

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

RIMFROST AS  
Petitioner,

v.

AKER BIOMARINE ANTARCTIC AS  
Patent Owner.

---

Case IPR2018-00295

U.S Patent No. 9,320,765

---

**Patent Owner's Motion to Amend the Claims**

Mail Stop Patent Board  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## TABLE OF CONTENTS

|       |   |    |
|-------|---|----|
| I.    | INTRODUCTION .....  | 1  |
| II.   | STATEMENT OF RELIEF REQUESTED .....   | 2  |
| III.  | THE SUBSTITUTE CLAIMS MEET ALL THE REQUIREMENTS<br>OF 37 C.F.R. § 42.121.....   | 2  |
| IV.   | THE PROPOSED SUBSTITUTE CLAIMS ARE SUPPORTED BY<br>U.S. PATENT APPLICATION SERIAL NO. 14/020,155 .....  | 3  |
| A.    | Independent Claim 49 .....  | 5  |
| B.    | Dependent Claims 50-56.....   | 10 |
| V.    | LEVEL OF ORDINARY SKILL IN THE ART .....  | 11 |
| VI.   | CLAIM CONSTRUCTION .....  | 9  |
| VII.  | THE PROPOSED SUBSTITUTE CLAIMS ARE PATENTABLE<br>OVER THE CITED PRIOR ART .....   | 10 |
| A.    | The Proposed Substitute Claims Are Patentable Over The Prior<br>Art At Issue In This Proceeding.....  | 12 |
| 1.    | None of Petitioner’s references, alone or in combination,<br>teaches or suggests encapsulated krill oil compositions<br>comprising “from 5% to 8% ether phospholipids w/w of<br>said krill oil.” .....                      | 12 |
| 2.    | None of Petitioner’s references, alone or in combination,<br>teaches or suggests encapsulated krill oil compositions<br>comprising “astaxanthin esters in amount of from 100<br>mg/kg to 700 mg/kg of said krill oil.”..... | 17 |
| B.    | The Proposed Substitute Claims Are Patentable Over The Prior<br>Art At Issue During Prosecution .....   | 21 |
| VIII. | CONCLUSION .....  | 25 |

## I. INTRODUCTION

Patent Owner Aker BioMarine Antarctic AS (“Patent Owner” or “Aker”) respectfully moves under 35 U.S.C § 316(d) and C.F.R. § 42.121 to amend U.S. Patent No. 9,320,765 (“the ‘765 patent”), contingent on the outcome of this trial. In the event the Board finds the original claims unpatentable, Patent Owner respectfully requests that the Board grant this motion to amend and issue the corresponding substitute claims presented in the attached appendix. Patent Owner relies on the Declaration of Dr. Nils Hoem (Ex. 2013) and the additional exhibits in the Exhibit Listing that is filed concurrently herewith.

As the motion and the accompanying declaration of Dr. Hoem demonstrate, this motion and the substitute claims meet all the requirements of 37 C.F.R § 42.121. Namely, 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, each amendment proposes no more than one substitute claim for each conditionally canceled claim, and the motion clearly shows the changes sought and the support in the original disclosure of the patent for each claim that is added or amended.

The Federal Circuit has recently held that “the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference; and [] in the absence of

anything that might be entitled deference, the PTO may not place that burden on the patentee.” *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).

Although Patent Owner respectfully believes that it should not bear the burden of either persuasion or production regarding the patentability of the proposed substitute claims as a condition of allowance, the instant motion and supporting declaration of Dr. Hoem demonstrate that the proposed substitute claims are patentable over the references at issue in this proceeding.

## **II. STATEMENT OF RELIEF REQUESTED**

To the extent the Board finds any original claim unpatentable in this proceeding, Patent Owner respectfully requests that the Board grant this motion to amend with respect to each corresponding substitute claim presented herein. The Board should not consider this motion for any original claim it finds patentable.

## **III. THE SUBSTITUTE CLAIMS MEET ALL THE REQUIREMENTS OF 37 C.F.R. § 42.121**

As shown in the attached claims appendix (Appendix A), proposed substitute independent claim 49 retains all features of the corresponding original claim 25 of the ‘765 patent and does not broaden the scope of the claims in any way. Rather, the contingent amendments add upper limits to the ranges of two different components of the claimed encapsulated krill oil, each of which narrows the scope of the claims. Specifically, the substitute claims add the following limitations to the original claims: (1) a range of ether phospholipids of from 5% to

8%, deleting the term “about”; and (2) an upper limit of 700 mg/kg to the range of astaxanthin esters (“from 100 mg/kg to 700 mg/kg”). For the same reasons, the proposed substitute dependent claims 50-56 likewise do not broaden the scope of any original claim of the ’765 patent. *See* 37 C.F.R. § 42.121(a)(2)(ii).

Proposed substitute dependent claims 50-56 correspond to original dependent claims 26-32 of the ’765 patent and are amended only to reflect their new dependency from the amended substitute independent claims and to be consistent with substitute independent claim 49. Because the dependent claims have not been substantively amended, the proposed substitute dependent claims are also responsive to the § 103 grounds of unpatentability. *See Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26, Decision at 9 (PTAB June 11, 2013).

And as demonstrated in the next section, the proposed substitute claims are supported by U.S. Patent Appln. Serial No. 14/020,155 (Ex. 2012; “the ‘155 application”), which is the originally filed application from which the ’765 patent was granted; therefore, they do not introduce new subject matter. *See* 37 C.F.R. § 42.121(a)(2)(ii).

#### **IV. THE PROPOSED SUBSTITUTE CLAIMS ARE SUPPORTED BY U.S. PATENT APPLICATION SERIAL NO. 14/020,155**

The ’765 patent was filed as U.S. Patent Appln. Serial No. 14/020,155 (Ex. 2012; “the ‘155 application”) and is a continuation of Application No. 12/057,775,

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.