

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE USA CORPORATION,
Petitioner,

v.

BRIGHTPLUS VENTURES LLC,
Patent Owner.

IPR2023-01412
Patent 8,330,710 B2

Before STACEY G. WHITE, KEVIN C. TROCK, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND
37 C.F.R. § 42.121(e)

I. INTRODUCTION

On April 25, 2024, we instituted trial as to claims 1, 2, 5, 11–13, 16, 17, 47, and 48 of U.S. Patent No. 8,330,710 B2. Paper 7. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1, 17, 47, and 48.¹ Paper 12 (“Motion” or “Mot.”). Petitioner filed an Opposition on October 17, 2024. Paper 17 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with 37 C.F.R. § 42.121(a)(1)(ii).² Mot. 4, 21–22; *see* 37 C.F.R. § 42.121(e)(1); *see also Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024) (“Final Rule”). 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 requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner

¹ Patent Owner states that this motion “is contingent upon a finding in a final written decision that challenged claims 1, 17, 47, and 48 are unpatentable,” and that “if claims 1, 17, 47, and 48 are found to be unpatentable, substitute proposed amended claims 58, 59, 60, and 61.” Paper 12, 4. We note that this statement may be read to require that claims 1, 17, 47, and 48 all need to be found unpatentable before the contingency is triggered and any proposed claim is substituted for any original claim. Patent Owner should clarify the exact meaning of the contingency.

² Although Patent Owner’s submission requested guidance under the Board’s MTA (Motion to Amend) Pilot Program, because the Pilot Program has been replaced with Final Rule governing motion to amend practice as of October 18, 2024, we provide guidance under the Final Rule, but note that our guidance is the same either way.

establishes a reasonable likelihood that the substitute claims are unpatentable. 37 C.F.R. § 42.121(e)(1), (2); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121(a)(2), (a)(3), (b) (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). The reasonable likelihood standard this Preliminary Guidance applies is different than the preponderance of the evidence standard applied when ultimately deciding the Motion. *Compare* 37 C.F.R. § 42.121(e)(1) *with* § 42.121(d). Finally, this preliminary guidance is not a “decision” for purposes of rehearing under 37 C.F.R. § 42.71(d). 37 C.F.R. § 42.121(e)(2).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. We do not address the patentability of the originally challenged claims. 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 or any other subsequent decision in this proceeding. 37 C.F.R. § 42.121(e)(2); *see Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

Patent Owner bears the ultimate burden to show that its Motion to amend complies with the requirements of 35 U.S.C. § 316(d)(1), (3) and 37 C.F.R. § 42.121(a)(2), (a)(3), (b)(1), and (b)(2). 37 C.F.R. § 42.121(d)(1). For the reasons discussed below, at this stage of the proceeding, and based on the current record, Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend. *See* 37 C.F.R. § 42.121(e)(1).

1. Reasonable Number of Substitute Claims

A motion to amend must propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Patent Owner has shown it proposes a reasonable number of substitute claims because Patent Owner proposes no more than 1 substitute claim for each challenged claim. *See* 37 C.F.R. § 42.121(a)(3) (presumption that only one substitute claim is needed to replace each challenged claim).

2. Respond to Ground of Unpatentability

A motion to amend must respond to a ground of unpatentability involved in the proceeding. 37 C.F.R. § 42.121(a)(2)(i). Patent Owner has responded to a ground of unpatentability involved in this proceeding because the Motion adds further limitations that Patent Owner contends render the claims patentable over

Shteynberg,³ Arai,⁴ Zhang,⁵ Kobori,⁶ Kawabata,⁷ and Lee⁸ cited in the Petition. Mot. 4, 9–21.

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner’s Motion removes the language “*a plurality of*” for on-state drive current from claim 58. Petitioner does not contend that the Motion enlarges the scope of the claims of the patent. *See generally* Opp. On this record, we consider that the additional language being added (in particular, the requirement that “an on-state drive current” be supplied to “*each of the plurality of strings . . . wherein the on-state drive current is individually determined for each string*”) requires a plurality of on-state drive currents. Therefore, at this stage, we do not find that the Motion enlarges the scope of the claims. The parties are invited to address this issue in future papers.

4. Claim Listing

The claim listing does not show the changes clearly. 37 C.F.R. § 42.121(b).

In claim 58, line 6, “current” should be “current[[s]].” In claim 59, line 8, the comma should be underlined. In claim 61, line 3, the comma should be underlined and in line 4 the period should not be underlined.

³ US 2008/0116818 A1, published May 22, 2008 (Ex. 1007, “Shteynberg”).

⁴ US 2007/0121320 A1, published May 31, 2007 (Ex. 1008, “Arai”).

⁵ CN 1750732A, published Mar. 22, 2006 (original (Ex. 1009) and English translation (Ex. 1010, “Zhang”).

⁶ US 2006/0139954 A1, published June 29, 2006 (Ex. 1011, “Kobori”).

⁷ US 2003/0016205 A1, published Jan. 23, 2003 (Ex. 1012, “Kawabata”).

⁸ US 2007/0013647 A1, published Jan. 18, 2007 (Ex. 1013, “Lee”).

5. New Matter

A motion to amend may not introduce new subject matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). We preliminarily determine that Patent Owner has not established that the Motion does not introduce new subject matter because Patent Owner has not set forth sufficient written description support for the proposed substitute claims, as explained below.

i. Patent Owner’s Insufficient Written Description Support

Patent Owner has not set forth sufficient written description support for the proposed substitute claims in accordance with the relevant sections of 37 C.F.R. and the precedential *Lectrosonics* decision.

First, the Motion is required to set forth the support “in the original disclosure of the patent.” 37 C.F.R. § 42.121(b)(1); *Lectrosonics* at 7–8 (“[i]mportantly, to meet this requirement, citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued”). The Motion (*see* Mot. 8–9) did not set forth the support in the original disclosure of the ’710 patent that was filed October 11, 2011, but instead set forth disclosure in the patent as issued in December 11, 2012. Second, the Motion (*see* Mot. 8–9, 21) did not set forth support in the priority application original disclosure. *See* 37 C.F.R. § 42.121(b)(2) (the motion must set forth the support in an earlier-filed disclosure for each claim for which the benefit of the filing date of the earlier-filed disclosure is sought); *Lectrosonics* at 7–8 (motion to amend must “set forth support in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought”). Third, the Motion did not set forth written description support for each proposed substitute claim *as a whole*. *See Lectrosonics* at 8 (“the motion must set forth written description support for each

proposed substitute claim as a whole, and not just the features added by the amendment”).

ii. Petitioner’s Arguments Regarding “firing order” and “luminous intensity” . . . “synchronized with periodic operations of the display”

Petitioner argues that “Patent Owner has failed to demonstrate written description support under 35 U.S.C. § 112 for its proposed amendments reciting that the ‘firing order’ and ‘luminous intensity’ of each of the strings in the plurality of strings are ‘synchronized with periodic operations of the display.’” Opp. 2. Petitioner argues “[t]he specification of the ’710 Patent is *devoid* of any reference to any ‘periodic operations’ of a display.” *Id.*

We disagree with Petitioner because Patent Owner cites dependent claim 15 for support (Mot. 8), and dependent claim 15 recites “wherein the control system is configured to receive a synchronizing signal from a display controller configured to control a display and *wherein the firing order is synchronized with periodic operations of the display.*” Ex. 1001, 19:21–25 (emphasis added). This claim was an original claim in both the application that resulted in the ’710 patent (Ex. 1002, 30) and its parent (Ex. 1004, 32–33), which, in conjunction with the specification, supports that the applicant was in possession of the claimed invention at those times.

Petitioner further argues that the ’710 patent “fail[s] to describe synchronizing the ‘**luminous intensity** of each of the strings’ in the plurality of strings with any ‘periodic operations of the display.’” Opp. 5. At this stage, we do not agree with Petitioner’s argument because the argument does not take into account the collective teachings of claim 15 and other description in the ’710 patent. For example, the ’710 patent describes:

solid state backlight panel 1420 may include multiple strings of solid state light emitters that can be controlled to achieve a desired . . . *luminous intensity. Varying the output of a string may be accomplished, for example, by firing the string for a portion of a period,* which may be controlled by a backlight controller 1440. In some embodiments, the refresh rate of the LCD controller 1430 may be synchronized with the firing of the solid state backlight panel 1420 by sending a synchronizing signal from the LCD controller to the backlight controller 1440.

Ex. 1001, 15:38–48 (italics added); *see also id.* at Fig. 14. This passage describes backlight controller 1440 controlling luminous intensity by firing a string for a portion of a period and backlight controller 1440 being synchronized with LCD controller 1430.⁹

B. Unpatentability Arguments by Petitioner

Claim 58 is an independent claim that is a proposed substitute for independent claim 1 and claim 59 is an independent claim that is a proposed substitute for independent claim 17. Claim 60 is a dependent claim that is a proposed substitute for independent claim 47 and claim 61 is a dependent claim that is a proposed substitute for dependent claim 48.

Petitioner bears the ultimate burden to show that any proposed substitute claims are unpatentable. 37 C.F.R. § 42.121(d)(2). For the reasons discussed below, at this stage of the proceeding, and based on the current record,¹⁰ Petitioner

⁹ At this stage and on this record, we consider the claim limitation regarding firing order and luminous intensity being synchronized with periodic operations of the display to have written description support if Patent Owner establishes the language in column 15 and Figure 14 is in the original disclosure of the '710 patent and any earlier-filed disclosure for which the benefit of the filing date of the earlier-filed disclosure is sought, as discussed above.

¹⁰ We express no view on the patentability of original claims 1, 17, 47, and 48 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner's Motion to Amend.

has shown a reasonable likelihood that proposed substitute claims 58–61 are unpatentable as obvious. *See* 37 C.F.R. § 42.121(e)(1).

1. Claim 58

We now address each of the limitations added to claim 58, which is reproduced below as provided by Patent Owner.

58. (proposed substitute for Claim 1) A backlight lighting system for an LCD display, comprising:

a plurality of strings of solid state lighting devices arranged in a first direction and positioned at intervals in at least one second direction;

a current supply circuit configured to selectively supply a ~~plurality of an~~ on-state drive current to each of the plurality of strings responsive to a plurality of control signals, wherein the on-state drive current is individually determined for each string; and

a control system configured to receive a user input and to selectively provide control signals to the current supply circuit responsive to the user input to selectively drive the plurality of strings, the control system further including firing logic configured to determine a firing order of the plurality of strings, the control system further being operable to determine a luminous intensity of each of the strings in the plurality of strings; and

wherein the control system is configured to receive a synchronizing signal from a display controller configured to a display and wherein the firing order of the plurality of strings and the luminous intensity of each of the strings in the plurality of strings are synchronized with periodic operations of the display.

Mot., App. A.

i. backlight system for an LCD display

At this stage, we agree with Petitioner’s contentions that the combination of Arai, Kawabata, and Zhang teach a backlight system for an LCD display and that there would have been motivation to combine the teachings of these references.

See Opp. 5–6, 14–15; *see, e.g.*, Ex. 1008 (Arai) ¶¶ 24, 27 (liquid crystal panel unit

2 and backlight unit 3); Ex. 1012 (Kawabata) ¶ 2 (“[t]he present invention relates to a lighting unit for use as a backlight in a liquid crystal display device, for example, and also relates to a liquid crystal display device that uses the lighting unit”); Ex. 1010 (Zhang), Spec. 1:6–8, 5:2–5. Further, Shteynberg describes “backlighting” as a functional purpose of its system. Ex. 1007 (Shteynberg) ¶ 79. Also, the ’710 patent describes “[s]olid state lighting panels are commonly used as backlights for small LCD display screens.” Ex. 1001, 1:32–33.¹¹

- ii. wherein the on-state drive current is individually determined for each string

At this stage, we agree with Petitioner’s contentions that the combination of Shteynberg and Kawabata teach wherein the on-state drive current is individually determined for each string and that there would have been motivation to combine the teachings of these references. *See* Opp. 6–8, 16–18; *see, e.g.*, Ex. 1007 (Shteynberg) ¶¶ 47 (“turning on or off any selected series of LEDs”), 54 (“each series of LEDs 110₁, 110₂, 110₃, through 110_N will be provided with a selected and *independent current level*”) (emphasis added), 104 (describing Figure 10); Ex. 1012 (Kawabata) ¶¶ 60, 61 (“[t]he lighting controller 30 controls the emission states of the light-emitting elements 2 *independently* by supplying drive signals (e.g., currents or voltages) of substantially different types to the respective light-emitting elements 2”) (emphasis added).

¹¹ *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375–76 (Fed. Cir. 2022) (admissions are permissible evidence in an IPR for establishing background knowledge possessed by a person of ordinary skill in the art).

- iii. the control system further being operable to determine a luminous intensity of each of the strings in the plurality of strings

At this stage, we agree with Petitioner’s contentions that Shteynberg teaches a control system further being operable to determine a luminous intensity of each of the strings in the plurality of strings. *See* Opp. 9–11, 18–19; Ex. 1007 (Shteynberg) ¶¶ 8 (“each LED string of the LED array is controlled by a separate current regulator with a processor, to alter the *brightness*^[12] and/or color of the generated light using pulse-width modulated signals”) (emphasis added), 11 (“[t]he exemplary embodiments provide a multistring LED driver which controls current independently for each series of LEDs of the array, for corresponding effective color and *brightness control*, among other features”) (emphasis added), 19 (“the controller may be further adapted, in response to a first input, to adjust an output *brightness* of the plurality of series of light-emitting diodes by modifying each corresponding period of time of current switching to each of the series of light-emitting diodes”) (emphasis added); *see also* Ex. 1012 (Kawabata) ¶ 97 (“the *emission intensities* of the light-emitting elements are also controllable by getting the magnitudes of the currents or voltages, supplied or applied to the light-emitting elements, (i.e., the maximum signal intensities of their drive signals) adjusted by the lighting controller”) (emphasis added).

Also, the BACKGROUND section of the ’710 patent describes that “[s]olid state lamps, such as LED’s, are current-controlled devices in the sense that the intensity of the light emitted from an LED is related to the amount of current driven through the LED.” Ex. 1001, 2:8–11.

¹² *See* Ex. 1020 (Betancourt Decl.) ¶¶ 22 (explaining that a person of skill would understand “brightness” as another term for “luminous intensity”), 39.

iv. wherein the control system is configured

Petitioner contends that the combination of Kawabata and Kobori teach wherein the control system is configured to receive a synchronizing signal from a display controller configured to a display and wherein the firing order of the plurality of strings and the luminous intensity of each of the strings in the plurality of strings are synchronized with periodic operations of the display and that there would have been motivation to combine the teachings of these references. *See* Opp. 11–13, 19–22.

In connection with the firing order being synchronized with periodic operations of the display, Petitioner argues:

Patent Owner, however, suggests that disclosures in the specification of the '710 Patent with respect to synchronization of solely the “firing rate” of strings with the “refresh rate of the LCD display” provide written description support for these amendments. . . . *At least based on Patent Owner’s apparent interpretation of these amendments, the elements were well known in the art prior to the '710 Patent.*

Opp. 11–12 (emphasis added).

Kawabata teaches:

[i]n this example, the lighting controller 30 is so constructed as to sequentially *turn ON and OFF the respective light-emitting elements 2 synchronously with the input of the vertical sync signal to the liquid crystal panel 300.* A drive signal (i.e., a voltage signal or a current signal) to be supplied to each of the light-emitting elements is a periodic signal, *of which one period is as long as one vertical scanning period of the liquid crystal panel 300.*

Ex. 1012 (Kawabata) ¶ 69 (emphasis added). Kawabata further teaches: “[i]t should be noted that each light-emitting element 2 should start to emit light *synchronously with the input of a video signal to a predetermined display area of the liquid crystal panel 300 that is associated with the light-emitting region 4 of the light-emitting element 2.*” *Id.* ¶ 70 (emphasis added)..

Petitioner argues that these descriptions of Kawabata “means the *firing rate* of light emitting elements 2 is synchronized with the *refresh rate* of the liquid crystal panel 300.” Opp. 13 (emphasis added); *see also id.* at 20–22.

We disagree with Petitioner’s obviousness analysis of this limitation that the firing order be synchronized with periodic operations of the display because the claim limitation recites firing *order* not firing *rate*. However, at this stage we consider that paragraphs 69 and 70 of Kawabata teach to one of ordinary skill in art that firing order be synchronized with periodic operations of the display.

In more detail, paragraphs 69 and 70 describe periodic operations of the display in the form of “the input of the vertical sync signal to the liquid crystal panel 300” and “one vertical scanning period of the liquid crystal panel 300.” Ex. 1012 (Kawabata) ¶ 69. Firing order is taught by “*sequentially* turn[ing] ON and OFF the *respective* light-emitting elements.” *Id.* (emphasis added). Further, firing order is taught by “each light-emitting element 2 should start to emit light synchronously with the input of a video signal to a predetermined display area of the liquid crystal panel 300 that is associated with the light-emitting region 4 of the light-emitting element 2” (*id.* ¶ 70) because this description teaches that each light-emitting element 2¹³ should start to emit light (that is, should fire) synchronously with the input of a video signal to a particular area of the liquid crystal panel 300.¹⁴ Finally, these paragraphs expressly teach that such firing order and such periodic operations of the display be performed “synchronously.” *Id.* ¶¶ 69, 70; *see also*

¹³ “[O]ne light-emitting element 2 is provided for one light-emitting region 4. Optionally, a plurality of light-emitting elements 2 may be provided for a single light-emitting region 4.” Ex. 1012 (Kawabata) ¶ 60.

¹⁴ At institution we found that Shteynberg and Zhang also teach firing order. Paper 7, 18–21. Patent Owner contends the amendments distinguish Shteynberg (Mot. 9–11) and Zhang (Mot. 12–14). Similarly, at institution we found other portions of Kawabata teach firing order. Paper 7, 31–33.

¶ 66 (“as the pixels of the liquid crystal panel 300 are *sequentially* rewritten in the vertical scanning direction d3, light can be emitted *from one* of the light-emitting regions 4 of the lighting unit 100 *after another*”) (emphasis added).

At this stage, we agree that there would have been motivation to combine Kobori and Kawabata in the manner Petitioner does. *See* Opp. 21–22. At this stage, Patent Owner has not addressed the teachings in paragraphs 69 and 70 of Kawabata cited above. Mot. 15–17.

In connection with the luminous intensity being synchronized with periodic operations of the display, Petitioner argues Kobori teaches this limitation and that there would have been motivation to combine Kobori and Kawabata in the manner Petitioner does. *See* Opp. 11–13, 19–22. At this stage, we agree with Petitioner’s contentions. *See* Opp. 11–13, 19–22; *see, e.g.*, Ex. 1011 (Kobori) Fig. 4, ¶¶ 40, 41, 42 (“the image processor 13 controls the luminiferous level to the luminiferous control circuit 1 in a linking relation with the brightness and color components of the input video signal”), 43 (“*in synchronization with the image refresh cycle of the input video signal, the luminiferous level of the LED is corrected/controlled, thereby realizing luminiferous level control linking with the video signal and causing no uncomfortable feeling*”) (emphasis added). At this stage, Patent Owner has not addressed these teachings in paragraphs 42 and 43 of Kobori. Mot. 14–15.

For the reasons discussed above, at this stage of the proceeding, and based on the current record, Petitioner has shown a reasonable likelihood that proposed substitute claim 58 is unpatentable as obvious.

2. Claim 59

Our reasoning set forth above in connection with claim 58 applies to the corresponding limitations of claim 59. At this stage of the proceeding, and based

on the current record, Petitioner has shown a reasonable likelihood that proposed substitute claim 59 is unpatentable as obvious.

3. Claim 60

Claim 60 recites each drive current supplied to the plurality of strings comprises an independently determined PWM signal.

At this stage, we agree with Petitioner's contentions that Shteynberg teaches this limitation. *See* Opp. 8–9, 23–24; *see, e.g.*, Ex. 1007 (Shteynberg) ¶¶ 3 (“LEDs may be controlled by a processor to alter the brightness and/or color of the generated light, such as by using pulse-width modulated (‘PWM’) signals”), 4 (“driv[ing] a corresponding string of an RGB LED light source 15, with a PWM 20 driving scheme”), 8 (“*each LED string* of the LED array is controlled by a *separate* current regulator with a processor, to alter the brightness and/or color of the generated light *using pulse-width modulated signals*”) (emphasis added); *see also* Ex. 1011 (Kobori) ¶¶ 27, 29 (“[a]ccording to the amplitude value AMP and the *drive cycle PWM*, the lamp driver 3 generates the drive signal *waveforms 3a to 3d for each of the LEDs 4-7* so as to turn ON and OFF the LEDs 4 to 7”) (emphasis added), Fig. 1, Fig. 3 (showing different waveforms 3a to 3d).

Patent Owner argues that Shteynberg distinguished its invention from pulse width modulation. Mot. 18. We disagree because cited paragraph 115 of Shteynberg simply discloses another variation of its time-division modulation techniques (Ex. 1007 (Shteynberg) ¶ 115) and does not negate the teachings of Shteynberg cited above. *See* Opp. 24. At this stage, Patent Owner has not addressed the teachings of Kobori cited above. Mot. 20.

Further, the '710 patent describes PWM as “[o]ne common method.” Ex. 1001, 2:11–15.

For the reasons discussed above, at this stage of the proceeding, and based on the current record, Petitioner has shown a reasonable likelihood that proposed substitute claim 60 is unpatentable as obvious.

4. Claim 61

Our reasoning set forth above in connection with claim 60 applies to claim 61. For the reasons discussed above, at this stage of the proceeding, and based on the current record, Petitioner has shown a reasonable likelihood that proposed substitute claim 61 is unpatentable as obvious.

III.CONCLUSION

This concludes our Preliminary Guidance. Patent Owner has the option to reply to this Preliminary Guidance *or* to file a revised MTA by DUE DATE 3. 37 C.F.R. § 42.121(e)(3), (f); Paper 9. Patent Owner's reply or revised MTA may only respond to this Preliminary Guidance or Petitioner's Opposition and may be accompanied by new evidence (including declarations). 37 C.F.R. § 42.121(e)(3). Petitioner has the option to file a sur-reply responsive to this Preliminary Guidance, Patent Owner's reply, or Patent Owner's revised MTA but may not present new evidence in any case. 37 C.F.R. § 42.121(e)(3). Petitioner may also file a reply to the preliminary guidance in the case Patent Owner does not file a reply or revised MTA. 37 C.F.R. § 42.121(e)(4).

In addition, 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.

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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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