
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GCE GAS CONTROL EQUIPMENT INC.,

Petitioner,

v.

VBOX, INC.,

Patent Owner.

Inter Partes Review No. IPR2023-00326
Patent No. 11,389,614

PATENT OWNER'S SUR-REPLY

TABLE OF CONTENTS

TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES	ii
I. <i>DEANE</i>	1
II. § 325(d)	4
CERTIFICATE OF COMPLIANCE.....	6

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469 (PTAB Feb. 13, 2020)	4
<i>Amphenol Corp. v. PPC Broadband, Inc.</i> , IPR2022-00721, Paper No. 11 (PTAB Oct. 26, 2022)	5
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG</i> , IPR2017-01586 (PTAB Dec. 15, 2017)	5
<i>Edge Endo, LLC v. Michael Scianamblo</i> , IPR2018-01320 (PTAB Jan. 14, 2019)	4
<i>Exactech, Inc. v. Zimmer, Inc.</i> , IPR2022-00836, Paper 7 (PTAB Nov. 8, 2022)	5
<i>Google LLC v. Kewazinga Corp.</i> , IPR2021-00525, Paper 14 (August 24, 2021)	3
 Other Authorities	 Page(s)
35 U.S.C. § 325(d)	4
PTAB Consolidated Trial Practice Guide (Nov. 2019), available at https://www.uspto.gov/TrialPracticeGuideConsolidated	3

I. DEANE

Petitioner has a problem. Petitioner drew a green line through the feed tube 608 in *Deane*'s Figure 6 in an effort to demonstrate that *Deane* meets the non-contact limitations, which are in each independent claim. However, there is adsorbent material where Petitioner drew its green line. See Petition (Paper 1) at page 49. As a result, fluid flowing along Petitioner's green line will contact adsorbent, contrary to the non-contact limitations. See, e.g., POPR (Paper 6) at pages 29-35.

Petitioner responds to this argument by ignoring its own annotations to *Deane*'s Figure 6, and brazenly arguing that Figure 6 “does not show adsorbent 612 extending into feed tube 608.” See Reply (Paper 7) at page 2. Yet, Figure 6 does show adsorbent in the feed tube, and Petitioner's green line passes directly through adsorbent. See POPR at pages 29-35. Nothing else in *Deane* teaches that the feed tube lacks adsorbent. *Id.* Therefore, Petitioner has failed to establish that *Deane* teaches, expressly or inherently, the non-contact limitations. *Id.*

Not only that, but Petitioner submitted an article authored by its own Declarant which proves that two bed systems, including a main bed and a pre-bed, were known and beneficial. See Ex. 1068 at pages 126-129. Therefore, it would make sense for *Deane*'s feed tube to be providing a pre-bed. See POPR at page 33. So, not only has Petitioner failed to establish express or inherent disclosure of the

non-contact limitations in *Deane*, but Petitioner's own evidence provides a plausible explanation as to why *Deane* is showing adsorbent in its feed tube.

Petitioner does not address the possibility of a pre-bed in its Reply. Petitioner's silence concedes that *Deane*'s feed tube could have a pre-bed.

In a belated effort to establish that *Deane* does not have adsorbent material in its feed tube, Petitioner now argues that *Deane* refers to its fluid as "feed gas" after it passes through the feed tube, which, according to Petitioner, means that the gas has yet to pass through any adsorbent. Reply at page 2. Petitioner cites no evidence that "feed gas" is strictly defined as gas that has not contacted any adsorbent. Petitioner also overlooks that *Deane* could include a main bed and a pre-bed. In two bed systems, "feed gas" refers to gas that is fed to both beds. See Ex. 1068 at page 127-129 ("feed air" flows relative to pre-bed and main bed in Figures 6.10(b)(1), (5); describing "feed air" as being "[a]ir at near-ambient pressure [that] is passed through the prebed and main bed...").

Petitioner believes Figure 7A of *Deane* proves that adsorbent does not extend into the feed tube. See Reply at page 2. But Figure 7A is highly schematic and does not show adsorbent at all. See POPR at page 32. Figure 7A does not prove that the feed tube does not include a pre-bed.

Petitioner also now argues that the absence of retaining disks in *Deane*'s feed tube proves there is no adsorbent in the feed tube. See Reply at page 2. However,

Petitioner submits no evidence that adsorbent beds always require a retaining disk, especially considering the feed tube could include a pre-bed, which may be held in place differently than a standard, main bed.

Petitioner eventually appears to acknowledge that Figure 6 could be showing adsorbent in the feed tube. But, per Petitioner, if Figure 6 does show adsorbent in the feed tube, then Figure 6 is inaccurate. *See* Reply at pages 2, 3. The fact is, *Deane's* Figure 6 could have easily been drawn without adsorbent in the feed tube. In truth, Petitioner only half-heartedly alleges that *Deane's* Figure 6 is unreliable because Petitioner extensively relies on *Deane's* drawings in an attempt to teach various other claim features. By and large, Petitioner needs *Deane's* drawings to be credible. It is telling that Petitioner, only now, seeks to distance itself from Figure 6.

Petitioner believes its Declarant's testimony "carries more weight than PO's attorney argument." *See* Reply at page 3. Petitioner's Declarant, however, never addressed why *Deane's* Figure 6 shows adsorbent in its feed tube or why he drew a green line contacting that adsorbent. Petitioner's Declarant's testimony is detached from the actual disclosure of *Deane*. *See Google LLC v. Kewazinga Corp.*, IPR2021-00525, Paper 14, pages 19-20 (August 24, 2021) (denying institution, partially because petitioner used expert as a substitute for disclosure in the prior art) *citing* PTAB Consolidated Trial Practice Guide (Nov. 2019), page 36, available at <https://www.uspto.gov/TrialPracticeGuideConsolidated> ("Expert testimony...

cannot take the place of a disclosure in a prior art reference, when that disclosure is required as part of the unpatentability analysis.”). Unlike Petitioner’s Declarant, Patent Owner has addressed the glaring discrepancy between what Petitioner alleges is taught by *Deane* and what is actually shown in *Deane*’s Figure 6. Patent Owner has also demonstrated, without any rebuttal on Reply, that Petitioner’s own evidence explains why *Deane* shows adsorbent in the feed tube.

II. § 325(d)

There are 22 different references to *Deane* listed in the “References Cited” section of the ’614 Patent. *Deane* was cited and relied on by the Office pervasively during prosecution of the family of the ’614 Patent. See POPR at page 12 (table). Petitioner emphasizes that the ’614 Patent was not rejected over *Deane*, but § 325(d) applies to either “the same prior art or arguments.” See POPR at pages 40, 41, citing § 325(d) and *Edge Endo, LLC v. Michael Scianamblo*, IPR2018-01320, Paper 15 at 12 (PTAB Jan. 14, 2019). Since the same art was before the Examiner, the first *Advanced Bionics* prong is met. See POPR at pages 39-41, citing *Advanced Bionics*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

Regarding the second prong of *Advanced Bionics*, it is Petitioner’s burden to establish that the Office made a material error. *Id.* At a minimum, Petitioner has not adequately demonstrated that the non-contact limitations are taught by *Deane*. Petitioner’s Reply is a classic case of improper burden shifting. See Reply at page 3

(“PO has not identified even one difference between *Deane* and the challenged claims...”).

The cases introduced on Reply are readily distinguished. Unlike here, in *Amphenol* the Board instituted because a patent owner did not specifically identify any claim features that distinguished a previous ground of rejection. *Amphenol Corp. v. PPC Broadband, Inc.*, IPR2022-00721, Paper No. 11, page 15 (PTAB Oct. 26, 2022). Unlike *Amphenol*, Patent Owner is not asking the Board to simply assume there is a distinguishing claim feature. *Id.* Regarding *Exactech*, the Board instituted because the petitioner established that a relevant section of a prior art reference was overlooked. *Exactech, Inc. v. Zimmer, Inc.*, IPR2022-00836, Paper 7, page 13 (PTAB Nov. 8, 2022). Here, Petitioner has not met its burden of showing that *Deane* teaches the non-contact limitations. Nothing in *Deane* was overlooked.

In general, every *Becton*, *Dickinson* factor favors Patent Owner. See POPR at pages 36-47. The Board should use its discretion to deny institution.

Respectfully Submitted,

CARLSON, GASKEY & OLDS, P.C.

/Timothy J. Murphy/
Timothy J. Murphy
Registration No. 64,613
400 West Maple, Suite 350
Birmingham, MI 48009
Telephone: (248) 283-0732

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing document is no more than five pages, as authorized by the Board in its April 21, 2023 email, excluding a table of contents, a table of authorities, this certificate of compliance, and a certificate of service.

Respectfully Submitted,
CARLSON, GASKEY & OLDS, P.C.

/Timothy J. Murphy/
Timothy J. Murphy
Registration No. 64,613
400 West Maple, Suite 350
Birmingham, MI 48009
Telephone: (248) 283-0732

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing document was served electronically via email on May 5, 2023 in its entirety on the following:

Robert M. Masters
Timothy Cremen
Eric K. Gill
Roy D. Jung

Via email: legaltm-gce-ipr@sheppardmullin.com

Sheppard, Mullin, Richter & Hampton LLP
2099 Pennsylvania Avenue, NW, Suite 100
Washington, DC 20006-6801

Petitioner has consented to electronic service.

Respectfully Submitted,
CARLSON, GASKEY & OLDS, P.C.

_____/Timothy J. Murphy/
Timothy J. Murphy
Registration No. 64,613
400 West Maple, Suite 350
Birmingham, MI 48009
Telephone: (248) 283-0732