

Case IPR2023-00973
U.S. Patent No. 8,468,244

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION
Petitioner

v.

DIGITAL DOORS, INC.
Patent Owner

IPR2023-00973

U.S. Patent No. 8,468,244

INTERNATIONAL BUSINESS MACHINES CORPORATION'S
PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE

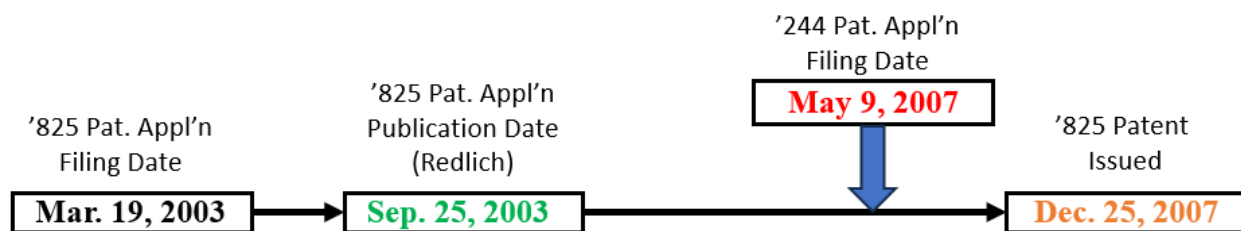
Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. REDLICH IS NOT THE SAME ART AS THE '825 PATENT

Patent Owner (PO) incorrectly alleges that the '825 Patent (US 7,313,825) is “the same art” (POPR, 6) to the '244 Patent as Redlich (US Pub. 2003/0182435).

The '244 Patent is a Continuation-in-part application “of Ser. No. 11/746,440 filed **May 9, 2007** which was [a] regular patent application based upon provisional patent application Ser. No. 60/883,522 filed Jan. 5, 2007.” EX1001, 62. During prosecution, the Examiner found that the '244 Patent is not entitled to the priority date of “[t]he provisional application relied upon, 60/883522.” EX1002, 2221 (Part 5). Accordingly, the effective filing date of the '244 Patent is **May 9, 2007**, which is the filing date of the '244 Patent’s parent.

The '825 Patent was filed on March 19, 2003, (EX1005, 1), published on **September 25, 2003** (*id.*) as US Pub. 2003/0182435 (“Redlich”), and issued on **December 25, 2007**, as the '825 Patent. The '825 Patent is not prior art to the '244 Patent. The '825 Patent issued after **May 9, 2007**, and therefore *is not prior art* under pre-AIA 35 U.S.C. ¶102(a)/¶102(b).¹



In contrast, Redlich qualifies as pre-AIA 35 U.S.C. ¶102(b) prior art to the

¹ The '825 Patent *is not prior art* under pre-AIA 35 U.S.C. ¶102(e) as well, because it is not “by another.” See EX1001, 1; EX2001, 1 (listing same inventors).

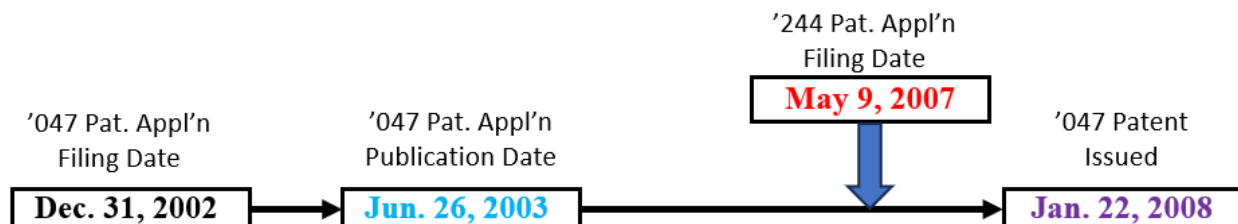
'244 Patent. Pet., 15-16. Accordingly, the statement “[t]he examiner also declined to pursue the § 103(a) rejection against amended claims 3-4” (POPR, 3) is misleading because it implies that the Examiner had the option to pursue a §103(a) rejection over the '825 Patent.

II. REDLICH IS NOT SUBSTANTIALLY THE SAME ART AS THE '047 PATENT (“REDLICH PATENT”)

PO also incorrectly alleges that US 7,322,047 (“Redlich Patent”/“'047 Patent) is “substantially the same art” (POPR, 6) to the '244 Patent as Redlich.

The '047 Patent was filed on December 31, 2002 (EX2004, 1), published on **June 26, 2003**, as US Pub. 2003/0120949, and issued on **January 22, 2008**.

EX2004, 1. The '047 Patent *is not prior art* to the '244 Patent for the same reasons the '825 Patent is not prior art.



Thus, the '825 and '047 Patents are not “(substantially) the same art” as Redlich. Besides they were only available for double patenting rejections, where the Examiner *only considered the claims*—not the specification—of the '825 and the '047 Patents. Therefore, the Petition properly concluded that “[t]he PTO has not previously considered Redlich ... in connection with the claims of the '244

Patent.”^{2, 3} Pet., 75. Denial under 35 USC § 325 (d) is not appropriate.

III. THE USPTO MATERIALLY ERRED

Even if the ’825 and ’047 Patents were considered to be “(substantially) the same art,” denial under 35 USC § 325(d) would still not be appropriate. The Examiner found that the ’244 Patent claims and the claims of the ’825 and ’047 Patents “are not patentably distinct because [the ’825 and ’047 Patent claims] contain every limitation, or an obvious variation of” the ’244 Patent claims. (*Double patenting* (OTDP) rejections) EX1002, 2225 (Part 5). The Examiner maintained the *OTDP* rejections of amended claim 3 over the ’047 Patent claims. EX1002, 2247-48 (Part 5). Because the ’825 and ’047 Patents are presumed to satisfy written description, *their corresponding disclosures, as well as Redlich and the ’047 Patent pre-issuance publication, also “contain every limitation, or an obvious variation of” (id.)* the ’244 Patent claims.

Therefore, the Examiner erred by not rejecting under 35 U.S.C. § 103 the original/amended ’244 Patent claims over the ’047 Patent pre-issuance publication and Redlich.⁴

² In *Microsoft Corp. v. Koninklijke Philips NV*, IPR2018-00279, **both** the publication and the patent qualified as prior art to the challenged patent for 102/103 purposes. Also, the Examiner considered the publication and rejected the claims under 35 U.S.C. §103, not double patenting.

³ In *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, **both** Yang and the Yang parent qualified as prior art to the challenged patent for 102/103 purposes.

⁴ Redlich is a CIP of the ’047 Patent and comprises the ’047 Patent disclosure.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a complete copy of the foregoing was caused to be served on counsel of record for Patent Owner by filing this document through P-TACTS and by sending this document via electronic mail to the following addresses:

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