

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION
Petitioner,

v.

DIGITAL DOORS, INC.
Patent Owner.

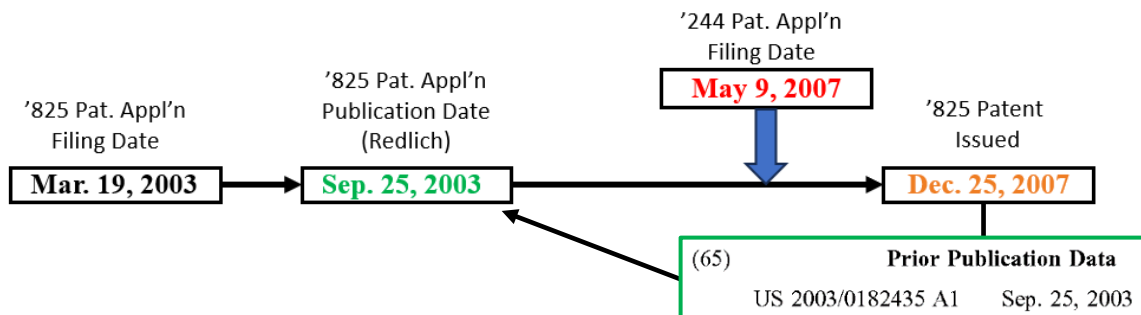
Case IPR2023-00973
U.S. Patent 8,468,244

**PATENT OWNER DIGITALDOORS, INC.'S SUR-REPLY TO
PETITIONER'S PRELIMINARY REPLY**

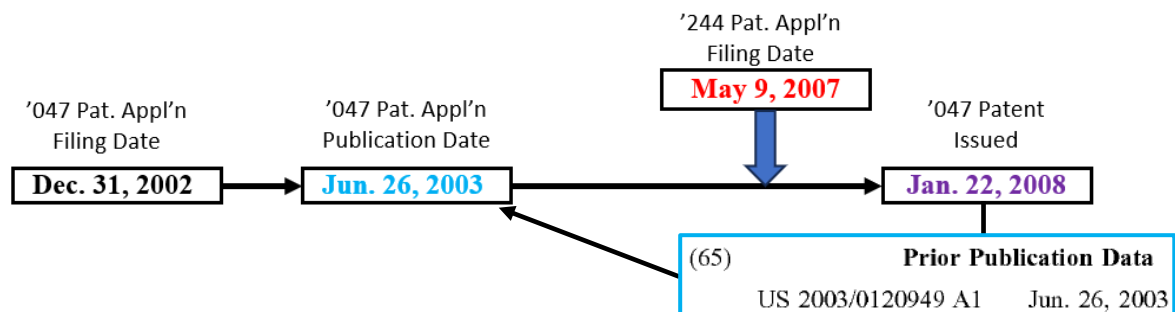
I. The Piece of Art Petitioner Relies Upon Was Before the Examiner, Who Considered it Before Allowing the '244 Patent.

Although Petitioner accuses us of being misleading, their Preliminary Reply is what is misleading. It misleads by arguing that the reference it relies on, “Redlich,” was *not* before the examiner as § 102(a)/(b) art during the '244 Patent prosecution. In fact, it was.

Petitioner concedes that the examiner considered the '825 Patent and the '047 Patent. EX1002 Part 5, 2225. What Petitioner omits is that the face of the '825 Patent lists “Redlich,” US 2003/0182435, as its prior (Sep. 2003) publication.



Similarly, the '047 Patent/Redlich Parent lists its prior (June 2003) publication.



Both Redlich and the Redlich Parent's publication, therefore, were clearly § 102(a)/(b) prior art (by at least three-and-a-half years) before the examiner. While the Petitioner tries to ignore these facts, it cannot dispute them.

DigitalDoors took an extra step in its Response, showing lack of material difference between Redlich and the '825 Patent and Redlich Parent. *See* POPR, 3, 8-11; EX2003. Doing so foreclosed possible argument that something in the earlier publication differed from the issued '825 Patent. The same is true of the Redlich Parent and its earlier publication. *See* EX2008.

The case here against institution is far stronger than the one in *Ivantis, Inc. v. Sight Scis., Inc.*, where the Board denied institution under § 325(d). No. IPR2022-01529, 2023 WL 2588217 (P.T.A.B. Mar. 21, 2023). In that case, the examiner had considered a disclosure (Gharib '841) substantially the same as the one supporting the petition *during prosecutions of different but related patents to the one the petition challenged*. *Id.*, at *7. In our case, the same disclosure was *twice* before the examiner (as both Redlich and the Redlich Parent) *during prosecution for the very patent being challenged*. Notably, Petitioner cites no contrary authority.

II. In Both its Petition and Preliminary Reply, Petitioner Failed to Establish Material Error by the USPTO.

When art on which the petition is based was previously before the examiner, Petitioner has the burden of establishing material PTO error in considering that art. *Ivantis*, 2023 WL 2588217, at *9; *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, No. IPR2019-01469, 2020 WL 740292, at *8 (PTAB. Feb. 13, 2020). This § 325(d) framework reflects the commitment to defer to previous USPTO evaluations. *Advanced Bionics*, at *3. Our Response

demonstrated that the Petition lacked any effort to establish examiner error. POPR, 17.

Petitioner now tries to rectify its failure by pointing to a single sentence from the '244 Patent's file history that fails to suggest examiner error. That statement concerned a double-patenting rejection based upon the '825 Patent and the Redlich Parent. EX1002 Part 5, 2225. What Petitioner leaves out is that the examiner later dropped the double-patenting rejection based on the '825 Patent. *Id.*, 2341-2350. This earlier statement, therefore, can't be presumed to prove that the '825 Patent contains every limitation or obvious variations of the '244 claims.

Regardless, that quoted sentence has nothing to do with whether underlying specifications of the '825 and '047 Patents, rather than their issued claims, included all elements of the challenged '244 Patent's claims.¹ Petitioner had to point to "misapprehended or overlooked specific teachings" in *both* the pre-issuance publications of the '825 Patent and the Redlich Parent. *Ivantis*, 2023 WL 2588217, at *9. But nowhere does Petitioner even try to establish examiner error in this manner. Its position "amounts to mere attorney argument, belatedly presented in Petitioner's Reply" and should be given "little weight." *Id.*

Denial under 35 USC § 325(d) is appropriate.

¹ While one should presume that the specifications support the claims, what is found in the specifications is still a legally distinct issue.

Dated: November 13, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(4) & 42.105(a))

A copy of PATENT OWNER DIGITALDOORS, INC.'S SUR-REPLY TO
PETITIONER'S PRELIMINARY REPLY and Exhibit 2008 have been served on
counsel of record for Petitioner on November 13, 2023 as follows:

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