

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXON ENTERPRISE, INC. and DEDRONE HOLDINGS, INC.,
Petitioner,

v.

AIRSPACE SYSTEMS, INC.,
Patent Owner.

IPR2025-00530
Patent 10,249,199 B2

Before MICHAEL R. ZECHER, BARRY L. GROSSMAN, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

I. INTRODUCTION

On October 8, 2025, we instituted trial as to claims 1–9 of U.S. Patent No. 10,249,199 B2 (Ex. 1001, the “’199 patent”). Paper 10. After institution, Patent Owner filed a Non-Contingent Motion to Amend, with proposed substitute claims 10–18. Paper 15 (“Motion” or “Mot.”). Petitioner filed an Opposition. Paper 20 (“Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with 37 C.F.R. § 42.121(a)(1)(ii). 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 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 has shown it

proposes a reasonable number of substitute claims by proposing a single substitute claim (i.e., claims 10–18) for each original claim (i.e., claims 1–9). *See* Mot. 1–2, Claims App.; *see also* 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 has responded to the grounds of unpatentability involved in this proceeding by presenting arguments explaining why the newly added limitations in proposed substitute claim 10 overcome the prior art in those grounds. *See* Mot. 2, 18–23. 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 asserts that proposed substitute claim 10 only adds further limitations to original claim 1, and that proposed substitute claims 11–18 are only amended with respect to dependencies. Mot. 2; *see also id.* at Claims App. Accordingly, Patent Owner asserts that “no proposed substitute claim enlarges the scope of the challenged claims.” *See id.* at 2.

Petitioner contends the amendment of proposed substitute claim 18 to depend directly from proposed substitute claim 10, rather than intervening proposed substitute claim 17, “impermissibly broadens substitute dependent claim 18 because the claim no longer requires ‘a control system for controlling the

disruption system’ as recited by substitute dependent claim 17 (original dependent claim 8).” Opp. 1–2. We disagree with Petitioner’s contention.

The standard we apply is whether a substitute claim broadens the *claims of the patent*, not any particular claim. *See Lectrosonics*, IPR2018-01129, Paper 15, at 6–7 (“A substitute claim will meet the requirements of § 42.121(a)(2)(i) and (ii) if it narrows the scope of at least one claim of the patent . . .”). Substitute claim 18 includes the newly added limitations in proposed substitute claim 10 from which it depends. The removal of an intervening dependency does not change the fact that claim 18 is thus narrower than original claim 1.¹ Each of the remaining proposed substitute dependent claims ultimately depend from proposed substitute claim 10, and therefore also include the narrowing limitations added in the amendment.

Petitioner’s reliance on *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231 (Fed. Cir. 2023) is unavailing. *See* Opp. 1. In *Sisvel*, the court affirmed the Board’s denial of a motion to amend where the proposed substitute independent claim was broader in one respect than the corresponding original independent claim, even though it contained other narrowing limitations. *See* 81 F.4th at 1239–40. The court based its holding on the principle that “a claim ‘is broader in scope than the original claim[] if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent.’” *Id.* at 1237 (alteration in original) (citing *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183

¹ We note, however, that despite the change in dependency of proposed substitute claim 18, it retains a recitation of “*the control system*.” Mot., Claims App. (emphasis added). The only prior recitation of a control system is in proposed substitute claim 17 (original claim 8), from which claim 18 no longer depends. Although not raised by Petitioner, Patent Owner may consider addressing the antecedent basis issue presented by removing the intervening dependency.

F.3d 1369, 1374 (Fed. Cir. 1999)). Here, there is no conceivable apparatus contained within the scope of proposed substitute claim 18 that would not have infringed original claim 1, because proposed substitute claim 18 is not broader in any respect than original claim 1.

For these reasons, neither proposed substitute claim 18, nor any of the other proposed substitute claims, enlarges the scope of the 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). In particular, a motion to amend must show “support in the original disclosure of the patent for each proposed substitute claim.” 35 C.F.R. § 42.121(b)(1); *Lectrosonics*, IPR2018-01129, Paper 15, 7 (“[T]he Board requires that a motion to amend set forth written description support in the originally filed disclosure of the subject patent for each proposed substitute claim . . .”).

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). Patent Owner’s Motion provides citations to U.S. Patent Application No. 15/598,303 (Ex. 2002, the “’303 application”), from which the ’199 patent issued, for each limitation in the proposed substitute claims. *See* Mot. 2–18.

Petitioner contends Patent Owner’s identified portions of the ’303 application fail to provide written description support for the proposed substitute claim 10 limitation in which “the identification receiver is configured to receive the aerial system identifier signal and a second factor identifier associated with the aerial system.” Opp. 3, Mot., Claims App. In particular, Petitioner argues that

“[n]one of the disclosures provide details regarding the reception of both an ‘aerial system identifier signal’ and a ‘second factor identifier,’ let alone an ‘identification receiver’ that is configured to ‘receive the aerial system identifier signal **and a second factor identifier associated with the aerial system**’ as claimed.” *Id.* at 4.

The ’303 application, however, clearly discloses using a second factor identifier, as Petitioner acknowledges. Opp. 6 (“The only reference in the specification to a ‘second factor identifier’ is found in [the ’303 application] at 4:15-24”). In particular, the second factor identifier may be used “as a secondary authenticator for the aerial system to prevent tampering and/or identifier reproduction,” and may be transmitted with “an optical signal generator (e.g., a blinking [light-emitting diode (“LED”)]).” Ex. 2002, 4:19–24. Further, one of ordinary skill in the art would have understood that the ’303 application demonstrates possession of the feature of receiving the second factor identifier at the identification receiver. According to the disclosure, “the identification receiver 102 is a wireless communication module including an antenna array 607 and chipset 608 but can alternatively include any other suitable component.” *Id.* at 8:21–23. For example, in an embodiment, “the identification receiver 102 includes a signal receiver 609,” which “can be: an optical sensor, acoustic sensor, an electromagnetic wave receiver, or by any other suitable sensor.” *Id.* at 10:1, 10:13–14. Given that (1) the second factor identifier may be transmitted with an optical signal and may be used for authentication, and (2) the identification receiver may include an optical sensor and may perform authentication (*see id.* at 26:16–17 (“The method can be entirely or partially performed by: . . . the identification receiver”), 30:24–31:1 (“In a second variation, authentication is accomplished by using a secondary identifier.”)), one of ordinary skill in the art

would have understood that the '303 application discloses receiving the second factor identifier at the identification receiver.

Petitioner further contends there is no identified written description support for the second factor identifier limitation “because the claim places no restriction on where the ‘second factor identifier associated with the aerial system’ is ‘receive[d]’ from—effectively claiming that it can be received from *anywhere*,” and “[t]he specification is not so broad.” Opp. 6. In particular, Petitioner argues that the '303 application “requires that [the second factor identifier] is transmitted by a ‘second identifier transmission system.’” *Id.*

The '303 application supports a broader scope than Petitioner asserts. In an embodiment, the '303 application discloses that “the aerial system 100 can include a first and second identifier, transmitted by a first and second identifier transmission system, respectively,” where, as noted above, “the second identifier transmission system can be an optical signal generator (e.g., a blinking LED).” Ex. 2002, 4:15–17, 4:23–24. But this is merely exemplary. While an identifier transmission system “preferably mounts to an aerial system 100,” it may more generally “be *otherwise associated with the aerial system 100*.” *Id.* at 15:8–12 (emphasis added). Further, an identifier transmission system “preferably includes identification transmitters and a coupling mechanism, but can alternatively include *any other suitable component*.” *Id.* at 15:12–14 (emphasis added). This broad disclosure of an identifier transmission system comports with the '303 application’s broad disclosure of an identification receiver, which can receive signals from a wide array of sources. *See, e.g., id.* at 9:13–10:10.

Petitioner also contends Patent Owner’s identified portions of the '303 application fail to provide written description support for the proposed substitute claim 10 limitation in which

the identification system is configured to determine and verify an authenticity of the aerial system identifier of the aerial system identifier signal using the second factor identifier and to provide an authenticated aerial system identifier of the aerial system identifier signal when the authenticity has been determined and verified.

Opp. 6; Mot., Claims App. In particular, Petitioner argues Patent Owner has not shown support for the “separate steps of ‘determin[ing]’ an authenticity and separately ‘verify[ing]’ an authenticity, let alone doing such ‘determin[ing]’ and ‘verify[ing]’ of authenticity using a ‘second factor identifier’ as claimed.” Opp. 7. Further, Petitioner argues that, “[f]or the same reasons, the citations do not support ‘to provide an **authenticated aerial system identifier** of the aerial system identifier signal **when the authenticity has been determined *and* verified.**”’ *Id.*

On the current record, it appears the disputed language in proposed substitute claim 10—“to determine and verify an authenticity of the aerial system identifier”—has written description support in the ’303 application. For example, the ’303 application includes disclosures that state “[d]etermining an aerial system identifier 310 can optionally include verifying the authenticity of the aerial system identifier 310,” where, in one embodiment, “authentication is accomplished by using a secondary identifier.” Ex. 2002, 30:17–18, 30:24–31:1. Patent Owner will have the opportunity to address Petitioner’s assertion that proposed substitute claim 10 requires authenticating the aerial system identifier in two separate steps—i.e., determining and verifying—that are allegedly not supported by the disclosure, and, optionally, to consider submitting a revised motion.

Petitioner contends other limitations in proposed substitute claim 10 are not supported by the ’303 application because they refer back to the allegedly unsupported limitation of an “authenticated aerial system identifier.” *See* Opp. 8. These contentions are not persuasive because, as noted above, it appears the ’303

application discloses the functionality of determining and verifying the authenticity of an aerial system identifier.

Petitioner additionally asserts the limitation in proposed substitute claim 10 that requires “a disruption system configured to disrupt an operation of the aerial system (i) when it is determined by the permission module that the aerial system associated with the authenticated aerial system identifier of the aerial system identifier signal is not permitted to be in an airspace” is not supported by the ’303 application. Opp. 9.

The ’303 application, however, appears to disclose the case where a disruption system may disrupt operation of an aerial system for which an identifier has been authenticated. For example, the ’303 application discloses enabling the disruption system if the “identifier is valid but is not permissioned.” Ex. 2002, 36:21–24; *see also* Fig. 5.

Accordingly, on the current record, Patent Owner has shown a reasonable likelihood that the proposed substitute claims have adequate written description support in the ’303 application.

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 shown a reasonable likelihood that proposed substitute claims 10–18 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

² We express no view on the patentability of original claims 1–9 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in Patent Owner’s Motion.

1. Indefiniteness

Petitioner contends, regarding proposed substitute claim 10, that “[i]t is unclear from the claims, specification, and prosecution history what a ‘second factor’ identifier entails or what makes an identifier a ‘second factor’ identifier,” and this “ambiguity renders the claim indefinite.” Opp. 10. Further, Petitioner contends “it is unclear whether the ‘second factor identifier’ is received from the previously recited ‘identifier transmission system’ . . . or an unrecited component.” *Id.*

Petitioner also contends the proposed substitute claim 10 limitation “wherein the disruption system is preemptively enabled based on the received aerial system identifier signal” renders the claim indefinite “because the claims, specification, and prosecution history of the ’199 [p]atent do not provide any insight into the meaning of ‘preemptively enabled,’ making substitute claim 10’s scope ambiguous and unclear.” Opp. 11.

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 proposed substitute claim 10 is indefinite.

First, there is no ambiguity in the term “second factor identifier.” Upon reading the ’199 patent, one of ordinary skill in the art would have understood that this refers to an identifier in addition to the claimed “aerial system identifier.” Further, we see no lack of clarity as to the source of the “second factor identifier.”

Proposed substitute claim 10 does not specify the source of the “second factor identifier,” but this relates to the breadth of the claim, and not indefiniteness. *See In re Miller*, 441 F.2d 689, 693 (CCPA 1971) (“breadth is not to be equated with indefiniteness, as we have said many times”).

Second, upon reading the ’199 patent, one of ordinary skill in the art would likely be reasonably certain of the scope of the term “preemptively enabled.” In the embodiment depicted in Figure 5, the ’303 application discloses that “the disruption system 105 may thus be preemptively enabled if certain conditions are met (e.g. aerial system detected w/o an identifier 500, identifier is received but is invalid 501, identifier is valid but is not permissioned 502, etc.).” Ex. 2002, 36:21–24. The ’303 provides that this “configuration would minimize any delays associated with powering on the disruption system 105 and thus allow the system to respond to fast moving aerial systems 100.” *Id.* at 36:24–37:2. Illustratively, Figure 5 shows a sequence of steps including: 1) “Enable disruption system 503”; and 2) “Disrupt aerial system operation 505.” In this context, one of ordinary skill in the art would be reasonably certain that the term “preemptively enabled” limits the operation of the disruption system such that it must be enabled prior to performing an actual disruption.

2. Obviousness

i. Ground 7—Obviousness over Whitmarsh, Viggiano, and Gong⁶³⁷

Proposed substitute claim 10 recites the following newly added limitations (underlined):

an identifier transmission system . . . configured to broadcast an aerial system identifier signal comprising an aerial system identifier . . . ;

an identification system comprising an identification receiver;

...

wherein the identification receiver is configured to receive the aerial system identifier signal and a second factor identifier associated with the aerial system;

wherein the identification system is configured to determine and verify an authenticity of the aerial system identifier of the aerial system identifier signal using the second factor identifier and to provide an authenticated aerial system identifier of the aerial system identifier signal when the authenticity has been determined and verified, and

to provide the authenticated aerial system identifier of the aerial system identifier signal to the permission module, and

wherein the permission module is configured to determine that the aerial system associated with the authenticated aerial system identifier of the aerial system identifier signal is not permitted to be in an airspace; and

a disruption system configured to disrupt an operation of the aerial system (i) when it is determined by the permission module that the aerial system associated with the authenticated aerial system identifier of the aerial system identifier signal is not permitted to be in an airspace, or (ii) when the authenticity of the aerial system identifier of the aerial system identifier signal is not verified

Mot., Claims App.

For Ground 7, Petitioner contends proposed substitute claims 10–12 and 14–18 would have been obvious over Whitmarsh (Ex. 1005), as asserted against original claims 1–3 and 5–9 in Ground 1 in the Petition (i.e., (1) obviousness over Whitmarsh), in combination with Viggiano (Ex. 1007) and the newly asserted reference Gong637 (Ex. 1022).

In particular, focusing on the newly added limitations, Petitioner asserts that Whitmarsh teaches an unmanned aerial vehicle (“UAV”) that transmits an aerial system identifier (i.e., a UAV media access control (“MAC”) address), and a UAV defense system that includes an identification receiver. *See* Opp. 17–18. Petitioner further asserts, in view of Viggiano’s teachings, that “Whitmarsh’s parts forming

an *identification receiver* would have received (1) UAV aircraft identification information that is the wireless communication signal including the MAC address of a UAV (*wherein the identification receiver is configured to receive the aerial system identifier signal*) as well as (2) a message authentication code formed from identification information of the UAV and a secret key of the UAV (*and a second factor identifier associated with the aerial system*).” *Id.* at 19.

In addition, Petitioner asserts, in view of Viggiano and Gong637, that “Whitmarsh’s computer system, processor, or similar component that identifies UAVs based on their received MAC address (*identification system*) would have authenticated the identity of a UAV” Opp. 21. Further, Petitioner asserts that “Viggiano and Gong637 teach that this authentication comparison is performed consecutive times,” so that the combination “not only determines but also *verifies* that the authentication is accurate.” *Id.* Petitioner asserts that Whitmarsh teaches “the UAV MAC address is provided to the components forming the *permission module*,” which “determine[s] that a UAV associated with a UAV MAC address is not authorized to be in a particular area.” Opp. 22.

Finally, Petitioner asserts that, in the Whitmarsh-Viggiano-Gong637 combination, “successful authentication would have resulted in Whitmarsh’s UAV MAC address having been authenticated, and thus the disruption provided by the countermeasures system would have occurred when the components forming the *permission module* determine that the UAV associated with the authenticated UAV MAC address is not authorized to be in a particular area.” Opp. 23. On the other hand, Petitioner asserts, in view of Viggiano and Gong637, that “Whitmarsh’s countermeasures system (*disruption system*) disrupts operation of the UAV by forcing it to land (*configured to disrupt an operation of the aerial system*) when the

authentication comparison involving the UAV MAC address fails consecutive times” *Id.* at 24.

In combining the references for Ground 7, Petitioner reasons that the combination “represent[s] the mere application of known techniques (*i.e.*, known aircraft identification authentication techniques, as taught by Viggiano and Gong637) to a known system (e.g., Whitmarsh[] . . . system[] that utilize[s] the MAC address of a UAV for identification) ready for improvement, the results of which would have been predictable and had a reasonable expectation of success.” Opp. 17.

For the reasons explained in the Opposition and highlighted above, at this stage, and based on the current record, we determine that Petitioner has shown a reasonable likelihood that proposed substitute claims 10–12 and 14–18 would have been obvious based on Whitmarsh, Viggiano, and Gong637.

ii. Ground 8—Obviousness over Whitmarsh, Falk, Viggiano, and Gong637

Petitioner contends proposed substitute claim 13 would have been obvious over Whitmarsh and Falk (Ex. 1011), as asserted against original claim 4 in Ground 2 in the Petition (*i.e.*, (2) obviousness over Whitmarsh and Falk), in further combination with Viggiano and Gong637. No newly added limitations are recited in proposed substitute claim 13. Accordingly, for the reasons discussed above, at this stage, Petitioner has shown a reasonable likelihood that proposed substitute claim 13 would have been obvious based on Whitmarsh, Falk, Viggiano, and Gong637.

- iii. Grounds 9 and 10—Obviousness over (9) Whitmarsh, Goodrich, Viggiano, and Gong637, and (10) Whitmarsh, Goodrich, Falk, Viggiano, and Gong637

For Ground 9, Petitioner contends proposed substitute claims 10–12 and 14–18 would have been obvious over Whitmarsh and Goodrich (Ex. 1008), as asserted against original claims 1–3 and 5–9 in Ground 3 in the Petition (i.e., (3) obviousness over Whitmarsh and Goodrich), in further combination with Viggiano and Gong637. For Ground 10, Petitioner contends proposed substitute claim 13 would have been obvious over Whitmarsh, Goodrich, and Falk, as asserted against original claim 4 in Ground 4 in the Petition, also in further combination with Viggiano and Gong637. Petitioner does not provide any additional assertions for the newly added limitations, based on the addition of the Goodrich reference to these grounds. *See* Opp. 14–25. For the reasons already discussed with respect to Grounds 7 and 8, at this stage, Petitioner has shown a reasonable likelihood that proposed substitute claims 10–12 and 14–18 would have been obvious based on Whitmarsh, Goodrich, Viggiano, and Gong637, and that proposed substitute claim 13 would have been obvious based on Whitmarsh, Goodrich, Falk, Viggiano, and Gong637.

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 11, 10–11, 13. 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 *inter partes* review 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).

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