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

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 SUBSTITUE 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,

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