

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AROMA360, LLC,

Petitioner,

v.

AIR ESSSENTIALS, INC.,

Patent Owner.

Case IPR 2025-00705
U.S. Patent No. 9,527,094

PATENT OWNER'S
CONTINGENT MOTION TO AMEND

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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I. INTRODUCTION

Patent Owner, Air Essentials, Inc., respectfully moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to conditionally amend challenged independent claim 7 of the '094 patent. In the event the Board finds all of claims 7-9 and 11 (“the challenged MTA claims”) of the '094 Patent unpatentable, Patent Owner respectfully requests that the Board grant this Motion to Amend (MTA) with respect to the corresponding proposed substitute claim. Accordingly, this Motion to Amend is contingent upon a determination of unpatentability of the challenged MTA claims. Patent Owner also requests Preliminary Guidance.

As shown below, this motion and the substitute claim meets all requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. *See also Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 at 4 (PTAB Feb. 25, 2019) (precedential). Specifically, the substitute claim is i) presented in a claim listing; ii) reasonable in number; iii) responsive to a ground of unpatentability involved in the trial; iv) non-broadening; and v) supported by the written description. *Id.* at 4-8. Moreover, the motion confirms (hereby and as explained below) Patent Owner’s belief that the proposed substitute claim is patentable over all known prior art, whether alone or in combination. Having met its burdens, Patent Owner respectfully submits that it is entitled to the contingent substitute claim unless Petitioner “prove[s] all propositions

of unpatentability.” *Aqua Products v. Matal*, 872 F.3d 1290, 1310 (Fed. Cir. 2017)(en banc).

II. STATEMENT OF RELIEF REQUESTED

Patent Owner elects to participate in the pilot program published in the Notice Regarding a New Pilot Program to Amend Practice and Procedure in Trial Proceedings, 84 Fed. Reg. 9497 (March 15, 2019)(extended first in 86 Fed. Reg. 51656 and again in 87 Fed. Reg. 60134). Accordingly, Patent Owner respectfully requests that the Board issue preliminary, non-binding guidance on this Contingent Motion to Amend.

Furthermore, this Motion is Contingent upon the Board’s finding that claims 7-9 and 11 of the ‘094 Patent are found unpatentable. In such an event, Patent Owner moves to substitute independent claim 7 with its substitute claim presented herein.

III. THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. § 42.121(a)

a. The Substitute Claims are Non-Broadening

As shown in the attached appendix, the proposed substitute claim only adds non-broadening limitations which do not enlarge the scope of the corresponding original claim. On the contrary, the newly included recitation further specifies the scope of the original claim.

b. The Substitute Claims are Responsive to a Ground of Unpatentability

Patent Owner does not concede that the currently issued claims of the '094 Patent are rendered obvious by the asserted prior art. The proposed amendments further amplify distinctions between the asserted references and the '094 Patent.

Petitioner has alleged that Claims 7-9 and 11 are unpatentable under 35 U.S.C. § 103 on the following grounds:

Ground 1: Sevy

Ground 2: Sevy in view of Zeng

Ground 3: Goubet

Ground 4: Goubet in view of Kaiser

Ground 5: Gao

Ground 6: Gao in view of Zeng

This Contingent Motion proposed amendments to independent claim 7 that are responsive to Petitioner's grounds in the instant IPR in that they further clarify the structure and function of the silencer assembly and its components. None of the asserted references, individually or in combination, disclose or render obvious a silencer assembly that implements the recited claim features.

Moreover, it is not necessary "that every word added to or removed from a claim in a motion to amend must be solely for the purpose of overcoming an

instituted ground.” *Veeam Software Corp. v. Veritas Techs., LLC*, IPR2014-00090, Paper 48 at 28 (Jul. 17, 2017). Rather, the question is whether “the proposed claim as a whole is ‘responsive to a ground of unpatentability involved in the trial.’” *Id.* at 29. Beyond that threshold, Patent Owner may add other amendments that “serve[] the public interest by ensuring issuance of valid and clear patents,” including “additional limitations to address potential ... § 112 issues.” *Id.*

c. The Substitute Claims are Reasonable in Number

Patent Owner proposes only one substitute claim per 37 C.F.R. § 42.121(a)(3).

IV. THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. § 42.121(b)

a. The Substitute Claims are Presented in a Claim Listing

As required by 37 C.F.R. § 42.121(b), this motion is accompanied by an appendix that lists the proposed substitute claims and clearly shows the proposed amendments to the claims in light of the corresponding original claims.

b. The Substitute Claims are Supported by the Original and Earlier Filed Disclosures for Each Claim

Pursuant to 37 C.F.R. § 42.121(b)(1) and (b)(2), the table below demonstrates that each substitute claim is supported by each earlier-filed disclosure as to which the benefit of the filing date is sought.¹ The ‘094 Patent issued from U.S. Application

¹ The citations to the disclosure are not considered exhaustive nor meant to limit the meaning or construction of the corresponding claim terms.

Serial No. 14/844,650, and is a continuation of U.S. Application Serial No. 13/838,364 (Exhibit 1005), which in turn claimed the benefit of U.S. Provisional Application Serial No. 61/694,500 (Exhibit 1006).

New Claim Recitation	Exemplary Support from 61/694,500	Exemplary Support from 13/838,364
a silencer assembly having a <u>silencer chamber</u> , silencer inlet, a silencer outlet, and a baffle, <u>said baffle being disposed within said silencer chamber</u> ,	Ex. 1006, page 30, lines 4-5; Ex. 1006, pages 13-14, Figures 1-2	Ex. 1005, page 18, lines 16-18; Ex. 1005, pages 28-29, Figures 1-2
wherein said baffle partially restricts <u>disrupts</u> movement of the fluid dispersion through said silencer chamber from said silencer inlet to said silencer outlet, thereby dampening sound waves generated during operation of said fluid dispersion assembly[[.]]; <u>and</u>	Ex. 1006, page 30, lines 6-9; Ex. 1006, pages 13-14, Figures 1-2	Ex. 1005, page 18, lines 18-20; Ex. 1005, pages 28-29, Figures 1-2
“ <u>wherein said silencer inlet is disposed relative to the baffle to direct the flow of fluid towards the baffle so as to maximize said disruption of flow.</u> ”	Ex. 1006, page 30, lines 9-13; Ex. 1006, pages 13-14, Figures 1-2	Ex. 1005, page 18, lines 21-25; Ex. 1005, pages 28-29, Figures 1-2

V. PATENTABILITY OVER THE PRIOR ART

In light of the Federal Circuit’s en banc decision in *Aqua Products v. Matal*, 872 F.3d 1290, 1296, 1310 (Fed. Cir. 2017), Patent Owner need not prove the

patentability of the proposed substitute claims. And as the Patent Office has acknowledged before the Federal Circuit, and the Federal Circuit has held, Patent Owner adequately meets its duty of candor by simply confirming its belief that the proposed substitute claim is patentable over all known prior art, alone or combined. *Nike Inc. v. Adidas AG*, 812 F.3d 1326, 1350 (Fed. Cir. 2016) (overruled en banc on other grounds). Patent Owner so confirms its belief that the proposed substitute claim is patentable over all known prior art, alone or combined.

VI. CONCLUSION

Patent Owner respectfully requests the Board's preliminary guidance as to this Motion, and further requests that, to the extent that claims 7-9 and 11 are deemed unpatentable, the Board substitute the proposed substitute claim.

Dated: January 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Contingent Motion to Amend has been served in its entirety on January 15, 2026, by causing it and accompanying documents (if any) to be electronically mailed to the following attorneys of record for the Petitioner:

Dated: January 15, 2026

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CLAIM APPENDIX

Underlining and strikethrough text show the modifications to the original claim being made in the corresponding substitute claim.

21. (Substitute for independent claim 7, if found unpatentable)

A fluid dispersion assembly is operatively interconnected to a container of an operative fluid and a compressed air source to generate and discharge a fluid dispersion into a surrounding airspace, said fluid dispersion assembly comprising:

a diffusion unit at least partially defining a diffusion chamber,

a discharge port disposed in fluid communication between said diffusion chamber and the surrounding airspace,

a diffusion assembly disposed in an operative engagement with said diffusion unit, wherein said diffusion assembly comprises an atomizer assembly, and

a silencer assembly having a silencer chamber, silencer inlet, a silencer outlet, and a baffle, said baffle being disposed within said silencer chamber, wherein said baffle partially ~~restricts~~disrupts movement of the fluid dispersion through said silencer chamber from said silencer inlet to said silencer outlet, thereby dampening sound waves generated during operation of said fluid dispersion assembly[[]]; and

wherein said silencer inlet is disposed relative to the baffle to direct the flow of fluid towards the baffle so as to maximize said disruption of flow.