

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

KONINKLIJKE KPN N.V.,
Patent Owner.

IPR2022-00068
Patent 9,549,426 C1

Before KEVIN F. TURNER, NORMAN H. BEAMER, and
RUSSELL E. CASS, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On May 25, 2022, we instituted trial as to claims 6, 8–10, 14, and 18 of U.S. Patent No. 9,549,426 C1 (“the ’426 patent”). Paper 13 (“Decision” or “Dec.”).¹ After institution, Patent Owner filed a Non-Contingent Motion to Amend which proposes substitute claims 20–25, to replace original claims 6, 8–10, 14, and 18. Paper 17, 1 (“Motion” or “Mot.”). Patent Owner also proposes substitute claims 26–30 to replace unchallenged “claims 19, 11–13, 15, respectively,” where “those dependent claims are changed only by re-numbering to depend from the new claim numbers that reflect the substitutions made for Claims 6 and 10.” *Id.* at 4. Petitioner filed an Opposition to the Motion. Paper 18 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested 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 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*

¹ Prior to filing a Preliminary Response to the Petition, which also challenged claim 1, Patent Owner disclaimed claim 1. *See* Dec. 2.

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 February 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].”); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020) (“Rules”).

For this Preliminary Guidance, we focus on the amendments reflected in the substitute claims 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 papers on the underlying merits of Petitioner’s challenges. We emphasize that the views expressed below may change upon consideration of the complete record. Additionally, the views expressed below may not apply to any revised motion to amend that Patent Owner may file in response to this Preliminary Guidance. Thus, this Preliminary Guidance is not binding on the Board when rendering its final written decision. *See id.* 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))

No. Patent Owner proposes one substitute claim to replace each of challenged claims 6, 8–15, 18, and 19 (substitute claims 20–25), and one substitute claim to replace each of unchallenged claims 11–13, 15, and 19 (substitute claims 26–30). Mot. 2–3. Patent Owner thus proposes eleven substitute claims, though only six remaining claims are challenged. Petitioner argues “Substitute Claims 26-30 should not be entered, because they do not replace challenged claims.” Opp. 2 (citing 35 U.S.C. § 316(d)(1)(B)). We agree with Petitioner.

Our interpretation of the statute, cited by both parties, is that substitute claims may be introduced only to replace challenged claims. *See, for example, Apple Inc. v. Uniloc 2017 LLC*, IPR2018-01092 (PTAB Dec. 13, 2019) (Paper 25, 45) (“Section 316(d) does not permit Patent Owner to cancel or propose substitutes for non-challenged claims”). Patent Owner thus does not propose a reasonable number of substitute claims, because the amendment seeks to replace unchallenged claims.

As such, we will not address additional issues with respect to substitute claims 26–30.

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 contends that “the amendments in the substituted claims distinguish the art at issue in this proceeding.” Mot. 17. Petitioner does not argue otherwise. *See generally* Opp.

Under Rule 42.121, the requirement is for the amendment to be responsive to “a ground of unpatentability.” 37 C.F.R. § 42.121(a)(2)(i). Patent Owner has met this requirement by amending the claims in response to the Petition’s asserted prior art.

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))

No. Patent Owner contends “Claims 20-25 are each narrowed relative to their respective Claims 6, 8-10, 14, and 18,” because “[n]o original elements are removed from those claims, apart from items removed for claim renumbering and for the incorporation of the contents of base Claim 1 (disclaimed) into the substitutes for its dependent Claims 6 and 18,” and thus do not broaden claim scope. Mot. 4. Petitioner does not argue otherwise. *See generally* Opp.

Because no subject matter is removed along with the addition of new limitations, the amendments do not seek to enlarge the scope of the claims.

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))

Yes. More accurately, on this record, having considered Petitioner’s arguments, Patent Owner appears to have *not* sufficiently identified adequate written description support for all elements in the proposed substitute claims. It is the Patent Owner’s burden to clearly establish, “by readily identifiable and persuasive evidence of record,” that no new matter is sought to be added via the proposed claim amendments. Rules, 85 Fed. Reg. at 82924. We conclude Patent Owner has not clearly established written description support for claims 20–25 in its Motion.

For example, limitation [20d] recites “prior to initiation of the second transfer stage, sending a partial subscription data transfer indication indicative of storing only the first set of subscription data in the attach control node. Limitation [20d] matches a portion of claim 16, which was addressed in IPR2022-00401, as Patent Owner indicates. Mot. 17. The limitation in claim 16 is part of the claim that pertains to “instructions that when executed cause the user equipment to carry out operations” that include the step now introduced as limitation [20d]. However, claim 20 is not directed to “user equipment,” but instead addresses “receiving in a first transfer stage a first set of subscription data from the subscriber database

and storing the first set of subscription data in the attach control node.” Claim 16 thus recites a limitation about receiving *at the user equipment* an indication about storing data at the telecommunications node. But claim 20 instead recites limitations concerning communication between the telecommunications node and the *subscriber database*. Mot. 25–26; *cf.* Ex. 1001, Reexamination Certificate, 5:6–6:31 (physical page 41 of Ex. 1001).

Patent Owner contends, for example, that support for limitation [20d] (“prior to initiation of the second transfer stage, sending a partial subscription data transfer indication . . .”) is at page 3, lines 10–13 and 18–20 of Exhibits 2010 and 2011. Mot. 6. Patent Owner additionally cites for support, without explanation, “Ex. 2010, 5:8–30; Ex. 2011, 3:18–20, 5:8–30. See also Ex. 2010, 12:20–32, 12:37–13:5, and steps (iii) and (vii) in each of FIGS. 5B, 5C, 10B, 10C; Ex. 2011, 12:20–32, 12:37–13:5, and steps (iii) and (vii) in each of FIGS. 5B, 5C, 10B, 10C.” *Id.*

In the cited priority documents², page 3, lines 10–13, describes a step related to a “telecommunications node [] configured for receiving authentication data . . . in the attach control node.” Ex. 2010 at 3:2–4. There, the text states “the *telecommunications node* is configured for receiving in a second transfer stage, following the first transfer stage, at least one second set of subscription data *from the subscriber database* and storing the second set of subscription data in the attach control node.” *Id.* at 3:10–13 (emphasis added). There is no mention in this portion of the document of sending a partial subscription data transfer indication, as recited in limitation 20[d].

Moreover, the next quoted portion, at page 3, lines 18–20, concerns a *user equipment*, where the user equipment “is configured for use with the telecommunications node as described in the previous paragraph. The user equipment is configured for receiving and processing at least one of a partial subscription data transfer indication indicative of storing only the first set of subscription data in the telecommunications node.” *Id.* at 3:17–20.

These two portions of page 3 are describing different configurations of different systems, one a *user equipment* that communicates with the

² Here we cite only to Ex. 2010. Ex. 2011 has similar information at the same cited locations.

telecommunications node, and one a telecommunications node that communicates with a *subscriber database*, which is not resident on the user equipment. The portion cited at page 3, lines 18–20, describing “receiving” an “indication,” thus does not provide support for limitation [20d], because this portion of the disclosure does not address communication between a telecommunications node and a *subscriber database*, as recited in claim 20. Petitioner essentially makes this point in arguing:

PO does not identify any support for any particular device, let alone the attach control node or the telecommunications node, sending a “partial subscription data transfer indication” as required by Substitute Claims 20-23 and 25, or for a subscriber database receiving a partial subscription data transfer indication from an attach control node as required by Substitute Claim 22.

Pet. 4.

Additionally, Patent Owner has not set forth the “relevance of the evidence” cited in the string citation after the two quoted portions of Exhibit 2010. *See* 37 C.F.R. § 41.104(b)(5); *see also Intel Corp. v. Alacritech, Inc.*, IPR2017-01391, Paper 81, 44 (2018) (“It is not the responsibility of the Board to search through the string citations to find sufficient written description support for each element”).

In considering the string cite, we do encounter step “(v),” in Figure 5B, which “indicates to the HLR that the first set has been received successfully.” Ex. 2010 at 12:8–27. It is conceivable that this may provide at least some of the support for the newly-added limitation [20d]. However, without Patent Owner’s guidance, we do not reach that conclusion, especially since Patent Owner only directs us to “steps (iii) and (vii)” in Figure 5B. *See* Pet. 6.

The issues are identical for limitations in each of claims 21–23 and 25 corresponding to limitation [20d], and in claim 24 because of its dependency on claim 23, specifically limitations [21d], [22f], [23e], and [25d]. Mot. 25–36.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

35 U.S.C. § 103(a) — Obviousness

Yes. At this point in the proceeding, Petitioner has shown a reasonable likelihood that this limitation is rendered obvious by the combination of Aerts, Eberspächer, and Feng.

We focus on the new limitation [20d] in substitute claim 20. As to that limitation, Petitioner contends “*Aerts* discloses a location update procedure wherein subscription data is transmitted from a subscriber database (e.g., a home location register (HLR, *see* Pet. at 26-27)) to an attach control node (e.g., a mobile switching center/visitor location register (MSC/VLR, *see id.* at 25-26)) in two sets.” Opp. 8 (citing Pet. 14–17). Figure 2 of *Aerts* is reproduced below, which shows a schematic diagram of *Aerts*’s location registration system.

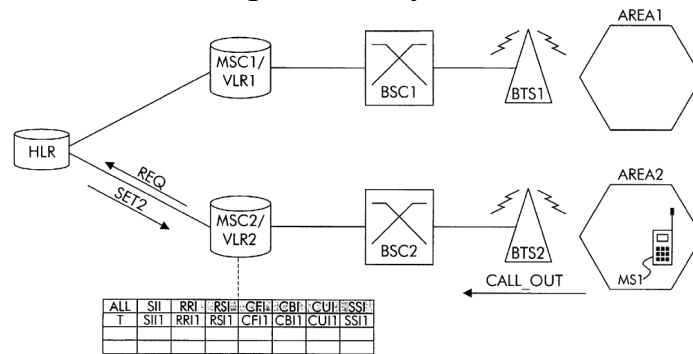


Figure 2 shows a request (“REQ”) sent from mobile switching center 2 to the Home Location Register, which sends a second set of location data (“SET2”). Ex. 1007 ¶ 27. This is because “the second mobile switching centre MSC2 consults the Visitor Location Register VLR2 which recognises that it did not yet receive all subscriber information for mobile station MS1 by monitoring the flag F in the ALL-field.” *Id.* Then, the “Visitor Location Register VLR2 thereupon requests the Home Location

Register HLR to download a second subset SET2 of information for mobile station MS1.” *Id.*

Petitioner further contends “Following the ‘Insert Subscriber Data’ message, Eberspächer shows that the VLR transmits a ‘Subscr. Data Insert. Ack.’ message to the HLR.” *Id.* at 9 (citing Ex. 1008, 194). On this basis, Petitioner contends a “POSITA would have recognized that the ‘Subscr. Data Insert. Ack.’ message is an acknowledgement (‘Ack.’) message that indicates that the VLR (1) received the ‘Insert Subscriber’ message’ and corresponding data and (2) stored the subscriber data included in the ‘Insert Subscriber Data’ message.” *Id.* (citing Ex. 1046 ¶¶ 53–54) (“*Aerts* provides that the VLR is configured as a local database that ‘memoris[es]’ subscriber data that the MSC/VLR receives from the HLR” (citing Ex. 1003 §§ 86–88, 103–105)). Figure 6.2 of Eberspächer is reproduced below, which shows an overview of the described location updating procedure, annotated to highlight the identified “Ack.” message.

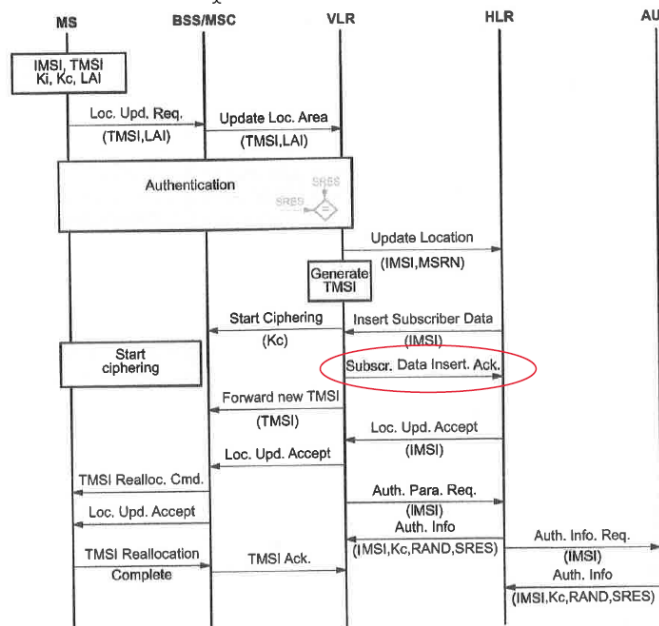


Figure 6.2 Overview of the location updating procedure.

Petitioner indicates “Figure 6.2 of *Eberspächer* discloses an ‘Insert Subscriber Data’ message transmitted from an HLR to a VLR during a location update procedure,” and “*Eberspächer* refers to the procedure of sending the ‘Insert Subscriber Data’ message as a ‘MAP procedure’ (Ex[1008], 192), and a POSITA would have understood that message to be the same as *Aerts*’ ‘MAP_INSERT_SUBSCRIBER_DATA’ message.” (Ex[1046], ¶ 52). Opp. 9 (citing Ex. 1046 ¶ 52).

This analysis applies equally to substitute claims 21–25, because of the corresponding new limitation in each.

Accordingly, based on the current record, at this stage of the proceeding, it appears that Petitioner has shown a reasonable likelihood that the combination of Aerts, Eberspächer, and Feng renders obvious substitute claims 20–25. We note that Patent Owner has not yet had an opportunity to respond to Petitioner’s contentions.

IPR2022-00068
Patent 9,549,426 C1

FOR PETITIONER:

Chad C. Walters
Douglas M. Kubehl
Harrison Rich
BAKER BOTTS L.L.P.
chad.walters@bakerbotts.com
doug.kubehl@bakerbotts.com
harrison.rich@bakerbotts.com

PATENT OWNER:

Lawrence P. Cogswell III
Keith J. Wood
Timothy J. Meagher
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
lawrence.cogswell@hbsr.com
keith.wood@hbsr.com
timothy.meagher@hbsr.com