

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDUCTEV, INC.
Petitioner,

v.

WITRICITY CORPORATION,
Patent Owner.

Case IPR2023-01208
Patent 8,912,687

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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STATUTES

35 U.S.C. §325(D) 1, 2

**THE BOARD SHOULD DENY INSTITUTION UNDER
35 U.S.C. §325(D) AND *ADVANCED BIONICS***

This is the prototypical example of IPR that 35 U.S.C. § 325(d) and *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper No. 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”) were intended to prevent. Here, the Petition includes only art that the Examiner considered.

In its Petition, the Petitioner does not argue that any reference anticipates any claim of the ‘687 Patent. Instead, Petitioner asserts that the same combination of two references¹ renders each of the eighteen Claims of WiTricity’s U.S. Patent No. 8,912,687 (the “‘687 Patent”) obvious. But Petitioner admits – as it must – that both of those references were previously considered by the Office during prosecution of the ‘687 Patent. Accordingly, it would be a waste of the Board’s time and unfairly burden the Patent Owner (“PO”) to revisit the same or substantially the same art and disclosures previously considered during prosecution. *Advanced Bionics*, at 8-9.

¹ For its obviousness assertions, Petitioner’s relies upon U.S. Patent Application Publication No. 2009/0299918 A1 (“Cook”) (Ex. 1007) and U.S. Patent Publication No. 2010/0036773 A1 (“Bennett”) (Ex. 1005).

***Advanced Bionics* Two-Part Analysis Framework**

The Board has discretion to determine whether to institute *inter partes* review, and 35 U.S.C. § 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics*, at 7.

In an analysis under § 325(d), *Advanced Bionics* set forth a two-part framework: (1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.* at 8. The purpose of the *Advanced Bionics* two-part framework reflects a commitment by the Board to defer to previous Office evaluations of the evidence of record unless the Petitioner can show that the Office made a material error.

As an initial matter, Petitioner's arguments regarding Section 325(d) and the two-part *Advanced Bionics* analysis appear to be an afterthought. Petitioner apparently admits that *Advanced Bionics* Part One is met because Petitioner does not mention Part One, and skips straight to Part Two. Regarding its analysis of *Advanced Bionics* Part Two, Petitioner presents its entire argument in only two

conclusory sentences. (Pet. at 67). Of course, Petitioner's arguments are summary conclusions with little, if any, analysis. Therefore, those arguments should accordingly be given little to no weight.

Petitioner asserts that it has met *Advanced Bionics* Part Two because the prosecution history is silent regarding the Examiner's analysis of the two references. *Id.* But the Board has been clear that mere silence regarding references presented to and considered by the Examiner does not show material error by the Examiner. *Microsoft Corp. v. ThroughPuter, Inc.*, IPR2022-00757, Paper 10 at 21 (PTAB Nov. 1, 2022).

In its second (and last) sentence addressing § 325(d), Petitioner asserts that even though its two references were previously considered by the Examiner, Petitioner submitted a declaration from a person of skill in the art ("POSA") on the motivation to combine those two references. But the Federal Circuit and the Board have been clear that an Examiner is considered a POSA. *Duodecad IT Services Luxembourg S.À.R.L., et al. v. WAG Acquisition, LLC*, IPR2015-01036, Paper 17 at 17 (PTAB Oct. 20, 2016). So the Petitioner's declaration adds nothing to what the Examiner presumptively knew as a POSA when considering Petitioner's two references during prosecution. Also, in its two-sentence argument, the Petitioner does not explain how the Examiner made a material error, or failed to consider, misapprehended, or overlooked Petitioner's two references or the knowledge of a

POSA. *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 19 (PTAB Nov. 8, 2022) (exercising §325(d) discretion to deny petition where petitioner failed to show material error as no rejection was issued over IPR references while each was before examiner or cumulative).

For these reasons, the Board should exercise its discretion under 325(d) and *Advanced Bionics* and deny the Petition.

I. *Advanced Bionics* Part One: The Same or Substantially the Same Prior art was Previously Presented to the USPTO.

In this case, Petitioner admits that each of the two references Petitioner relies upon were previously considered by the Examiner.² Moreover, in its two-sentence argument regarding the Board's discretion under § 325(d), Petitioner failed to address *Advanced Bionics* Part One. Accordingly, Petitioner concedes that *Advanced Bionics* Part One is met.

II. *Advanced Bionics* Part Two: Petitioner Failed to Show a Material Error Made by the Examiner.

As noted above, the Petitioner asserts that it has met *Advanced Bionics* Part Two because the prosecution history is silent regarding the Examiner's analysis of the two references. Petition at 67. But mere silence regarding references presented

² Stating that "Bennett and Cook are listed on the face of the '687 patent" Pet. at 67.

to and considered during prosecution does not show material error by the Examiner. *Microsoft Corp. v. ThroughPuter, Inc.*, IPR2022-00757, Paper 10 at 21 (PTAB Nov. 1, 2022) (denying institution and rejecting petitioner’s argument that the Office did not take substantive action showing consideration of cited art because “the lack of a rejection itself is not dispositive of whether there was material error.”).³

In the next sentence, Petitioner asserts that even though its two references were previously considered by the Examiner, Petitioner submitted a declaration from a person of skill in the art (“POSA”) on the motivation to combine those two references. But the Examiner is considered a POSA while evaluating references during prosecution. *Duodecad IT Services Luxembourg S.À.R.L., et al. v. WAG Acquisition, LLC*, IPR2015-01036, Paper 17 at 17 (PTAB Oct. 20, 2016).⁴ And as a POSA, the Examiner is presumed to be aware of all pertinent prior art references. *Standard Oil v. American Cyanamid*, 774 F.2d 448, 454 (Fed. Cir. 1985). It

³ See also *Juniper Networks, Inc. et al. v. Mobile Telecommunications Technologies, LLC*, IPR2017-00642, Paper 31 at 20 (PTAB March 14, 2018) (denying institution and rejecting Petitioner’s argument that there was material error because the Examiner was silent regarding applying considered prior art in the record to the claims).

⁴ Citing *St. Clair Intellectual Prop. Consultants, Inc. v. Canon Inc.*, 412 Fed. Appx. 270, 276 (Fed. Cir. 2011) and *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

follows that the Petitioner's declaration regarding the knowledge of a POSA does not add anything to what the Examiner presumptively knew as a POSA when considering Petitioner's two references in the record during prosecution.

Further, in its two-sentence argument addressing § 325(d), the Petitioner fails to explain how the Examiner made a material error, or failed to consider, misapprehended, or overlooked Petitioner's two references or the knowledge of a POSA. *Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 9 at 23 (PTAB Jan. 3, 2023) (exercising §325(d) discretion to deny petition where petitioner made a "mere two-sentence assertion regarding § 325(d)" and failed to discuss with specificity how the examiner erred with respect to reference); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 19 (PTAB Nov. 8, 2022) (exercising §325(d) discretion to deny petition where petitioner failed to show material error as no rejection was issued over IPR references while each was before examiner or cumulative).⁵ Accordingly, the Petitioner has not met its burden under *Advanced Bionics* Part Two.

⁵ See also *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14, at 19 (PTAB Mar. 27, 2023) (exercising §325(d) discretion to deny petition where petitioner argued the references in the record were not discussed by the Examiner).

CONCLUSION

For the reasons explained above, both parts of the *Advanced Bionics* analysis confirm that the Board should exercise its discretion under § 325(d) to deny institution.

Dated: November 30, 2023

Respectfully submitted,

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CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing *Patent Owner's Preliminary Response to Petition* totals 1,295, which is less than the 14,000 allowed under 37 CFR § 42.24(b)(1).

Dated: November 30, 2023

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CERTIFICATE OF SERVICE

It is certified that a copy of the *Patent Owner's Preliminary Response to Petition* has been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the address of record as follows:

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