Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORP., and
CAVIUM, INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner

Case IPR2017-01392[1]
U.S. Patent No. 7,337,241

PATENT OWNER'S CONTINGENT MOTION TO AMEND UNDER 37 C.F.R. § 42.121

[1] Cavium, who filed a Petition in Case IPR2017-01728, has been joined as a petitioner in this proceeding.

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LIST OF EXHIBITS

Exhibit #	Description
Ex. 2019	U.S. Prov. App. No. 60/061,809
Ex. 2021	U.S. Pat. App. Pub. 2004/0064578 A1 (application publication of U.S. App. No. 10/260,878)

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I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Alacritech, Inc. ("PO") submits this contingent motion to substitute proposed claims 25-48 for original claims 1-24 (collectively, the "Challenged Claims") of U.S. Patent No. 7,337,241 ("the '241 Patent") should any of the Challenged Claims be found unpatentable. Patent Owner has conferred with the Board prior to filing this motion, as required by 37 C.F.R. § 42.121, and Board authorized the filing of this motion on January 24, 2018 in email and in an Order *Conduct of Proceedings* entered January 25, 2018. *See* Paper 22.

In *Aqua Products*, *Inc. v. Joseph Matal et al.*, Case No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (*en banc*), the Federal Circuit held that the burden of persuasion to establish that proposed amendments are patentable no longer rests with the patent owner. *Id*. at 5-6. Instead, it is the petitioner's burden to prove unpatentability of the proposed amendments. *Id*. 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.

As explained below, the proposed substitute claims satisfy the requisite showing for a motion to amend. They (1) "do not impermissibly enlarge the scope of the claims"; (2) present a "reasonable number of substitute claims"; (3) "do not introduce new subject matter"; and (4) "respond to a ground of unpatentability in the trial." PO has thus met its burden of production. Accordingly, should any of

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