UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUIZ FOOD PRODUCTS, INC.,

Petitioner,

v.

MACROPOINT LLC,

Patent Owner.

Case IPR2017-02016
U.S. Patent No. 8,275,358 B1

PATENT OWNER'S MOTION TO AMEND (CONTINGENT)

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EXHIBIT LIST

Exhibit Number	Description
2001	Expert Declaration of David Hilliard Williams
2002	David Hilliard Williams CV
2003	Ruiz Food Products, Inc.'s Initial Invalidity Contentions, Civil Action 6:16-cv-1133
2004	Expert Report of Dr. Stephen B. Heppe dated January 25, 2017, Civil Action 6:16-cv-1133
2005	Ruiz Food Products, Inc.'s Final Election of Asserted Prior Art, Civil Action 6:16-cv-1133

I. STATEMENT OF RELIEF REQUESTED

Patent Owner MacroPoint LLC ("Patent Owner"), pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, respectfully moves the Patent Trial and Appeal Board ("PTAB" or "Board") to amend U.S. Patent No. 8,275,358 (Ex. 1001; the "'358 patent") contingent on the outcome of the trial.

If the Board finds claim 1 unpatentable, Patent Owner requests that the Board issue substitute claims 31–48 in lieu of original claims 1–18. Patent Owner notes that this includes replacing original claim 13, which is in independent form, with proposed substitute claim 43 which is written to depend from substitute claim 31. Further, if the Board finds claim 19 unpatentable, Patent Owner requests that the Board issue substitute claims 49–60 in lieu of claims 19–30.

II. INTRODUCTION

As set forth in this Motion and the accompanying Declaration of David Hilliard Williams (Ex. 2001; "Williams Decl."), this Motion and the proposed substitute claims meet all of the requirements of 37 C.F.R. § 42.121. *See* Order (Paper 9, "Order"). The Board must assess the patentability of proposed substitute claims "without placing the burden of persuasion on the patent owner." *Aqua Products, Inc. v. Martal*, 872 F.3d 1290 (Fed. Cir. 2017). The proposed substitute claims still must meet the statutory requirements of 35 U.S.C. § 316(d) and the procedural requirements of 37 C.F.R. § 42.121. *See also* "Guidance on Motions to

Amend in view of Aqua Products" (Nov. 21, 2017) (https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf) ("Guidance"). Specifically, the motion must: (a) propose a reasonable number of substitute claims for each challenged claim, 35 U.S.C. § 316(d)(1)(B); (b) respond to a ground of unpatentability involved in the trial, 37 C.F.R. § 42.121(a)(2)(i); (c) not seek to enlarge the scope of the claims or introduce new subject matter, 37 C.F.R. § 42.121(a)(2)(ii); and (d) set forth the support in the original disclosure of the patent for each substitute claim, 37 C.F.R. § 42.121(b)(1).

If the motion to amend satisfies these requirements and the petitioner cannot show unpatentability by a preponderance of the evidence based on the entirety of the record, the motion should be granted and the proposed substitute claims issued. Order 4 ("patent owner does not bear the burden of persuasion to demonstrate the patentability of substitute claims presented in a motion to amend. Rather … the burden of persuasion will ordinarily lie with the petitioner."). *See also* Guidance 2.

Here, the motion meets all of the requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. The motion proposes only one substitute claim for each conditionally cancelled claim; each contingent amendment is responsive to a ground of unpatentability involved in this proceeding; none of the amendments seeks to enlarge the scope of the claims or introduce new subject matter; and the

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