UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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K/S HIMPP,
Petitioner,

v.

BRAGI GMBH,
Patent Owner.

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IPR2023-01150
Patent 9,843,853 B2

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Before LARRY J. HUME, STACEY G. WHITE, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

PATENT OWNER'S MOTION TO AMEND

# I. INTRODUCTION

On January 22, 2024, we instituted trial as to claims 1–21 of U.S. Patent No. 9,843,853 B2 (Ex. 1001, "the '853 patent"). Paper 8 ("Institution Decision" or "Dec."). After institution, Patent Owner filed a Motion to Amend. Paper 12 ("Motion" or "Mot."). In its Motion, Patent Owner proposes to amend the '853 patent to replace claims 1–21 with substitute claims 22–42. Mot. 1–2. Petitioner timely filed an Opposition to Patent Owner's Motion. Paper 23 ("Opposition" or "Opp.").

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board's Pilot Program concerning motion to amend practice and procedures. Mot. 1; *see also* 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) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) ("Notice"). We have duly considered Patent Owner's Motion and Petitioner's Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, and non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 ("The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]"); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements

and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally issued and challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

## II. PRELIMINARY GUIDANCE

As a threshold matter, Patent Owner has not clearly articulated whether the Motion is either: (1) contingent upon a finding in a final written decision that the challenged claims are unpatentable; or (2) non-contingent. "A motion to amend claims may cancel claims and/or propose substitute claims." *Lectrosonics* at 3 (citing 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3)). A request to substitute claims ordinarily will be treated as contingent. *Id.* "In other words, a proposed substitute claim normally will be considered only if a preponderance of the evidence establishes that the original patent claim that it replaces is unpatentable." *Id.* "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." *Id.*

Because Patent Owner indicates a desire to "substitute" claims, for purposes of this Preliminary Guidance, we treat the Motion as contingent upon a finding in a final written decision that the challenged claims are unpatentable, and we will not treat any of the original claims 1–21 as either cancelled or withdrawn. *Lectrosonics* at 3 ("[A] request to substitute claims ordinarily will be treated as contingent"). However, we advise Patent Owner to expressly state whether the motion is contingent or non-contingent in either a reply in support of the motion to amend or in a revised motion to amend.

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

| **Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B)); 37 C.F.R. § 42.121(a)(3))** |
|---|
| **Yes**. Patent Owner proposes no more than 1 substitute claim for each challenged claim. Mot. 2, A-1–A-7 (App. A). Petitioner does not argue otherwise. *See generally* Opp. |

2. Respond to Ground of Unpatentability

| **Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))** |
|---|
| **Yes**. Patent Owner responds to the grounds of unpatentability by amending the claims in response to the Petition's asserted prior art. Mot. 2, 7–16. Petitioner does not argue otherwise. *See generally* Opp. |

3. Scope of Amended Claims

| **Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))** |
|---|
| **No**. It appears that each proposed substitute claim is narrower in scope than the corresponding original claim. Mot. 3–4, A-1–A-7 (App. A). Petitioner does not argue otherwise. *See generally* Opp. |

4. New Matter

| **Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))** |
|---|
| **Yes**. For the reasons discussed below, on this record, we are persuaded that proposed substitute claims 31–42 introduce new matter in violation of 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii). *See* Mot. 4–5.<br><br>Patent Owner asserts that the proposed substitute claims are supported by the specification of the original non-provisional application, No. 15/245,031 ("the '031 application"). Mot. 4. The '031 application claims priority to U.S. Provisional Patent Application No. 62/211,767, filed on August 29, 2016. Ex. 1008, 1:6–7. Patent Owner asserts "the inventor possessed the Substitute Claims as of August 29, 2015." Mot. 4. Patent Owner contends the '031 application supports the "in-ear" limitation and the limitation reciting that "the powering circuitry is housed within the in-ear wireless earpieces" in the proposed substitute claims. *Id.* at 5 (citing Ex. 1008, 2:8–12, 4:19–20, 12:3–7, Figs. 1, 2, 4). Patent Owner asserts that the '031 application also supports the limitation reciting that the smart case "comprises a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpieces" in the proposed substitute claims. *Id.* (citing Ex. 1008, 3:27–29, 5:3–15, 6:6–20, 7:5–13, 9:14–20, 9:26–10:2).<br><br>Petitioner does not argue that Patent Owner's identification of support for proposed substitute claims 22–30 is insufficient. *See generally* Opp. However, Petitioner argues Patent Owner's identification of support for proposed substitute claims 31–42 is deficient. *See* Opp. 1–5. Petitioner contends "the original disclosure does not reasonably convey to a person of ordinary skill in the art ('POSITA') that the inventors had possession of PO's proposed claim amendment 'a smart case comprising a rechargeable |

battery configured to receive charge inductively,' recited directly or indirectly by substitute claims 31–41 and similarly by substitute claim 42." *Id.* at 2. Instead, Petitioner contends the original specification discloses *an earpiece battery that is inductively charged* and a smart case that is charged using a hardware interface or connector. *Id.* at 2–4 (citing Ex. 1008, 3:23–42, 5:3–5, 6:6–11, 7:5–7, 9:14, 9:26–10:2; Ex. 1017, ¶¶ 11–12).

On this record, we agree with Petitioner's position that Patent Owner's Motion does not appear to sufficiently set forth written description support for proposed substitute claims 31–42 because Patent Owner's citations do not reasonably convey that the inventors had possession of the claimed smart case comprising "a rechargeable battery configured to receive charge inductively" recited in proposed substitute claims 31 and 42. *See* Mot. A-3, A-6–A-7 (App. A). We note that Patent Owner has not yet had an opportunity to respond to the arguments and evidence cited in Petitioner's Opposition or this Preliminary Guidance. Patent Owner will have the opportunity to do so in a Reply or in a Revised Motion to Amend in this proceeding.

B. Patentability[1]

For the reasons discussed below, at this stage of the proceeding, and based upon the current record,[2] it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 22–42 are unpatentable.

[1] Unless otherwise noted, all citations to the prior art references are to the original page numbers of the references themselves.

[2] We express no view on the patentability of original claims 1–21 in this Preliminary Guidance. Instead, we focus on the proposed amendments to those claims in the proposed substitute claims in the Patent Owner's Motion to Amend.

**Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?**

**Yes**. On this record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 22–42 are unpatentable as indefinite, anticipated, and obvious on the grounds discussed below.

We note that Patent Owner has not yet had an opportunity to respond to the arguments and evidence cited in Petitioner's Opposition or this Preliminary Guidance. Patent Owner will have the opportunity to do so in a Reply or in a Revised Motion to Amend in this proceeding.

**I. Indefiniteness**

**Yes**. Patent Owner proposes adding the term "in-ear" to several of the proposed substitute claims such that all of the claims directly or indirectly recite "in-ear wireless earpiece(s)." *See* Mot. A-1–A-7 (App. A). Petitioner contends the term "in-ear" is indefinite because the metes and bounds of the term are unclear. Opp. 5–8. For the reasons discussed below, it appears that Petitioner has established that proposed substitute claims 22–42 are indefinite.

Petitioner contends the metes and bounds of "in-ear" are unclear in view of the Specification, the prosecution history, and the rest of the substitute claims. Opp. 5. According to Petitioner, neither the Specification nor the prosecution history provides any guidance for the term because "in-ear" does not appear in either place. *Id.* (citing Ex. 1017 ¶ 13). Petitioner also contends "[t]he rest of the claim language provides no guidance regarding the meaning of this term, as no other claim language is directed to or suggest[s] how the wireless earpiece is worn." *Id.*

Petitioner states that "in-ear" "at best conveys that the wireless earpiece is 'in' the 'ear,'" but argues that the term

> does not convey what portion of the ear is relevant (*e.g.*, "in" the ear means within the periphery of the ear as a whole or within the ear canal only), how much of the wireless earpiece should be in the ear (*e.g.*, in the ear in its entirety, at least a portion in the ear, or predominantly in the ear), or if there are other characteristics or features relevant to whether a wireless earpiece is "in-ear."

Opp. 6.

Petitioner contends testimony from Patent Owner's declarant shows further that the meaning of "in-ear" is unclear. First, Patent Owner's declarant said that Brown's[3] hearing aid is not an "in-ear" wireless earpiece, but acknowledged that some portions of the hearing aid are inside the user's ear, including the earmould and part of the sound tube. Opp. 6–7 (citing Ex. 2001, ¶¶ 61–62; Mot. 7–8). Given this testimony, Petitioner contends Patent Owner and Patent Owner's declarant "appear to interpret 'in-ear' as requiring the earpiece to be wholly contained within the ear canal." *Id.* at 7 (citing Ex. 1019, 25:25–26:3, 77:12–13; Ex. 1017, ¶¶ 14–15). However, Patent Owner's declarant was unable to articulate whether the earbud shown in the images in Exhibit 1020 is "in-ear" without reviewing additional technical documents "despite agreeing that a portion of the earbud 'goes inside the ear' and that 'part of that device [] is outside the ear.'" *Id.* at 7–8 (citing Ex. 1019, 28:11–12, 30:9–15, 30:19–31:1, 31:9–15, 31:20–32:3, 33:9–16, 47:17–48:2, 49:3–50:3). According to Petitioner, "[t]hat PO's expert needs unspecified technical documents or information about a wireless earpiece to determine whether it is 'in-ear' further demonstrates that this term is indefinite." *Id.* at 8 (citing Ex. 1017, ¶ 16).

A patent claim is indefinite when that claim, "viewed in light of the specification and prosecution history, [does not] inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). In view of the foregoing preliminary analysis, proposed substitute claims 22–42 do not appear to meet the requirements of *Nautilus*, and thus appear to be indefinite.

We separately note that proposed substitute claim 38 appears to be indefinite for lacking antecedent basis for the limitation reciting "the rechargeable battery configured to charge the left in-ear *wireless* earpiece and the right in-ear *wireless* earpiece." Mot. A-5 (App. A) (emphasis added). It appears that proposed substitute claim 38 does not contain an earlier recitation or limitation of "a left in-ear *wireless* earpiece" or "a right in-ear *wireless* earpiece." *Id.* (emphasis added). Instead, proposed substitute claim 38 only recites "a left in-ear earpiece" and a "right in-ear earpiece." *Id.*

[3] GB 1254017, filed Mar. 25, 1969, published Nov. 17, 1971. Ex. 1007, "Brown".

## II. Anticipation

**Yes**. For the reasons discussed below, it appears that Petitioner has established a reasonable likelihood that proposed substitute claims 22–24 and 26 are anticipated.

A. *Hain*[4] *(Proposed Substitute Claims 22–24 and 26)*

Patent Owner proposes adding the term "in-ear" to proposed substitute claims 22–24 and 26 such that the claims recite "in-ear wireless earpieces." *See* Mot. A-1–A-2 (App. A). Patent Owner also proposes adding a limitation reciting "wherein the powering circuitry is housed within the in-ear wireless earpieces" to proposed substitute claim 22. *Id.*

Petitioner argues Hain anticipates proposed substitute claims 22–24 and 26 and Patent Owner does not dispute that Hain anticipates the "in-ear" limitation in proposed substitute claims 22–24 and 26 and proposed substitute claim 22's limitation reciting "wherein the powering circuitry is housed within the in-ear wireless earpieces." Opp. 14. Instead, Patent Owner contends Hain does not disclose "powering circuitry of the in-ear wireless earpieces utilizing a high power mode in response to detecting a magnetic field is not applied to one or more of the in-ear wireless earpieces" because "Hain teaches that when a single hearing aid detects a magnetic field (and importantly, the other hearing aid does not detect a magnetic field), the hearing aid detecting the magnetic field operates in high power mode." *See* Mot. 9–10. Patent Owner also contends Hain discloses that one of its earpieces operates in a high-power mode when a singular wireless earpiece detects a magnetic field, which differs from Patent Owner's claimed invention because the '853 patent discloses that "if one or more wireless earpieces detect a magnetic field, they will operate in a 'low power' mode as they are coupled to the smart case for charging." *Id.* at 11.

According to Petitioner, these arguments by Patent Owner show that it continues to conflate limitations 1A and 1B and continues to contend that "one or more" wireless earpieces should be interpreted as a "singular" wireless earpiece. Opp. 14–15; *and see* Dec. 47–50. Petitioner argues the Board rejected both of these arguments in the Institution Decision. *Id.* at 15–16 (citing Dec. 49–50, 52).

For the same reasons discussed in the Institution Decision for the original claims (Dec. 46–54), it appears that Petitioner also has established a

reasonable likelihood that proposed substitute claims 22–24 and 26 are anticipated by Hain.

## III. Obviousness

**Yes**. For the reasons discussed below, it appears that Petitioner has established a reasonable likelihood that proposed substitute claims 22–42 would have been obvious from the teachings of the cited prior art.

### A. *Brown*[5] *and Marks*[6] *(Proposed Substitute Claims 31 and 35)*

Patent Owner proposes adding the term "in-ear" to proposed substitute claims 31 and 35 such that the claims recite an "in-ear wireless earpiece," and limitations reciting "wherein the powering circuitry is housed within the in-ear wireless earpiece" and "wherein the magnetic field is applied by a smart case comprising a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpiece" to proposed substitute claim 31. *See* Mot. A-3–A-4 (App. A). Petitioner contends Brown and Marks render each of these claim limitations obvious as discussed further below.

#### 1. "in-ear" wireless earpiece

Because Petitioner contends the term "in-ear" is indefinite, Petitioner analyzes the claim language under two possible constructions: (1) "'in-ear' wireless earpieces include earpieces having a portion of the earpiece that fits into a user's ear"; and (2) "'in-ear' wireless earpieces require the earpiece to wholly fit into the user's ear or to not be 'on' the ear." Opp. 9–10. First, Petitioner argues Brown teaches in-ear wireless earpieces having a portion of the earpiece that fits into a user's ear for the same reasons the Board explained in the Institution Decision. *Id.* (citing Dec. 41).

Second, Petitioner argues Brown teaches in-ear wireless earpieces that wholly fit into the user's ear or are not on the ear because Brown teaches earpieces worn "in the ear." Opp. 10 (citing Ex. 1007, 1:9–11). Petitioner contends further that Hain, Steinbrecher, Sørensen, and Shaffer also teach

[4] DE 10 2007 039 455 A1, filed Aug. 21, 2007, published Feb. 26, 2009. Ex. 1004, "Hain".

[5] GB 1254017, filed Mar. 25, 1969, published Nov. 17, 1971. Ex. 1007, "Brown".

[6] U.S. Patent App. Pub. No. 2015/0200554 A1, published July 16, 2015. Ex. 1018, "Marks".

earpieces that fit into the user's ear. *Id.* (citing Ex. 1004, ¶ 1; Ex. 1006, ¶ 24; Ex. 1005, 1:23–26; Ex. 1003, ¶ 32, Figs. 3, 10; Ex. 1017, ¶ 21).

As discussed above, on this record, it appears that the term "in-ear" is indefinite. However, Petitioner's Opposition appears to show that Brown, Hain, Steinbrecher, Sørensen, and Shaffer teach "in-ear" wireless earpieces under either construction of "in-ear" proposed by Petitioner. *See* Opp. 9–11. Because this Preliminary Guidance reflects our initial, preliminary, non-binding views on the patentability of Patent Owner's proposed substitute claims, we invite the parties to address the construction of "in-ear" in further briefing and/or in a revised motion.

2. "wherein the powering circuitry is housed within the in-ear wireless earpiece"

Petitioner contends Patent Owner admits that Brown teaches the powering circuitry is housed within the in-ear wireless earpiece. Opp. 11 (citing Mot. 7). Petitioner contends further that "nothing in substitute claims 31 and 35 requires that the powering circuitry be housed in a specific portion of the earpiece, let alone the portion that is within the ear." *Id.* Petitioner instead argues that proposed substitute claims 31 and 35 "merely require that the powering circuitry be housed within the in-ear wireless earpieces, without specifying a particular location within the earpiece." *Id.*

Petitioner's Opposition appears to show that Brown teaches "wherein the powering circuitry is housed within the in-ear wireless earpiece."

3. "a smart case comprising a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpiece"

Petitioner contends it would have been obvious to include a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpiece in Brown's case. Opp. 11–12 (citing Ex. 1017, ¶ 23). According to Petitioner, Marks teaches a portable case for wearable electronic devices, such as hearing aids. *Id.* at 12 (citing Ex. 1018, ¶¶ 18–19, Fig. 1).

Petitioner argues Marks teaches that an auxiliary battery within the portable case charges a main battery of the electronic device, and that the auxiliary battery is charged inductively using a plurality of wireless components "so that 'no cable is needed.'" *Id.* (citing Ex. 1018, ¶¶ 18, 30, 38; Ex. 1017, ¶ 19).

Petitioner's Opposition appears to show that the combination of Brown and Marks teaches "a smart case comprising a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpiece." More specifically, it appears that paragraph 38 of Marks teaches wireless charging components can be used to wirelessly charge the electronic device inductively by transferring a charge from the auxiliary battery of the portable case to the main battery of the electronic device. Ex. 1018, ¶ 38. It also appears that paragraph 30 of Marks teaches a means of wirelessly charging one or both of the main battery and the rechargeable auxiliary battery such that no cable is needed to enable charging. *Id.* ¶ 30.

4. Motivation to Combine Brown and Marks

Petitioner contends a person of ordinary skill in the art would have been motivated to combine Brown and Marks to obtain a case that includes a rechargeable battery configured to receive charge inductively and to charge hearing aids for the following reasons:

a. Brown and Marks are from the same field of endeavor because they are both directed to a case that charges an electronic device stored therein (Opp. 12–13 (citing Ex. 1007, 1:88–2:66, Fig. 1; Ex. 1018, ¶¶ 18–19, Fig. 1; Ex. 1017, ¶ 25));

b. A person of ordinary skill in the art would have combined Brown's case with Marks's rechargeable battery configured to receive charge inductively to charge hearing aids using "known and routine electronic device design and manufacturing techniques" to yield expected, predictable results (*id.* (citing Ex. 1007, 1:88–2:66, Fig. 1; Ex. 1018, ¶¶ 18, 30, 38, Fig. 1; Ex. 1017, ¶ 26));

c. Implementing Marks's rechargeable battery configured to receive charge inductively would have made the charging process more convenient and simplified because "no cable is needed to enable the charging" (*id.* at 13–14 (citing Ex. 1018, ¶ 30; Ex. 1017, ¶ 27)); and

d. A person of ordinary skill in the art would have had a reasonable expectation of success combining Brown's case with Marks's rechargeable battery that can be charged inductively (*id.* at 14 (citing Ex. 1017, ¶ 28)).

Petitioner's Opposition appears to show that a person of ordinary skill in the art would have had reason to combine Brown and Marks to implement inductive charging of a rechargeable battery.

Petitioner's contentions appear to show that proposed substitute claims 31 and 35 include subject matter that would have been obvious over the combination of the cited art. Thus, it is our preliminary, non-binding opinion that Petitioner has established a reasonable likelihood that the combined teachings of Brown and Marks would have rendered proposed substitute claims 31 and 35 obvious.

B. *Steinbrecher*[7] *and Marks (Proposed Substitute Claims 31 and 42)*

Patent Owner proposes adding to proposed substitute claims 31 and 42 the term "in-ear" such that the claims recite an "in-ear wireless earpiece" and the limitation of "a rechargeable battery configured to receive charge inductively." *See* Mot. A-3, A-6–A-7 (App. A). Patent Owner also proposes adding a limitation reciting "wherein the powering circuitry is housed within the in-ear wireless earpiece" to proposed substitute claim 31. *See id.* at A-3 (App. A). Petitioner contends Steinbrecher and Marks render each of these claim limitations obvious.

Petitioner argues Steinbrecher and Marks render proposed substitute claims 31 and 42 obvious because Patent Owner does not dispute that Steinbrecher discloses the proposed amendments reciting "in-ear" and "wherein the powering circuitry is housed within the in-ear wireless earpiece." Opp. 18 (citing Mot. 12–13). Petitioner contends Marks teaches "a rechargeable battery configured to receive charge inductively," and it would have been obvious to combine Steinbrecher's smart case with Marks's rechargeable battery configured to receive charge inductively for the following reasons:

1. Steinbrecher and Marks are from the same field of endeavor because they are both directed to a case that charges an electronic device stored therein (Opp. 19 (citing Ex. 1006, ¶¶ 24–25, Figs. 1, 2; Ex. 1018, ¶¶ 18–19, Fig. 1; Ex. 1017, ¶ 38));
2. A person of ordinary skill in the art would have combined Steinbrecher's case with Marks's rechargeable battery configured to

[7] EP 1 727 395 B1, filed Feb. 8, 2006, published Aug. 20, 2008. Ex. 1006, "Steinbrecher".

receive charge inductively to charge hearing aids using "known and routine electronic device design and manufacturing techniques" to yield expected, predictable results (*id.* at 19–20 (citing Ex. 1006, ¶¶ 24–25, Figs. 1, 2; Ex. 1018, ¶¶ 18, 30, 38, Fig. 1; Ex. 1017, ¶ 39));

3. Implementing Marks's rechargeable battery configured to receive charge inductively would have made the charging process more convenient and simplified because "no cable is needed to enable the charging" (*id.* at 20 (citing Ex. 1018, ¶ 30; Ex. 1017, ¶ 40)); and
4. A person of ordinary skill in the art would have had a reasonable expectation of success combining Steinbrecher's case with Marks's rechargeable battery that can be charged inductively (*id.* (citing Ex. 1017, ¶ 41)).

Petitioner's Opposition appears to show that a person of ordinary skill in the art would have had reason to combine Steinbrecher and Marks.

Petitioner's contentions appear to show that proposed substitute claims 31 and 42 would have been obvious over the cited art. Thus, it is our preliminary, non-binding opinion that Petitioner has established a reasonable likelihood that the combined teachings of Steinbrecher and Marks would have rendered proposed substitute claims 31 and 42 obvious.

C. *Shaffer*[8]*, Hain, and/or Sørensen*[9] *(Proposed Substitute Claims 22–30)*

Petitioner argues the combination of Shaffer, Hain, and/or Sørensen renders proposed substitute claims 22–30 obvious because Patent Owner "does not point to any deficiency in Shaffer or Sorensen as to substitute claims 22–30," but instead "notes that Grounds 4 and 5 include Hain and, like for Ground 2, argues that 'Hain does not disclose 'powering circuitry of the wireless earpieces utilizing a high power mode in response to detecting a magnetic field is not applied to one of the wireless earpieces.'"" Opp. 21 (citing Mot. 14). Petitioner argues further that Shaffer, Hain, and/or Sørensen render proposed substitute claims 22–30

[8] US 2015/0245126 A1, filed Oct. 9, 2014, published Aug. 27, 2015. Ex. 1003, "Shaffer".

[9] US 8,265,315 B2, filed Oct. 12, 2009, issued Sept. 11, 2012. Ex. 1005, "Sørensen".

obvious because Hain teaches proposed substitute claim 22's limitations reciting "powering circuitry of the in-ear wireless earpieces utilizing a high power mode in response to detecting a magnetic field is not applied to one or more of the in-ear wireless earpieces" and "altering the power sent to the circuitry of the in-ear wireless earpieces to a low power mode in response to detecting a magnetic field is applied to one or more of the in-ear wireless earpieces" for the reasons discussed above. *Id.* (citing Ex. 1017, ¶ 43).

For the same reasons discussed above for the anticipation ground based on Hain, it appears that Petitioner has established a reasonable likelihood that proposed substitute claims 22–30 would have been obvious over Shaffer, Hain, and/or Sørensen.

D. *Shaffer, Steinbrecher, Sørensen, and/or Marks (Proposed Substitute Claims 31–42)*

Petitioner argues the combination of Shaffer, Steinbrecher, Sørensen, and/or Marks renders proposed substitute claims 31–42 obvious because Patent Owner "does not dispute that the combination of Shaffer with Steinbrecher and/or Sorensen discloses the proposed 'in-ear' [wireless earpiece] and 'wherein the powering circuitry is housed within the in-ear wireless earpiece' amendments in substitute claims 31–42," but instead "argues that 'none of these references disclose a 'smart case comprising a rechargeable battery configured to receive charge inductively and to charge the in-ear wireless earpiece.'"" Opp. 21–22 (citing Mot. 15; Ex. 1017, ¶¶ 44–45).

Petitioner contends further that the combination of Shaffer, Steinbrecher, Sørensen, and/or Marks renders proposed substitute claims 31–42 obvious for the following reasons:

1. Shaffer teaches "a smart case comprising a rechargeable battery configured . . . to charge the in-ear wireless earpiece" (Opp. 22 (citing Ex. 1003, ¶¶ 42, 56–57, Figs. 3D, 4; Ex. 1017, ¶ 46));
2. Shaffer teaches the rechargeable battery can be charged when electrical components within the case transfer charge from "a power source via plug 19" via PCB 1004 to battery 109 (*id.* (citing Ex. 1003, ¶ 57; Ex. 1017, ¶ 47));
3. Shaffer and Marks are from the same field of endeavor because they are both directed to a case that charges an electronic device stored

therein (*id.* at 23 (citing Ex. 1003, ¶¶ 39–47, Figs. 2A–3D; Ex. 1018, ¶¶ 18–19, Fig. 1; Ex. 1017, ¶ 50));

4. A person of ordinary skill in the art would have combined Shaffer's case with Marks's rechargeable battery configured to receive charge inductively to charge hearing aids using "known and routine electronic device design and manufacturing techniques" to yield expected, predictable results (*id.* at 22–24 (citing Ex. 1003, ¶ 56, Fig. 4; Ex. 1018, ¶¶ 18, 30, 38, Fig. 1; Ex. 1017, ¶¶ 48, 51));
5. Implementing Marks's rechargeable battery configured to receive charge inductively would have made the charging process more convenient and simplified because "no cable is needed to enable the charging" (*id.* at 24–25 (citing Ex. 1018, ¶ 30; Ex. 1003, ¶¶ 47, 49, Figs. 5A, 5B; Ex. 1017, ¶ 52)); and
6. A person of ordinary skill in the art would have had a reasonable expectation of success combining Shaffer's case with Marks's rechargeable battery that can be charged inductively (*id.* at 25 (citing Ex. 1017, ¶ 53)).

Petitioner contends a person of ordinary skill in the art would have been motivated to combine Shaffer, Steinbrecher, and Sørensen for the same reasons discussed in the Petition (Paper 1, "Pet."). Opp. 23, n.7 (citing Ex. 1017, n.2)).

Petitioner's Opposition appears to show that a person of ordinary skill in the art would have had reason to combine Shaffer, Steinbrecher, Sørensen, and/or Marks.

Petitioner's contentions appear to show that proposed substitute claims 31–42 would have been obvious over the combination of the cited art. Thus, it is our preliminary, non-binding opinion that Petitioner has established a reasonable likelihood that the combined teachings of Shaffer, Steinbrecher, Sørensen, and/or Marks would have rendered proposed substitute claims 31–42 obvious.

## III. CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner's first option under the Board's Pilot Program. Notice, 84 Fed. Reg. at 9,497. Patent Owner has the additional option under the Board's Pilot Program to file a revised motion to amend by August 30, 2024 (Due Date 3). Paper 15, 2. These two options are in addition to Patent Owner's original option to file a reply brief in response to Petitioner's opposition to the motion to amend.

In addition to those two options under the Board's Pilot Program and the option to file a reply brief, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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