

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALIVECOR, INC.,  
Petitioner,

v.

APPLE INC.,  
Patent Owner.

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IPR2023-00950  
Patent 10,076,257 B2

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Before KEN B. BARRETT, JOSIAH C. COCKS, and  
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE  
PATENT OWNER'S MOTION TO AMEND

## I. INTRODUCTION

On January 9, 2024, we instituted trial as to claims 1–22 of U.S. Patent No. 10,076,257 B2 (“the ’257 patent,” Ex. 1001). Paper 12 (“Inst. Dec.”). After institution, Patent Owner filed a contingent Motion to Amend (Paper 19 (“Mot.”)) requesting that “[t]o the extent the Board finds any of original claims 16–22 unpatentable,” we amend the ’257 patent to “enter[] at least the proposed claim(s) [23–29] presented herein in substitution for the corresponding claim(s) found unpatentable.” Mot. 2. Petitioner filed an opposition on June 26, 2024. Paper 24 (“Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1–2; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). 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 (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory

requirements for a motion to amend); 37 C.F.R. § 42.121 (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).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *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. *See id.* at 9,500.

## II. PRELIMINARY GUIDANCE

### A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied these requirements for proposed substitute claims 23–29.

#### 1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
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<b>Although Patent Owner's proposed number of substitute claims is equal to the number of contingently-replaced challenged claims, Patent Owner does not appear to have met its burden to establish that</b>
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**the Motion to Amend complies with the requirements of 37 C.F.R. § 42.121(a)(3).**

Section 42.121(a)(3) states that “[a] motion to amend may . . . propose a reasonable number of substitute claims” with the “presumption [being] . . . that only one substitute claim would be needed *to replace* each challenged claim, and it may be rebutted by a demonstration of need.” 37 C.F.R. § 42.121 (emphasis added).

Although Patent Owner asserts that “for each challenged MTA claim [(here, original challenged claims 16–22)], Apple proposes only one substitute claim, fitting the ‘presumption . . . that only one substitute claim would be needed to replace each challenged claim’” (*see* Mot. 11), Patent Owner’s substitute claims 23–29 do not appear to be *replacements* for the originally challenged claims 16–22 (as 37 C.F.R. § 42.121(a)(3) requires).

For example, proposed substitute claims 23–29 now all depend from original independent claim 1 (and not from original independent claim 15 from which original claims 16–22 depend). *See* Mot. App. (Claims Appendix); *see also* Ex. 1001, 13:49–14:50.

Proposed substitute claims 23–29 also delete substantially all original limitations of original claims 16–22 that they are intended to replace. *See* Mot. App. (Claims Appendix). For example, proposed substitute claim 23 deletes all limitations in original claim 16 aside from the reference to “[t]he electronic device,” even though it is intended to be a “Substitute for claim 16.” *Id.* The other proposed substitute claims similarly present all new limitations. *See id.*

So, although Patent Owner calls proposed claims 23–29 “[s]ubstitute[s] for” originally challenged claims 16–22 (*see id.*), Patent Owner’s proposed claims 23–29 lack a meaningful relationship to original claims 16–22, and the limitations of proposed claims 23–29 are not traceable to the limitations of original claims 16–22.

A patent owner “may file one motion to amend a patent,” (37 C.F.R. § 42.121(a)); however, what Patent Owner has done in this instance is propose an entirely new claim set not related to the limitations of the original claims 16–22. We question whether Patent Owner has proposed a reasonable number of *substitute claims* within the confines of our limited mandate set forth in 35 U.S.C. § 315(d). Patent Owner has the burden to establish that the proposed number of substitute claims is reasonable. Patent Owner has not sufficiently explained why seven proposed new

claims—*whose features and dependencies are not traceable to features and dependencies of the seven original claims they are intended to replace*—represent “*a reasonable number of substitute claims*” to “*replace each challenged claim.*” See 37 C.F.R. §§ 42.121(a)(3) (emphases added), 42.121(d)(1) (noting that “patent owner bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with the requirements of . . . paragraphs (a)(2), (a)(3), (b)(1), and (b)(2) of [37 C.F.R. § 42.121]”). The parties should further address whether Patent Owner’s proposed new claims comply with our statutory and regulatory requirements, including 37 C.F.R. § 42.121.

At this juncture, Patent Owner has not met the burden of showing that it has proposed a reasonable number of *substitute claims*.

We acknowledge that Patent Owner has not yet had the opportunity to address our concerns outlined *supra*. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend). See Notice, *passim*.

## 2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

**Yes.**

Patent Owner responds to the grounds of unpatentability on which we instituted trial. Mot. 7–10, App. (Claims Appendix); *see* Inst. Dec. 10. Upon review of Patent Owner’s arguments, we agree that proposed substitute claims 23–29 recite new limitations, and new combinations of limitations, that directly respond to the grounds of unpatentability involved in the trial. *See* Mot. App. (Claims Appendix).

Petitioner contends the Motion does not respond to a ground of unpatentability. *See* Opp. 2–3. In particular, Petitioner asserts that “Apple has failed to address the prior art references on which trial was instituted” and “has thus failed to demonstrate how the proposed amendments are responsive to a ground of rejection.” *Id.* Patent Owner, however, points to Petitioner’s Ground 2 (Markel and Nissilä) and identifies clarifying amendments in the proposed substitute claims directed to features of the processor and location and morphology of leads and pads that “[n]one of the asserted references, individually or in combination, disclose or render

obvious.” Mot. 8–9. Indeed, Petitioner’s grounds of unpatentability asserted that various features pertaining to the leads, pads, and processor recited in the originally challenged claims were obvious over Markel and Nissilä. *See* Pet. 7–91. And Patent Owner’s proposed substitute claims 23–29 add limitations directed to features of the leads, pads, and processor. *See* Mot. App. (Claims Appendix). Moreover, “nothing in the America Invents Act (AIA) or the Board’s regulations precludes a patent owner from amending a claim to both overcome an instituted ground and correct other perceived issues in the claim.” *Am. Nat’l Mfg. v. Sleep No. Corp.*, 52 F.4th 1371, 1380 (Fed. Cir. 2022).

For purposes of this preliminary guidance and based on the current record, we are therefore persuaded that Patent Owner’s amendments presented via proposed substitute claims 23–29 respond to the grounds of unpatentability that were instituted by the Board in the Decision to Institute. *See* Mot. 7–10; Inst. Dec. 10, 54.

### 3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**Patent Owner may not have met its burden to establish that the Motion to Amend complies with the non-enlargement requirement of 37 C.F.R. § 42.121(a)(2)(ii).**

Patent Owner asserts that the proposed substitute claims “do not enlarge the scope of the corresponding original claims” because they “all depend from existing independent or dependent claims and add non-broadening limitations.” Mot. 3.

Notably, however, proposed substitute claims 23–29 (i) now depend directly or indirectly from original claim 1 (and not from original claim 15), and also (ii) delete all features of original claims 16–22 and delete the feature of “a second lead embedded in the display screen” that was incorporated into original claims 16–22 through their dependency from claim 15. *See* Mot. App. (Claims Appendix).

Petitioner contends that “Apple has broadened the claims by changing the direct or indirect dependencies of all the substitute claims from independent claim 15 to claim 1,” and because “Apple deleted all the original claim limitations in each of the original dependent claims,” the

result is that “every substitute claim is broader in some respect than the original claim.” Opp. 4.

At this stage, we determine that Patent Owner does not appear to have met its burden to establish that its proposed substitute claims 23–29 *are what is intended to be covered by the statutory and regulatory non-enlargement requirements* of 37 C.F.R. § 42.121 and 35 U.S.C. § 316. Here, Patent Owner’s proposed substitute claims seek to change the overall dependency and replace all of the features of original claims 16–22.

We acknowledge that a substitute dependent claim that *deletes some limitations of its corresponding original dependent claim while still retaining all limitations of the original independent claim from which the original dependent depends*, would not enlarge the scope of the claims—as such a substitute dependent claim would be narrower than the original independent claim from which the substitutable original dependent depends. *See Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231, 1237–38 (Fed. Cir. 2023); 37 C.F.R. § 1.175; MPEP § 1412.03 (9th ed. Rev. 07.2022, rev. February 2023). Given Patent Owner’s unusual approach, however, in altering the claim hierarchy of certain dependent claims, it is not apparent that Patent Owner has met the burden of establishing that broadening substitute dependent claims *beyond even the scope of the original independent claim (here, claim 15) from which the substitutable original dependents (16–22) depended*, would satisfy the statutory and regulatory non-enlargement requirements of 37 C.F.R. § 42.121 and 35 U.S.C. § 316.

Because Patent Owner has seemingly not met this burden, for purposes of this preliminary guidance and based on the current record, we are unpersuaded that proposed substitute claims 23–29 do not enlarge the scope of the claims in satisfaction of the statutory and regulatory requirements of 37 C.F.R. § 42.121 and 35 U.S.C. § 316.

We acknowledge that Patent Owner has not yet had the opportunity to address our concerns with respect to the non-enlargement requirements of 37 C.F.R. § 42.121 and 35 U.S.C. § 316. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend). *See Notice, passim.*

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**Patent Owner does not appear to have met the burden to establish written description support for proposed substitute claim 29.**

**With respect to proposed substitute claims 23–28, although Patent Owner appears to have met the burden to establish written description support in a *patent application publication* of the application that became the ’257 patent,<sup>1</sup> Patent Owner has not met the burden to establish written description support in *the original disclosure* of the ’257 patent that was filed on December 20, 2013 (as U.S. Patent Application No. 14/136,658 (“the ’658 application”)), or in *the original disclosure* of the parent application of the ’257 patent that was filed on January 23, 2009 (as U.S. Patent Application No. 12/358,905).**

In order to provide guidance to the parties—and in view of the fact that the patent application publication (Ex. 2011) of the ’658 application is presumed to be substantially identical to the originally filed version of the ’658 application—we discuss Patent Owner’s identified support for the proposed substitute claims in Exhibit 2011. We note, however, that a Motion to Amend is required to set forth support “in the original disclosure of the patent,” which Patent Owner has not done. *See Lectrosonics*, Paper 15 at 7–8 (requiring Patent Owner to “set forth written description support in the originally filed disclosure of the subject patent for each proposed substitute claim”); *see also* 37 C.F.R. § 42.121(b)(1).

**Proposed Substitute Claim 23**

Proposed substitute dependent claim 23 adds limitations directed to the positioning of the first pad in a bezel. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 23 depends from original claim 12 (which, in turn, depends from original claim 1) and recites that the electronic device “further compris[es] a touch screen display, wherein

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<sup>1</sup> Patent Owner has set forth support for proposed substitute claims 23–29 in U.S. Patent Application Publication No. 2014/0171776 A1 (Ex. 2011, *see* Mot. 11–13) which is the patent application publication of U.S. Patent Application No. 14/136,658.



the bezel extends around the touch screen display; and wherein the first pad is embedded in an inner surface of the bezel.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 23. *See* Mot. 12 (citing Ex. 2011 ¶¶ 9, 16–18, 24–25, 34, 42, 44–50, 55, Figs. 3, 4B, and 5).

Petitioner, however, contends that Patent Owner fails to establish written description support for the limitation that “the first pad is embedded in an inner surface of the bezel,” and for the limitation that “the bezel extends around the touch screen display.” Opp. 8–9.

Based on the current record, we do not find Petitioner’s contentions persuasive because Petitioner fails to address some of the portions in Ex. 2011 referenced by Patent Owner as written description support for the new limitations in proposed substitute claim 23. *See* Mot. 12. For example, Petitioner asserts that Patent Owner relies on disclosure that “each lead can include a pad or extended area *placed on* the outer or inner surface of an electronic device bezel” but that Patent Owner’s own narrow interpretation of “embedded in” excludes a pad merely being “placed on” a bezel. Opp. 8. But paragraph 47 cited by Patent Owner appears to also describe a lead 472 (where a lead may comprise a pad (*see, e.g.,* Ex. 2011 ¶¶ 34, 42)) that may be embedded in an inner surface of the bezel 460. *See id.* ¶ 47 (“[L]ead 472 of the heart sensor can be positioned against the back surface of bezel 460. Alternatively, lead 472 can be placed within the thickness of bezel 460 (e.g., in a pocket within the bezel wall), but underneath the outer surface of the bezel.”), Fig. 4B; *see also id.* ¶ 44 (providing that leads 322 and 324 of Figure 3 may be “embedded directly in bezel 310”).

Petitioner also asserts that although Patent Owner’s cited portions of Exhibit 2011 disclose the individual features of a bezel and a touch screen, the disclosure does “not indicate whether or how the bezel depicted ‘extends around’ the display.” Opp. 9. But Figures 4B and 5 (of Exhibit 2011) cited by Patent Owner each appear to show a bezel (460 and 510, respectively) that extends around a touch screen display (452 and 502, respectively). *See* Ex. 2011 ¶ 47, Figs. 4B and 5.

Thus, at this stage, Patent Owner appears to have met its burden and we are not persuaded by Petitioner’s assertions that Patent Owner’s proposed substitute claim 23 adds new subject matter. Here, it appears that there is adequate support (in Exhibit 2011) for “a touch screen display, wherein

the bezel extends around the touch screen display; and wherein the first pad is embedded in an inner surface of the bezel” (as claimed in proposed substitute claim 23).

**Proposed Substitute Claim 24**

Proposed substitute dependent claim 24 depends from proposed substitute claim 23 and adds further limitations directed to second and third leads and pads, and the use of the pads by a user. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 24 recites that the electronic device includes “a third lead comprising a third pad that is embedded in the second portion of the enclosure [(recited in claim 1)], wherein the third pad is configured to detect a third electrical signal of the user’s cardiac signal via the user’s skin’s contact with the third pad,” “the second pad [(recited in claim 1)] is configured to detect the second electrical signal of the user’s cardiac signal via the user’s skin’s contact with the second pad,” and “the first pad detects signals through a first hand, and the second and third pads detect signals through a second hand.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 24. *See* Mot. 12 (citing Ex. 2011 ¶¶ 9, 33–34, 42–44, 46–47, 50, 55, Abstract, Figs. 3, 4B, and 5).

Petitioner, however, contends that Patent Owner fails to establish written description support for the features of “a ‘third pad that is embedded in the second portion of the enclosure,’” so as to be “exposed for ‘user’s skin’s contact with the third pad,’” where the “‘second and third pads detect signals through a second hand.’” Opp. 9–10. Further, Petitioner contends “[t]he identified disclosures also do not support two leads *in the same portion* detecting signals from one hand.” *Id.* at 10.

Based on the current record, we do not find Petitioner’s contentions persuasive because Petitioner fails to address some of the portions in Ex. 2011 referenced by Patent Owner as written description support for the claimed limitations. *See* Mot. 12. For example, paragraphs 34, 44, 46, and 47 (of Exhibit 2011) cited by Patent Owner disclose multiple leads that “can include a pad or extended area placed on the outer or inner surface of an electronic device bezel or housing” (¶ 34), “leads 322 and 324 to be embedded directly in bezel” (¶ 44), “several leads . . . placed along different portions of bezel” (¶ 47), leads “positioned on the exterior surface of bezel 310” (¶ 46) or “embedded along the outer surface of bezel

410” (¶ 46), and leads “positioned against the back surface of bezel 460” (¶ 47) or “placed within the thickness of bezel 460 (e.g., in a pocket within the bezel wall), but underneath the outer surface of the bezel” (¶ 47).

Moreover, the disclosure (as reflected in Exhibit 2011) indicates that Figure 3 may include multiple “leads [that] can be integrated in any suitable portion of the electronic device” such as “[l]eads 322 and 324 . . . coupled to sides 312 and 314 of bezel 310” or “[a]lternatively, bezel 310 can include any other suitable number of leads, or any other suitable distribution of leads along bezel 310 and in other portions of electronic device 300.” *See* Ex. 2011 ¶ 42. The disclosure (as reflected in Exhibit 2011) also indicates that “[b]ezel 510 [of the electronic device in Figure 5] can be separated into several electrically isolated segments” whereby “bezel 510 can be separated into any suitable number of electrically isolated segments, and each segment can have any suitable size.” *Id.* ¶¶ 48, 50.

In short, Exhibit 2011 discloses flexibility in the placement of leads/pads in portions of an enclosure, and location of the leads/pads with respect to inner and outer surfaces of the enclosure. Thus, Patent Owner appears to have met its burden, and we are unpersuaded by Petitioner’s arguments that proposed substitute claim 24 adds new subject matter because there is no support for a third pad embedded in the same portion of an enclosure as a second pad and arranged for contact with a user’s skin.

With respect to the limitation in proposed substitute claim 24 reciting that “the first pad detects signals through a first hand, and the second and third pads detect signals through a second hand,” we agree with Petitioner that paragraph 43 (of Exhibit 2011) describes three leads that detect electrical signals through two hands, but not in a way that maps to the recited claim limitation. *See* Opp. 10. In particular, the three leads described in paragraph 43 and expressly shown in Figure 3 are not all *embedded in an enclosure or bezel*; rather, one of the leads (326, which detects signals through one of the two hands) is “embedded in or behind display 302” (*see* Ex. 2011 ¶ 43) such that it cannot map to a “first pad [embedded in an inner surface of the bezel] [that] detects signals through a first hand” (as required by proposed substitute claim 24).

Even though we agree with Petitioner on this point, we are not fully persuaded, at this stage, that claim 24 lacks written description support. Petitioner’s current argument does not fully address paragraph 34 (of Exhibit 2011), which provides that “the size and location of the leads can

be selected to ensure that sufficient contact is made between the user (e.g., the user's hand or finger)"; paragraph 42 (describing Figure 3) provides that "bezel 310 can include any other suitable number of leads, or any other suitable distribution of leads along bezel 310 and in other portions of electronic device 300" with "[t]he size of leads 322 and 324 . . . selected based on any suitable consideration, including for example the different possible positions of a user's hands on the device"; and paragraph 48 provides that "the sizes and distribution of each [conductive lead] segment [in Fig. 5] can be selected based on physiological considerations (e.g., where a user's hand will be positioned on the device, or aligning the segments to contact particular portions of the user's body)." See Ex. 2011 ¶¶ 34, 42, 48. At this stage and based on the current record, it appears that these paragraphs *may imply or suggest proposed claim 24's limitation of* "the first pad [that] detects signals through a first hand, and the second and third pads [that] detect signals through a second hand."

We note, however, that "a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1356 (Fed. Cir. 2010). Patent Owner has the burden to establish written description support, and we will determine whether the above-discussed paragraphs (or others) of Exhibit 2011 (and the original disclosure) provide actual support for "the first pad [embedded in a bezel] [that] detects signals through a first hand, and the second and third pads [embedded in a portion of the disclosure] [that] detect signals through a second hand" (as recited in proposed substitute claim 24) upon a final record.

We will also determine whether and how a limitation that describes how a user *employs* the electronic device (i.e., "the first pad detects signals through a first hand, and the second and third pads detect signals through a second hand") actually limits the claimed electronic device. We will determine after a complete trial and on a full record, whether Patent Owner will have met the burden to establish written description support for the limitation of "the first pad [that] detects signals through a first hand, and the second and third pads [that] detect signals through a second hand" (if this limitation is retained in proposed substitute claim(s)).

#### **Proposed Substitute Claim 25**

Proposed substitute dependent claim 25 depends from proposed substitute claim 24 and adds further limitations directed to the second and third pads. See Mot. App. (Claims Appendix). More particularly, proposed substitute

claim 25 recites that “the second and third pads are adjacent pads” and “an electrically isolating component is inserted between the second and third pads.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 25. *See* Mot. 12 (citing Ex. 2011 ¶¶ 10–11, 47, 50).

Petitioner does not specifically contend Patent Owner fails to establish written description support for the newly recited limitations in proposed substitute claim 25. *See* Opp. 10.

At this stage, we determine that Patent Owner has met its burden for establishing written description support for proposed substitute claim 25 because, for example, paragraphs 10–11 (of Exhibit 2011) cited by Patent Owner disclose an electronic device that “can include several leads” in the device’s enclosure, and “*the leads may be electrically isolated. . . . [and] an electrically isolating component can be inserted between adjacent leads.*” Ex. 2011 ¶¶ 10–11 (emphasis added). Moreover, Figure 5 of Patent Owner’s disclosure (relied upon as support for proposed substitute claim 24, from which claim 25 depends, *see* Mot. 12) is also described as possibly including three leads/conductive segments, some of which may be adjacent and separated by an electrically isolating component. *See* Ex. 2011 ¶¶ 48 (“[b]ezel 510 can be separated into several electrically isolated segments, for example segments 522 and 524. The segments can be electrically isolated using isolating portions 530 and 532” and “[a]lthough FIG. 5 shows bezel 510 broken into two segments having similar sizes . . . bezel 510 can be separated into any suitable number of electrically isolated segments, and each segment can have any suitable size”), 50 (“heart sensor leads can be placed at any other suitable position on the electronic device enclosure” and “if the enclosure is constructed from a bezel supporting a display and a housing forming the exterior surface of the device behind the display, one or more leads can be embedded in or adjacent to the housing”), Fig. 5.

#### **Proposed Substitute Claim 26**

Proposed substitute dependent claim 26 adds limitations directed to the positioning of the first pad in an electrically conductive metal bezel. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 26 depends from original claim 1 and recites that “the first pad is embedded in an inner surface of an electrically conductive metal bezel that forms a portion of an exterior surface of the electronic device” and “the

second pad is exposed on the exterior surface of the electronic device for direct contact from a user.” See *id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 26. See Mot. 13 (citing Ex. 2011 ¶¶ 9, 16–18, 34, 42, 44–50, 55, Figs. 3, 4B, and 5).

Petitioner, however, contends Patent Owner fails to establish written description support for proposed substitute claim 26 for the same reasons discussed above regarding the similar “embedded in” limitation recited in proposed substitute claim 23. Opp. 11.

As discussed *supra* with respect to proposed substitute claim 23, we are not persuaded by Petitioner’s arguments that a first pad embedded in an inner surface of a bezel lacks written description support (as evidenced by Ex. 2011). Moreover, Patent Owner also referenced portions in Exhibit 2011 that provide support for the bezel being an electrically conductive metal bezel (as recited in proposed substitute claim 26). See Mot. 13 (citing Ex. 2011 ¶¶ 9, 34, 44, 47, 48). And Patent Owner references portions in Exhibit 2011 that provide support for an electronic device having a pad embedded in an inner bezel surface and another pad exposed on an exterior surface of the device (as required by proposed substitute claim 26).

#### **Proposed Substitute Claim 27**

Proposed substitute dependent claim 27 adds limitations directed to the processor. See Mot. App. (Claims Appendix). More particularly, proposed substitute claim 27 depends from original claim 1 and recites “the processor [of claim 1] is further configured to extract one or more characteristics of the detected cardiac signal and compare the extracted one or more characteristics with one or more characteristics previously stored in memory that were associated with an authorized user” and “if the extracted one or more characteristics match those of an authorized user, the electronic device authenticates the user.” See *id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 27. See Mot. 13 (citing Ex. 2011 ¶¶ 7, 51). Petitioner does not specifically contend Patent Owner fails to establish written description support for the newly recited limitations in proposed substitute claim 27. See Opp. 7–12.

At this stage, we determine that Patent Owner has met its burden for establishing written description support for proposed substitute claim 27 because, for example, paragraph 7 (of Exhibit 2011) cited by Patent Owner discloses “software or hardware operative to process the output of a cardiac sensor to extract, from the received output, characteristics of the user’s heartbeat, heart rate, or other cardiac signals” such as “one or more characteristic durations associated with the user’s heart rate” or “one or more characteristic amplitudes or amplitude ratios associated with the user’s heart rate.” *See* Ex. 2011 ¶ 7; *see also id.* ¶ 8 (describing operations for comparing, matching, and authenticating). Paragraph 51 (of Exhibit 2011) cited by Patent Owner discloses that “[u]pon receiving the cardiac activity, the electronic device can extract one or more characteristics of the received activity and compare the extracted characteristics with the characteristics previously stored in memory that were associated with authorized users” and “[i]f the extracted characteristics match those of an authorized user, the electronic device can authenticate the identified user.” *See id.* ¶ 51.

**Proposed Substitute Claim 28**

Proposed substitute dependent claim 28 adds limitations directed to the positioning of the second pad, and the spatial relationship between the first and second pads. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 28 depends from original claim 1 and further recites that “the exterior surface of the enclosure comprises an exterior surface of the second portion [in which the second pad is embedded, per base claim 1], wherein the second pad is positioned underneath the exterior surface of the second portion of the enclosure,” “the first and second pads are adjacent pads,” and “an electrically isolating component is inserted between the first and second pads.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 28. *See* Mot. 13 (citing Ex. 2001 ¶¶ 9–11, 33, 47, 50, 55, Figs. 3 and 5). Petitioner does not specifically contend Patent Owner fails to establish written description support for the newly recited limitations in proposed substitute claim 28. *See* Opp. 7–12.

At this stage, we determine that Patent Owner has met its burden for establishing written description support for proposed substitute claim 28 because, the “second pad” limitations in proposed substitute claim 27, which mirror the “first pad” limitations in original claim 1, are supported by at least Figure 4B and paragraphs 11 (“the leads can be positioned

underneath the exterior surface of the enclosure . . . electronic signals can be transmitted through the steel or aluminum enclosure to a silver based lead underneath the enclosure”) and 47 (“[L]ead 472 of the heart sensor can be positioned against the back surface of bezel 460. Alternatively, lead 472 can be placed within the thickness of bezel 460 (e.g., in a pocket within the bezel wall), but underneath the outer surface of the bezel.”) of Exhibit 2011. Moreover, as discussed above regarding proposed substitute claim 25, paragraphs 10–11 (of Exhibit 2011) cited by Patent Owner disclose the feature of an electrically isolating component inserted between two adjacent pads, which is also recited in proposed substitute claim 28.

**Proposed Substitute Claim 29**

Proposed substitute dependent claim 29 depends from proposed substitute claim 28 and adds further limitations directed to the enclosure and the use of the pads by a user. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 29 recites that “the first pad detects signals from a first hand and the second pad detects signals from a second hand,” “the first and second portions of the enclosure are located on a same face of the electronic device,” and “the first and second portions of the enclosure each comprise a metallic conductive portion exposed for direct user contact.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 29. *See* Mot. 13 (citing Ex. 2001 ¶¶ 6, 9–11, 33, 43, 50, 55, Figs. 3 and 5).

Petitioner, however, contends that Patent Owner fails to establish written description support for the features of “pads being on the ‘same face of the electronic device’” for “‘detecting signals’ from ‘a first hand’ and a ‘second hand’ ‘on a same face of the electronic device.’” Opp. 11. Further, Petitioner contends Patent Owner fails to establish written description support for the limitation that “the first and second portions of the enclosure each comprise a metallic conductive portion exposed for direct user contact.” *Id.* at 12.

With respect to the first and second enclosure portions (which includes the first and second pads, as per claim 1) being located “on a same face of the electronic device,” we agree with Petitioner’s assessment that Patent Owner “has failed to identify any disclosure in its application that uses the



term ‘face’ or that illustrates pads being on the ‘same face of the electronic device.’” Opp. 11.

Figure 5 cited by Patent Owner in support appears to show conductive segments/leads 522, 524 that are partially visible when viewing the frontal face of the device. *See* Ex. 2001, Fig. 5. Whether this positioning of leads in the enclosure qualifies as enclosure portions and leads that are “located *on a same face* of the electronic device” (as claimed by claim 29), is unclear—at least because it appears (from Figure 5) that the bulk of leads 522 and 524 actually extend on *opposite vertical sides* of the device (i.e., along left and right vertical sides of the device that are perpendicular to the frontal face of the device in Figure 5). Moreover, Patent Owner’s citation to paragraphs 6, 9–11, 33, 43, 50, 55, and Figures 3 and 5 on page 13 of the Motion does not explain how or where, in these paragraphs or figures, is there a disclosure of enclosure portions (and embedded leads) “located on a same face of the electronic device” (as recited in proposed substitute claim 29).

Patent Owner has the burden to establish written description support for “first and second portions of the enclosure [holding the first and second pads] are located on a same face of the electronic device” as claimed in proposed substitute claim 29. On the current record, the evidence of written description support is ambiguous at best. Thus, Patent Owner has not met this burden. For purposes of this preliminary guidance and based on the current record, we agree with Petitioner that proposed substitute claim 29 contains new matter, for the reasons discussed *supra*. We acknowledge that Patent Owner has not yet had the opportunity to respond. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend) in this proceeding. *See* Notice, *passim*.

With respect to the feature in proposed substitute claim 29 that requires different hands to use the two adjacent first and second pads (i.e., “the first pad detects signals from a first hand and the second pad detects signals from a second hand”), we observe that adjacent pads have written description support in Exhibit 2011 (as discussed *supra* with respect to proposed substitute claims 25 and 28). We also observe that, although paragraph 43 (describing Figure 3) of Exhibit 2011 mentions only *one hand* using the leads embedded in the device’s bezel, paragraphs 34, 42, and 48 of Exhibit 2011 *may imply or suggest* that enclosure-set pads are touched *by different hands* (as discussed *supra* with respect to proposed

substitute claim 24). But as we noted for proposed substitute claim 24, “a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1356 (Fed. Cir. 2010).

Patent Owner has the burden to establish written description support, and we will determine whether Patent Owner adequately addresses whether paragraphs 34, 42, and 48 (or others) of Exhibit 2011 (and of the original disclosure) provide actual support for adjacent first and second pads whereby “the first pad detects signals from a first hand and the second pad detects signals from a second hand” as recited in proposed substitute claim 29. We are also concerned with how a limitation that describes how the user employs the pads (i.e., “the first pad detects signals from a first hand and the second pad detects signals from a second hand”) actually limits the claimed electronic device. We will determine after a complete trial and on a full record, whether Patent Owner will have met the burden to establish written description support for this limitation (if this limitation is retained in proposed substitute claim(s)).

Finally, with respect to the feature in proposed substitute claim 29 that requires that “the first and second portions of the enclosure each comprise a metallic conductive portion exposed for direct user contact,” we are not persuaded by Petitioner’s argument that Patent Owner has “disclaimed” this subject matter. *See* Opp. 12. To the extent Petitioner here refers to prosecution disclaimer, we see no disclaimer that “is ‘both clear and unmistakable to one of ordinary skill in the art.’” *Tech. Props. Ltd. v. Huawei Techs. Co.*, 849 F.3d 1349, 1357 (Fed. Cir. 2017). Petitioner has pointed to the ’257 patent applicant’s discussion during prosecution of why certain prior art does not disclose certain features, and an Examiner’s rejection based on different prior art, but has not specifically explained which statements on behalf of the applicant evidence disclaimer of which specific subject matter. *See* Opp. 12; Ex. 1002, 209–210, 300–301. In any case, we see little relevance for the prosecution disclaimer doctrine here, where the inquiry is whether the original disclosure provides written description support for a new claim in the first instance.

Nevertheless, for the reasons discussed above, at this stage, we determine that Patent Owner has not met its burden of establishing written description support for proposed substitute claim 29, specifically, with respect to the “same face” feature.

## B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,<sup>2</sup> it appears that Petitioner (or the record) has not shown a reasonable likelihood that proposed substitute claims 23–26 are unpatentable, but Petitioner has shown a reasonable likelihood that proposed substitute claims 27–29 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

### **I. Indefiniteness**

**No, as to proposed substitute claims 25, 28, and 29.**

Petitioner argues that the recitation of the term “adjacent” renders each of proposed substitute claims 25, 28, and 29 indefinite. Specifically, Petitioner asserts that “[t]erms of degree are indefinite absent guidance as to the scope of the claims,” and argues that “the specification and prosecution history fail to provide any guidance as to scope of the term ‘adjacent’ in substitute claims 25, 28, and 29.” Opp. 25 (citing *Sonix Tech. Co. v. Publ’ns Int’l, Ltd.*, 844 F.3d 1370, 1377 (Fed. Cir. 2017)).

Petitioner’s argument has not established a reasonable likelihood that proposed substitute claims 25, 28, and 29 are indefinite.

Claims must “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). There are several mentions of the term “adjacent” in the ’257 patent that are pertinent to the indefiniteness analysis: “an electrically isolating component can be inserted between adjacent leads” (Ex. 1001, 2:53–55); “the distance along the enclosure between adjacent leads can be sufficient to isolate the leads” (*id.*, 2:57–59); “[b]y placing several leads at substantially larger distances apart along the electronic device enclosure than the thickness of the enclosure,

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<sup>2</sup> We express no view on the patentability of original claims 1–22 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

electronic signals can be transmitted through the steel or aluminum enclosure to a silver based lead underneath the enclosure, but not along the surface of the enclosure to cause adjacent leads to short” (*id.* at 3:7–13); “the distance between adjacent leads can be sufficiently large (e.g., substantially larger than the thickness of bezel 460) that different leads of bezel 460 cannot detect the same electrical signal” (*id.* at 9:53–57). The ’257 patent discloses that adjacent leads can have varying distance between them, and, in an embodiment, this distance may be large enough so as to prevent transmission of electrical signals between them. One of ordinary skill in the art would realize that in this disclosure the term “adjacent” does not specify any particular distance, but rather describes the relationship between the leads for which the distance between them may vary. That is, the leads discussed in the identified disclosure are those that are next to each other, separated by some variable distance.

Accordingly, in the recitation of “adjacent pads” in the proposed substitute claims (where the ’257 patent describes that leads may include pads (Ex. 1001, 8:20)), the term “adjacent” is not a term of degree, but rather one that relates the leads/pads to each other. The fact that the proposed substitute claims do not specify some maximum distance between pads (*see* Opp. 25 (“neither the specification nor prosecution history provide any examples of when lead are *no longer* ‘adjacent’”)) is inapposite. We need not seek guidance on the scope of a distance parameter that is not even recited in the claims. Proposed substitute claim 25 recites “an electrically isolating component is inserted between the second and third pads,” and proposed substitute claim 28 (and proposed substitute claim 29 based on its dependency on proposed substitute claim 28) recites that “an electrically isolating component is inserted between the first and second pads.” So, the proposed substitute claims at issue appear to capture a different embodiment than that which relies on distance to electrically isolate leads/pads. *See, e.g.*, Ex. 1001, 2:53–59 (“In some embodiments, an electrically isolating component can be inserted between adjacent leads. *Alternatively, . . .* the distance along the enclosure between adjacent leads can be sufficient to isolate the leads.”) (emphasis added).

Therefore, Petitioner has failed to show there is a reasonable likelihood that one of ordinary skill in the art would not have been able, with reasonable certainty, to ascertain the scope of the term “adjacent” as it is used in the proposed substitute claims.

Accordingly, at this stage of the proceeding, on the record before us, Petitioner has not shown a reasonable likelihood that proposed substitute claims 25, 28, and 29 are indefinite. Likewise, based on the record before us, there is no indication that any of claims 23–29 are indefinite.

## II. Obviousness

**No, as to proposed substitute claims 23–26.**

**Yes, as to proposed substitute claims 27–29.**

Petitioner has asserted the following obviousness challenges against the following proposed substitute claims:

Ground asserting Markel (Ex. 1005)<sup>3</sup> (original Ground 1 (*see* Pet. 1)) against proposed substitute claims 23–29.

Ground asserting Markel and Nissilä (Ex. 1006)<sup>4</sup> (original Ground 2 (*see* Pet. 1)) against proposed substitute claims 23–29.

Ground asserting Markel, Nissilä, and Engstrom (Ex. 1020)<sup>5</sup> against proposed substitute claims 24, 25, and 27–29.

*See* Opp. 12.

On this record, it appears that Petitioner has not shown a reasonable likelihood that proposed substitute claims 23–26, are unpatentable as obvious based on the grounds identified above. Petitioner has shown, however, a reasonable likelihood that proposed substitute claims 27–29 are unpatentable based on the Markel, Nissilä, and Engstrom ground.

### **Proposed Substitute Claims 23–26**

**Proposed substitute dependent claim 23** adds limitations directed to the positioning of the first pad in a bezel. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 23 depends from original claim 12 (which, in turn, depends from original claim 1) and recites that the electronic device “further compris[es] a touch screen display, wherein the bezel extends around the touch screen display; and wherein the first pad is embedded in an inner surface of the bezel.” *Id.*

<sup>3</sup> US 2007/0021677 A1, published Jan. 25, 2007.

<sup>4</sup> US 6,775,566 B2, issued Aug. 10, 2004.

<sup>5</sup> US 2008/0113650 A1, issued May 15, 2008.

Petitioner contends claim 23 is obvious over Markel, or Markel in combination with Nissilä. Opp. 15–18. In particular, Petitioner relies on a Markel for teaching “a touch screen display” and for rendering obvious a bezel that “extends around the touch screen display.” Opp. 17. For a first pad “embedded in an inner surface of the bezel, Petitioner points to its contentions in Petition that “*Markel* alone and/or *Nissilä* renders obvious a first pad that is embedded in a bezel *and* underneath the exterior surface of the bezel.” *Id.* Petitioner then concludes that “to be both embedded in and underneath the bezel, it would have been obvious to a POSITA that the first pad is embedded in an inner surface of the bezel.” *Id.*

At this stage, we disagree with Petitioner’s contentions regarding the feature of a first pad that is “embedded in an inner surface of the bezel” recited in proposed substitute claim 23. Petitioner does not adequately identify teachings in Markel or Nissilä of a pad “embedded in an inner surface of the bezel.” *See* Opp. 17–18. Further, Petitioner improperly incorporates arguments made in prior briefing without explanation as to how those arguments apply to the modified claims. *See id.*; *see also* 37 C.F.R. § 42.6(a)(3) (“arguments must not be incorporated by reference from one document into another document”).

We are not persuaded that even if the combination of Markel and Nissilä renders obvious a pad “embedded in a bezel *and* underneath the exterior surface of the bezel,” it necessarily follows that it would have been obvious to embed the pad in an inner surface of the bezel. *See* Opp. 17. The original claim limitations Petitioner refers to here—“a first pad that is embedded in a first portion of the enclosure . . . wherein the first pad is positioned *underneath the exterior surface* of the first portion” (claim 1 (emphasis added)); “wherein the first portion of the enclosure is a bezel” (claim 12)—are different limitations than the newly recited limitation of a first pad “embedded in an *inner surface* of the bezel.” Petitioner has not explained adequately how this new limitation would have been obvious. In that respect, for purposes of this Preliminary Guidance, we are not persuaded that Petitioner’s argument, or Dr. Berger’s testimony, necessarily follows, i.e., “to be embedded in and underneath the bezel, it would have been obvious to a POSITA that the first pad is embedded in an inner surface of the bezel.” *See* Opp. 17 (citing Ex. 1021 ¶ 62).

We further question Petitioner’s rationale for modifying the Markel-Nissilä combination such that the first pad is embedded in an inner surface of the bezel—“to simultaneously create an electrically conductive

connection between the pad and the outer surface of the enclosure while ensuring that the pad [is] accessible to the wiring inside the enclosure that is necessary to complete the electrical circuit” (Opp. 18). The Petition asserts that these objectives are already achieved by Markel alone, or the original Markel-Nissilä combination. *See* Pet. 16–21, 28–29, 71–73.

Thus, based on the current record, Petitioner does not appear to have shown a reasonable likelihood that Markel and Nissilä disclose or suggest a “first pad [that] is embedded in an inner surface of the bezel,” as recited in proposed substitute claim 23. Petitioner also does not appear to have shown a reasonable likelihood that Markel and Nissilä disclose or suggest all limitations of **proposed substitute claims 24 and 25**, which depend from proposed substitute claim 23 and therefore require the “first pad . . . embedded in an inner surface of the bezel” recited in proposed substitute claim 23.

With respect to other limitations in proposed substitute claims 24 and 25 (i.e., second and third adjacent pads that contact the user’s skin/hand, and electrically isolating component between the pads), it appears that Petitioner has sufficiently shown that Markel, Nissilä, and/or Engstrom disclose or suggest these other limitations (*see* Opp. 18–21).

Thus, based on the current record, Petitioner does not appear to have shown a reasonable likelihood that Markel alone, Markel and Nissilä, or Markel, Nissilä, and Engstrom disclose or suggest all the limitations recited in proposed substitute claims 23, 24, and 25.

**Proposed substitute dependent claim 26** adds limitations directed to the positioning of the first pad in an electrically conductive metal bezel. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 26 depends from original claim 1 and recites that “the first pad is embedded in an inner surface of an electrically conductive metal bezel that forms a portion of an exterior surface of the electronic device” and “the second pad is exposed on the exterior surface of the electronic device for direct contact from a user.” *See id.*

With respect to claim 26’s “first pad [that] is embedded in an inner surface of an electrically conductive metal bezel that forms a portion of an exterior surface of the electronic device”—which is similar to the limitation of a “first pad [that] is embedded in an inner surface of the bezel” recited in proposed substitute claim 23—Petitioner’s obviousness analysis relies upon its analysis of proposed substitute claim 23. As discussed *supra* with

respect to proposed substitute claim 23, at this stage and based on the current record, we are not persuaded by Petitioner's assertions that Markel alone, or Markel in combination with Nissilä disclose or suggest an electrical pad embedded in an inner surface of a bezel.

Thus, based on the current record, Petitioner does not appear to have shown a reasonable likelihood that Markel alone, Markel and Nissilä, or Markel, Nissilä, and Engstrom disclose or suggest all the limitations recited in proposed substitute claim 26.

**Proposed Substitute Claims 27**

**Proposed substitute dependent claim 27** adds limitations directed to the processor. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 27 depends from original claim 1 and recites “the processor [of claim 1] is further configured to extract one or more characteristics of the detected cardiac signal and compare the extracted one or more characteristics with one or more characteristics previously stored in memory that were associated with an authorized user” and “if the extracted one or more characteristics match those of an authorized user, the electronic device authenticates the user.” *See id.*

Petitioner contends proposed substitute claim 27 is obvious over Markel, Nissilä, and/or Engstrom. *Opp.* 22–23. In particular, Petitioner relies on Engstrom's teachings in paragraphs 27, 31, and 56 for the newly recited features in proposed substitute claim 27. At this stage, it appears Petitioner has sufficiently shown Engstrom teaches these features. For example, Engstrom describes “capturing of a heart beat profile of the user, and its saving as a reference for subsequent analysis of a real time captured heart beat profile of the user to authenticate the user.” *Ex.* 1020 ¶ 31.

Thus, based on the current record, Petitioner appears to have shown a reasonable likelihood that the ground based on the combination of Markel, Nissilä, and Engstrom teaches or renders obvious the newly recited features of proposed substitute claim 27. We acknowledge that Patent Owner has not yet had the opportunity to respond to this ground. Patent Owner will have the opportunity to do so in its Reply to Petitioner's Opposition (or in a revised motion to amend) in this proceeding. *See* Notice, *passim*.

To the extent Petitioner also contends Markel alone renders obvious proposed substitute claim 27 (*see* *Opp.* 22–23), we disagree. Petitioner



cites paragraph 97 of Markel (*id.*), which provides that the “cardiac information acquisition module 1710 may . . . be adapted to identify the user of the MCD 1700” and “such identification (or authentication) may be utilized in an exemplary scenario where a variety of users may be utilizing the MCD 1700,” whereby “the acquisition module 1710 may be adapted to acquire cardiac information for a plurality of different users and to segment such information according to user identity.” Ex. 1005 ¶ 97. Paragraph 97 therefore provides that a user may be identified or authenticated, but the paragraph does not disclose *how* the user is authenticated or identified, and more particularly, does not disclose that *the user’s detected cardiac signal/information is used to authenticate or identify the user* (as in proposed substitute claim 27). Rather, Markel states that identifying a user allows cardiac information acquired from that user to be “segment[ed] . . . according to user identity” (*id.* ¶ 97), to be “store[d] . . . in the memory 1740 (e.g., indexed by user identification)” and “access[ed] . . . from the memory 1740” (*id.* ¶ 98), and to be “analyze[d] . . . by, at least in part, performing spectral analysis on a cardiac signal” and “determining a difference between a current cardiac signal at least one previous cardiac signal, and determining the existence of a cardiac pathology based, at least in part, on spectral analysis of the determined difference” (*id.* ¶ 130).

**Proposed Substitute Claims 28 and 29**

Proposed substitute dependent claim 28 adds limitations directed to the positioning of the second pad, and the spatial relationship between the first and second pads. *See* Mot. App. (Claims Appendix). More particularly, proposed substitute claim 28 depends from original claim 1 and further recites that “the exterior surface of the enclosure comprises an exterior surface of the second portion [in which the second pad is embedded, per base claim 1], wherein the second pad is positioned underneath the exterior surface of the second portion of the enclosure,” “the first and second pads are adjacent pads,” and “an electrically isolating component is inserted between the first and second pads.” *See id.*

We determined in the Institution Decision that there was a reasonable likelihood that the combination of Markel and Nissilä rendered obvious the claim 1 features of “wherein an exterior surface of the enclosure comprises an exterior surface of the first portion, wherein the first pad is positioned underneath the exterior surface of the first portion.” *See* Inst. Dec. 38–42. For similar reasons, at this juncture there appears to be a

reasonable likelihood that the Markel-Nissilä combination also renders obvious the similar newly recited limitations as they pertain to the second pad, namely, “wherein the exterior surface of the enclosure comprises an exterior surface of the second portion, wherein the second pad is positioned underneath the exterior surface of the second portion of the enclosure” (proposed substitute claim 28).

We acknowledge that Patent Owner has not yet had the opportunity to respond to Petitioner’s contentions regarding the teachings of Markel and Nissilä with respect to a second pad, in addition to the first pad, placed “underneath the exterior surface” of the respective second portion of the enclosure. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend) in this proceeding. *See Notice, passim.*

For completeness, we add that, with respect to other limitations recited in proposed substitute claims 28 and 29 (i.e., adjacent pads, electrically isolating component between pads, first and second pads that contact different hands, enclosure portions located on a same face of the electronic device, and enclosure portions comprising metallic conductive portions), it appears that Petitioner has sufficiently shown that Markel, Nissilä, and/or Engstrom disclose or suggest these other limitations (*see Opp. 20–21, and 24–25*).

### III. CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner’s first option under the Board’s pilot program. Notice, 84 Fed. Reg. at 9,497. Patent Owner has an additional option under the Board’s pilot program to file a revised MTA by DUE DATE 3. *See Scheduling Order.*

In addition to those two options under the Board’s pilot program, 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*

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*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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