

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHARKNINJA, INC., SHARKNINJA OPERATING LLC,
SHARKNINJA MANAGEMENT LLC, and
SHARKNINJA SALES COMPANY,
Petitioner,

v.

DYSON TECHNOLOGY LIMITED,
Patent Owner.

IPR2024-00219
Patent 11,589,660 B2

Before JAMES A. TARTAL, FRANCES L. IPPOLITO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

37 C.F.R. § 42.121(e)

I. INTRODUCTION

We instituted trial as to claims 1–9, 15, 18, 23, 24, and 30–34 of U.S. Patent No. 11,589,660 B2 (“the ’660 patent,” Ex. 1001). Paper 10 (“Inst. Dec.”). After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of the challenged claims. Paper 15 (“Motion” or “Mot.”). Petitioner filed an opposition. Paper 21 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requests that we provide preliminary guidance concerning the Motion. Mot. 3; *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 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. *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. 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, it appears that Patent Owner has 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 proposes a single substitute claim for each challenged claim (Mot. 3–4), which we presume to be reasonable. *See* 37 C.F.R. § 42.121(a)(3) (“The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need”). Petitioner does not argue otherwise. *See* Opp.

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 responds to the grounds of unpatentability asserted in the Petition by presenting arguments explaining why the newly added limitations in proposed substitute claims 40 and 55 define over the prior art in those grounds. *See* Mot. 11–22. Petitioner does not argue otherwise. *See* 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’s Motion does not enlarge the scope of the claims of the patent because the Motion only adds narrowing limitations. *See* Mot., App. A. Petitioner does not argue otherwise. *See* Opp.

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’s Motion identifies where each limitation in the proposed substitute claims has support in U.S. Patent App. No. 15/689,705 (the “’705 application”), which is the application from which the

'660 patent issued. *See* Mot. 4–11 (citing Ex. 1002); *see also* Ex. 1001, code (21). Petitioner contends that the limitation recited in independent proposed substitute claims 40 and 55 in which “the actuator interacts with only one of the first and second protrusions” lacks written description support in the originally filed application. *See* Opp. 3–8. We determine, at this stage, that Patent Owner has shown a reasonable likelihood that the disputed limitation has adequate written description support.

The test for satisfying the written description requirement “is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “[D]rawings alone *may* be sufficient to provide the ‘written description of the invention’” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991); *see also In re Wolfensperger*, 302 F.2d 950, 956 (CCPA 1962) (“The issue here is whether there is supporting ‘disclosure’ and it does not seem, under established procedure of long standing, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there.”). This “inquiry is a factual one and must be assessed on a case-by-case basis.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath*, 935 F.2d at 1561).

Patent Owner cites to paragraphs 66 and 67, which Patent Owner asserts “compar[e] description of slots 232 to slot 232a.” Mot. 6. Patent Owner also cites to Figures 5–6a and asserts that

Fig. 5 disclos[es] one slot and protrusion at the top interacting with an actuator while the slot in the center of Fig. 5 that is enlarged in Figs. 6a and 6b does not interact with an actuator and fail[s] to disclose an aperture for the actuator to slide into slot 232, as opposed to Figs. 1a and 1b that disclose an aperture for the actuator to slide into slot 232a.

Id.

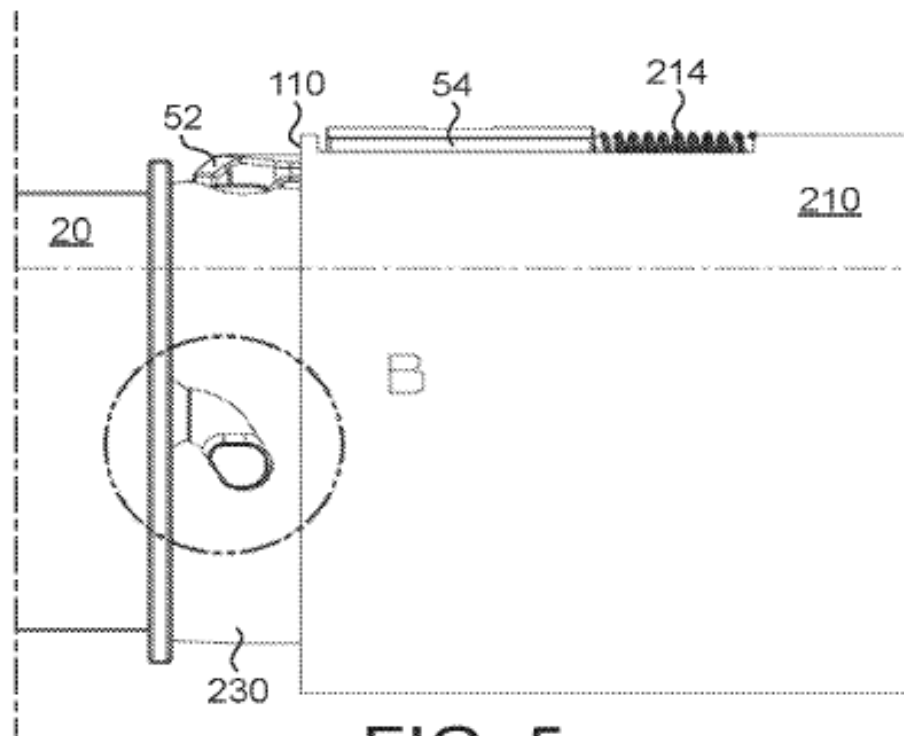
Petitioner argues that Patent Owner's citation to paragraphs 66 and 67 in the '705 application provides insufficient support. Opp. 4–5 (citing Ex. 1002).

Specifically, Petitioner asserts that the cited paragraphs

make[] no mention of what the slots 232 and the slots 232a are relative to each other, . . . how the different descriptions of the slots 232 and the slots 232a relate to whether an actuator interacts with only one of a first and a second protrusion, or any details that may indicate to a POSITA that the inventor contemplated an actuator that “interacts with only one of the first and second protrusions.”

Id. at 5 (citing Ex. 1013 ¶¶ 15–21). We agree here with Petitioner to the extent that the text of the cited paragraphs of the '705 application does not alone show a reasonable likelihood of written description support for the disputed feature of actuator interaction with one of two protrusions. In this regard, while paragraph 67 of the '705 application describes that “the actuator functions to retain the protrusion 30 in the slot 232a,” paragraph 66, which discusses how “the protrusion 30 is pushed into the slot 232,” does not mention whether or not an actuator interacts with protrusion 30 in slot 232. *See* Ex. 1002, 335 (¶¶ 66–67).

However, when considering Patent Owner's cited figures in conjunction with the text of the '705 application, we understand the '705 application to provide adequate description to support the limitation that “the actuator interacts with only one of the first and second protrusions.” Figure 5, reproduced below, illustrates “an alternative cross section through an attachment mechanism according to the invention” (Ex. 1002, 333 (¶ 55)):

**FIG. 5**

As shown above, the Figure 5 embodiment includes, in the vertical center of the depicted view of attachment collar 230 of body 210, what appears to be a slot with an inserted protrusion. *See id.*, Fig. 5. This arrangement includes no actuator that interacts with the protrusion. Towards the top of attachment collar 230, there appears to be an arrangement with another protrusion engaged in another slot, but with first part 52 of an actuator positioned next to the protrusion. *See id.*, Fig. 5, ¶ 67 (“The actuator 50 has a first part 52 which physically retains a protrusion 30 with slot 232a.”). Although the slots in Figure 5 are not labeled, for example, with reference numbers 232 or 232a, it is clear from the figure that the ’705 application contemplates an embodiment in which an attachment mechanism includes two protrusions engaged in two respective slots, only one of which interacts with an actuator.

Petitioner's arguments with respect to the figures are unavailing. Petitioner argues that the text of the '705 application contradicts what is shown in Figures 5–6b. Opp. 6. Petitioner points (*see id.*) to a portion of the Specification of the '705 patent that refers to Figures 4b, 7, and 8, and states the following:

When an attachment 20 is presented to the body 210, the protrusions 30 first align with slots 232, 232a. The protrusions 30, once they are pushed passed the third region 154 of the first part 52 of the actuator 50 are automatically pushed towards the recess 240 formed at the end 238 of the channel by the second region 152 of the first part 52 of the actuator 50.

Ex. 1002, 340 (§ 86). Petitioner appears to argue that this disclosure describes two slots 232 and 232a that each have a protrusion 30 that interacts with an actuator. *See* Opp. 5–7. None of Figures 4b, 7, or 8 referenced in this paragraph, however, depict a slot labeled 232 or 232a. In every other portion of the Specification of the '705 application, in which an actuator is discussed with respect to a reference number of a slot, it is with respect to a slot labeled 232a, not 232. *See, e.g.*, Ex. 1002, 327–343. And in any case, even if the Specification of the '705 application fails to consistently use the convention of labeling a slot with an actuator as “slot 232a,” the fact remains that the Figure 5 embodiment, relied on by Patent Owner for support, does not show an actuator engaging the protrusion in the slot in the vertical center of the depicted view.

Petitioner also argues that the alleged coincidental depiction in Figure 5 of one slot with an actuator and another slot without an actuator fails to provide sufficient written description support because it does not provide enough representative species to support a genus. Opp. 7–8. Petitioner cites to the Board's decision in *Danxiao Information Tech. Ltd. v. Shenzhen Svakom Tech. Co., Ltd.*, PGR2022-00050, Paper 36, at 24 (PTAB Jan. 19, 2024), for the proposition that “accidental disclosure that happens to be ‘consistent’ with the claim limitations ‘is

insufficient to demonstrate possession.” *Id.* In that case, however, the claim limitation at issue was an abstract mathematical relationship that the Board found was not supported by a single example of a set of numbers from which “any number of abstractions might be made.” *Danxiao Information Tech.*, Paper 36, at 24. In contrast to an abstract mathematical relationship, the disputed limitation in claims 40 and 55 recites a relationship between concrete parts, specifically, the interaction of an actuator of an attachment mechanism with one of two protrusions of an attachment. There is no need here to find support for any genus when the limitation at issue in this case defines a particular arrangement, as opposed to a broader category of attachment mechanisms. As discussed above, Figure 5 of the ’705 application supports, with a reasonable likelihood, the claimed arrangement recited in the disputed limitation of an actuator that “interacts with only one of the first and second protrusions.”

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,¹ it appears that Petitioner has not shown a reasonable likelihood that proposed substitute claims 40–56 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

1. Indefiniteness

Petitioner contends that the limitation recited in independent proposed substitute claims 40 and 55 in which “the actuator interacts with only one of the first and second protrusions” renders proposed substitute claims 40–56 indefinite.

¹ We express no view on the patentability of original claims 1–9, 15, 18, 23, 24, and 30–34 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

Opp. 8–10. Specifically, Petitioner argues that “the use of the phrase ‘interacts with’ is unclear in this context and the specification provides no help to understand it.” *Id.* at 8–9. Petitioner further argues that “[i]t is also unclear what the term ‘only one of’ means.” *Id.* at 9.

In post-grant proceedings the Board applies the indefiniteness standard set forth in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014). *See* Memorandum: Approach to Indefiniteness Under 35 U.S.C. § 112 in AIA Post-Grant Proceedings (Jan. 6, 2021) (available at <https://www.uspto.gov/sites/default/files/documents/IndefinitenessMemo.pdf>). Under *Nautilus*, a claim is indefinite if fails to “inform those skilled in the art about the scope of the invention with reasonable certainty.” 572 U.S. at 910. At this stage, we disagree with Petitioner that the disputed language renders the proposed substitute claims indefinite.

First, the phrase “interacts with” defines a relationship between the actuator and the one protrusion, such that the movement of one affects the other, based on the plain meaning of the term “interact.” This is captured in claims 40 and 55, which recite that the actuator “has a first position and a second position and the actuator is slidably moved from the first position towards the second position in a longitudinal direction of the body as the first protrusion engages with the first slot.” This interaction is described in the Specification of the ’660 patent, which provides, for example, that “the actuator is moved from the first position towards the second position as the protrusion engages with the slot,” and more particularly, that “the actuator comprises a surface which interacts with the protrusion when the protrusion engages with the slot,” and that “when the protrusion is at a pre-determined position within the slot, the actuator returns towards the first position.” Ex. 1001, 1:42–55. While claims 40 and 55 may encompass different levels of

interaction (*see* Opp. 9 (“For example, does ‘interact with’ require physical contact or is it sufficient for the actuator to cause the protrusion to be released such that to meet the proposed language, the actuator would release only one of two protrusions?”))), claims 40 and 55 inform one of ordinary skill in the art with reasonable certainty that, at a minimum, they require a relationship between the actuator and one of the protrusions such that engagement of the one protrusion with a respective slot causes the actuator to slide from one position to another.

Second, claims 40 and 55 inform an ordinarily skilled artisan with reasonable certainty that the phrase “only one of” refers to one of the two protrusions introduced in claims 40 and 55, by reciting that “the actuator interacts with only one of the first and second protrusions.” Petitioner’s questioning as to whether the claims would cover a system with an actuator that interacted with more than one protrusion if the system had three protrusions (Opp. 9.) is unavailing in demonstrating indefiniteness. Claims 40 and 55 use the open-ended term “comprising” when introducing the first and second protrusion elements of the claimed attachment. Accordingly, the claims encompass attachments with additional elements, but they are definitely limited in that, of the set of two protrusions defined in the claim, the actuator interacts with only one of the two.

Therefore, on this record, Petitioner has not shown a reasonable likelihood that proposed substitute claims 40–56 are indefinite.

2. Obviousness

Petitioner contends that proposed substitute claims 40–56 would have been obvious based on newly asserted grounds 7–12. Opp. 10–25. Each of the new grounds 7–12 includes the prior art relied on in a respective one of originally

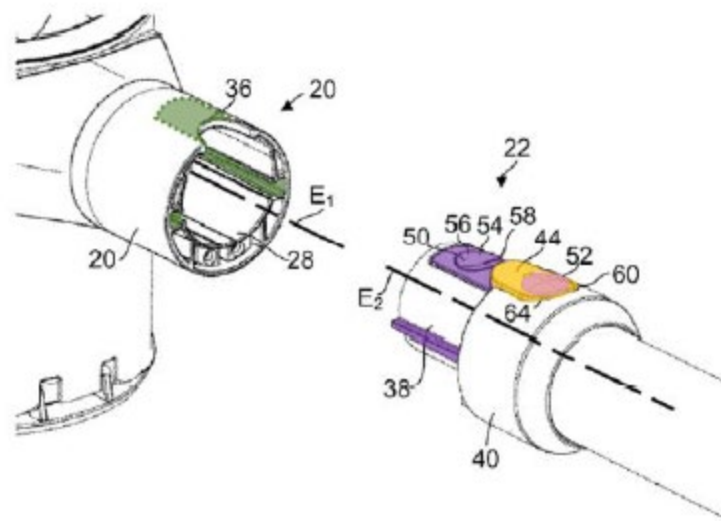
asserted grounds 1–6, with the addition of Marsh², or, alternatively, Marsh and Brook³. *See* Opp. 13–25.

For ground 7, based on Hoblingre in view of Marsh, or Marsh and Brook, Petitioner relies on both Hoblingre and Marsh, or Marsh and Brook, for the newly added limitations in proposed substitute claims 40 and 55 of “a second slot” and “a second protrusion to engage with the second slot,” but relies on Marsh, or Marsh and Brook, for teaching the newly added limitation that “the actuator interacts with only one of the first and second protrusions.”⁴ *See* Opp. 15–16 (citing Pet. 17–21; Ex. 1003 ¶¶ 44–56, 59–122; Ex. 1013 ¶¶ 45–47; Ex. 1014 ¶¶ 27, 32–38, Figs. 2, 5; Ex. 1015 ¶ 30, Fig. 4a). In particular, Petitioner asserts that “Marsh’s attachment mechanism for connecting the cleaning tool to the vacuum cleaner body includes an actuator (catch 44, annotated in orange), three slots (recess 30 and two keyways, annotated in green), and three protrusions (latching portion 50 having a protrusion 54 and two ribs, annotated in purple) that engage with the three slots.” *Id.* at 11 (citing Ex. 1013 ¶¶ 30–37). Petitioner provides the following annotated drawings:

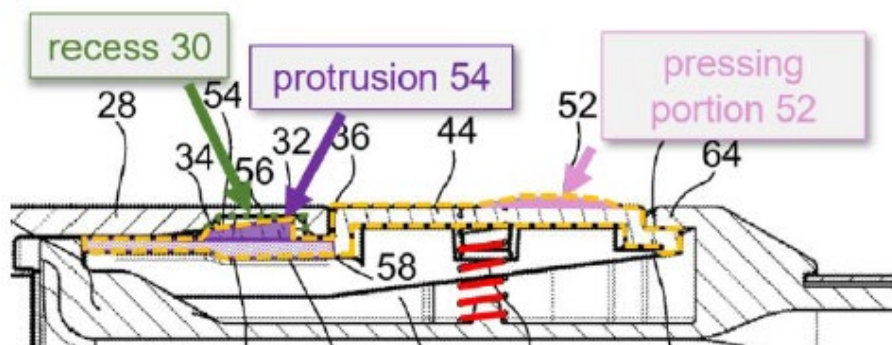
² US 2015/0297045 A1, published Oct. 22, 2015.

³ GB 2513561 A, published May 11, 2014.

⁴ We underline the text added in the proposed amendment. *See* Mot., App. A.



Id. (annotating Ex. 1014, Fig. 5).



Id. at 12 (annotating Ex. 1014, Fig. 2). Petitioner adds that, [a]lthough Marsh does not label its keyways and ribs with reference numbers,” one of skill in the art “would have recognized the ribs and the keyways as explicitly disclosed components that engage with each other,” as evidenced by Brooks, which “lists a common inventor, shares a common assignee and shares figures that are very similar” with respect to Marsh. *Id.* at 11–12 (citing Ex. 1013 ¶¶ 31–37; Ex. 1015, 7:30–8:2).

Mapping the newly added limitations and some of the original limitations to Marsh, Petitioner asserts that “Marsh/Marsh+Brook also discloses a first slot

(recess 30), a second slot (one of the keyways), and an actuator (catch 44 and spring 66),” as well as “a first protrusion (protrusion 54 of latching portion 52) configured to engage with the first slot (recess 30) and a second protrusion (one of the ribs) to engage with the second slot (one of the keyways).” *Id.* at 15–16 (citing Ex. 1013 ¶¶ 45, 46; Ex. 1014 ¶¶ 27, 33–38, Figs. 2, 5; Ex. 1015 ¶ 30, Fig. 4a). Petitioner further asserts Marsh discloses that “[w]hen a user ‘press[es] down on the pressing portion 52’ of catch 44, catch 44 pushes against spring 66 into a channel and ‘disengages latching element 50 from the recess 30,’” but “[c]atch 44 and spring 66 do not interact with either of the ribs.” *Id.* at 16 (citing Ex. 1014 ¶ 37).

For ground 10, based on Mouhot in view of Marsh, or Marsh and Brook, Petitioner relies on both Mouhot and Marsh, or Marsh and Brook, for the newly added limitations in proposed substitute claims 40 and 55 of “a second slot” and “a second protrusion to engage with the second slot,” but relies on Marsh, or Marsh and Brook, for teaching the newly added limitation that “the actuator interacts with only one of the first and second protrusions.” *See* Opp. 22–23 (citing Pet. 62–68; Ex. 1003 ¶¶ 44–56, 161–219; Ex. 1013 ¶¶ 60–62; Ex. 1014 ¶¶ 27, 33–38, Figs. 2, 5; Ex. 1015 ¶ 30, Fig. 4a). With respect to the specific teachings of Marsh, or Marsh and Brook, Petitioner relies on the same contentions noted above for ground 7. *See id.*

We determine, at this stage, that Petitioner’s contentions highlighted above, which are supported by expert testimony, show a reasonable likelihood that the combinations asserted in grounds 7 and 10 teach the newly added limitations in claims 40 and 55, particularly in view of Marsh, or Marsh and Brook. As discussed below, however, Petitioner has not shown a reasonable likelihood that it

would have been obvious to combine Marsh, or Marsh and Brook, with the respective base references Hoblingre and Mouhot.

Petitioner contends that “it would have been obvious to modify Hoblingre’s actuator to include an actuator that interacts with only one of the first and second protrusions based on Marsh’s (and Brook’s) teachings of latching portion 52 and recess 30.” Opp. 16–17. Similarly, Petitioner contends that “[i]t would have been obvious to modify Mouhot’s actuator to include an actuator that interacts with only one of the first and second protrusions based on Marsh/Marsh+Brook’s teachings of latching portion 52 and recess 30.” *Id.* at 22–23.

Specifically, Petitioner asserts that a skilled artisan “would have been motivated to modify Hoblingre’s fastener by the structural and functional similarities—the slot and protrusion engagement and the spring-loaded actuator—between the Hoblingre fastener and the connector disclosed in Marsh.” *Id.* at 14. Moreover, Petitioner asserts that its expert explains that “a release actuator that interacts with only one of two protrusions rather than both protrusions is a simpler mechanism that is easier to manufacture. *Id.* (citing Ex. 1013 ¶¶ 41–44). Petitioner presents similar assertions with respect to the proposed modification of Mouhot. *See id.* at 20–21.

Petitioner has not, at this juncture, adequately explained how or why an ordinarily skilled artisan would have modified the similar ring elements in Hoblingre and Mouhot, which Petitioner relies on for teaching an actuator (*see* Pet. 17–19, 62–66), such that either of these ring elements in Hoblingre or Mouhot would act as an actuator that interacts with only one of two protrusions, in view of Marsh (*see* Opp. 14–15, 20–22). Contrary to Petitioner’s assertion regarding the “structural and functional similarities—the slot and protrusion engagement and the spring-loaded actuator”—between either Hoblingre or Mouhot and Marsh (Opp.

14, 20), the attachment mechanism in Marsh is quite different. Marsh's catch 44 occupies a particular channel 42 in a circumferential section of a connector part of an attachment. *See* Ex. 1014 ¶¶ 28–34, Figs. 4, 5. Catch 44 is rendered effective by “a spring 66 [] disposed between the catch 44 and the bottom of the channel,” and, as can be seen in Figure 2 of Marsh, the spring is aligned on an axis perpendicular to the axis of the connector part. *Id.* ¶ 35, Fig. 2. In contrast, in each of the similar ring and spring arrangements in Hoblingre and Mouhot, the ring surrounds the entire circumference of a part to be connected, and the spring is aligned on an axis parallel to the respective part to be connected. *See* Ex. 1004, 2:27–38, Figs. 1, 2; Ex. 1005, 3:13–18, Figs. 1–3.

Further, while Marsh's arrangement of a single actuator that interacts with only one of multiple protrusions, as Petitioner alleges, may be “a simpler mechanism that is easier to manufacture” (Opp. 14 (citing Ex. 1013 ¶¶ 41–44)), it is not clear how these benefits apply to either Hoblingre or Mouhot. The ring in each of these references necessarily surrounds the whole circumference of a part to be connected (*see* Ex. 1004, 2:27–38, Figs. 1, 2; Ex. 1005, 3:13–18, Figs. 1–3), and so even if the ring in either reference were somehow adapted to interact with one, as opposed to two protrusions, of the part to be connected, it appears the entire ring would still be required and would operate in the same manner.

To the extent Petitioner argues that Mouhot suggests modifying the ring described therein to interact with only one protrusion, we disagree on the current record. Specifically, Petitioner references (Opp. 21) the following disclosure in which Mouhot describes

the coupler comprising means for locking the lateral protruding part of the shank in position inside the slot of the socket, characterized in that *at least one of the sides of the socket delimiting the slot comprises stop means that delimit at least one locking position* of the lateral protruding part and in that the locking means comprise wedge-shaped means

movable in the slot between a first locking position, in which these wedge-shaped means prevent the lateral protruding part of the shank from disengaging from the stop means of the slot of the socket, and a second retracted position.

Ex. 1005, 2:22–28 (emphasis added). We read this disclosure as defining the interaction of a single locking means with a single protruding part in a single slot. The portion of this disclosure emphasized above appears to describe that the stop means delimiting the locking position may be on either side of the slot, not that the socket may have slots on either side, only one of which has stop means. We see no suggestion here to use locking means on only one of two protruding parts.

Accordingly, we determine, at this preliminary stage based on the current record, that Petitioner does not appear to have shown a reasonable likelihood that one of ordinary skill in the art would have combined Marsh, or Marsh and Brook, with either Hoblingre or Mouhot as proposed. Therefore, we determine that Petitioner has not sufficiently shown that obviousness grounds 7–12 asserted against proposed substitute claims 40–56 have a reasonable likelihood of success on the current record.

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 19. 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. 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).

IPR2024-00219

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