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Paper 25
Date: February 27,2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01054 (Patent 10,452,974 B1);
IPR2023-01055 (Patent 11,238,344 B1)[1]

Before BARBARA A. PARVIS, ROBERT J. WEINSCHENK, and RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. § 42.5

[1] This Order applies to each of the listed proceedings. We exercise our discretion to issue one Order to be docketed in each proceeding.

I. INTRODUCTION

On February 15, 2024, Patent Owner advised the Board by email that it wishes to file a motion to amend in this proceeding. On February 22, 2024, the parties held a conference call under 37 C.F.R. § 42.121(a) to confer with the panel regarding the proposed motion to amend. This Order summarizes the discussion with the parties on the call and provides additional information and guidance to the parties regarding the proposed motion to amend.

II. DISCUSSION

During the call, Patent Owner stated that it intends to file a motion to amend that is contingent as to certain claims and non-contingent as to other claims. For the authority to do so, Patent Owner pointed to the Board's opinion in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 3 (PTAB Feb. 25, 2019) (precedential) ("A patent owner should adopt a claim-by-claim approach to specifying the contingency of substitution, e.g., which claim is to be substituted for which claim, and under what circumstances.").

Should Patent Owner file a motion to amend, it may elect the option under the MTA Pilot Program to receive preliminary guidance from the Board on the substance of any amended claims in its motion to amend. *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) ("MTA Pilot Program Notice").

We remind the parties that, although Patent Owner does not bear the burden of persuasion to demonstrate patentability of the proposed substitute

claims,[2] a motion to amend must still comply with several statutory and regulatory requirements, as discussed in *Lectrosonics*. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. Patent Owner should follow the guidance provided in *Lectrosonics* and the Office's November 2019 Consolidated Trial Practice Guide to ensure that the motion to amend complies with all relevant statutory and regulatory requirements. 84 Fed. Reg. 64,280 (Nov. 21, 2019), available at https://www.uspto.gov/ TrialPracticeGuideConsolidated. We also note that Patent Owner may only propose substitute claims, not amendments to original claims. Additionally, Patent Owner may propose only substitute claims for challenged claims, not unchallenged claims.

Because this *inter partes* review was instituted after March 15, 2019, the Motion to Amend Pilot Program applies. The details of the Motion to Amend Pilot Program are set forth in the MTA Pilot Program Notice. *See* 84 Fed. Reg. 9,497, as noted above. If Patent Owner elects to seek non-binding preliminary guidance from the Board on its motion to amend, an explicit request for preliminary guidance must be included in the motion to amend, filed no later than DUE DATE 1.

We remind the parties that the Board's consideration of the substitute claims is not limited to unpatentability under 35 U.S.C. §§ 102 and 103. *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017–00948, Paper 34 (PTAB Jan. 18, 2019) (precedential).

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[2] *See Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols., LLC v. Matal*, 878 F.3d 1027 (Fed. Cir. 2017) (as amended Mar. 15, 2018).

Patent Owner has options for addressing the Board's preliminary guidance and/or Petitioner's opposition, including filing a revised motion to amend. *See* 84 Fed. Reg. at 9,499–9,502. We note that a request for preliminary guidance is not a prerequisite for filing a revised motion to amend, and Patent Owner may file a revised motion to amend regardless of whether it requested preliminary guidance. *See id.* at 9,501.

Should Patent Owner file a revised motion to amend, the Board will issue a revised Scheduling Order to allow additional briefing. *See id.* The parties should carefully consult the MTA Pilot Program Notice for further details and guidance.

As stated in the Scheduling Order (Paper 8), the deadlines for the portions of DUE DATE 2 and DUE DATE 3 related to motion to amend briefing cannot be changed by party agreement and stipulation, absent authorization from the Board (*id*. at 8). The parties are cautioned that under motion to amend practice, if a revised motion to amend is filed, the schedule may require revision with further compression of deadlines.

Finally, we again remind the parties of their duty of candor pursuant to 37 C.F.R. § 42.11.

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