

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner,

v.

INPRIA CORP.,
Patent Owner.

IPR2024-00033
Patent 9,823,564 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

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

I. INTRODUCTION

On April 24, 2024, we instituted an *inter partes* review of claims 1–12 of U.S. Patent No. 9,823,564 B2 (Ex. 1001, “the ’564 patent”). Paper 13 (“Decision on Institution” or “Dec.”). After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1–12. Paper 20 (“Motion” or “Mot.”). Patent Owner also filed a Response to the Petition. Paper 19 (“Response” or “Resp.”).

In the Motion, Patent Owner proposes cancellation of claim 6 and proposes substitute claims 13–23 to replace original claims 1–5 and 7–12. Mot. 1–3. Petitioner filed an Opposition to the Motion (Paper 28 (“Opposition” or “Opp.”)) and a Reply to the Response (Paper 27).

Patent Owner requests that we provide preliminary guidance concerning the Motion in accordance with 37 C.F.R. § 42.121(a)(1)(ii).¹ Mot. 2; *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 provide that guidance based on our consideration of the Motion and 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 establishes a reasonable likelihood that the substitute claims are unpatentable. 37

¹ 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 the 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.

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 applied in this Preliminary Guidance is different from 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). 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, 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. *See 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. 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 provided below, at this stage of the proceeding, and based on the current record, we find Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend with respect to all proposed substitute claims. *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 it proposes one substitute claim for each of claims 1–5 and 7–12. Mot. 1–3. Petitioner does not argue otherwise. *See generally* Opp.

2. Responsive 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 by contending that the proposed substitute claims are patentable over three of the references asserted in the Petition’s challenges. Mot. 4; Paper 1 (“Pet.”), 3. Petitioner does not argue that the Motion is nonresponsive. *See generally* Opp.

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 proposes to use the

language “at least about 2” instead of “at least 2” in proposed substitute claim 19, which, at first blush, may appear enlarging. Mot. 14. Proposed substitute claim 19, however, depends from a claim that has a narrowing amendment (claim 13); therefore, on this preliminary record and at this stage of the proceeding, we do not view claim 19 as impermissibly enlarging the scope of the claims. *See Hisense USA Corp. v. Brightplus Ventures LLC*, IPR2023-01410, Paper 19 at 5 (PTAB Oct. 23, 2024) (non-precedential).

At this stage, based on the current record, Patent Owner’s proposed amendments do not enlarge the scope of the original claims.

4. 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). Patent Owner cites passages in support of proposed amendments for substitute claims 13 and 19 in non-provisional Application No. 12/850,867 (“the ’867 application”), to which the ’564 patent claims priority. Mot. 4–8 (citing Ex. 1004); Ex. 1001, code (63).

The test for sufficiency of a written description is whether the disclosure “‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991)) (second alteration in the original). The disclosure must “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* Possession means “possession as shown in the disclosure” and “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.*

At this juncture, we find Patent Owner’s citations to the ’867 application sufficiently support the proposed substitute claims. For instance, the ’867 application indicates possession of substitute claim 13’s average thickness of “about 25 nm” by describing an average thickness range of “about 1 nm to about 25 nm.” Ex. 1004, 23:18–22. In particular, the disclosed endpoint of “about 25 nm” provides support for reciting “about 25 nm” in proposed substitute claim 13.

In addition, the ’867 application indicates possession of substitute claim 19’s “molar concentration ratio of radiation sensitive ligands to metal ion of at least about 2.” Ex. 1004, 4:26–27, 10:10–11, 16:17–19, 20:8–10, 38 (claim 1).

Petitioner raises arguments regarding compliance with the written description requirement for limitations of the original claims, which we address in the next section. Opp. 2–6. Otherwise, Petitioner does not argue that the proposed amendments introduce new matter. *See generally* Opp.

Therefore, in our preliminary view, Patent Owner has met its burden to show the proposed substitute claims contain no new matter.

B. Unpatentability Arguments by Petitioner

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,² it appears that Petitioner has not shown a reasonable likelihood that proposed substitute claims 13–23 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

² We express no view on the patentability of original claims 1–12 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in Patent Owner’s Motion to Amend.

1. Written Description

Petitioner asserts that the proposed substitute claims lack written description support due to the limitations “radiation sensitive ligands,” “metal ions with radiation sensitive ligands,” and a “coating material” in which “radiation alters the chemical properties of the coating material.” Opp. 2–6.

Petitioner’s arguments pertain to limitations of the originally challenged claims. In this Preliminary Guidance, however, we focus on the proposed substitute claims and, specifically, on the amendments proposed in the Motion: We do not address the patentability of the originally challenged claims. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. Therefore, at this juncture, we do not address Petitioner’s written description arguments.

2. Enablement

Petitioner contends that the proposed substitute claims fail to comply with the enablement requirement because of the limitations “radiation sensitive ligands,” “metal ions with radiation sensitive ligands,” and a “coating material” in which “radiation alters the chemical properties of the coating material.” Opp. 6–8. Petitioner’s enablement arguments pertain to limitations of the originally challenged claims. As a result, we do not address Petitioner’s enablement arguments.

3. Indefiniteness

At this point in the proceeding, Petitioner has not shown a reasonable likelihood that proposed substitute claims 13–23 are indefinite.

Petitioner argues that proposed substitute claims 13–23 are indefinite because proposed substitute claim 13 recites an average thickness of “about 25 nm.” Opp. 8–10. Specifically, Petitioner contends that the ’564 patent “fails to

give sufficient guidance to construe the magnitude of variation permitted” and “fails to provide any guidance to a POSA in determining the range of thicknesses would fall within ‘about 25 nm.’” *Id.* at 8–9 (citing *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1217–18 (Fed. Cir. 1991); *Synthes (USA) v. Smith & Nephew, Inc.*, 547 F. Supp. 2d 436 (E.D. Pa. 2008)); Ex. 1040 ¶¶ 163–168.

According to Petitioner, during examination, a claim that included the phrase “about 30 nm” was rejected as indefinite and, although disagreeing with the rejection, Patent Owner ultimately removed “about” from the claim. Opp. 9 (citing Ex. 1007, 404, 489, 495–497, 504). Petitioner also observes that Patent Owner’s witness, Dr. Banerjee, when posed questions regarding the breadth of the term “about 25 nm,” repeatedly insisted that one of ordinary skill in the art would understand its scope but “was unable to answer whether any particular value would fall inside or outside that scope.” *Id.* at 9–10 (citing Ex. 1033, 85:16–135:14).

Words of approximation, such as “substantially” or “about,” are ubiquitous in patent claiming and do not necessarily render a claim indefinite. MPEP § 2173.05(b) (words of approximation are acceptable if one of ordinary skill in the art would understand what is claimed). As we observed in our Decision on Institution, the public record of prosecution provides some guidance on the issue, revealing that an ordinarily skilled artisan would have expected small changes to coating thickness (for example, a change of 5 nm, when going from 30 nm to 35 nm) to change the properties of the invention. Dec. 11 (citing Ex. 1007, 508). Furthermore, the specification explains how to achieve a desired thickness, based on “precursor solution concentration, viscosity, and . . . spin speed,” and why “it can be desirable to use a thin coating” for applications in which one aims to “facilitate formation of small and highly resolved features.” Ex. 1001, 14:43–61.

We are not persuaded that Dr. Banerjee's refusal or inability to answer questions during cross-examination about whether particular values fall within or outside the scope of "about 25 nm" is determinative on the question of indefiniteness. Ex. 1033, 92:8–13, 115:2–116:3, 121:7–11, 123:19–126:16. For example, Petitioner does not show that this line of questioning falls within the scope of his direct examination, as presented in his supporting declaration (Ex. 2009), and, therefore, it is unsurprising that Dr. Banerjee was unprepared or unwilling to answer these questions.

At this juncture, therefore, we preliminarily find that Petitioner has not established a reasonable likelihood that one of ordinary skill in the art would not have been able to discern the scope of "about 25 nm," as recited in proposed substitute claim 13, with reasonable certainty. However, we encourage the parties to address this issue should Patent Owner further pursue proposed substitute claims 13–23.

Petitioner also asserts that proposed substitute claims 13 and 14 are indefinite due to the limitation "metal ions," proposed substitute claims 18 and 23 are indefinite due to the limitations "high absorption . . . relative to conventional radiation-based resists" and "effectively patterned," and proposed substitute claims 13–23 are indefinite because proposed substitute claim 13 is directed to an apparatus but requires a method step in the limitation "exposure of the coating material to . . . radiation" and proposed substitute claim 20 recites "the coating material has been heated to temperatures from 45° C. to 150° C." Opp. 10–14. These arguments pertain to limitations of the originally challenged claims; therefore, we do not address them here.

In addition, Petitioner argues that proposed substitute claims 13–23 are indefinite for failure to claim the structure that performs the purported exposure

and heating method steps in these apparatus claims. Opp. 13 (citing *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005)). On this preliminary record, to the extent Petitioner’s argument applies to the entirety of the proposed substitute claims, including the newly-added limitations, we find the *IPXL Holdings* case inapposite, because unlike any proposed substitute claim at issue here, the *IPXL Holdings* case involved a claim that attempted to cover “both a system and a method for using that system.” *IPXL Holdings, LLC*, 430 F.3d at 1384. Petitioner relies on additional authority, similarly inapposite, which involved a means-plus-function claim and whether the specification disclosed sufficient structure for the claimed means. Opp. 13 (citing *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303 (Fed. Cir. 2011)).

4. Obviousness over Stowers 2008 and Stowers 2009

At this point in the proceeding, Petitioner has not shown a reasonable likelihood that proposed substitute claims 13–21 and 23 are anticipated by Stowers 2008 (Exhibit 1008), proposed substitute claims 13–21 and 23 would have been obvious in view of Stowers 2008, or proposed substitute claim 19 would have been obvious in view of Stowers 2008 and Stowers 2009 (Exhibit 1010). *Id.* at 14–16. Petitioner provides arguments regarding new limitations added in proposed substitute claims 13 and 19, but otherwise relies upon arguments presented in the Petition for the remaining limitations and claims, including an argument that Stowers 2008 qualifies as prior art. *Id.*

Setting aside the dispute about whether Stowers 2008 qualifies as prior art, we consider Petitioner’s argument that this reference renders obvious the thickness limitation of “about 25 nm” added by proposed claim 13. In that regard, Petitioner contends that Stowers 2008 discloses “that HfSO_x and ZrSO_x materials can be ‘deposited in films ranging in thickness from 2 to 500 nm.’” Opp. 15 (quoting

Ex. 1008, 18) (emphasis omitted). We recognize that a *prima facie* case of obviousness typically exists when a claimed range overlaps ranges disclosed in the prior art. *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1006 (Fed. Cir. 2018).

The record here, however, is not so clear. To arrive at the claimed value of “about 25 nm,” Petitioner relies on an inherency theory that Stowers 2008 would have prompted an ordinarily skilled artisan “to reduce Stowers 2008’s 30 nm thickness to avoid pattern collapse.” Opp. 15. We are not persuaded at this juncture that the evidence cited by Petitioner adequately supports that inherency theory. *Id.* (citing Ex. 1009, 265; Ex. 1040 ¶¶ 130–132).

During examination, the Office may provide a reasonable basis to believe that a claimed characteristic is inherent in a prior art product, and, once done, the burden shifts to the applicant to prove that the prior art product does not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1254–55 (CCPA 1977). In an *inter partes* review, however, the burden of proof is on the petitioner to prove unpatentability by a preponderance of the evidence, and that burden never shifts to the patent owner. *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

Consequently, in order to prevail, Petitioner must provide evidence establishing that claim limitations are inherent in the prior art. Petitioner cannot, as an examiner can, establish unpatentability of the challenged claims based on a presumption that the composition of the coating described by Stowers 2008 would necessarily possess the claimed properties. Allowing Petitioner to rely solely on a presumption of inherency would improperly shift the burden to Patent Owner to establish that the claimed properties are not necessarily present in the prior art.

Petitioner asserts further that proposed substitute claim 19's "molar concentration ratio of radiation sensitive ligands to metal ion of at least about 2" would have been obvious because Stowers 2008 teaches a ratio of 0.75:1, "the addition of peroxide in the films allows the films to act as photoresists," and the peroxide (ligand) content of a film is a result-effective variable that one of ordinary skill in the art would have optimized in an obvious manner and arrived at the claimed ratio. Opp. 15–16 (citing Ex. 1008, 68, 143; Ex. 1040 ¶¶ 135–138). Here again, Petitioner appears to rely on a presumption of inherency that is not available to a challenger in an *inter partes* review.

Stowers 2008 indicates that "the patterning of HafSOx and ZircSOx was significantly improved on by changing chemistries to a peroxide based system." Ex. 1008, 143. This statement, cited by Petitioner, does not specify that it is the content of peroxide that is being changed when the "chemistries" of a peroxide based system are changed. Dr. Holland's testimony also relies upon this statement in Stowers 2008. Ex. 1040 ¶ 136. Other cited testimony by Dr. Holland refers to a paper published by Stowers in 2018, *which is after the date the '564 patent issued*. *Id.* ¶ 137 (citing Ex. 1019, 4); Ex. 1001, code (45). Because of this, the paper does not demonstrate that the *prior art* recognized peroxide content as a result-effective variable. In view of these considerations, we have questions whether Petitioner has demonstrated a reasonable likelihood that proposed substitute claim 19's ratio would have been obvious.

With regard to the remaining limitations of proposed substitute claims 13–21 and 23, Petitioner relies on arguments set forth in the Petition. Opp. 14. Accordingly, we do not address those arguments in this Preliminary Guidance.

In view of the questions noted above for this challenge, Petitioner has not shown a reasonable likelihood that proposed substitute claims 13–21 and 23 are

anticipated by Stowers 2008, proposed substitute claims 13–21 and 23 would have been obvious in view of Stowers 2008, and proposed substitute claim 19 would have been obvious in view of Stowers 2008 and Stowers 2009.

5. Obviousness over Trikeriotis

At this point in the proceeding, Petitioner has not shown a reasonable likelihood that proposed substitute claims 13, 15, 18, 20, 22, and 23 are anticipated or obvious in view of Trikeriotis (Exhibit 1024). Opp. 16–17. Petitioner provides arguments regarding the new limitations added in proposed substitute claim 13, but otherwise relies upon arguments presented in the Petition for the remaining limitations and claims, including the argument that Trikeriotis qualifies as prior art. *Id.* at 14, 16–17.

Setting aside the question of whether Trikeriotis qualifies as prior art, with regard to patentability, Patent Owner argues that Trikeriotis “only mentions offhand” a “film thicknesses ranging from 30 nm to 200 nm can be easily achieved” but discloses “40–45 nm thick resists [would] be commonplace,” Trikeriotis measured its tested coating at between 60–160 nm with the thinnest at 30 nm, and Trikeriotis indicated “a desire to pattern on ‘thicker films’” without “mentioning thinner films.” Mot. 11 (citing Ex. 1024, 18, 21) (alteration in original).

Petitioner asserts that Trikeriotis teaches a film thickness of 30–200 nm and that “[t]he trend of ever decreasing feature sizes in subsequent lithography generations is paralleled by the need to reduce resist thickness to prevent pattern collapse.” Opp. 16 (citing Ex. 1024, 15, 18) (emphasis omitted, alteration in original). In view of this, Petitioner argues it would have been obvious to use a reduced film thickness to avoid pattern collapse. *Id.* at 16–17 (citing Ex. 1012, 8;

Ex. 1040 ¶¶ 133–134). At this preliminary stage, here again, we find Petitioner appears to rely on an inherency theory not established adequately on this record.

With regard to the remaining limitations of proposed substitute claims 13–21 and 23, Petitioner relies on arguments set forth in the Petition. *Id.* at 14. We do not address those arguments in this Preliminary Guidance.

6. Anticipation and Obviousness over Keszler

At this point in the proceeding, Petitioner has not shown a reasonable likelihood that proposed substitute claims 13–18 and 20–23 are anticipated by Keszler (Ex. 1038) or that proposed substitute claim 19 is unpatentable as obvious in view of Keszler. Opp. 17–25.

With regard to proposed substitute claim 13, from which each of the other challenged proposed substitute claims depends, Petitioner contends that “Keszler discloses ‘patterning a device using a photoresist’ by ‘providing a structure’ which comprises a ‘resist layer,’” including depositing films on silica substrates via spin coating. *Id.* at 17–18 (citing Ex. 1038, 4:16–25, 40:8–20, 42:8–10; Ex. 1040 ¶¶ 90–91) (emphasis omitted). Petitioner argues that Keszler teaches precursor solutions including hafnium or zirconium with peroxide (H_2O_2) ligands. *Id.* at 18 (citing Ex. 1038, 4:16–25, 38:6–63). According to Petitioner, Keszler discloses that peroxide is a radiation sensitive ligand, one of ordinary skill in the art would have understood this, and Keszler discloses an example that contains the same components as examples described in the ’564 patent. *Id.* at 18–19 (citing Ex. 1038, 28:9–12; Ex. 1040 ¶¶ 95–100; Ex. 1001, 6:9–10). Petitioner further argues that “Keszler discloses depositing the precursor solutions as ‘a thin film (from about 1 nm to about 100 nm).” *Id.* at 19 (citing Ex. 1038, 32:3–15).

With regard to proposed substitute claim 13’s limitation of “wherein exposure of the coating material to UV, EUV and/or electron-beam radiation alters

the chemical properties of the coating material creating an exposed coating material with differential dissolution rates between exposed and un-exposed regions of the coating material,” Petitioner asserts that because Keszler’s solution is the same as the ’564 patent’s and “the ’564 patent and other post-priority publications show radiation breaks the peroxide bond of the HafSO_x and ZircSO_x resists,” “radiation exposure must also cause a chemical change resulting in differential dissolution in the Keszler HafSO_x and ZircSO_x resists.” *Id.* at 20–21 (citing Ex. 1038, 8:1–12, 28:15–21; Ex. 1040 ¶¶ 97–100, 105–108).

These arguments incorporate an inherency theory; namely, that the prior art discloses the same solution at the ’564 patent and, therefore, inherently discloses the same properties. For reasons discussed above with regard to Petitioner’s other prior art challenges in the Opposition, we are not persuaded at this juncture that these inherency arguments are supported sufficiently by the objective evidence cited by Petitioner. *Id.* at 19, 20, 22, 23.

Petitioner also provides arguments why Keszler anticipates proposed substitute claims 14–18 and 20–23 and why proposed substitute claim 19 would have been obvious in view of Keszler. *Id.* at 21–25. We do not address those arguments about the dependent claims, where Petitioner has not shown sufficiently that claim 13, from which they depend, is unpatentable.

We acknowledge that Patent Owner has not yet had the opportunity to address Petitioner’s assertions with regard to Keszler. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition and/or this Preliminary Guidance (or in a revised motion to amend). 37 C.F.R. § 42.121(e)(3), (f).

III. CONCLUSION

This concludes our Preliminary Guidance. Patent Owner has the option to reply to Petitioner’s Opposition and/or this Preliminary Guidance *or* to file a

revised motion to amend by DUE DATE 3. 37 C.F.R. § 42.121(e)(3), (f); Paper 14. Patent Owner's reply or revised motion to amend 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 motion to amend, but may not present new evidence in any case. 37 C.F.R. § 42.121(e)(3). Petitioner may also file a reply to this Preliminary Guidance in the case Patent Owner does not file a reply or revised motion to amend. 37 C.F.R. § 42.121(e)(4).

We remind Patent Owner that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after this proceeding, including subsequent to the issuance of any final written decision entered in this proceeding. We direct Patent Owner 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). Should Patent Owner choose 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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For PETITIONER:

Dion Bregman
Michael Lyons
Ahren Hsu-Hoffman
Guylaine Hache
Alison Slaughter
MORGAN, LEWIS & BOCKIUS LLP
dion.bregman@morganlewis.com
michael.lyons@morganlewis.com
ahren.hsu-hoffman@morganlewis.com
guylaine.hache@morganlewis.com
alison.patitucci@morganlewis.com

For PATENT OWNER:

Naveen Modi
Phillip Citroen
Eric Dittmann
Isaac Ashkenazi
Paul Anderson
Daniel Zeilberger
Michael Wolfe
Maksim Y. Mints
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
phillipcitroen@paulhastings.com
ericdittmann@paulhastings.com
isaacashkenazi@paulhastings.com
paulanderson@paulhastings.com
danielzeilberger@paulhastings.com
michaelwolfe@paulhastings.com
maskimmints@paulhastings.com