

**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 LIMITED,  
Patent Owner,

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IPR2022-01137  
U.S. Patent No. 8,581,706

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**PETITIONER'S OPPOSITION TO MOTION TO AMEND**

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**PETITIONER'S EXHIBIT LIST**

Ex.1001	U.S. Patent No. 8,581,706
Ex.1002	Prosecution History of U.S. Patent No. 8,581,706
Ex.1003	Declaration of Dr. Joshua Phinney under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Dr. Joshua Phinney
Ex.1005	U.S. Patent No. 6,824,064 to Guthery et al. ("Guthery")
Ex.1006	JP2000163539 to Nozawa et al. ("Nozawa") – Certified English Translation
Ex.1007	<i>RFID Handbook: Radio-Frequency Identification Fundamentals and Applications</i> , Klaus Finkenzeller (1999)
Ex.1008	<i>Smart Card Handbook: Third Edition</i> , Wolfgang Rankl (3 <sup>rd</sup> ed. 2003)
Ex.1009	Reserved.
Ex.1010	Reserved.
Ex.1011	Complaint, <i>Aire Technology Ltd. v. Apple Inc.</i> 6-21-cv-01101 (W.D. Tex. Oct. 22, 2021)
Ex.1012	Infringement Contentions, <i>Aire Technology Ltd. v. Apple Inc.</i> 6-21-cv-01101 (W.D. Tex. Oct. 22, 2021)
Ex.1013	Scheduling Order, <i>Aire Technology Ltd. v. Apple Inc.</i> 6-21-cv-01101 (W.D. Tex. Oct. 22, 2021)
Ex.1014	Standing Order Governing Proceedings (OGP) 4.1
Ex.1015	Complaint, <i>Aire Technology Ltd v. Samsung Electronics Co., Ltd.</i> , 6:21-cv-00955 (W.D. Tex. Sep. 15, 2021)
Ex.1016	JP2000163539 to Nozawa et al. (original)

Ex.1017	Internet Archive capture of “Wiley:Smart Card Handbook, 3 <sup>rd</sup> Edition,” <a href="https://web.archive.org/web/20041026102425/http://www.wiley.com:80/WileyCDA/WileyTitle/productCd-0470856688.html">https://web.archive.org/web/20041026102425/http://www.wiley.com:80/WileyCDA/WileyTitle/productCd-0470856688.html</a> (archived October 26, 2004)
Ex.1018	Declaration of Franchesca Ruiz
Ex.1019	Reserved.
Ex.1020	Reserved.
Ex.1021	Reserved.
Ex.1022	Reserved.
Ex.1023	Federal District Court Trial Statistics (June 2022)
Ex.1024	Email chain with Board granting Petitioner's request to file preliminary reply briefs
Ex.1025	Plaintiff Aire Technology Ltd.'s Motion to Amend Preliminary Infringement Contentions, <i>Aire Technology Ltd. v. Apple Inc.</i> 6-21-cv-01101 (W.D. Tex. Sept. 30, 2022)
<b>Ex.1026</b>	<b>Supplemental Declaration of Dr. Joshua Phinney under 37 C.F.R. § 1.68</b>

**I. Introduction**

Patent Owner filed a Motion to Amend (“Motion,” Paper 16) with substitute claims 23-26. The Motion should be denied for several reasons. First, the proposed substitute claims recite new matter in violation of 35 U.S.C. § 316(d)(3). Second, the proposed claims are unpatentable (i) under 35 U.S.C. § 112 because they are indefinite hybrid method-apparatus claims and are not enabled, and (ii) under 35 U.S.C. § 103 because they are obvious in view of the prior art combination presented in the petition.

**II. The Proposed Amendments Add New Subject Matter by Claiming Functionality Different than the Functionality Described in the Specification.**

Patent Owner’s motion to amend should be denied because the proposed substitute claims are directed to concepts not supported by the specification of the ’706 patent. “Before considering the patentability of any substitute claims, ... the Board first must determine whether the motion to amend meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.” *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (Feb. 25, 2019) (precedential). One such requirement is that any amendment “may not ... introduce new matter.” 35 U.S.C. 316(d)(3). New subject matter is any addition to the claims that lacks sufficient support in the subject patent’s original disclosure. *See TurboCare Div. of Demag Delaval Turbomach. v. Gen. Elec. Co.*, 264 F.3d 1111,

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