

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AROMA360, LLC
Petitioner,

v.

AIR ESSCENTIALS, INC.
Patent Owner.

IPR2025-00706
Patent 10,583,449 B1

Before MITCHELL G. WEATHERLY, ERIC C. JESCHKE, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JESCHKE, *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, 4, and 7–10 of U.S. Patent No. 10,583,449 B1 (Ex. 1001, “the challenged patent”). Paper 9. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1, 4, and 7–10. Paper 14 (“Motion” or “Mot.”). Petitioner filed an opposition on April 15, 2026. Paper 19 (“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. 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 applied in this Preliminary Guidance differs from the preponderance of the evidence standard applied when ultimately deciding the Motion. *Compare* 37 C.F.R. § 42.121(e)(1), *with* § 42.121(d). 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).

Before providing the Preliminary Guidance, we address the schedule in this proceeding. On December 9, 2025, the parties filed a joint stipulation to modify Due Dates 1, 2, and 3 from the Scheduling Order. In relevant part, the Scheduling Order states:

The parties may not stipulate to a different date for the portion of DUE DATE 2 related to Petitioner’s opposition to a motion to amend, or for the portion of DUE DATE 3 related to Patent Owner’s reply to an opposition to a motion to amend (or Patent Owner’s revised motion to amend) without prior authorization from the Board. In stipulating to move any due dates in the scheduling order, the parties must be cognizant that the Board requires four weeks after the filing of an opposition to the motion to amend (or the due date for the opposition, if none is filed) for the Board to issue its preliminary guidance, if requested by Patent Owner.

Paper 10 at 9–10. Despite those instructions, and without prior authorization, the parties filed a joint stipulation extending all aspects of Due Date 2 (including those related to a motion to amend) “from March 11, 2026 to April 15, 2026” and extending all aspects of Due Date 3 “from April 22, 2026 to May 15, 2026.”

Paper 11, 2. For future practice before the Board, counsel are reminded that modification of the portions of Due Dates 2 and 3 related to a Motion to Amend requires prior authorization from the panel.

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 not 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 two claims to replace six challenged claims. Mot. 6. Patent Owner amends original independent claim 1 to arrive at independent proposed substitute claim 20 and amends original independent claim 7 to arrive at independent proposed substitute claim 21. Mot. 10–12 (Claims App.). On the facts here, Patent Owner has shown it proposes a reasonable number of substitute claims. Petitioner does not argue otherwise. *See generally* Opp.

2. Respond to a 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 asserts that the proposed amendments to independent claims 1 and 7 found in proposed substitute claims 20 and 21, respectively, are responsive to the grounds in the Petition. Mot. 5–6. Specifically, Patent Owner contends that “[p]roposed claim 20, to be substituted for independent claim 1, includes disclosure from unchallenged claim 3 pertaining to a drip tube” and that “[p]roposed claim 21, to be substituted for independent claim 7, further clarifies the structure and function of the atomizer assembly and its components.” *Id.* And, according to Patent Owner, “[n]one of the asserted references, individually or in combination, disclose or render obvious the recited claim features.” Mot. 6.

When considering the Motion as a whole, Patent Owner responds to a ground of unpatentability. *See Lectrosonics*, Paper 15 at 5 (stating that “in considering the motion, we review the entirety of the record to determine whether a patent owner’s amendments respond to a ground of unpatentability involved in the trial”). Patent Owner has responded to a ground of unpatentability involved in this proceeding. Petitioner does not argue otherwise. *See generally* Opp.

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). Proposed substitute claim 20 is a substitute for claim 1 and adds the limitation of “a drip tube disposed in an interconnecting relation between said enclosed diffusion chamber and the container.” Mot. 11 (Claims App.). Proposed substitute claim 21 is a substitute for claim 7 and adds the limitation of “said fluid inlet disposed relative to said atomizer air inlet channel such that compressed air from the compressed air source flows over said fluid inlet and into said mixing chamber.” Mot. 12 (Claims App.).

Patent Owner's Motion has not enlarged the scope of the claims of the challenged patent. Petitioner does not argue otherwise. *See generally* 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). Petitioner does not contend that the proposed amendment adds new matter, but does contend that the Motion does not comply with the Board's precedential decision in *Lectrosonics*, Paper 15 at 8, because the Motion fails to "set forth written description support for each proposed substitute claim as a whole, and not just the features added by the amendment." Opp. 6–7. We agree with Petitioner that the Motion is procedurally deficient. *Id.* The table on page 7 of the Motion includes only the claim features added by the proposed amendments. We note that this deficiency alone may constitute a basis for the Board to deny the Motion.

5. Conclusion

For the foregoing reasons, we conclude that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

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, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 20 and 21 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).¹

¹ As noted above, we express no view on the patentability of original claims 1, 4, and 7–10 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner's Motion to Amend.

1. Alleged Obviousness of Proposed Substitute Claims 20 and 21 Over
Sevy and Sevy in View of Gao (Grounds 1 and 2)

i. Proposed Substitute Claim 20

Petitioner contends that Sevy discloses or suggests all of the limitations of proposed substitute claim 20. *See* Opp. 8–10. Petitioner’s contentions are supported by the supplemental declaration of Dr. White. *See* Ex. 1047 ¶ 38.

In particular, Petitioner contends that Sevy discloses “a drip tube disposed in an interconnecting relation between said enclosed diffusion chamber and the container” “or at least renders it obvious.” Opp. 8. According to Petitioner, “Sevy discloses (i) the chamber/container interface and (ii) the same practical issue the alleged ‘drip tube’ addresses: accumulated liquid returns toward the reservoir” (*id.*) and “that atomizer 16 may secure to reservoir 18 ‘such as by threads or the like,’ (Opp. 8–9 (citing Ex. 1009 ¶ 41; Pet. 37)). According to Petitioner, this disclosure relates to “the same diffusion-unit/container interface targeted by Patent Owner’s amendment.” Opp. 9. And, according to Petitioner, one of ordinary skill in the art:

would recognize that, once a reference discloses liquid accumulation and dripping back toward the reservoir, adding a simple drip-return tube or drain feature at that same interface is a routine, predictable design refinement. It directs the return flow. It reduces mess and pooling. It improves repeatability. It also reduces unintended liquid contact with internal components to enhance longevity (e.g., by mitigating corrosion or residue buildup). This refinement would not change the diffuser’s principle of operation.

Opp. 9 (citing Ex. 1047 ¶ 38).

On the current record, we agree with Petitioner. We credit Dr. White’s testimony that “it is a routine and predictable engineering refinement to add a drip-return tube or drain at the chamber/reservoir interface to direct the return flow, reduce mess and pooling, and improve repeatability, without changing the device’s atomization principle of operation.” Ex. 1047 ¶ 38.

We note that Patent Owner has not had an opportunity to respond to Petitioner's contentions and the supplemental declaration of Dr. White. Thus, in subsequent papers, the parties should address (1) whether a person of ordinary skill would have been motivated to modify Sevy's apparatus by adding a drip tube at the diffusion-unit/container interface and (2) whether such a modification would have changed the principle of operation of Sevy's diffuser.

Petitioner also contends that proposed substitute claim 20 would have been obvious over the combination of Sevy and Gao. Opp. 10. Petitioner does not, however, contend that Gao discloses a drip tube. Rather, Petitioner asserts that "Ground 2, which relies on Gao as another basis for the 'fluid dispersion' term, would render the claims obvious for the same reason as Ground 1" because "[i]n the proposed combination, nothing in Gao displaces Sevy's container/chamber interface structure or its disclosed return of agglomerated liquid toward the reservoir." *Id.* Accordingly, Petitioner's contention that proposed substitute claim 20 would have been obvious over the combination of Sevy and Gao, with respect to the newly added limitation, depends on the same issues identified above.

At this stage of the proceeding, the current record establishes a reasonable likelihood that proposed substitute independent claim 20 would have been obvious over Sevy and also the combination of Sevy and Gao.

ii. Proposed Substitute Claim 21

Petitioner contends that Sevy discloses or suggests all of the limitations of substitute claim 21. *See* Opp. 10–11. Petitioner's contentions are supported by the supplemental declaration of Dr. White. *See* Ex. 1047 ¶¶ 39–40.

In particular, Petitioner contends that "Sevy teaches that channel 114 carries air from passage 50 toward orifice 118" and "[c]avity 116 is open from below to siphon tube 96." Opp. 11 (citing Ex. 1009 ¶¶ 79–82; Pet. 27–30). Petitioner

asserts that Sevy discloses that “[w]hen pressure is reduced in cavity 116, liquid is drawn from reservoir 18 through siphon tube 96 to orifice 118 and mixed with the high-speed air stream and the mixture exits through exit orifice 119.” *Id.* And, according to Petitioner, in view of that disclosure, one of ordinary skill in the art would have found it obvious to have arranged:

the relative placement of the siphon tube opening and the air-flow path at orifice 118 so that compressed air flows over (or across) the fluid-inlet opening and into the mixing cavity 116 because that is the predictable configuration required for suction-based entrainment and mixing in the disclosed eductor architecture.

Id. (citing Ex. 1047 ¶¶ 39–40). Dr. White explains that a person of ordinary skill would have understood “that the Venturi (educting) effect in twin-fluid atomizers requires a high-velocity gas stream created by a constriction or jet (the ‘throat’ region) that produces a localized pressure drop” and that “[t]hat pressure drop draws liquid through a nearby inlet opening into the gas stream, where the liquid and gas initially mix and atomization begins.” Ex. 1047 ¶ 39. Dr. White also testifies that Sevy describes “a Venturi-style eductor arrangement in which the air jet creates suction at the fluid inlet and entrains liquid into the air stream; and that, at minimum, this disclosure renders obvious positioning the fluid inlet relative to the air-flow path so that compressed air flows over (or across) the inlet opening and into the mixing region.” *Id.* ¶ 40.

On the current record, we agree with Petitioner. We credit Dr. White’s testimony that a person of ordinary skill in the art would have understood that Sevy describes a Venturi-style eductor and that it would have been obvious to position the fluid inlet “relative to said atomizer air inlet channel such that compressed air from the compressed air source flows over said fluid inlet and into said mixing chamber” as required by the added limitation of proposed substitute claim 21.

We note that Patent Owner has not had an opportunity to respond to Petitioner's contentions and the supplemental declaration of Dr. White. Thus, in subsequent papers, the parties should address (1) whether any modification of Sevy's apparatus would be required to arrive at the newly added limitation and (2) whether such a modification would change the principle of operation of Sevy's diffuser.

2. Alleged Obviousness of Proposed Substitute Claims 20 and 21 Over Goubet and Goubet in View of Kaiser (Grounds 3 and 4)

i. Proposed Substitute Claim 20

Petitioner contends that Goubet discloses or suggests all of the limitations of substitute claim 20. *See* Opp. 11–13. Petitioner's contentions are supported by the supplemental declaration of Dr. White. *See* Ex. 1047 ¶ 38.

In particular, Petitioner contends that Goubet “discloses the same head/container interface and a droplet-flow path directed back toward the reservoir interior” and that “adding a drip-return tube at that same interface would have been obvious.” Opp. 12.

Petitioner's obviousness position for Grounds 3 and 4 appears to be essentially identical to Petitioner's position for Grounds 1 and 2, discussed above. *See* Opp. 12–13; Ex. 1047 ¶ 38. For essentially the same reasons, the current record establishes a reasonable likelihood that proposed substitute independent claim 20 would have been obvious over Goubet or the combination of Goubet and Kaiser.

Again, we note that Patent Owner has not had an opportunity to respond to Petitioner's contentions and the supplemental declaration of Dr. White. Thus, in subsequent papers, the parties should address the issues of (1) whether a person of ordinary skill would have been motivated to modify Goubet's apparatus by adding

a drip tube at the diffusion-unit/container interface; and (2) whether such a modification would have changed the principle of operation of Goubet's diffuser.

ii. Proposed Substitute Claim 21

Petitioner contends that Goubet discloses or suggests all of the limitations of substitute claim 21. *See* Opp. 13–14. Petitioner's contentions are supported by the supplemental declaration of Dr. White. *See* Ex. 1047 ¶¶ 39, 41.

According to Petitioner, “Goubet discloses that compressed air penetrates the diffuser head via air inlet channel 9, enters diffusion chamber 5 through compressed air inlet 6, and flows through the venturi region (cone 7)” and “that the chamber includes an oil inlet at the upper end 10 of dip tube 8 connected to essential oil 3 in reservoir 2.” Opp. 13 (citing Ex. 1016, 3:31–4:2, 4:15–1, Fig. 2). Petitioner asserts that “Goubet explains that ‘when the compressed air flows into the diffusion chamber 5, the essential oil 3 is drawn into the diffusion chamber 5 by the vacuum created,’ i.e., the compressed air flow across the oil-inlet opening creates suction that draws oil into the chamber where air and oil are mixed.” *Id.* (citing Ex. 1016, 4:19–22). And, according to Petitioner, “Figure 2 [of Goubet] depicts the compressed-air flow path (arrows F) flowing past the dip-tube inlet (10) at the venturi region and into diffusion chamber 5.” *Id.* Based on this disclosure, Petitioner contends that a person of ordinary skill would have understood “that the fluid inlet (dip tube end 10) is disposed relative to the air-inlet path such that compressed air flows over (or across) the fluid inlet and into the mixing region (diffusion chamber 5) where air and oil mix.” Opp. 13–14 (citing Ex. 1047 ¶¶ 39, 41; Ex. 1016, 4:15–22, Fig. 2).

On the current record, we agree with Petitioner. We credit Dr. White's testimony that one of ordinary skill in the art would have understood “that Goubet's disclosed venturi geometry necessarily requires, and therefore at

minimum renders obvious, positioning the dip-tube fluid inlet relative to the air-inlet path so that compressed air flows over (or across) the fluid-inlet opening and into the mixing region where entrainment and mixing occur.” Ex. 1047 ¶ 41.

We note that Patent Owner has not had an opportunity to respond to Petitioner’s contentions and the supplemental declaration of Dr. White. Thus, in subsequent papers, the parties should address (1) whether any modification of Goubet’s apparatus would be required to arrive at the newly added limitation and (2) whether such a modification would have changed the principle of operation of Goubet’s diffuser.

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; *see also* Paper 12 (modifying DUE DATE 3 to May 15, 2026).² 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

² As explained above, the parties improperly stipulated to modify the portions of Due Dates 2 and 3 relating to motions to amend without prior authorization from the Board.

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).

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