

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BILLERUD AKTIEBOLAG (PUBL),
Petitioner,

v.

WESTROCK MWV, LLC,
Patent Owner.

IPR2023-01206
Patent 11,293,142 B2

Before CHRISTOPHER M. KAISER, ELIZABETH M. ROESEL, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On March 13, 2024, we instituted trial as to claims 1, 2, and 4–23 of U.S. Patent No. 11,293,142 B2 (“the ’142 patent”). Paper 14 (“Decision” or “Dec.”). After institution, Patent Owner filed a Contingent Motion to Amend, which submits substitute claims 24–27, to replace original claims 1 (claim 24), 2 (claim 25), 6 (claim 26), and 7 (claim 27). Paper 22, 1 (“Motion” or “Mot.”).¹ Petitioner filed an Opposition to the Motion. Paper 24 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requests that we provide preliminary guidance 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”).² We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory

¹ We note that proposed substitute claims 25–27 depend from claim 1, not claim 24.

² The pilot program will become permanent under Final Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings, which will take effect October 18, 2024. *See* <https://www.federalregister.gov/documents/2024/09/18/2024-21134/rules-governing-motion-to-amend-practice-and-procedures-in-trial-proceedings-under-the-america>.

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* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB February 25, 2019) (precedential); *see also* 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].”); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020) (“Rules”).

In this Preliminary Guidance, we do not address the patentability of the originally challenged claims 1, 2, and 4–23. Instead, we focus on the limitations added to those claims and reflected in the substitute claims in Patent Owner’s Motion to Amend. *See* Notice, 84 Fed. Reg. at 9,497. Proposed substitute claim 24 includes a limitation copied from original claim 2. Mot. App. A, 1–2. Because claim 2 is an originally challenged claim, the Preliminary Guidance does not address the limitation of proposed claim 24 that was copied from claim 2.

We emphasize that the views expressed below may change upon consideration of the complete trial record. Additionally, the views expressed below may not apply to any revised motion to amend that Patent Owner may file in response to this Preliminary Guidance. Thus, this Preliminary Guidance is not binding on the Board when rendering its final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

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 shown a reasonable likelihood that it has satisfied all 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))
Yes. Patent Owner proposes replacing four issued claims with four proposed claims, on a contingent basis. Mot. 1. The statute states that “[f]or each challenged claim,” the Patent Owner may “propose a reasonable number of substitute claims.” 35 U.S.C. § 316(d)(1)(B). Because Patent Owner proposes one claim for each original claim, the number of substitute claims is reasonable.

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 does not set out in a separate section of the Motion any arguments addressing this requirement. However, Patent Owner indicates in the introduction to the obviousness section that the “amendments in each of the Substitute Claims address each one of the grounds of unpatentability.” Mot. 5. Petitioner does not argue that the Motion is nonresponsive. <i>See generally</i> Opp. Under the Rule, the requirement is for the amendment to be responsive to “a ground of unpatentability.” 37 C.F.R. § 42.121(a)(2)(i). We are persuaded that Patent Owner has met this requirement, by amending the claims in response to the Petition’s asserted prior art.

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. Patent Owner contends “[e]ach of the Substitute Claims contains only narrowing amendments.” Mot. 2–3. Petitioner does not contend otherwise.

Because no subject matter is removed along with the addition of new limitations, other than to correct obvious typographical errors, the amendments do not seek to enlarge the scope of the claims.

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))

No.

The ’142 patent claims the benefit of U.S. Provisional Application No. 62/846,278, filed May 10, 2019 (the “’278 Provisional,” Ex. 2009). Ex. 1001, code (60). Patent Owner asserts there is support in both the original disclosure for the ’142 patent and the ’278 Provisional for each limitation Patent Owner proposes to add to the claims. Mot., App. A, 2. Petitioner argues that the proposed claims lack written description support. We address the disputed limitations below. For the limitations not specifically discussed below, we find that Patent Owner establishes written description support in the ’278 Provisional.

Claim 24

Claim 24 recites passing a paperboard substrate through a thermo-roller and a counter roller, where “only” the thermo-roller is heated to an elevated temperature of at least 250° F, “and wherein the counter roller is not heated to the elevated temperature.” Mot., App. A, 1.

Patent Owner contends there is written description support for the proposed claim language, citing the Patent Owner Preliminary Response, and the Institution Decision. Mot. 3–4 (citing Paper 13, 11–18; Dec. 22). The Patent Owner Preliminary Response and the Institution Decision cite the ’142 patent, not the ’278 Provisional. Paper 13, 11–18; Dec. 20–22. However, our rules require “support in the original disclosure of the

patent,” or “support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.”

37 C.F.R. § 42.121(b). Thus, Patent Owner should have cited to the ’278 Provisional, which was not done for claim 24.

Petitioner contends there is no written description support “that the counter roller is not heated to the elevated temperature,” as claimed. Opp. 5.

Specifically, Petitioner contends, “nowhere in the ’142 Patent is there any disclosure, discussion or mention of any alternatives, or advantages or disadvantages of heating the counter roller or not heating the counter roller to the elevated temperature, or heating the counter to any temperature.”

Id. at 7 (citing *Novartis Pharma Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 1017 (Fed. Cir. 2022)).

Although the question is a close one, it is our preliminary view that Patent Owner has established written description support for the unheated counter roller limitation of claim 24.

In the Institution Decision, we determined that “the ’142 Patent’s silence about whether the counter-roller is heated is not enough to justify reading a negative limitation into the claim.” Dec. 20. That determination was based on the legal standard for claim construction, which considers lexicography or disclaimer. Dec. 20–22. The legal standard for written description is different. “Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation. *Such written description support need not rise to the level of disclaimer.*” *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) (emphasis added); *see also Novartis*, 38 F.4th at 1017 (“While a negative limitation need not be recited in the specification *in haec verba*, there generally must be something in the specification that conveys to a skilled artisan that the inventor intended the exclusion, such as a discussion of disadvantages or alternatives.”).

As discussed in the Institution Decision, the ’142 patent’s examples disclose both a hot-hard calender and a gloss-type calender. Dec. 20 (citing Ex. 1001, 6:45–50, 7:15–20, 7:52–57, 8:23–28, 8:60–65, 9:30–35, 10:40–48 (Table 1)); Dec. 22 (citing Ex. 1001, 7:2–3, 7:35–40, 8:5–11, 8:43–49, 9:13–18, 9:50–55).³ In the hot-hard calender, the surface

³ These same disclosures are found in the ’278 Provisional. See Ex. 2009 ¶¶ 39, 43, 46, 50, 53, 57, 60, 64, 67, 71, 74, 78.

temperature of the thermo-roller was 480°F or 500°F; whereas in the gloss-type calender, “roller surface temperatures (plural) were maintained at around 200°F.” Dec. 20, 22 (citing Prelim. Resp. 13). The Institution Decision relies on the testimony of Patent Owner’s declarant, Mr. Klass, that the gloss-type calender “substantiates that any counter rollers in the hot-hard calender are not heated to the elevated temperature.” Dec. 22 (citing Ex. 2003 ¶ 59).

Based on the patent examples and Mr. Klass’s testimony, it is reasonable to infer that the skilled artisan would have understood the ’142 patent (and the ’278 Provisional) as disclosing two alternatives: an unheated counter roller (as in the hot-hard calender) and a heated counter roller (as in the gloss-type calender). Based on the present record, it is our preliminary view that the disclosures of the ’142 patent (and the ’278 Provisional) are sufficient to show possession of the concept of only heating the thermo-roller, and not heating the counter roller, as recited in claim 24. *Novartis*, 38 F.4th at 1016 (“Another reason [sufficient to support a negative limitation] could be that the specification ‘distinguishes among’ the element and alternatives to it.”); *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1356 (Fed. Cir. 2015) (Support for a negative limitation may be “provided, for instance, by properly describing alternative features of the patented invention.”).

Claim 25

Claim 25 recites “applying a nip load to said paperboard substrate ranging from about 20 pli to about 90 pli.” Mot., App. A at 2. (The “90 pli” is amended from the upper limit of “500 pli,” in claim 2, which claim 25 proposes to replace, and which was copied into proposed claim 24.)

Patent Owner contends the 90 pli limit “is specifically called out as the nip load in the hot-hard calender in three of six detailed examples in the ’142 Patent specification.” Mot., App. A at 4–5 (citing Ex. 2009 ¶¶ 53, 60, 67).

Petitioner contends the Specification discloses a variety of ranges of nip load, including 20 pli to 350 pli, 20 pli to 160 pli, and 30 pli to 140 pli, as well as an applied nip load in disclosed examples of “about 90 pli.” Opp. 10–11. But, Petitioner argues, “disclosing specific endpoints such as a nip load of 20 pli and 90 pli is insufficient written description for claiming a nip load of about 20 pli to 90 pli.” Opp. 11.

It is our preliminary view that Patent Owner has shown written description support for this proposed claim. For example, the ’278 Provisional

discloses that “smooth paperboard is typically more dense (e.g., less bulky) than less smooth paperboard,” but that “low density is a desirable quality in many paperboard applications.” Ex. 2009 ¶¶ 3, 4. The document further describes that “using conventional processes generally requires substantially increasing paperboard density.” *Id.* ¶ 4. Based on examples disclosed in the application, the inventors disclose “a comparably smooth paperboard structure may be manufactured using the disclosed method (which utilizes the hot-hard calender) despite applying a significantly lower nip load.” *Id.* ¶ 82. According to the Provisional, “it is believed that calendering paperboard substrates at significantly higher temperatures may compensate for lower nip loads in achieving a desired smoothness.” *Id.*

The application discloses six examples of using the invented method, involving lower nip loads and higher temperatures, and six examples “using a traditional calender under traditional calendering conditions.” *Id.* ¶ 80. The disclosed method used nip loads of 90 pli in three cases (examples 4–6), and 140 pli in three cases (examples 1–3), where the “traditional” method examples used nip loads of 350 pli. *Id.* at Table 1. The Provisional discloses the “nip loads applied in Examples 1–6 ranged from 60% to 74.3% lower than the nip loads applied in their corresponding [traditional-method] Comparative Examples.” *Id.* ¶ 82.

The Provisional application also discloses a number of example ranges of nip loads, including “about 20 pli (pounds per linear inch) to about 500 pli,” “about 20 pli to about 350 pli,” “about 20 pli to about 160 pli,” and “about 30 pli to about 140 pli.” *Id.* ¶ 33; *see also* originally-filed claims 13–16 at p. 20.

The ’278 Provisional indicates a goal of using lower nip loads than traditionally used, and disclosing both a range of nip load from “about 20 pli to about 160 pli” (*id.* ¶ 33), as well as three examples using a nip load of 90 pli (*id.* ¶¶ 60, 67, 74). The three examples (Examples 4–6) using 90 pli resulted in better smoothness values (1.3 or 1.4) as compared to examples 1–3 using 140 pli (1.7 or 1.9), and with lower densities than the three traditional-method examples for 10-point caliper thickness, using fewer nips, thus disclosing several advantages to the approach used in Examples 4–6. *Id.* at Tables 1, 2.

These disclosures support our preliminary view that a skilled artisan could reasonably conclude the nip range of 20 pli to 90 pli is disclosed in the

'278 Provisional. *See RAI Strategic Holdings, Inc. v. Philip Morris Prod. S.A.*, 92 F.4th 1085, 1090 (Fed. Cir. 2024) (“The specification need not expressly recite the claimed range to provide written description support.”).

Claim 26

Claim 26 recites “wherein said elevated temperature is at least about 480° F.” Mot, App. A at 2.

Patent Owner contends there is “ample support for the elevated temperature of at least about 480° F.,” noting the temperature of 480° F. in three of the disclosed examples, and 500° F. in issued claim 3. Mot., App. A at 5 (citing Ex. 2009 ¶¶ 39, 46, 53, claim 3).

Petitioner contends “disclosing heating a thermo-roller to an elevated temperature of ‘at least 400° F[.]’ and an example of heating a thermo-roller to an elevated temperature of ‘about 480° F’ does not support the substitute of claim 27 [*sic*, claim 26]’s ‘at least 480° F’ elevated temperature.” Opp. 12.

At this preliminary stage, it is our view that Patent Owner has shown written description support for proposed claim 26.

The '278 Provisional discloses variously that the “elevated temperature” is “at least 250 °F,” “at least 300 °F,” “at least 400 °F,” and “at least 500 °F.” Ex. 2009 ¶ 34. The application also describes that, for each of the improved-method examples, the temperature of the thermo-roller surface was either 480 °F (examples 1–3) or 500 °F (examples 4–6), compared to 200 °F for the traditional-method examples. *Id.* at Table 1.

Given the '278 Provisional’s teaching that higher temperatures permitted lower nip load values to achieve acceptable smoothness at lower densities (Ex. 2009 ¶ 82), it is our preliminary view that a skilled artisan would reasonably conclude the disclosed values from the examples showed possession of the concept of an elevated temperature of at least 480 °F, because all six of the examples use temperatures at or above that temperature.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Petitioner has not shown a reasonable likelihood that substitute claims 24–27 are unpatentable.

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

35 U.S.C. § 112(a)

Petitioner contends that the ‘142 patent does not teach a person of ordinary skill in the art how to make and use the full scope of the purported invention without undue experimentation. Opp. 13. According to Petitioner, the ‘142 patent does not provide sufficient enabling disclosure “to know what temperature the counter roller should be heated or at what temperature the counter roller should be.” *Id.* (citing Ex. 1001).

Specifically, Petitioner argues:

A person of ordinary skill in the art would wonder whether the counter roller of claim 24 ... should be at ambient temperature, heated to a temperature less than the elevated temperature or even heated to a temperature over the elevated temperature[] (Ex. 1001), as well as the effects on the paperboard for doing so.

Id.

At this stage of the proceeding, it is our preliminary view that Petitioner has not demonstrated a lack of enablement. As an initial matter, Petitioner does not provide evidence applying the *Wands* factors. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) (listing factors that may be considered when determining if a disclosure requires undue experimentation).

Furthermore, Petitioner does not cite any expert testimony or other evidence (aside from the ‘142 patent) to support its non-enablement argument. Opp. 12–13. At this juncture, Petitioner’s argument about undue experimentation appears to be inconsistent with the testimony of Petitioner’s declarant. Mr. Zotterman testifies that “it is routine optimization in the art to explore the temperature of thermo-rollers as a result-effective variable” and “it would be a routine exercise (i.e., routine optimization) to explore the effects of different temperatures of the roller

upon the web being passed over it – from ambient temperature to the highest operational temperature that can be achieved by the roller.” Ex. 1003 ¶ 111. Generally speaking, routine optimization is not considered undue experimentation. *Cephalon, Inc. v. Watson Pharms., Inc.*, 707 F.3d 1330, 1336 (Fed. Cir. 2013) (“[A]lthough experimentation must not be undue, a reasonable amount of routine experimentation required to practice a claimed invention does not violate the enablement requirement.”).

35 U.S.C. § 103 — Obviousness

Petitioner contends that proposed substitute claims are unpatentable as obvious in view of Fugitt (Ex. 1004), Papermaking (Ex. 1005), and Gratton (Ex. 1006), which are asserted in the Petition, and Zakaib (Ex. 2007), which is asserted in the Opposition. Opp. 14. At this point in the proceeding, it is our preliminary view that Petitioner has not shown that claims 24–27 are likely obvious over the asserted prior art.

Claim 24

As to “only” heating the thermo-roller, where a counter-roller is not heated to the elevated temperature, Patent Owner contends “*Fugitt* and *Papermaking* fail to disclose any calender nip wherein a contact surface of only the thermo-roller is heated to an elevated temperature and the counter roller is not heated to the elevated temperature, as recited in Substitute Claim 24.” Mot. 7. Patent Owner further contends “*Papermaking* includes a section that specifically discusses multi-roll hard-nip calenders like the one in *Fugitt*, but it does not mention heating or thermo-rollers.” *Id.* at 6 (citing Ex. 1005, pp. 54–60).

Petitioner contends that Zakaib and Papermaking teach the unheated counter-roller limitation of claim 24. Petitioner contends that a person of ordinary skill in the art would have viewed Zakaib’s single induction heating system “as having one roll heated.” Opp. 14–15 (citing Ex. 2007, 58, 60, Fig. 1). Petitioner asserts that Papermaking teaches “hard-nip calenders . . . for a variety of paper and board grades” and discloses that a “two-roll hard-nip calender is composed of a heated cast-iron roll and a deflection compensated roll.” Opp. 15–16 (citing Ex. 1005, 35, 38–39); *see also* Pet. 32. Petitioner also indicates that Papermaking discloses that

“Heating up both nip rolls, however, is complicated because the other roll is a deflection-compensated roll.” *Id.* at 16.⁴

On the present record, it is undisputed that the Fugitt does not teach the unheated counter roller limitation of claim 24 and instead teaches a paperboard production process that uses multiple steam-heated rolls. Mot. 7; Dec. 25; Pet. 30–31. Although Petitioner contends that Zakaib and Papermaking teach an unheated counter roller, Petitioner does not provide a sufficient rationale for combining that teaching with Fugitt or modifying Fugitt’s process that uses multiple steam-heated rolls. The Petition asserts: “It would also be obvious to use the heated hard-nip calenders disclosed in *Papermaking* in the process of *Fugitt*, including the two-roll hard-nip calender that has a thermo-roller and a counter roller.” Pet. 37. We did not need to consider that contention for purposes of institution. Dec. 25. At this stage, we are not persuaded that Petitioner provides a sufficient rationale to support obviousness of replacing Fugitt’s multi-roll calender with a two-roll hard-nip calender, as disclosed in Papermaking.

Claim 25

Proposed claim 25 recites “[t]he method of claim 1 wherein said passing said paperboard substrate through said hot-hard calender comprises applying a nip load to said paperboard substrate ranging from about 20 pli to about 90 pli.” Mot., App. A at 2. (The “90 pli” replaces the “500 pli” in issued claim 2. *Id.*)

Patent Owner contends “[f]or the only nip load range in *Fugitt* or *Papermaking* that even partially overlaps the range in Substitute Claim 25, namely 57.1 to 228.6 pli . . . [t]hat range is not relevant to paperboard and is thus irrelevant to the claims,” because it “is for completely different paper products.” Mot. 10 (citing Ex. 2003 ¶ 106).

Petitioner relies on Mr. Zotterman’s testimony that a nip load of “10–90 kN/m [57.1 – 513.9 pli] is common.” Opp. 16 (citing Ex. 1009 ¶ 119). Petitioner asserts that Patent Owner’s witness, Mr. Klass, “confirmed that Marley discloses a hot hard pre-calender in which the surface temperature of the heated roll is 300°C and the nip load is ranging

⁴ Although Petitioner cites to pages 38–39 of Ex. 1005, the quoted passage is actually at page 40.

from 10 N/mm [57.1 PLI] to 100 N/mm.” *Id.* (citing Ex. 1012, 110–115; Ex. 1015⁵). Petitioner contends that claim 25 “overlaps with the common range in the prior art.” Opp. 17.

Although Marley discloses a nip load range that overlaps the claimed range, Petitioner does not provide a sufficient rationale for combining Marley’s nip load range with the paperboard production process of Fugitt and Papermaking. Petitioner also does not address whether a person of ordinary skill in the art would have expected to achieve the paperboard properties (smoothness and basis weight) disclosed in Fugitt and recited in claim 1 by combining Marley’s nip load with the production process of Fugitt and Papermaking.

Claims 26 and 27

Claim 26 recites that the “elevated temperature is at least about 480° F.,” and claim 27 recites that the “elevated temperature is at least 400° F.” Mot., App. A at 2.

Patent Owner contends that the “elevated temperature” in each of claims 26 and 27 are “well above any of the temperatures disclosed in *Papermaking* and cited in Ground 1. Since *Fugitt* and *Papermaking* do not disclose the elevated temperature as recited in Substitute Claim 26, this claim is patentable over *Fugitt* and *Papermaking*.” Mot. 11. Patent Owner further indicates, as to claim 27, “[a]ccording to *Papermaking*, [400° F] is above the upper limit for steam heating,” and the “highest temperature stated in *Papermaking* for oil is 220° C, which converts to 428 °F.” *Id.* at 11–12 (citing Ex. 1005 at 98). However, according to Patent Owner, “[i]t would not have been obvious to modify the steam heating system disclosed in *Fugitt* with the oil heating system disclosed in *Papermaking*.” *Id.* at 12.

Petitioner directs us to *Papermaking*’s teaching that “Steam can be used up to 170°C [338°F] surface temperature” and that oil-heated rolls can reach “can reach over 220°C [428°F].” Opp. 17. According to Petitioner, Marley “shows that 300°C [572° F] was known in the art for pre-calendering before coating of paperboard.” Opp. 17 (citing Ex. 1005, 98; Ex. 1015, 17).

⁵ The Opposition mistakenly refers to Marley as Ex. 1005, rather than Ex. 1015. Opp. 16.

Although Papermaking discloses a temperature range that overlaps the ranges recited in claims 26 and 27 and Marley discloses a temperature within the claimed range, Petitioner does not provide a sufficient rationale for modifying Fugitt's process that uses steam-heated rolls (having a maximum surface temperature of 338°F) with the teachings Papermaking or Marley that disclose higher temperatures. Petitioner also does not address whether a person of ordinary skill in the art would have expected to achieve the paperboard properties (smoothness and basis weight) disclosed in Fugitt and recited in claim 1, if the roller temperature were increased above the level achievable by steam-heated rolls.

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 an additional option under the Board's pilot program to file a revised MTA by DUE DATE 3. Paper 20, 1.

In addition to those two options under the Board's pilot program, 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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