

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REFLEX USA LLC,
Petitioner,

v.

LONGYEAR TM, INC. and GLOBALTECH CORPORATION PTY LTD.,
Patent Owners.

IPR2023-00642
U.S. Patent 10,830,013

**PATENT OWNERS' SUR-REPLY TO PETITIONER'S REPLY
TO PRELIMINARY RESPONSE**

TABLE OF CONTENTS

PATENT OWNER EXHIBIT LIST iii

I. INTRODUCTION 1

II. PETITIONER CANNOT SHOW MATERIAL ERROR BASED ON
THE SUBSTANTIVELY DIFFERENT CLAIMS OF THE CHILD
PATENT 2

III. WIESE IS CUMULATIVE BECAUSE THE EXAMINER ALREADY
BELIEVED BEACH-127 TAUGHT OPTICAL COMMUNICATION 4

CERTIFICATE OF SERVICE 7

PATENT OWNER EXHIBIT LIST

Exhibit	Description
Ex.2001	File History for U.S. Patent No. 10,047,581
Ex.2002	U.S. Patent No. 10,047,581 (the “Grandparent Patent”)
Ex.2003	Table comparing independent claim 1 of the '013 Patent, the Parent Patent, the Grandparent Patent, and the Child Patent

I. INTRODUCTION

Patent Owners' position is simple: Petitioner cannot establish material error in the prosecution of the '013 Patent by pointing to the Examiner's consideration of substantively different claims in the Child Patent. This is especially true when the Examiner held multiple times that the *specific "window" limitation of the '013 Patent* is patentable over the Beach-127 reference. *See, e.g.,* Ex.1011, 54-56, 36, 31, 9-13 (Examiner allowing Parent Patent because of the "window" limitation). Neither the Petition nor Petitioner's Reply adequately addresses or explains why the Board should ignore these previous findings by the Examiner when *Advanced Bionics* requires deference. *See Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 9 (Feb. 3, 2020) (precedential) ("*Advanced Bionics*").

The Wiese reference is cumulative to Beach-127 for the purposes of § 325(d) and does not provide a compelling reason for institution. Petitioner asserts it is relying upon Wiese for disclosure of "optical communication"—but the Examiner already believed "optical communication" was taught by Beach-127. Accordingly, even if the Examiner had Wiese before him, the '013 Patent would have still been allowed.

Petitioner fails to provide a compelling reason why Patent Owner should be forced to relitigate the validity of the '013 Patent.

II. PETITIONER CANNOT SHOW MATERIAL ERROR BASED ON THE SUBSTANTIVELY DIFFERENT CLAIMS OF THE CHILD PATENT

The Board has consistently found that a Petitioner cannot show material error under *Advanced Bionics* by pointing to an Office evaluation of substantively different claims. For example, in IPR2021-00419, the Board held that Petitioner's reliance on the Office's "analysis of different claim language is insufficient to show Examiner error" and confirmed its decision to deny institution under § 325(d). *BMW of North America, LLC, et. al., v. Stragent, LLC*, IPR2021-00419, Paper 21 at 10 (March 21, 2022). Likewise, in IPR2021-01520, the Board denied institution under § 325(d) where it found Petitioner "wrongly relie[d]" on a previous evaluation of a parent patent to demonstrate Examiner error "because the [parent] patent claims differ materially from the [challenged] patent claims." *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01520, Paper 23 at 26 (March 22, 2022) (noting that "the [challenged] patent claims require a 'first operator' and a 'second operator,' whereas the [parent] patent claims require only an 'operator.'").

Here, Petitioner cannot show material error by pointing to the Examiner's consideration of the broader—and thus materially different—"window" limitation of the Child Patent (or the pending Grandchild application cited in the Reply). As discussed in the Preliminary Response, the "window" claimed in the Child Patent

is not required to be “*proximate the closed proximal end of the sealed interior cavity*.” Consistent with this, there is no indication that the Examiner evaluated whether Beach-127 teaches the “*proximate*” requirement in the prosecution of the Child Patent. The Office Action simply alleged that Beach-127 includes “a window (illustrated in Fig. 2 above) that extends from the exterior surface into optical communication with the sealed interior cavity.” Ex.1013, 192. Petitioner’s own annotations and manufactured chart in Exhibit 1014 are not evidence the Examiner affirmatively considered a requirement not found in the pending claims. Because the Examiner had no reason to—and in fact did not—consider the “*proximate*” requirement of the ’013 Patent during the prosecution of the Child Patent, Petitioner cannot prove material error based the different claims of the Child Patent.

Importantly, every time the Examiner *did* consider the narrower window limitation with the “*proximate*” requirement (as in the ’013 Patent, the Parent Patent, and the Grandparent Patent), he affirmatively found that Beach-127 did not disclose such a limitation. *See* POPR, 3-8. For example, the narrower window limitation was the *reason for allowance* in the Parent Patent and the Grandparent Patent. *Id.* at 3-5. Petitioner’s assertion that the Examiner suddenly changed his mind with respect to Beach-127 on his *fourth* evaluation of the reference is simply not credible. The Examiner evaluated a different claim in the Child Patent and

came to a different conclusion. Petitioner has thus not shown the Examiner erred allowing the '013 Patent over Beach-127.

III. WIESE IS CUMULATIVE BECAUSE THE EXAMINER ALREADY BELIEVED BEACH-127 TAUGHT OPTICAL COMMUNICATION

Wiese is, by definition, cumulative to Beach-127 for the purposes of § 325(d) because the Examiner would have allowed the '013 Patent even if Wiese was before him. Specifically, Petitioner relies upon Wiese *not* for the “*proximate*” requirement that the Examiner believed was missing in Beach-127, but instead for “*optical communication*,” which the Examiner believed was already disclosed by Beach-127.

As discussed above and in the Preliminary Response, the Examiner allowed the narrower window limitation with the “*proximate*” requirement over Beach-127 three times—in the Grandparent Patent, the Parent Patent, and the '013 Patent. *See* POPR, 3-6. It was only when Patent Owner removed the “*proximate*” requirement from the window limitation in the as-filed claims of the Child Patent that the Examiner rejected the window limitation over Beach-127. *Id.* at 6-7. The Examiner’s repeated allowance of the narrower window limitation and subsequent rejection of the broader window limitation indicates that he believed that Beach-127 lacks a window “*proximate the closed proximal end of the sealed interior cavity.*”

Petitioner does not rely upon Wiese for the “*proximate*” requirement the Examiner believed missing—it doesn’t even allege that Wiese includes the claimed “*sealed interior cavity*” or the claimed “*closed proximal end of the sealed interior cavity*.”). See Petition, 25-28 (limitation 1[b]); see also Reply, 5. Instead, Petitioner emphasizes in its Reply that it relies upon Wiese’s “explicit disclosures...regarding ‘*optical communication*’.” Reply, 4 (emphasis in original). The Examiner, however, already believed that Beach-127 discloses the “optical communication” requirement of the window limitation. Ex.1013, 192 (alleging Beach-127 includes “a window (illustrated in Fig. 2 above) that extends from the exterior surface into **optical communication** with the sealed interior cavity.”); see also Petition, 35. Accordingly, even if the Examiner had before him Wiese’s disclosures of optical communication, he would still have allowed the ’013 Patent. This is true regardless of whether the Examiner perceived Wiese’s optical communication disclosure as somehow “better” than Beach-127’s disclosure—optical communication was not the reason for allowance. The ’013 Patent would have still issued because Wiese does not teach a window “*proximate the closed proximal end of the sealed interior cavity*.” Wiese is therefore cumulative to Beach-127 for the purposes of § 325(d).

Patent Owner respectfully asks the Board to deny institution of a petition that revisits the same issues the Examiner thoroughly and conclusively addressed during prosecution.

Respectfully submitted,

Dated: August 2, 2023
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e),
service was made on Petitioner as detailed below.

Date of service August 2, 2023

Manner of service Electronic Service by E-mail: sweidenfeller@cov.com;
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Documents served **Patent Owners' Sur-Reply to Petitioner Reply to
Preliminary Response**

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