Paper 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEX RECREATION CORP.,
Petitioner,

v.

BESTWAY INFLATABLES AND MATERIAL CORP.,
Patent Owner.

Case No. IPR2023-00489
Patent No. 10,687,633

PATENT OWNER'S PRELIMINARY SUR-REPLY
(Per Board Authorization, Paper 9)

Intex's reliance on *Samsung Electronics v. Hardin* is misplaced. There, the Board relied on the fact that: (i) "the claims are very long"—exceeding 7,000 total words—with "claim 1 [being] at least two and half columns in length"; and (ii) each petition raised "the same, single ground." IPR2022-01330, Paper 13 at 20, 22-23. Thus, due to claim length, it was impossible to include all claims in a single petition, even after petitioner streamlined the proceedings by asserting a single common ground. By contrast, the challenged claims here are readily manageable in a single petition. Claim 1 of the '633 Patent is approximately half a column in length. Ex. 1001 at 12:36-2:3. And, the total word count of the challenged claims is less than 1,000 words. Paper 8 at 6-7. Rather than streamline, Intex has multiplied the proceedings—with nine distinct grounds amongst four petitions, including redundant grounds both within and between the petitions. Paper 3 at 1; Paper 8 at 10-14. In short, nothing in *Samsung* undermines the fact that Intex has failed to show it could not have included all of the challenged claims in a single petition.

Wirtgen America v. Caterpillar is also inapplicable. Intex relies on its finding that an "ambiguity in the prosecution history" justified two petitions. IPR2022-01395, Paper 9 at 46-47. In particular, it was unclear whether, in light of statements in the prosecution history, certain challenged claims required a "rotary actuator." *Id.* Intex does not identify any such "ambiguity" in the '633 Patent or its prosecution history. Rather, Intex suggests that this is analogous to Intex's "need to address

Lin's U.S. and related EU prosecutions." Reply at 2. But the only ambiguity is Intex's own position as to whether the EPO history on a related patent is relevant to the present IPRs. Paper 8 at 14 (noting Intex's statements that both the EPO erred but that the errors "do not affect" Intex's grounds). Intex's failure to simplify these proceedings—instead taking alternative positions on various issues—does not justify multiple petitions.

Dated: July 21, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on July 21, 2023, I will cause a true and correct copy of the foregoing Patent Owner's Preliminary Sur-Reply, and all associated exhibits or appendices referred to therein (if any), to be served via e-mail to Petitioner's counsel of record at:

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CERTIFICATE OF COMPLIANCE

This paper complies with the type-volume limitation set by the Board in its Order Granting In Part Petitioner's Request to File Reply. This paper contains 338 words as counted by the word-processing program used to generate this paper, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(a)(1) and counsel's signature block.

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and the type style requirements of 37 C.F.R. § 42.6(a)(2)(iii)&(iv).

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