract, ¶¶ [0001], [0003], [0013], [0018], [0020]-[0022], Claim 1, FIGS. 1-5C.
14A	-	<i>See, e.g.,</i> ¶¶ [0002]-[0003], [0011], Claim 1, FIGS. 1, 3, 5A-5C.	<i>See, e.g.,</i> Abstract, ¶¶ [0002]-[0003], [0013], Claim 1, FIGS. 1, 3, 5A-5C.

² Claim element designations for substitute independent claim 14 are identified in the claim listing in Appendix A and are based on the designations used in the Petition for the original claims. Paper 1 (Pet.) at 143-145.

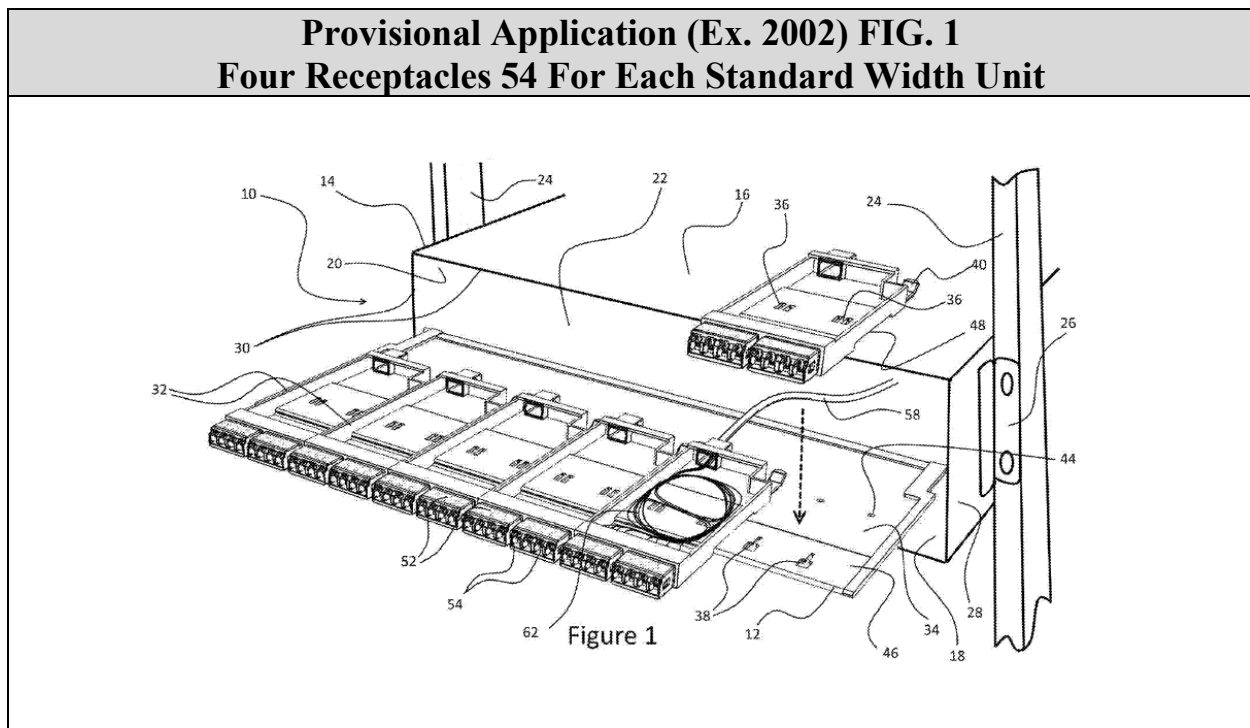
Claim/ Element ²	Limitations Added By Amendment	Support In Provisional Application (Ex. 2002)	Support In '831 Application (Ex. 2003)
14B	<u>wherein said tray has a width dimensioned to receive at least twelve standard width units side by side and is configured to be mounted in a 19-inch rack</u>	<i>See, e.g.</i> , ¶¶ [0003], [0011], [0014], [0017], Claim 1, FIGS. 1, 3-5C.	<i>See, e.g.</i> , Abstract, ¶¶ [0003], [0013], [0016], [0019], Claims 1, 2, FIGS. 1, 3-5C.
14C	-	<i>See, e.g.</i> , ¶¶ [0001], [0003], [0012], [0014], [0017]-[0020], Claim 1, FIGS. 1-3, 5A-5C.	<i>See, e.g.</i> , Abstract, ¶¶ [0001], [0003], [0014], [0016], [0019]-[0022], Claim 1, FIGS. 1-3, 5A-5C.
14D	-	<i>See, e.g.</i> , ¶¶ [0003], [0012], Claim 1, FIGS. 1-2B.	<i>See, e.g.</i> , Abstract, ¶¶ [0003], [0014], Claim 1, FIGS. 1-2B.
14D1	<u>a tab portion configured to extend from a rear portion of each of the cassettes and above the tray and to allow each of the cassettes to be released from said tray</u>	<i>See, e.g.</i> , ¶ [0012], FIGS. 1-2B.	<i>See, e.g.</i> , ¶ [0014], FIGS. 1-2B.

Claim/ Element ²	Limitations Added By Amendment	Support In Provisional Application (Ex. 2002)	Support In '831 Application (Ex. 2003)
14D2	<u>wherein each of said cassettes consists of only four fiber optic plug receiving receptacles for each standard width unit arranged side by side in a row along a front thereof</u>	<i>See, e.g.</i> , ¶¶ [0003], [0013]-[0014], Claim 1, FIGS. 1-4D.	<i>See, e.g.</i> , ¶¶ [0015]-[0016], Claim 4, FIGS. 1-4D.
14E	-	<i>See, e.g.</i> , ¶¶ [0003], [0012], [0014], Claim 1, FIGS. 1, 3-5C.	<i>See, e.g.</i> , Abstract, ¶¶ [0003], [0014], [0016], Claims 1, 2, 4, FIGS. 1, 3-5C.
15	-	<i>See, e.g.</i> , ¶ [0013], FIGS. 1, 2A-2B.	<i>See, e.g.</i> , ¶¶ [0005], [0015], Claim 3, FIGS. 1, 2A-2B.
16	-	<i>See, e.g.</i> , ¶¶ [0003], [0011], Claim 1, FIG. 1.	<i>See, e.g.</i> , ¶ [0013], Claim 5, FIG. 1.

Patent Owner also submits the declaration of Dr. Charles Eldering (Ex. 2001), who provides expert testimony regarding how a person of ordinary skill in the art (“POSITA”) would readily understand that, based on the disclosures of the Provisional Application and the ’831 Application, the inventors possessed the subject matter of the Substitute Claims, including the limitations added by amendment, as of the respective filing dates of those applications. Ex. 2001 ¶¶ 14-16. A POSITA also would understand that the written descriptions of the Provisional Application and the ’831 Application are sufficient to inform a POSITA how to

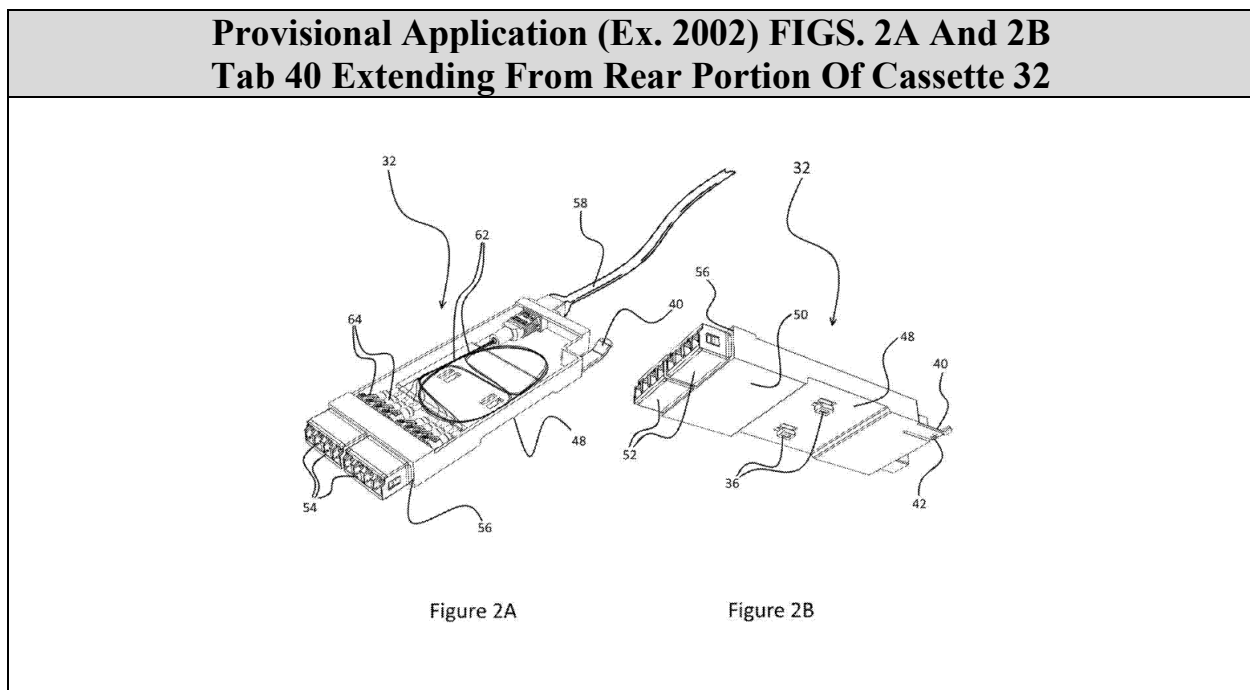
make and use the inventions recited in the Substitute Claims. Ex. 2001 ¶ 22.

For example, the additional limitation requiring that each of the cassettes consists of only four fiber optic plug receiving receptacles for each standard width unit arranged side by side in a row along a front thereof (claim element 14D2) is disclosed in at least paragraph [0003] (“each of the cassettes comprising four fiber optic plug receiving receptacles arranged side by side in a row along a front thereof for each standard width unit”) and FIG. 1 of the Provisional Application shown below (Ex. 2002) (four receptacles 54 per receiving module 52). Ex. 2001 ¶ 19.



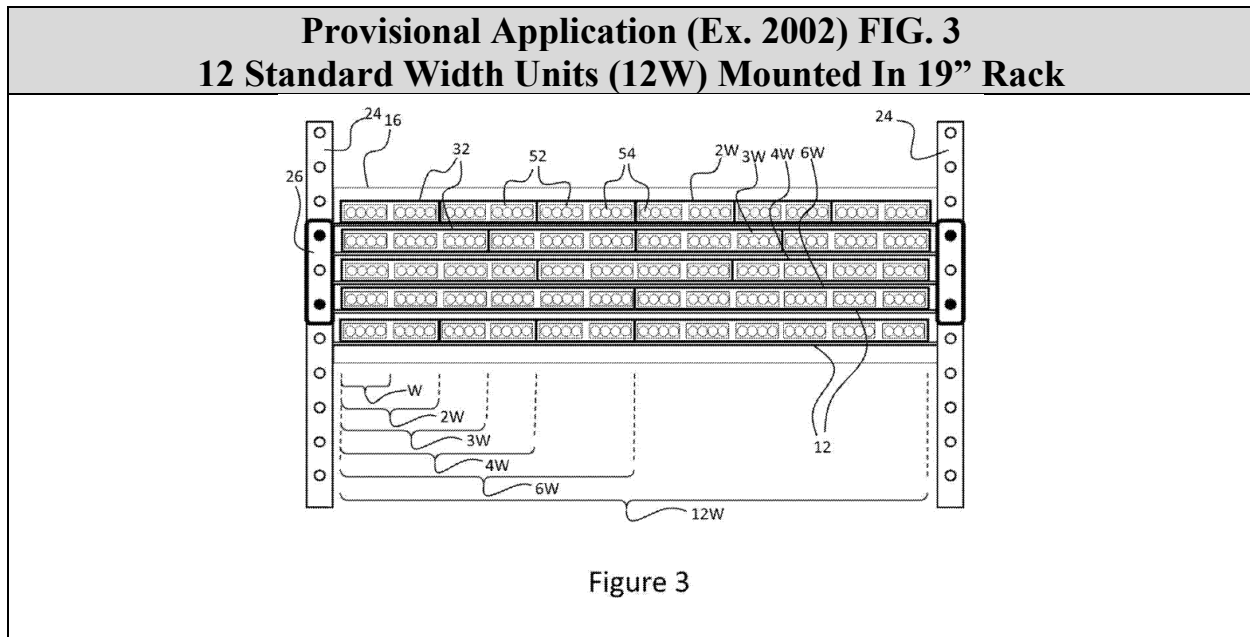
Similarly, the additional limitation requiring a tab portion extending from a rear portion of each cassette and above the tray for releasing cassettes (claim element 14D1) is disclosed in at least paragraph [0012] (“A flexible tab 40 is also provided

which comprises a boss 42 that engages a respective aperture 44 machined or otherwise formed in the tray 12 when the tabs 36 are engaged within their respective slots 38, thereby releasably securing the cassette 32 to the tray 12.”) and FIGS. 2A and 2B of the Provisional Application (Ex. 2002) shown below (tab 40). Ex. 2001 ¶ 20.



Finally, the additional limitation requiring a tray width dimensioned to receive at least twelve standard width units side by side and to be mounted in a 19-inch rack (claim element 14B) is disclosed in at least paragraph [0011] (“In a particular illustrated embodiment the system 10 is shown for mounting in a 19” rack”), paragraph [0014] (“The 2W, 3W, 4W and 6W cassettes 32 are typically used only with like cassettes 32 as illustrated and such that respectively

six (6), four (4), three (3) and two (2) cassettes fit snugly side by side on the 12W tray”), and FIG. 3 of the Provisional Application (Ex. 2002) shown below (“12W”). Ex. 2001 ¶ 21.



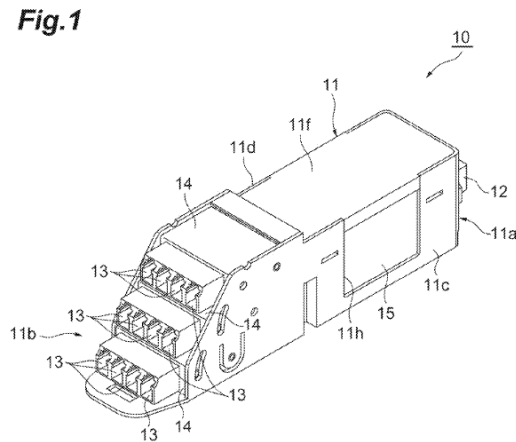
E. The Amendments Are Responsive To The Grounds Of Unpatentability In Accordance With 37 C.F.R. § 42.121(a)(2)(i).

The combination of additional claim limitations presented in the Substitute Claims are responsive to instituted grounds in this proceeding, distinguishing the claims from the prior art of record.³

³ The Substitute Claims also include amendments that address potential antecedent basis issues and/or obvious typographical errors. *See Lectrosonics*, Paper 15 at 6 (“[O]nce a proposed claim includes amendments to address a prior art ground in

For example, regarding the claim limitation requiring that each of the cassettes consists of only four fiber optic plug receiving receptacles for each standard width unit arranged side by side in a row along a front thereof (claim element 14D2), Fukui (Ex. 1004), the primary reference for Grounds 1-2 (Pet. 27-86), instead discloses a cassette consisting of twelve fiber optic plug receiving receptacles (13) for each standard width unit. *See* Fukui FIGS. 1, 4.

Fukui (Ex. 1004) FIG. 1
Twelve Fiber Optic Plug Receiving Receptacles (13)
For Each Standard Width Unit



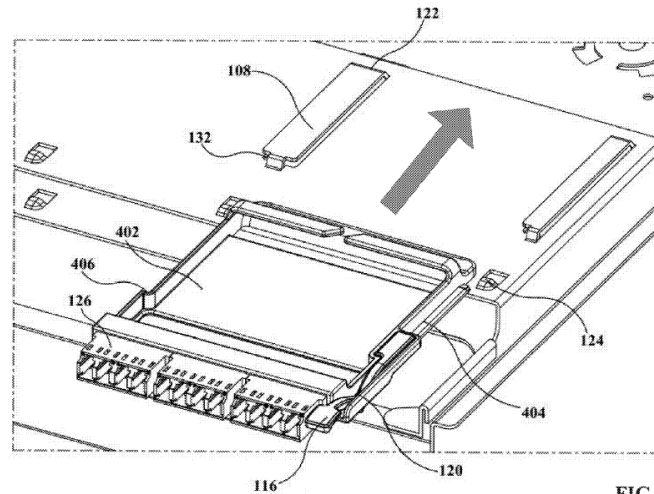
Indeed, the Examiner of a pending continuation application (U.S. Patent Application No. 18/328,431) in the same family as the '542 Patent recently agreed that this

the trial, a patent owner also may include additional limitations to address potential § 101 or § 112 issues, if necessary.”)

limitation was missing from Fukui in allowing the pending claims after this limitation was added by amendment to overcome a rejection based on Fukui. *See* Ex. 2004 pp. 5-44 (office action rejecting claims as anticipated or obvious in view of Fukui), 47-48 (office action response introducing new claim 118 adding the limitation “wherein the receptacle module is configured to consist of only four fiber optic plug receiving receptacle portions in a standard one width (1W) unit”), 75-76 (office action explaining that Fukui does not disclose or suggest this additional limitation), 87 (Examiner’s reasons for allowance stating that “the prior art does not disclose or reasonably suggest ... wherein the receptacle module is configured to consist of only four fiber optic plug receiving receptacle portions in a standard one width (1W) unit, in combination with the remaining limitations of the claims”), 91 (issue notification that U.S. Patent No. 12,313,896 will issue on May 27, 2025).

Furthermore, regarding the claimed tab portion extending from a rear portion of each cassette and above the tray for releasing cassettes (claim element 14D1), Fukui instead discloses hooks 11i, 11j for securing the cassette to the tray that extend from the bottom of the cassette and extend through and below the tray. *See* Fukui 8:52-56, FIG. 2.

**Sauter (Ex. 1006) FIG. 4
Front-Facing Release Latch 116**



In addition, Sauter fails to disclose the claimed tray width dimensioned to receive at least twelve standard width units side by side and to be mounted in a 19-inch rack (claim element 14B), and instead is silent regarding any tray dimensions, only providing unscaled drawings.

IV. THE SUBSTITUTE CLAIMS ARE PATENTABLE.

“A Patent Owner does not bear the burden of persuasion to demonstrate the patentability of substitute claims presented in a motion to amend.” *Lectrosonics*, Paper 15 at 4. Rather, “the burden of persuasion ordinarily will lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence.” Here, the additional claim elements of proposed independent amended claims are not taught by the prior art combinations used by Petitioner to

challenge the original claims. Accordingly, Petitioners have not met their burden to show that the proposed Substitute Claims are unpatentable by a preponderance of the evidence.

V. CONCLUSION

Because this Motion satisfies all the statutory and regulatory requirements for a motion to amend, Patent owner respectfully requests that the Board grant this Motion to Amend and issue each of the Substitute Claims.

Date: May 21, 2025

Respectfully submitted,

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Filed May 21, 2025

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER'S MOTION TO AMEND** was served pursuant to 37 C.F.R. § 42.6(e) via electronic mail on May 21, 2025 on the following:

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APPENDIX A

CLAIM LISTING – '542 PATENT

1.-5. (Cancelled)

8.-13. (Cancelled)

14. (substitute for original claim 1) *[14pre]*¹ A modular fiber optic cassette system, the system comprising:

[14A] a case comprising a top and a bottom wall and two opposed side walls, each of said sidewalls attached between respective side edges of said top and bottom wall, said walls together defining a tray receiving space there between and a forward edge of each said wall together defining an opening to said tray receiving space;

[14B] at least one tray slideably received within said tray receiving space for movement between a stored position wherein said tray is completely inside said tray receiving space and an accessible position wherein a front end of said tray is in front of said opening and outside of said tray receiving space, wherein said tray has a width dimensioned to receive

¹ Bracketed designations of independent claim elements are based on the designations used in the Petition for the original claims. Paper 1 (Pet.) at 143-144.

at least twelve standard width units side by side and is configured to be mounted in a 19-inch rack;

[14C] a set of fiber optic cassettes, a selected plurality of the cassettes arrangeable side by side along said tray front end wherein each of said cassettes comprises a plurality of fiber optic plug receiving receptacles arranged side by side in a row along a front thereof, a first of said set of cassettes comprising a first cassette width as measured between outer side edges thereof of one of one two three, four and six standard width units and a second of said cassettes comprising a second cassette width as measured between outer side edges thereof different from said first cassette width and one of one two three four and six standard width units; [and]

[14D] a fastener for removeably securing each of said cassettes to said tray;

[14D1] a tab portion configured to extend from a rear portion of each of the cassettes and above the tray and to allow each of the cassettes to be released from said tray;

[14D2] wherein each of said cassettes consists of only four fiber optic plug receiving receptacles for each standard width unit arranged side by side in a row along a front thereof; and

[14E] wherein when arranged on the tray an outer side edge of each of said selected cassettes is directly adjacent an outer side edge of at least one other selected cassette.

15. (substitute for original claim 3) The modular fiber optic cassette system of claim [1] 14, wherein each of said cassettes comprises a multi fiber connector receiving receptacle arranged on a rear thereof and a plurality of optic fibers, one of said optic fibers interconnecting a respective one of said fiber optic plug receiving receptacles with said multi fiber connector receiving receptacle.

16. (substitute for original claim 5) The modular fiber optic cassette system of claim [1] 14, wherein said system is for mounting in a rack and further comprising a pair of mounting brackets, one of said brackets attached to each of said sidewalls on either side of an outside of said case, said mounting brackets for securing said case to the rack.