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| **From:** | Jonathan Tuminaro |
| **To:** | Director_PTABDecision_Review |
| **Cc:** | jimglass@quinnemanuel.com; seangloth@quinnemanuel.com; Michael Specht; Jonathan Tuminaro; Richard M. Bemben; PTAB Account |
| **Subject:** | IPR2023-00435 -- Request for Director Review of Institution Decision |
| **Date:** | Friday, August 4, 2023 3:29:57 PM |
| **Attachments:** | image001.png<br>image002.png |

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Dear Director,

Patent Owner Pictometry filed a Request for Director Review of the Board's Institution Decision in IPR2023-00435 in P-TACTS. (*See* Paper 19.) Concurrently with that filing, Pictometry provides the following priority-ranked list of issues:

1. Important Issue of Law or Policy: The Director should grant review to clarify that § 325(d) arguments with respect to prior-art references explicitly addressed by the Office in priority applications are "reasonably foreseeable" and should be addressed by petitioners in the petition and not in additional pre-institution briefing *after* the one-year statutory-bar date. *Cf Google LLC v. Valtrus Innovs. Ltd.*, IPR2022-01197, Paper 12, 5 (PTAB Mar. 29, 2023) ("*Valtrus*").

2. Abuse of Discretion: The Board abused its discretion for two independent reasons:

    a. Departure from established precedent: The Board deviated from the precedential decision in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) by erroneously placing the burden on Patent Owner to show part one of *Advanced Bionics* was met.

    b. Clearly erroneous factual finding: The Board's Institution Decision rests on the clearly erroneous factual finding that prior-art references considered in priority applications were not of record during examination of the challenged patent, despite the fact that the MPEP *required* the examiner to consider all of the prior art from the priority applications while examining the challenged claims. *See* MPEP § 2001.06(b).

Here, four of the five prior-art references relied on in the Petition were thoroughly analyzed by the same examiner over a roughly ten-year period during examination of the priority applications to the challenged patent. But, remarkably, the Petition did not acknowledge any of these facts, erroneously stated that none of this prior art was previously addressed by the Office, and did not even include the file histories of the priority applications as exhibits to the Petition.

The Board abused its discretion and undermined the Director's guidance in *Valtrus* by permitting Petitioner to file a reply to the POPR to address these—reasonably foreseeable—§ 325(d) issues

*after* the one-year statutory-bar date. Compounding this error, the Board again abused its discretion by instituting this IPR without following *Advanced Bionics'* two-part framework. Specifically, the Board erroneously placed the burden on Pictometry to show that part one of *Advanced Bionics* was met and improperly found that the priority applications' claims were substantially different than the challenged claims by focusing on a claim limitation that was not even the basis for allowance of the challenged claims. Moreover, the Institution Decision rests on the clearly erroneous factual finding that four of the five prior-art references were not of record during original examination, even though Office procedure *required* the examiner to consider the art from the priority applications while examining the challenged claims.

Director Review is needed to correct the Board's mistakes and to provide much-needed guidance on these important legal and policy issues.

Regards,
Jonathan Tuminaro
*Counsel for Patent Owner Pictometry*


Sterne Kessler
STERNE KESSLER GOLDSTEIN & FOX

**Jonathan Tuminaro, Ph.D.**
Director
**Sterne, Kessler, Goldstein & Fox P.L.L.C.**
1101 K Street, NW, 10th Floor, Washington, DC 20005

**Email:** jtuminar@sternekessler.com
**Direct:** 202.772.8967
**Administrative Assistant:** Earnesteen Ginn-White
**Main:** 202.371.2600 **Direct:** 202.772.8574


***Please be aware as of August 1, 2023, the Sterne, Kessler, Goldstein & Fox office address is 1101 K Street, NW, 10th Floor, Washington, DC 20005. Information about our new address is being provided for your awareness and updating of our firm profile, your records, etc. if/as needed.***


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