

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 SUR-REPLY TO PETITIONER'S REPLY

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STATUTES

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Petitioner's Reply does not change the conclusion that the two prior art references it relies upon to argue that all 18 claims of the '687 Patent are obvious were previously presented to and considered by the Office, and Petitioner only summarily addressed §325(d) and *Advanced Bionics* analysis in just two conclusory sentences. *See* Petition at 67. Importantly, in its two-sentence discussion, Petitioner failed to assert or explain how the Office made a material error. Recognizing that its Petition did not meet its burden under §325(d), Petitioner now uses its Reply to insert new arguments and evidence that it clearly did not present in its Petition.

In the first three pages of its five-page Reply, for the first time, Petitioner attempts to discuss the Examiner's separate reasons for its Notice of Allowance regarding three groups of claims of the '687 Patent: Claims 1-6, 7-12, and 13-18, respectively. Petitioner's arguments are new and therefore improper for a reply brief; accordingly, those arguments should be rejected or ignored. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (affirming the Board's refusal to consider Petitioner's new argument under 37 C.F.R. § 42.23(b) because Petitioner presented it for the first time in Petitioner's Reply).

Moreover, as noted, the Petitioner's two prior art references were before the Examiner. And the Board has been clear that mere silence regarding particular

references presented to and considered by the Examiner does not show material error. *Microsoft Corp. v. ThroughPuter, Inc.*, IPR2022-00757, Paper 10 at 21 (PTAB Nov. 1, 2022).

Petitioner's attempt to distinguish Board cases ruling that mere silence regarding references presented to and considered during prosecution does not show material error by the Examiner is ineffectual. For example, in *Microsoft Corp. v. ThroughPuter*, the Petitioner, like here, argued that the Examiner erred by not making particular findings regarding particular elements of the prior art compared to the limitations of the patent claims in-issue. *Id.* at 21-22. But the Board rejected Petitioner's argument and denied institution because the Examiner indicated its analysis of the prior art and the claims by stating "it was each independent claim 'as a whole' that the Examiner found established patentability when considering" the prior art of record. *Id.* at 22. Here, like the facts in *Microsoft*, in its reasons for allowance for each of the claims of the '687 Patent, the Examiner did indicate her review of the prior art by stating that "none of the prior art of record" disclosed particular features "in combination with the remaining claimed features." *See, e.g.*, '687 FH at 798.

Further, in its two-sentence argument addressing §325(d) in the Petition, the Petitioner failed to explain how the Examiner made a material error, or failed to consider, misapprehended, or overlooked the Petitioner's two references. *See* PO

Prelim. Response at 4 to 6. In its Reply, Petitioner asserts that simply because it submitted a declaration with its Petition, such declaration is “new evidence” and cites cases for that general proposition. But nowhere in its Petition or in its Reply does the Petitioner explain how its declaration shows where the Examiner made a material error or failed to consider the Petitioner’s two prior art references that were clearly before the Examiner, or how the Examiner did not have the knowledge of a POSA when considering the references before her.

Instead, in its Reply – in a single conclusory sentence – the Petitioner states that its declaration was “not previously before the Office” and it “provides helpful insight from a POSA.” If that were the standard, then every petition would be instituted merely because it has an accompanying declaration from an alleged POSA. As the Board has made clear on numerous occasions, that is well below the standard a Petitioner must meet in order to warrant institution. Indeed, the Board often has exercised its discretion under §325(d) to deny institution in matters, like here, where the only two references relied upon by Petitioner were (1) before the Examiner, *and* (2) the Petitioner makes conclusory, two-sentence statements instead of showing how the Examiner made a material error or failed to consider the references. *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); *see also* PO Prelim. Response at 4 to 6 and citing cases.

For the reasons explained above and in Patent Owner's Preliminary Response, both parts of the *Advanced Bionics* analysis confirm that the Board should exercise its discretion under §325(d) to deny institution.

Dated: January 11, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that a copy of the *Patent Owner's Sur-reply to Petitioner's Reply* 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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