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.

AIRE TECHNOLOGY LTD.,

Patent Owner.

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Case IPR2022-01137

Patent 8,581,706

PATENT OWNER'S 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 23 – 26 for original claims 11, 12, 18, and 20, respectively, of U.S. Patent No. 8,581,706 ("the '706 Patent"). The Board has authorized this motion pursuant 37 C.F.R. § 42.121(a) via email on March 28, 2023.

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 11, 12, 18, and 20 of the '706 Patent are unpatentable, Patent Owner requests that the Board grant this Motion and herewith substitute original claims 11, 12, 18, and 20 with corresponding proposed substitute claims 23 – 26.

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 '706 Patent (U.S. Pat. Appl. No. 12/304,653) is a National Stage Entry of PCT/EP2007/005185 filed on June 12, 2007, which claims foreign priority to German Appl. No. DE 102006027200 filed on June 12, 2006. (Ex. 1002 at 368).

Patent Owner has proposed one substitute claim for each of original claims 11, 12, 18, and 20. Tables A – D below indicate the proposed amendments to claims 11, 12, 18, and 20, *vis-à-vis* substitute claims 23 – 26 respectively, and where there is support for the substitute claims in the original disclosures of the '706 Patent (U.S. Pat. Appl. No. 12/304,653) (Ex. 1002, p.285 – 311) and, pursuant to 37 CFR § 42.121(b). *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, 01130, Paper

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