

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXTGEN TOYS, LLC.,
Petitioner

v.

ZIPSTRING, LLC,
Patent Owner.

Case IPR2024-01213
Patent 11,674,774

PATENT OWNER'S CONTINGENT MOTION
TO AMEND UNDER 37 C.F.R. § 42.121

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I. STATEMENT OF RELIEF REQUESTED

Patent Owner hereby moves to amend the ‘774 Patent contingent upon whether the challenged claims are found unpatentable in the present IPR proceeding. *See* 37 C.F.R. § 42.121. If challenged claim 1 is found to be unpatentable, Patent Owner requests the Board order the following:

- Replacement of independent claim 1 with substitute claim 21; and
- Replacement of dependent claims 2-4 with substitute claims 22-24.

If challenged claim 12 is found to be unpatentable, Patent Owner requests the Board order the following:

- Replacement of independent claim 12 with substitute claim 25; and
- Replacement of dependent claim 15 with substitute claim 26.

If challenged claim 16 is found to be unpatentable, Patent Owner requests the Board order the following:

- Replacement of independent claim 16 with substitute claim 27; and
- Replacement of dependent claim 17 with substitute claim 28.

II. INTRODUCTION

Patent Owner ZipString, LLC (“ZipString” or “Patent Owner”) hereby moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to amend U.S. Patent No.

11,674,774 (the ‘774 Patent”), contingent on the outcome of this trial. In the event the Board finds any of the challenged claims unpatentable, Patent Owner respectfully requests that the Board grant this Motion to Amend and issue the substitute claims presented herein. In addition, ZipString elects to seek non-binding preliminary guidance from the Board on this Motion to Amend.

Patent Owner attaches the proposed substitute claims as Appendix A. Patent Owner proposes to substitute claims 1-4, 12 and 15-17 with claims 21-28, respectively. As shown in Appendix A, substitute claims 22-24, 26 and 28 are substantively identical to existing claims, but include amendments to the identification of the claim from which they depend. The proposed substitute claims are presented on a contingent basis for consideration in the event the Board finds that the original claims are unpatentable.

As this motion demonstrates, the substitute claims meet all of the requirements of 37 C.F.R. § 42.121. Namely, each amendment is responsive to a ground of unpatentability on which the trial was instituted, and none of the amendments seeks to enlarge the scope of the claims or introduce new subject matter. Further, the motion shows the changes that are sought and the support in the original disclosure of the patent and a priority application for each substitute claim.

Moreover, although the burden of persuasion for any substitute claims is on the Petitioner to show that such claims are unpatentable, *see Aqua Prods. Inc. V. Matal*, 872 F.3d 1290, 1324-25 (Fed. Cir. 2017) (en banc); *Bosch Auto Serv. Sols. LLC v. Matal*, F.3d 1027; 1040 (Fed. Cir. 2017), this motion demonstrates that the substitute claims are patentable over the references in this IPR.

On May 5, 2025, the Patent Owner contacted the Board by email in order to satisfy the requirement of 37 C.F.R. § 42.121 (a), to confer with the Board prior to filing a motion to amend. On May 8, 2025, the Board responded that the requirement to confer required by 37 C.F.R. § 42.121 (a) was satisfied through the email exchange.

III. THE SUBSTITUTE CLAIMS MEET ALL THE REQUIREMENTS OF 37 C.F.R. § 42.121

Under 35 U.S.C. § 316(d)(1)(B), a patent owner may propose a reasonable number of substitute claims for each challenged claim. A patent owner must show that each amendment in the proposed substitute claims is responsive to a ground of unpatentability involved in the trial, does not seek to broaden the challenged claim, and is supported by the filed or earlier filed disclosures. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2).

If a patent owner has met these statutory requirements, then the Board considers whether the substitute claims are unpatentable by a preponderance of the evidence. *Western Digit. Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 13 at 4 (PTAB Apr. 25, 2018). The petitioners have the burden to show that the amended claims are unpatentable over the prior art. 35 U.S.C. § 316(e); *Aqua Prods. Inc.*, 872 F.3d at 1324-25.

A. Reasonable Number of Substitute Claims

As shown in Appendix A, Patent Owner proposes only one substitute claim for each conditionally cancelled claim, thus satisfying the general presumption that “only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. § 42.121(a)(3).

B. The Proposed Claims Are Responsive to the Instituted Grounds

The proposed substitute claims are responsive to one or more grounds of unpatentability at issue in this proceeding. *See* 37 C.F.R. § 42.121(a)(2)(i). Specifically, Petitioners have asserted that the prior art discloses the elements of the original claims 1-4, 12 and 15-17, which this motion conditionally seeks to amend. The limitations added to the proposed substitute independent claims 1, 12 and 16 obviate the asserted grounds alleging anticipation and obviousness based on the Yeany, Abello, Wagner and Scorch references.

C. The Proposed Claims Do Not Enlarge the Scope of the Original Claims

Proposed substitute independent claims 21, 25 and 28 include additional limitations to address the prior art grounds that do not enlarge the scope of the claims. Instead, the amendment shown in proposed substitute independent claims 21, 25 and 28 add further limitations to the original claims 1, 12 and 16 as indicated below.

Proposed substitute independent claim 21 narrows the scope of the original independent claim 1 by adding limitations that the housing covers at least partially the pair of wheels and the housing has a loading slot through which the string is loaded between the pair of wheels.

Proposed substitute independent claim 25 narrows the scope of original independent claim 12 by adding the limitation that includes a loading slot which is the mechanism by which a user can load and unload the looped string.

Proposed substitute independent claim 28 narrows the scope of original independent claim 16 by adding the limitation that the housing additionally includes a guiding slot that extends around a portion of a circumference of at least one of the pair of wheels.

As discussed in more detail below, each of the newly added limitations has support in the specification as originally filed.

IV. SUPPORT FOR PROPOSED SUBSTITUTE CLAIMS

The originally filed disclosure of the ‘774 Patent supports each proposed substitute claim. *See* 37 C.F.R. § 42.121(b)(1)-(2). The ‘774 Patent issued on June 13, 2023 from Application No. 18/056,567 filed on Nov. 17, 2022 (herein submitted as Exhibit 2001) which claims priority from Provisional Application No. 63/280,810, filed on Nov. 18, 2021.

For purposes of this Motion to Amend, Patent Owner identifies in the table below support for each of the proposed substitute claims 21- 28.

Claim Limitation	Support for Claim Limitations 21-28 in Exhibit 2001 U.S. Appl. No. 18/056,567
Claim 21 A string shooting device comprising: a body; a housing attached to the body, a pair of wheels, wherein at least one of the pair of wheels is a driven wheel;	Exhibit 2001 ¶¶. [0006]; [0009]
a string, wherein the string comprises a surface texture configured to increase air friction in response to the string being propelled through air by the pair of wheels, wherein the string defines an axis along which the string extends, and wherein the string comprises a plurality of fibers extending away from the axis;	Exhibit 2001. ¶¶ [0006]; [0009]
<u>and wherein the housing covers, at least partially, the pair of wheels, and</u>	Exhibit 2001 ¶¶ [0007]; [0016]; [0017]; [0051];

wherein the housing defines a loading slot therein through which the string is loaded from between the pair of wheels.	
Claim 22 The string shooting device of claim [[1]] 21, wherein the plurality of fibers extending away from the axis generate a turbulent air boundary layer around the string in response to the string being propelled through the air by the pair of wheels.	Exhibit 2001 ¶¶ [0006]; [0009]
Claim 23 The string shooting device of claim [[2]] 22, wherein the string is a looped string, wherein the looped string, at a distal portion furthest from the body, generates lift from the turbulent air boundary layer.	Exhibit 2001 ¶ [0006]
Claim 24 The string shooting device of claim [[1]] 21, wherein <u>the body is configured to be hand held and the housing covers, at least partially, the pair of wheels, and wherein the housing defines a loading slot through which the string is loaded</u> ~~or~~	Exhibit 2001 ¶ [0035]
<u>the loading slot is further configured for removal of the string removed from between the pair of wheels.</u>	Exhibit 2001 ¶ [0007]
Claim 25 A method of propelling a looped string through air comprising: receiving a looped string into a housing <u>including a loading slot between a pair of wheels, wherein said loading slot</u>	Exhibit 2001 ¶ [0051]; [0055]

provides a mechanism to load and unload said looped string,	
wherein at least one of the pair of wheels is a driven wheel, wherein the looped string defines an axis along which the string extends, and wherein the looped string comprises a plurality of fibers extending away from the axis;	Exhibit 2001 ¶¶ [0006]; [0009]
driving the at least one driven wheel; propelling the looped string from the at least one driven wheel; and generating, from the looped string propelled by the at least one driven wheel, lift at an end of the looped string distal from the housing based on a surface texture of string configured to increase air friction in response to the looped string being propelled.	Exhibit 2001 ¶¶ [0006]; [0009]
Claim 26 The method of claim [[12]] 25, wherein propelling the looped string from the at least one driven wheel comprises: receiving the looped string through an intake aperture of the housing; guiding the looped string between the pair of wheels; and propelling the looped string through an exit aperture of the housing.	Exhibit 2001 ¶[0008].
Claim 27 A string shooting device comprising:	Exhibit 2001 ¶¶ [0007]; [0016]; [0017]; [0051];

a body; a housing attached to the body and defining a loading slot; a pair of wheels, wherein at least one of the pair of wheels is a driven wheel, wherein the loading slot is disposed at least partially over at least one of the pair of wheels; [[and]]	
<u>wherein the housing further comprises a guiding slot, wherein the guiding slot extends around a portion of a circumference of at least one of the pair of wheels; and</u>	Exhibit 2001 ¶ [0009]; [0016]; [0018]
a looped string, wherein the looped string comprises a surface texture configured to increase air friction in response to the looped string being propelled through air by the pair of wheels.	Exhibit 2001 ¶ [0009].
Claim 28 The string shooting device of claim [[16]] 25, wherein the surface texture comprises a plurality of fibers extending away from an axis along which the looped string extends to generate a turbulent air boundary layer around the looped string in response to the looped string being propelled through the air by the pair of wheels.	Exhibit 2001 ¶¶ [0009]; [00026].

V. SUBSTITUTE CLAIMS 21-28 RESPOND TO THE GROUNDS OF UNPATENTABILITY

Under 37 C.F.R. § 42.121(a)(2)(i), “[a] motion to amend may be denied where... [t]he amendment does not respond to a ground of unpatentability involved in the trial.” “[A] proposed substitute claim adding a novel and nonobvious feature or combination to avoid the prior art in an instituted ground of unpatentability” will meet the requirements of 37 C.F.R. § 42.121 (a)(2)(i) and (ii).” *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (Paper 15) at 6-7 (PTAB Feb. 25, 2019). As shown in the following sections, the proposed independent substitute claims are responsive to and patentable over Grounds 1, 2, 3 and 4.

A. Ground 1: Yeany does not anticipate proposed substitute independent claims 21, 25 and 27 under 35 U.S.C. § 102.

Yeany does not anticipate proposed substitute independent claim 21 as amended because Yeany does not teach a housing that covers the pair of wheels. Additionally, Yeany does not teach a housing that includes a loading slot through which the string is loaded from between the pair of wheels.

Yeany does not anticipate proposed substitute independent claim 25 as Yeany does not teach a device that has a housing that includes a loading slot which is the mechanism in which a user can load and unload the looped string.

Yeany also does not anticipate proposed substitute independent claim 27 because Yeany does not disclose a housing that includes loading slot and a guide slot that extends around a portion of a circumference of at least one of the pair of wheels.

B. Ground 2: Abello in view of Yeany does not render proposed substitute independent claims 21, 25 and 27 obvious under 35 U.S.C. § 103.

Abello in view of Yeany does not render obvious proposed substitute independent claim 21 as amended because neither Abello nor Yeany teach a housing that covers the pair of wheels. Additionally, Abello nor Yeany do not teach a housing that includes a loading slot through which the string is loaded from between the pair of wheels.

Abello in view of Yeany does not render obvious proposed substitute independent claim 25 as neither Abello nor Yeany teach a device that has a housing that includes a loading slot which is the mechanism in which a user can load and unload the looped string.

Abello in view of Yeany also does not render obvious proposed substitute independent claim 27 because neither Abello nor Yeany disclose a housing that

includes loading slot and a guide slot that extends around a portion of a circumference of at least one of the pair of wheels.

C. Ground 3: Wagner in view of Yeany does not render proposed substitute independent claims 21 and 25 obvious under 35 U.S.C. § 103.

Wagner in view of Yeany does not render obvious proposed substitute independent claim 21 as amended because neither Wagner nor Yeany teach a housing that covers the pair of wheels. Additionally, Wagner nor Yeany do not teach a housing that includes a loading slot through which the string is loaded from between the pair of wheels.

Wagner in view of Yeany does not render obvious proposed substitute independent claim 25 as neither Wagner nor Yeany teach a device that has a housing that includes a loading slot which is the mechanism in which a user can load and unload the looped string.

D. Ground 4: Wagner in view of Yeany and Scorch does not render obvious proposed substitute dependent claim 24 and proposed substitute independent claim 27 under 35 U.S.C. § 103.

Wagner in view of Yeany and Scorch does not render obvious proposed substitute dependent claim 24 as amended because neither Wagner nor Yeany teach

a housing that covers the pair of wheels. Additionally, Wagner nor Yeany do not teach a housing that includes a loading slot through which the string is loaded from between the pair of wheels. *See* Exhibit 2002.

Wagner in view of Yeany and Scorch does not render obvious proposed substitute independent claim 27 as amended because neither Wagner nor Yeany nor Scorch include a housing attached to the body and defining a loading slot and further comprising a pair of wheels, wherein at least one of the pair of wheels is a driven wheel, and the loading slot is disposed at least partially over at least one of the pair of wheels and wherein the housing further includes a guiding slot that extends around a portion of a circumference of at least one of the pair of wheels. *See* Exhibit 2002.

VI. CONCLUSION

For any original claim that the Board finds unpatentable, Patent Owner respectfully requests that the Board grant this motion to amend as to the substitute claims.

Respectfully submitted,

Dated May 19, 2025

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CERTIFICATE OF COMPLIANCE WITH PAGE LIMITS

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Motion to Amend complies with the page limit requirements of 37 C.F.R. §§ 42.24(a)(1)(vi), (b)(3) because it contains less than 25 pages, excluding the parts that are exempted.

Dated: May 19, 2025

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Claims Appendix A

Proposed amended claims are shown in marked-up form below, beginning with claim 21. Underlining and double bracketing or striking through text show, respectively the additions and deletions to the original claim being made in the corresponding substitute claim.

21. (Substitute for claim 1, if found unpatentable)

A string shooting device comprising:

a body;

a housing attached to the body;

a pair of wheels, wherein at least one of the pair of wheels is a driven wheel;

[[and]]

a string, wherein the string comprises a surface texture configured to increase air friction in response to the string being propelled through air by the pair of wheels, wherein the string defines an axis along which the string extends, and wherein the string comprises a plurality of fibers extending away from the axis; and

wherein the housing covers, at least partially, the pair of wheels, and wherein the housing defines a loading slot therein through which the string is loaded from between the pair of wheels.

22. (Substitute for claim 2, if found unpatentable),

The string shooting device of claim ~~[[1]]~~ 21, wherein the plurality of fibers extending away from the axis generate a turbulent air boundary layer around the string in response to the string being propelled through the air by the pair of wheels.

23. (Substitute for claim 3, if found unpatentable),

The string shooting device of claim ~~[[2]]~~ 22, wherein the string is a looped string, wherein the looped string, at a distal portion furthest from the body, generates lift from the turbulent air boundary layer.

24. (Substitute for claim 4, if found unpatentable),

The string shooting device of claim 1, wherein the body is configured to be hand held and the housing covers, at least partially, the pair of wheels, and wherein the housing defines a loading slot through which the string is loaded or and the loading slot is further configured for removal of the string removed from between the pair of wheels.

25. (Substitute for claim 12, if found unpatentable),

A method of propelling a looped string through air comprising:

receiving a looped string into a housing including a loading slot between a pair of wheels, wherein said loading slot provides a mechanism to load and unload

said looped string, wherein at least one of the pair of wheels is a driven wheel,
wherein the looped string defines an axis along which the string extends, and
wherein the looped string comprises a plurality of fibers extending away from the
axis;

driving the at least one driven wheel;

propelling the looped string from the at least one driven wheel; and

generating, from the looped string propelled by the at least one driven wheel,
lift at an end of the looped string distal from the housing based on a surface texture
of string configured to increase air friction in response to the looped string being
propelled.

26. (Substitute for claim 15, if found unpatentable),

The method of claim [[12]] 25, wherein propelling the looped string from
the at least one driven wheel comprises:

receiving the looped string through an intake aperture of the housing;

guiding the looped string between the pair of wheels; and

propelling the looped string through an exit aperture of the housing.

27. (Substitute for claim 16, if found unpatentable),

A string shooting device comprising:

a body;

a housing attached to the body and defining a loading slot;

a pair of wheels, wherein at least one of the pair of wheels is a driven wheel,
wherein the loading slot is disposed at least partially over at least one of the pair of
wheels; [[and]]

wherein the housing further comprises a guiding slot, wherein the guiding
slot extends around a portion of a circumference of at least one of the pair of
wheels; and

a looped string, wherein the looped string comprises a surface texture
configured to increase air friction in response to the looped string being propelled
through air by the pair of wheels.

28. (Substitute for claim 17, if found unpatentable),

The string shooting device of claim [[16]] 25, wherein the surface texture
comprises a plurality of fibers extending away from an axis along which the looped
string extends to generate a turbulent air boundary layer around the looped string in
response to the looped string being propelled through the air by the pair of wheels.

CERTIFICATE OF SERVICE

I hereby certify that on May 19, 2025 a copy of Patent Owner's Motion to Amend has been served via email on the following:

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EXHIBITS CITED

Exhibit No.	Patent Owners Description
2001	Original Patent Application as filed 18/056, 567.
2002	Declaration of Dr. Jason A. Janét, PhD.
2003	CV of Dr. Jason A. Janét, PhD.