UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,

Petitioner,

v.

SCRAMOGE TECHNOLOGY LTD.,

Patent Owner.

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Case IPR2022-00118

Patent 10,804,740

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

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I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner submits this contingent Motion to Amend, to substitute proposed claims 21, 22, and 23 for original claims 6, 16, and 17, respectively, of U.S. Patent No. 10,804,740 ("the '740 Patent"). The Board has provided procedural guidance to satisfy the conferral requirement of 37 C.F.R. § 42.121(a) via email on July 25, 2022.

Patent Owner requests preliminary guidance from the Board on this Motion to Amend pursuant to the Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the AIA. 86 Fed. Reg. 51656 (Sept. 16, 2021); 84 Fed. Reg. 9497 (March 15, 2019).

Patent Owner submits that this Motion to Amend satisfies the requirements under 37 C.F. R. §42.121(a), as explained below. Accordingly, should the Board find that claims 6, 16, and 17 of the '740 Patent are unpatentable, Patent Owner requests that the Board grant this Motion and herewith substitute original claims 6, 16, and 17 with proposed substitute claims 21, 22, and 23, respectively.

II. LEGAL STANDARD – MOTION TO AMEND

For a motion to amend, a Patent Owner need show that the requirements of "paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of [37 C.F.R. § 42.121]" are met. 37 C.F.R. § 42.121(d)(1). The burden to show that the amended claims are unpatentable over the prior art rests

solely on the Petitioner. 37 C.F.R. § 42.121(d)(2); *Aqua Products Inc. v. Matal*, 872 F.3d 1290, 1324 (Fed. Cir. 2017) (*en banc*).

A Patent Owner must therefore only show that the substitute claims (1) do not introduce new subject matter (37 C.F.R. § 42.121(a)(2)(ii); 2) do not impermissibly seek to enlarge the scope of the claims (*id.*); 3) propose a reasonable number of substitute claims (37 C.F.R. § 42.121(a)(3)); and (4) respond to a ground of unpatentability in the trial (37 C.F.R. § 42.121(a)(2)(i)). The Board may then consider whether the Petitioner has shown that the substitute claims at issue are unpatentable by a preponderance of the evidence. *L&P Property Mgt. Co. v. Remacro Machinery & Tech. Co., Ltd.*, Case IPR2019-00255, p. 6 (PTAB Jun. 18, 2019) (Paper No. 15).

Patent Owner's Motion to Amend satisfied these requirements for the following reasons:

a. Substitute Claims Do Not Add New Matter.

The '740 Patent (U.S. Pat. Appl. No. 16/264,360) is a continuation of U.S. Pat. Appl. No. 15/430,173, filed on Feb. 10, 2017 (U.S. Pat. No. 10,277,071), which is a continuation of U.S. Pat. Appl. No. 15/360,425, filed on Nov. 23, 2016 (U.S. Pat. No. 10,270,291), which is a continuation of U.S. Pat. Appl. No. 13/663,012, filed on Oct. 29, 2012 (U.S. Pat. No. 9,806,565)[1]. (Ex. 1001 at p. 1-2).

[1] U.S. Pat. Appl. No. 13/663,012 further claims priority under 35 U.S.C. § 119 to Korean Pat. App. No. 10-2012-0029987, filed March 23, 2012, and Korean Pat. App. No. 10-2012-0079004, filed July 19, 2012. (Ex. 1001 at p. 1).

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