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Paper 22
Entered: June 10, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and
LENOVO (UNITED STATES) INC.,
Petitioner,

v.

ERICSSON AB,
Patent Owner.

IPR2025-00003, Patent 9,313,178 B2
IPR2025-00004, Patent 11,122,313 B2[1]

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, and SCOTT RAEVSKY, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. §§ 42.5, 42.121(a)

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[1] This Order applies to each of the above-identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

I. Introduction

A conference call in the above proceeding was held on Tuesday, June 10, 2025, between respective counsel for the parties and Judges Braden, Beamer, and Raevsky. The purpose of the call was to allow Patent Owner to satisfy the requirement under to 37 C.F.R. § 42.121(a) to confer with the panel prior to filing a motion to amend. This Order reiterates the discussion with the parties on the call and provides additional information and guidance regarding any proposed motion to amend

II. Discussion

During the call, Patent Owner stated that it intended to file a motion to amend but did not yet indicate that it intended to elect the option of requesting preliminary guidance from the Board on the substance of any amended claims in its motion to amend. *See* "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 (effective Oct. 18, 2024); 37 C.F.R. § 42.121(e).

We remind the parties that, although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute claims,[2] a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). *See* 35 U.S.C.

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[2] *See Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017) (as amended Mar. 15, 2018)).

§ 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend). Patent Owner should follow the guidance provided in *Lectrosonics* and the relevant parts of the Office's November 2019 Consolidated Trial Practice Guide to ensure that the motion to amend complies with all relevant statutory and regulatory requirements. 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at https://www.uspto.gov/TrialPracticeGuideConsolidated. We also note that Patent Owner may only propose substitute claims, not amendments to original claims. Additionally, Patent Owner may propose only substitute claims for challenged claims, not unchallenged claims.

As we informed the parties during the call, the USPTO recently published changes to the rules concerning motions to amend to codify MTA Pilot Program in effect since March 15, 2019. 89 Fed. Reg. 76,421. Importantly, if Patent Owner elects to seek non-binding preliminary guidance from the Board on its motion to amend, an explicit request for preliminary guidance must be included in the motion to amend filed no later than DUE DATE 1. 37 C.F.R. § 42.121(a)(1)(ii). Patent Owner has several options for addressing the Board's preliminary guidance and/or Petitioner's opposition, including filing a revised motion to amend. 37 C.F.R. § 42.121(f). Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing. 89 Fed. Reg. 76,426.

As we further noted on the call, and as stated in our Scheduling Order, the parties may not stipulate to a different date for DUE DATE 2 related to Petitioner's opposition to the motion to amend, or for DUE DATE 3 related to Patent Owner's reply to the opposition to the motion to amend (or Patent

Owner's revised motion to amend), without prior authorization from the Board. Paper 15, 7.

Finally, we again remind the parties of their duty of candor pursuant to 37 C.F.R. § 42.11.

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