

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

BiTMICRO, LLC,
Patent Owner.

Case IPR2023-00783
Patent 6,496,939

**PATENT OWNER’S SUR-REPLY IN SUPPORT OF ITS
PRELIMINARY RESPONSE¹**

¹ This Sur-Reply was authorized by the Board by email on October 10, 2023.

The Petition contends that the “Supercap Manual” (pp. 62-103 of Ex. 1015) is a printed publication solely because it was contained within a file history of an unrelated patent. Pet., 2. This is wrong. The Board has held that the inclusion of a document in a file history is not, by itself, sufficient to make the document a printed publication. *See RPX Corp., et al. v. Iridescent Networks, Inc.*, IPR2017-01662, Paper 33 at 26 (PTAB Dec. 10, 2018); *C & D Zodiac, Inc. v. B/E Aerospace, Inc.*, IPR2017-01276, Paper 12 at 22 (PTAB Oct. 31, 2017) (“[W]e are not persuaded that, under Rule 1.11(a) (or any other authority), file histories of patent applications generally constitute printed publications by virtue of their being open to inspection by the public.”).

Petitioner’s Reply improperly submits new arguments on the Supercap Manual, but these also fail. Petitioner newly argues that Reasoner’s cover page and the IDS submitted in Reasoner’s file history both describe the Supercap Manual as “published.” Reply, 1. But these statements are hearsay, and do not prove that the Supercap Manual was **actually** published under pre-AIA 35 U.S.C. § 102.

Petitioner next argues that the “Reasoner applicant obtained a copy of the Supercap Manual,” (Reply, 1), but how this occurred is pure speculation. Further, Reasoner’s submission of the Supercap Manual in an IDS is not evidence that it was a printed publication. *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010).

The Reply newly cites to *Duodecad IT Services Luxembourg S.A.R.L, et al.*

v. *WAG Acquisition, LLC*, IPR2015-01036, Paper 17 (PTAB Oct. 20, 2016) and *Bruckelmyer v. Ground Heaters, Inc.*, 445 F. 3d 1374, 1379 (Fed. Cir. 2006), but these cases are not on point. As the Board has explained, “*Bruckelmyer* does not address whether a published patent application can act as a roadmap to direct a person of ordinary skill in the art to the file history to find a prior art reference.” *RPX Corp.*, Paper 33 at 22. *Duodecad* does not address this issue either.

Moreover, Reasoner does not provide a roadmap to the Supercap Manual in its file history. The document identified in the Reasoner specification is different than the document identified on the cover of the Reasoner patent. *Compare* Ex. 1015, 5:28 (discussing “Document No. DEP-10046”) *with id.*, References Cited (citing “Document No. CEP-1004G”). The Supercap Manual in the file history is incomplete—page 9 is missing—and bears a different date (1985) than the date stated on either the IDS or the cover page of Reasoner. Even the IDS acknowledges an uncertainty in the date, using the plus-or-minus symbol to estimate a date. Ex. 1015, 61. Petitioner cannot explain these discrepancies. Moreover, if anything, Reasoner’s disclosure directs a reader to NEC Electronics, Inc. for Document No. DEP-10046, not to the file history. *See* Ex. 1030, 5:26-30; *see also RPX Corp.*, Paper 33 at 21 (“Surdila directs the person of ordinary skill in the art to a specific website URL” not to the prosecution history). As in *RPX Corp.*, Petitioner has pointed to nothing that would direct a person of ordinary skill

in the art to look in the Reasoner file history for the Supercap Manual. *See Id.*

In *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364 (Fed. Cir. 2021), the Federal Circuit addressed evidence sufficient to establish public accessibility of an article appearing in a file history. *Id.* at 1373. This evidence included, *inter alia*, an inventor declaration and deposition acknowledging publication, the examiner's ability to independently locate the article via search and establish a publication date, and the applicant's lack of dispute over the article's prior art status. *Id.* at 1373-76. Comparable evidence does not exist here. There is no evidence in Reasoner that the examiner independently determined a publication date for the Supercap Manual. Petitioner argues that Reasoner was classified and indexed (Reply, 3), but Reasoner's U.S. Classification was Class 365 (Ex. 1030, [52]), while the '939 patent's U.S. Classification was Class 713 (Ex. 1001, (52)). And neither the Supercap Manual nor Reasoner was cited by the examiner during examination of the '939 patent. As in *RPX*, Petitioner has no evidence to show that the Supercap Manual, rather than Reasoner, was indexed or catalogued in a meaningful way so that a skilled artisan could have located the Supercap Manual in the Reasoner file history with reasonable diligence. *See RPX Corp.*, Paper 33 at 23.

It is Petitioner's burden to establish that a document is a printed publication. *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1375 (Fed. Cir. 2018), *as amended* (Sept. 20, 2018). Petitioner has failed to meet this burden.

IPR2023-00783 Patent Owner's Sur-Reply to the Preliminary Response

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CERTIFICATE OF SERVICE

I hereby certify that on October 26, 2023, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email address of record as follows:

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