

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CMS CEP COR LTD. and
CMS CEP COR AMERICAS LLC
Petitioner,

v.

SANDVIK INTELLECTUAL PROPERTY AB
Patent Owner.

IPR2024-01381
Patent 11,014,090 B2

Before CYNTHIA L. MURPHY, RICHARD H. MARSCHALL, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

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

I. INTRODUCTION

On March 18, 2025, we instituted trial as to claims 1–14 of U.S. Patent No. 11,014,090 B2. Paper 9. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1–14. Paper 14 (“Mot.”). Petitioner filed an opposition on September 16, 2025. Paper 19 (“Opp.”).¹

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). Mot. 1; *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

¹ On the same date, Petitioner also filed Paper 17, which appears to be a copy of Petitioner’s opposition in IPR2024-01380. Petitioner also filed several exhibits that are labeled as belonging in IPR2024-01380. Petitioner filed a motion to expunge the mistakenly filed opposition in this proceeding, and we will not consider that filing, or exhibits not cited in this Opposition, as part of Petitioner’s Opposition in this proceeding.

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 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 no more than one substitute claim for each challenged claim. More particularly, Patent Owner proposes twelve substitute claims (15–26) to replace twelve challenged claims (1–5 and 8–14). Petitioner does not argue that the Motion fails to propose a reasonable number of substitute claims. *See generally* Opp. Accordingly, Patent Owner has shown it proposes a reasonable number of substitute claims.

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 contends that the proposed substitute claims are responsive to the instituted grounds. Mot. 1–2. Petitioner does not argue that the Motion fails to respond to a ground of unpatentability involved in the proceeding. *See generally* Opp. Based on our review of the current record, the Motion is responsive to a ground of unpatentability involved in this proceeding. For example, the amendment to proposed substitute claim 15 is responsive to the ground of unpatentability based on Polinski, Piepho, and Harless. *See* Mot. 13–17.

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 contends that proposed “[s]ubstitute independent claims 15, 21, and 26 add limitations to original independent claims 1, 9, and 14 and thus do not enlarge the scope of the original claims.” Mot. 2. Petitioner does not argue that the Motion enlarges the scope of the claims of the patent. *See generally* Opp. We agree with Patent Owner that

proposed substitute independent claims 15, 21, and 26 are amended to add various limitations not recited in corresponding challenged independent claims 1, 9, and 14. Mot. 27–33. Each of proposed substitute claims 16–20 and 22–25 depends, directly or indirectly, from proposed substitute claims 15 and 21. Accordingly, Patent Owner’s Motion has not enlarged the scope of the claims of the patent.

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). In the Motion, Patent Owner identifies support for each proposed substitute claim in U.S. App. No. 15/035,774 (Ex. 2009, the “’774 application”) and EP Application No. 13192402.9 (Ex. 2008). Mot. 3–8. Patent Owner explains that “[t]he ’774 application is a national stage entry of PCT/EP2014/060594 (Ex. 2014), filed on May 23, 2014, and claims priority to EP Application No. 13192402.9 (Ex. 2008), filed on November 12, 2013.” *Id.* at 3. Petitioner does not argue that the Motion introduces new subject matter. *See generally* Opp. In the absence of any dispute, at this preliminary stage, Patent Owner has shown sufficient support for the proposed substitute claims in the originally-filed specification and Patent Owner’s Motion has not introduced new subject 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 Petitioner

² We express no view on the patentability of original claims 1–14 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 15–26 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

1. Improper incorporation by reference of arguments and analysis

We first address Petitioner’s approach to citing and incorporating arguments in its Opposition. Petitioner provides limited explanation for its obviousness arguments in the opposition brief, and relies mostly on extensive claim charts. *See* Opp. 11–18. Instead of including a complete analysis in its opposition brief, Petitioner states that “the Second Declaration of David Smith (Ex. 1044 Table pp. 36-64)” is “incorporated herein by reference” and “provides more detailed analysis.” *Id.* at 12. For example, Petitioner asserts that a person of ordinary skill in the art would be motivated to combine prior art “as described by Mr. Smith.” *Id.* at 12 (citing Ex. 1044 ¶¶ 52–57). Furthermore, Mr. Smith’s Second Declaration repeatedly refers to Mr. Smith’s First Declaration rather than provide a complete analysis in the second declaration itself. *See, e.g.,* Ex. 1044, 63 (“See 14a in my First Declaration.”). Mr. Smith’s First Declaration relied on Piepho for the challenged claim 14, yet there is no mention of Piepho in Petitioner’s Opposition as to claim 26, the proposed substitute for original claim 14.

This sort of incorporation by reference is not acceptable practice under the Board’s rules. A declaration may provide evidentiary support for an argument in a brief, but a party may not incorporate arguments made in a declaration by reference. *See* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”). Nevertheless, for purposes of this preliminary guidance we will consider Petitioner’s arguments set forth in the declarations of Mr. Smith. The parties are reminded that improperly incorporated arguments from a declaration in violation of 37 C.F.R. § 42.6(a)(3) may not be considered by the Board. If the briefing limits imposed by our Rules

are too difficult to meet given the number of issues, the parties may seek leave for additional pages rather than resorting to improper incorporation by reference.

To minimize the prejudice to Patent Owner, we *sua sponte* grant Patent Owner 15 additional pages in Patent Owner’s Reply or a revised MTA. If Patent Owner uses the additional pages, Petitioner may include an equal number of additional pages in its Sur-reply or Opposition to a revised MTA. The parties are reminded that the focus should be on the amended limitations rather than limitations found in the original claims.

2. Claim Construction

In an *inter partes* review, we apply the same claim construction standard as would be used by a district court to construe a claim in a civil action involving the validity or infringement of a patent. 37 C.F.R. § 42.100(b). Under that standard, claim terms are given their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history of record. *Id.*; *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc); *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). “The Board is required to construe ‘only those terms ... that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (alteration in original) (quoting *Vivid Techs., Inc. v. Am. Sci. Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Patent Owner proposes explicit constructions for two claim terms, and Petitioner disagrees. First, “Patent Owner submits that the proper construction of ‘end’ is an extremity of the shaft body or sleeve under its plain and ordinary meaning.” Mot. 9. According to Patent Owner, “[g]iven that a fluid inlet conduit

requires an inlet at some location and is described as extending axially, a POSITA would understand that the second end where the inlet is located is the extremity of the shaft and not a location along the length of the shaft.” *Id.* (citing Ex. 2010 ¶ 8) (Third Declaration of Harri Kytömaa, Ph.D.) (emphasis omitted). Second, “Patent Owner submits that that the phrase ‘indented at the external surface’ should [be] properly construed as a depression or recess in an external surface—specifically, the external facing surface of the shaft body.” *Id.* at 11 (citing Ex. 2010 ¶¶ 18–24).

Petitioner disagrees and argues that we need not construe any terms, and if we do, that Patent Owner’s proposed constructions unduly narrow the claim limitations. *See* Opp. 9–11. For example, Petitioner contends that “when considering the specification as a whole, it is clear that the patent drafters intended “end” to include additional regions beyond the extreme end surface.” *Id.* at 9–10. Petitioner also asserts that “indented at the external surface” encompasses grooves “on the shaft, in the shaft, or even near the shaft.” *Id.* at 11.

For the purposes of this preliminary guidance, we need not decide on an explicit claim construction for any claim terms because Petitioner shows the unpatentability of the claims even if we apply Patent Owner’s proposed constructions. In addition, construction of one or more of these terms may be central to the patentability of the original claims, and we are reluctant to provide a definitive construction without consulting briefing beyond this MTA that addresses these issues in the context of the original claims.

3. Proposed Substitute Claims 15–20 as Obvious Over Polinski, Harless, and Yagi

i. Proposed Substitute Independent Claim 15

Petitioner argues that proposed substitute independent claim 15 would have been obvious over the combination of Polinski, Harless, and Yagi. Opp. 12–13.

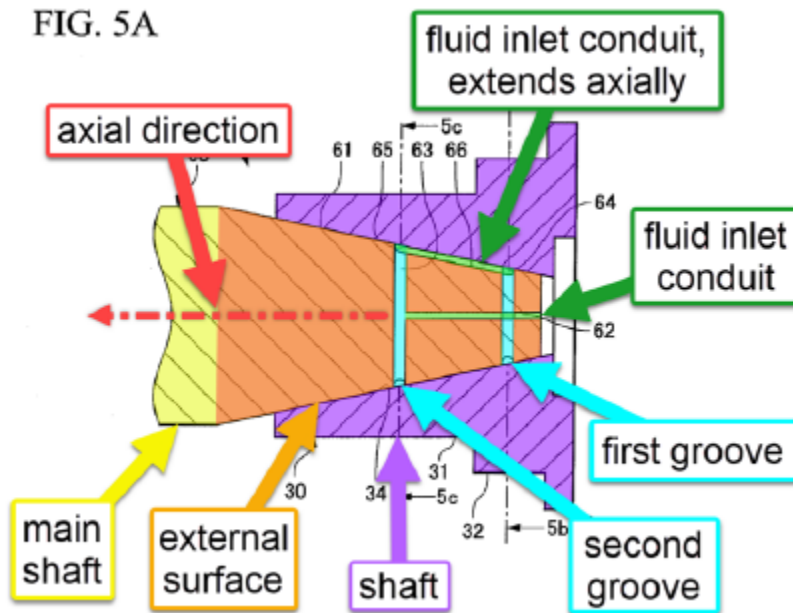
Petitioner's expert, Mr. Smith, opines that one of ordinary skill in the art would have been "motivated to combine Harless with Polinski to gain the advantages of easier assembly and disassembly disclosed by Harless" (Ex. 1044, 40) and because "a tapered sleeve is more robust and easier to install and remove" (*id.* at 41).

Mr. Smith contends that "Harless teaches a plurality of grooves (two in the sleeve and one in the shaft)." *Id.* at 41. Under Petitioner's proposed claim construction for "indented at the external surface," "the two grooves in the sleeve such as shown in Fig. 7 of Harless would satisfy this part of the limitation." *Id.* at 41–42. In addition, according to Mr. Smith, Yagi teaches "grooves in the shaft" and "whether the groove is cut in the sleeve or in the shaft is a design choice, either one of which will function to spread pressurized fluid to the interstitial space between the sleeve and the shaft." *Id.* at 42.

On this record, and using Petitioner's proposed construction, we agree with Petitioner that Harless discloses a plurality of grooves indented "at" the external surface of the shaft body. Nevertheless, even if we applied Patent Owner's narrower construction, on this preliminary record Petitioner establishes that Yagi teaches the limitation and also provides an adequate rationale for modifying the combination to place the threads on the shaft body because it would have been an obvious design choice.

Petitioner and Mr. Smith additionally rely on Yagi as disclosing "a plurality of grooves." *Id.* at 42. Petitioner contends that "[f]rom Harless and Yagi" a person of ordinary skill in the art "would understand that the number of oil grooves as taught is merely a design choice" and would have been "motivated to utilize oil grooves as opposed to shrink fitting as the process is easier and cheaper" and would also have been "motivated to use multiple grooves to supply a larger region, as taught by Yagi." *Id.* at 42–43.

According to Petitioner, “[b]oth Harless and Yagi disclose a first groove and a second groove where the first groove is closer to the second end of the shaft.” *Id.* at 44. Petitioner also contends that Yagi “teaches a fluid inlet ported to the one of two grooves that is furthest from the second end of the shaft.” *Id.* at 45. Mr. Smith provides an annotated version of Figure 5A of Yagi, reproduced below.



Id. at 46. The annotated version of Yagi’s Figure 5A includes a “first groove” and “second groove” colored light blue, and a “fluid inlet conduit” and “fluid inlet conduit, extends axially” connecting the grooves and colored light green. *Id.*

We have reviewed the disclosures of Polinski, Harless, and Yagi and they support Petitioner’s arguments, based on this preliminary record. For example, Yagi discloses “an axial oil passage 62 [labelled “fluid inlet conduit” in the figure above] is formed along the axial direction of the tapered shaft 60 from the front end surface of the taper part 61.” Ex. 1040, 6:40–42.

Patent Owner contends that (1) Harless fails to disclose grooves indented on the shaft body; (2) a person of ordinary skill in the art “would not have been

motivated to add multiple grooves in the shaft body” because “[d]oing so would create structural discontinuities that would increase the likelihood of fatigue failure in Polinski;” and (3) “neither Polinski nor Piepho discloses or suggests any ‘fluid inlet conduit,’” and that the internal oil bore 44 of Harless does not extend “internally within the shaft body only to the first groove,” as required by proposed substitute claim 15. Mot. 13–16 (emphasis omitted).

On this record, we are not persuaded by Patent Owner’s arguments. First, Patent Owner did not anticipate Petitioner’s reliance on a new reference, Yagi, and did not address Petitioner’s reliance on Yagi for specific limitations. As for the “grooves indented at the external surface” and “fluid inlet conduit” limitations, Petitioner has shown a reasonable likelihood that Yagi discloses that limitation. Second, as to the motivation to combine issues, “[t]he fact that the motivating benefit comes at the expense of another benefit . . . should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000).

We acknowledge that Patent Owner has not yet had the opportunity to address Petitioner’s arguments with regard to the combination of Polinski, Harless, and Yagi, and in particular, the alleged disclosures of Yagi and Petitioner’s related arguments. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised MTA).

For these reasons, at this stage of the proceeding Petitioner has shown a reasonable likelihood that proposed substitute claim 15 is unpatentable as obvious over Polinski, Harless, and Yagi.

ii. Proposed Substitute Dependent Claims 16–20

Petitioner argues that proposed substitute dependent claims 16–20 would have been obvious over the combination of Polinski, Harless, and Yagi. Opp. 13–14. Mr. Smith’s Second Declaration contains a detailed explanation of how the combination of Polinski, Harless, and Yagi meets every limitation of proposed substitute dependent claims 16–20. *See* Ex. 1044, 49–54. As noted above, Patent Owner did not address Petitioner’s reliance on Yagi in the proposed combination. *See id.*

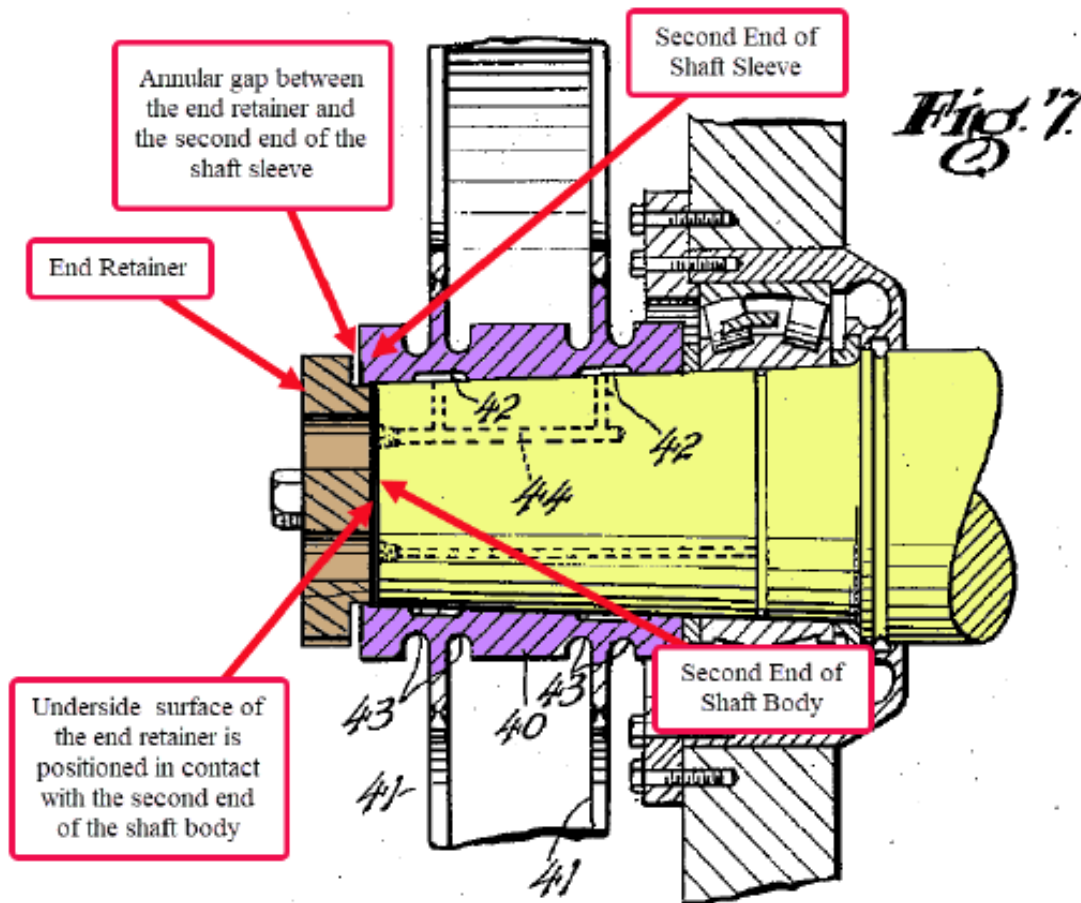
On this record, Petitioner (or the record) has shown a reasonable likelihood that proposed substitute dependent claims 16–20 are unpatentable as obvious over Polinski, Harless, and Yagi.

4. Proposed Substitute Claims 21–23, and 25 as Obvious Over Polinski and Harless

i. Proposed Substitute Independent Claim 21 as Obvious Over Polinski and Harless

Petitioner argues that proposed substitute independent claim 21 would have been obvious over the combination of Polinski and Harless. Opp. 15–16. Petitioner’s expert, Mr. Smith, opines that one of ordinary skill in the art would have been “motivated to make a simple substitution of an end retainer that has such a gap so as not to rely on a user to back off the bolts the correct amount” because “[i]f the bolt were to be backed off too much, the additional velocity of the sleeve and the lack of thread engagement could cause the end retainer to fail.” Ex. 1044, 57. Mr. Smith further asserts that “[i]t would be obvious for a POSITA to try such an end washer” and “[i]t would be a predictable solution to eliminate these issues and there would be more than a reasonable expectation of success.” *Id.*

Mr. Smith provides an annotated version of Figure 7 of Harless, modified to depict “an end retainer (brown) of the shape shown in Fig. 5 of Harless on Fig. 7 of Harless.”



Ex. 1044, 58. The annotated and modified version of Harless’s Figure 7 includes a brown structure on the left labelled “End Retainer” spaced from a purple shaft sleeve, with the space between the structures labelled “Annular gap between the end retainer and the second end of the shaft sleeve.” *Id.*

Patent Owner raises several arguments that address the combination, but Patent Owner did not address Petitioner’s new reliance on a combination of Harless’s Figures 5 and 7. *See* Mot. 20–22. For example, Patent Owner argues that Harless fails to disclose the claimed “recess” or “annular gap” because Harless shows washer 8 flush against gear hub 40 in the figures. *See id.* These arguments,

based on the current record, do not give adequate weight to Petitioner's argument, based on a combination of Figures 5 and 7, and Harless's teaching of an undercut shoulder that may be viewed as a recess when a user partially backs off the retaining bolt and allows movement of the alleged end retainer in Harless away from the end of the sleeve. *See* Ex. 1044, 56–58; Ex. 1033, 3:18–22 (instructing user to “back off the bolts 9 slightly” to facilitate removal and replacement of a gear). To the extent Patent Owner argues that the claimed “recess” requires the removal of additional material (beyond an undercut shoulder), Patent Owner should support such an argument with a formal claim construction position. In addition, the fact that Harless “does not identify an undercut shoulder in washer 8” or “disclose any movement of the washer away from the gear hub when bolts are backed off” as Patent Owner alleges does not establish, on the current record, that the undercut shoulder does not exist or that such movement does not occur as alleged by Petitioner. *See* Mot. 21.

We have reviewed the disclosures of Polinski and Harless and they support Petitioner's arguments, based on the current record. Petitioner has shown a reasonable likelihood that proposed substitute claim 21 would have been unpatentable over Polinski and Harless, based on the current record.

ii. Proposed Substitute Dependent Claims 22, 23, and 25 as Obvious Over Polinski and Harless

Petitioner argues that proposed substitute dependent claims 22, 23, and 25 would have been obvious over the combination of Polinski and Harless. Opp. 16–17. Mr. Smith's Second Declaration contains a detailed explanation of how the combination of Polinski and Harless meets every limitation of proposed substitute dependent claims 22, 23, and 25. *See* Ex. 1044, 58–62. These arguments include obviousness arguments not addressed by Patent Owner. *See id.*; Mot. 23.

On this record, Petitioner (or the record) has shown a reasonable likelihood that proposed substitute dependent claims 22, 23, and 25 are unpatentable as obvious over Polinski and Harless.

5. Proposed Substitute Claim 24 as Obvious Over Polinski, Harless, Piepho, and/or Yagi³

Petitioner argues that proposed substitute dependent claim 24 would have been obvious over the combination of Polinski, Harless, Piepho, and Yagi. Opp. 17. Mr. Smith's Second Declaration explains how the combination of Polinski, Harless, and Yagi meets every limitation of proposed substitute dependent claim 24. *See* Ex. 1044, 62. Mr. Smith also cites to the explanation in his first declaration addressing similar limitations in challenged claim 2. *See* Ex. 1002, 64–66. Patent Owner does not separately address claim 24.

On this record, Petitioner (or the record) has shown a reasonable likelihood that proposed substitute dependent claim 24 is unpatentable as obvious over Polinski, Harless, Piepho, and Yagi.

³ For purposes of this preliminary guidance, we interpret this challenge as including Piepho, even though the Opposition does not expressly mention Piepho in this context. The Opposition cites to Mr. Smith's Second Declaration, which refers back to portions of Mr. Smith's First Declaration, where Piepho was relied on for certain claims. *See, e.g.*, Ex. 1044, 62 (citing Mr. Smith's First Declaration's analysis of claim 2, which includes reliance on Piepho in the combination challenging claim 2). Because neither party addresses the relevance of Piepho to any of the amended limitations, we do not address Piepho further.

6. *Proposed Substitute Claim 26 as Obvious Over Polinski, Harless, Piepho, and/or Yagi*⁴

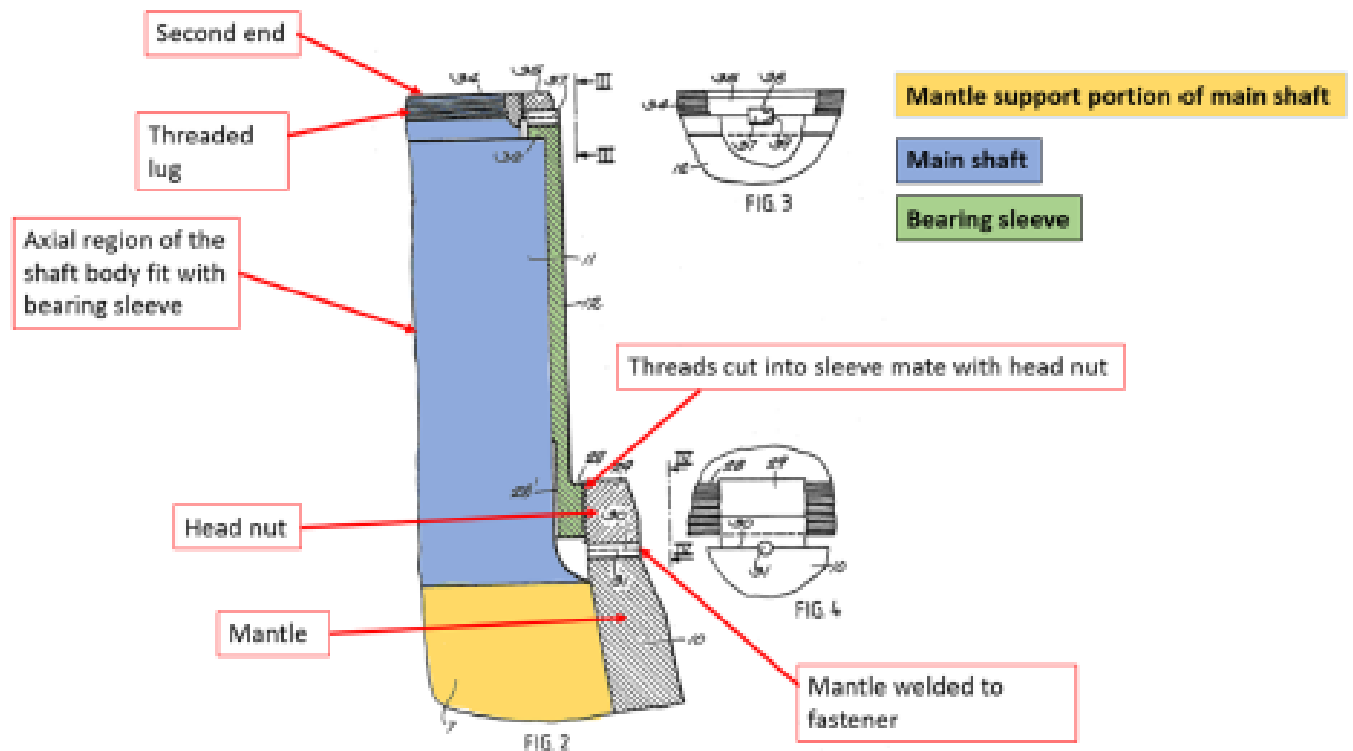
Petitioner argues that proposed substitute independent claim 26 would have been obvious over the combination of Polinski, Harless, Piepho, and/or Yagi. Opp. 17–18. Mr. Smith’s Second Declaration explains how the combination of Polinski, Harless, Piepho, and/or Yagi meets every limitation of proposed substitute dependent claim 26. *See* Ex. 1044, 62–66.

Patent Owner focuses on the limitation added by the proposed amendment, which requires “wherein the shaft sleeve is configured such that when positioned on the shaft body, the shaft sleeve is *independent of a crushing head* and a crushing shell.” Mot. 32–33 (quoting amendment to proposed substitute claim 26) (emphasis added and omitted). Patent Owner argues:

Polinski discloses that a sleeve 12, relied on by Petitioner for the sleeve recited in challenged claim 14, includes a threaded shoulder 28 near the bottom end of the sleeve 12 for securing a mantle 10 (corresponding to a crushing shell or crushing head mounted to the shaft 7 of Polinski) to a tapered mantle support portion 8 of the shaft 7. Accordingly, the sleeve is configured to secure the mantle 10 (corresponding to a crushing shell or crushing head) to the main shaft 7—Polinski’s sleeve 12 is not configured such that when positioned on the shaft body, the shaft sleeve is independent of a crushing head and a crushing shell. (Ex. 2010, ¶¶ 58–60.)

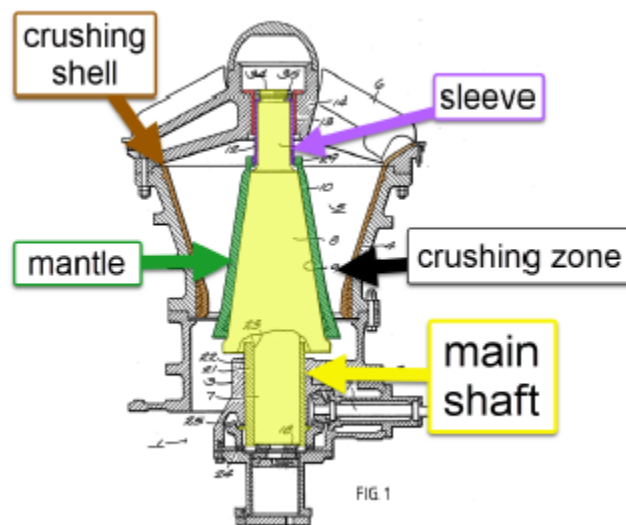
Id. at 24. Patent Owner’s expert’s annotated version of Figure 2 of Polinski is reproduced below.

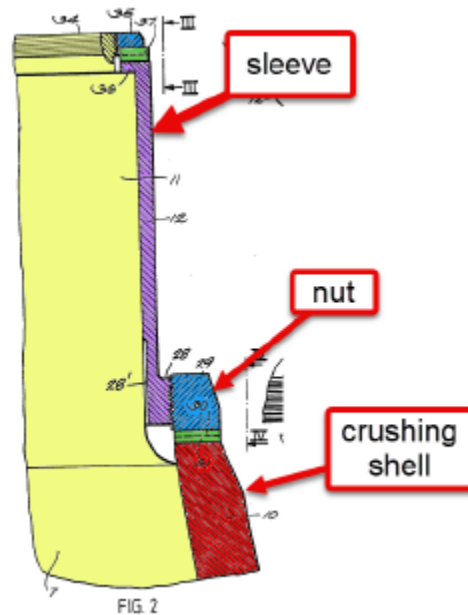
⁴ Similar to the challenge to claim 24, we interpret the challenge as including reliance on Piepho even though the Opposition does not expressly refer to Piepho, because the analysis incorporates analysis addressing the original claims that relies on Piepho. *See* Ex. 1044, 63–64 (citing analysis addressing original claims 14 and 15, which includes Piepho in the combination challenging claims 14 and 15).



Ex. 2010, 40.

Petitioner argues that “Polinski discloses a sleeve that is independent of the crushing head and a crushing shell.” Ex. 1044, 64. Petitioner’s annotated versions of Figure 1 and Figure 2 of Polinski are reproduced below.





The annotated Figure 1 colors a yellow “main shaft,” a purple “sleeve,” and a green “mantle,” while the annotated Figure 2 shows a blue “nut” and a red “crushing shell.” *Id.* According to Petitioner, “[t]he shaft sleeve of Polinski is press-fit to the main shaft body” which “means the shaft sleeve is dependent on the shaft body for its support” and “[t]he shaft sleeve is essentially bonded to the shaft body.” *Id.* at 65. Petitioner contends that “[t]he sleeve in Polinski is not supported by a crushing head or crushing shell” and “[t]herefore, a POSITA would understand that the sleeve of Polinski is independent of the crushing head and crushing shell.” *Id.* And, according to Petitioner, “[a]s shown in Figure 2 from Polinski above, the mantle, or crushing shell is not even attached to the shaft sleeve.” *Id.* at 66.

The difference between the parties’ positions primarily turns on claim construction. Patent Owner does not offer any explicit construction for the term “independent,” but Patent Owner appears to rely on an implicit construction of the term “independent” as meaning “not connected.” Petitioner contends that “the term ‘independent’ is not found anywhere in the ’090 specification, a POSITA

would be left with extrinsic definitions to understand the meaning of this claim element.” Ex. 1044, 64. Petitioner provides definitions from two dictionaries, namely Merriam-Webster Dictionary and Webster’s Unabridged Dictionary. *Id.* A definition of “independent” from Merriam-Webster offered by Petitioner is “not requiring or relying on something else: not contingent” and a definition from Webster’s that describes “independent” as “not relying on another or others for aid or support.” *Id.*

On this record, and in the absence of any explicit claim construction for “independent” from Patent Owner, we credit Petitioner’s construction, which supports its position that Polinski discloses a sleeve that is independent of the crushing head and crushing shell. As Petitioner points out, Polinski’s sleeve is “essentially bonded to the shaft body” and “is not supported by a crushing head or crushing shell.” Ex. 1044, 65. Although the current record supports Petitioner’s position, we acknowledge that Polinski’s sleeve is at least indirectly connected to its mantle (the crushing shell) via a nut such that the structures appear to move together. *See id.* at 64; Ex. 2010 ¶¶ 58–59. The parties may address this issue further, including whether structures bonded together may be viewed as independent even if Polinski’s sleeve movement depends on its shaft.

Because we agree with Petitioner that Polinski discloses the argued limitation based on this preliminary record, we need not address Patent Owner’s argument that “it would not have been obvious to modify Polinski in view of Piepho and Harless to include a sleeve that is configured such that, when positioned on the shaft body, it is independent of a crushing head and a crushing shell” (Mot. 25) because no modification of Polinski is required to meet the claim language under Petitioner’s construction. Petitioner does not raise such an argument in its Opposition. *See Opp.* 18; Ex. 1044, 63–66.

On this record, Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claim 26 is unpatentable as obvious over Polinski and Piepho.

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); Papers 10, 12. 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 or Patent Owner's reply. 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). If Patent Owner files a revised MTA, that motion replaces the original MTA and Petitioner may file an opposition to the revised MTA in accordance with any new scheduling order issued after the filing of a revised motion to amend. 37 C.F.R. § 42.121(f)(1)–(3).

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

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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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