### UNITED STATES PATENT AND TRADEMARK OFFICE

-----

## BEFORE THE PATENT TRIAL AND APPEAL BOARD

\_\_\_\_\_\_

PEAG LLC (d/b/a JLab Audio), AUDIO PARTNERSHIP LLC and AUDIO PARTNERSHIP PLC (d/b/a Cambridge Audio), Petitioner,

v.

VARTA MICROBATTERY GMBH, Patent Owner.

\_\_\_\_\_\_

Case No. IPR2020-01212 U.S. Patent No. 9,153,835 B2

\_\_\_\_\_

### PATENT OWNER'S CONTINGENT MOTION TO AMEND



# **TABLE OF CONTENTS**

I.	INT	INTRODUCTION				
II.	STA	ATEMENT OF RELIEF REQUESTED				
III.	PRC	CEDU	JRAL REQUIREMENTS OF 37 C.F.R. §42.121	4		
	A.	The Number of Substitute Claims is Reasonable 37 C.F.R. § 42.121(a)(3)				
	B.	The Amendments Are Responsive 37 C.F.R. § 42.121(a)(2)(i)5				
	C.	The Amendments Are Non-Broadening 37 C.F.R. §42.121(a)(2)(ii)7				
	D.	The Amendments Are Supported 37 C.F.R. §42.121(a)(2)(ii)9				
IV.	PATENTABILITY OF THE SUBSTITUTE CLAIMS					
	A.	Person of Ordinary Skill in the Art (POSA)				
	B.	Claim Construction				
	C.	Subs	Substitute Independent Claim 14			
		1.	The New Features from Element 14[e]	15		
		(a)	Combinations of Kaun and Kobayashi	15		
		(b)	The combination of Kobayashi and Ryou	16		
		2.	The New Features from Element 14[f*]	18		
		(a)	Combinations of Kaun and Kobayashi	18		
		(b)	The Combination of Kobayashi and Ryou	22		
	D.	Substitute Independent Claims 23				
	E.	Substitute Dependent Claims 15–22, 24, and 25				
	F. Objective Evidence of Nonobviousness					
V.	DUTY OF CANDOR					
VI.	CONCLUSION					
ДРР	ENDI	ΧA		A-1		



# **TABLE OF AUTHORITIES**

### Cases

Aqua Prods., Inc. v. Matal, 872 F.3d 1290 (Fed. Cir. 2017)12
In re Cuozzo Speed Techs., LLC, 793 F.3d 1268 (Fed. Cir. 2015)
<i>In re Fine</i> , 837 F.2d 1071 (Fed. Cir. 1988)23
<i>In re Freeman</i> , 30 F.3d 1459 (Fed. Cir. 1994)
Lectrosonics, Inc. v. Zaxcom, Inc., IPR2018-01129, -01130, Paper 15 (PTAB Feb. 25, 2019). 4, 5, 6, 7, 9, 12, 13, 24
<i>Tillotson Ltd. v. Walbro Corp.</i> , 831 F.2d 1033 (Fed. Cir. 1987)
Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991)
WBIP, LLC v. Kohler, 829 F.3d 1317 (Fed. Cir. 2016)24
Statutes
35 U.S.C. § 103
35 U.S.C. § 112
35 U.S.C. § 316
35 U.S.C. § 3719
Regulations
37 C.F.R. § 42.121
MTA Pilot Program Notice, 84 Fed. Reg. 9497 (Mar. 15, 2019)3



# **EXHIBIT LIST**

Exhibit	Description
2001	Email Chain dated April 27, 2020
2002	First Amended Consolidation Order, 2:20-cv-00051-JRG, Dkt. 021 (E.D. Tex., May 7, 2020)
2003	Discovery Order, 2:20-cv-00051-JRG, Dkt 051 (E.D. Tex., June 10, 2020)
2004	Docket Control Order, 2:20-cv-00051-JRG, Dkt. 054 (E.D. Tex., June 11, 2020)
2005	Defendants' Opposed Motion to Stay, 2:20-cv-00051-JRG, Dkt. 064 (E.D. Tex., Aug. 20, 2020)
2006	Plaintiff's Opposition to Defendants' Motion to Stay, 2:20-cv-00051- JRG, Dkt. 65 (E.D. Tex., Sept. 3, 2020)
2007	Order Denying Stay, 2:20-cv-00051-JRG, Dkt. 68 (E.D. Tex., Oct. 7, 2020)
2008	Complaint for Patent Infringement, 2:20-cv-00138-JRG Dkt. 001 (E.D. Tex., May 4, 2020)
2009	Complaint for Patent Infringement, 2:20-cv-00071-JRG, Dkt. 001 (E.D. Tex., March 4, 2020)
2010	Answer to Complaint for Patent Infringement, 2:20-cv-00051-JRG, Dkt. 26 (E.D. Tex., May 13, 2020)
2011	Joint Motion for Entry of Docket Control Order, 2:20-cv-00051-JRG, Dkt. 045, (E.D. Tex., June 8, 2020)
2012	Defendants' P.R. 3-3 Invalidity Contentions, 2:20-cv-00051-JRG, (E.D. Tex., July 10, 2020)
2013	U.S. Publication No. 2003/0013007 to Kaun ("Kaun '007")



Exhibit	Description
2014	Reserved
2015	Reserved
2016	Reserved
2017	Reserved
2018	Reserved
2019	Reserved
2020	Reserved
2021	Reserved
2022	Reserved
2023	Reserved
2024	Reserved
2025	IEC-62133-2 Standard
2026	Button Cell, WIKIPEDIA (Dec. 3, 2020, 11:24 AM), https://en.wikipedia.org/wiki/Button_cell
2027	Button Cell Battery Safety Act, S. 1165, 112th Cong. (2011)
2028	FIG. 11 of U.S. Publication No. 2005/0233212 to Kaun
2029	Rolled-Ribbon Cell Design, Rolled-Ribbon Battery Company, http://www.rolled-ribbon.com/downloads/D-RRBC_Cell%20Design_20190827_11x17.pdf (last visited Mar. 28, 2021)
2030	William H. Gardner Deposition Testimony – Days 1-2 (Mar. 3-4, 2021)



# DOCKET

# 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.

