

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OPTICIS CO., LTD

Petitioner,

v.

INNEOS LLC,

Patent Owner.

Case No. IPR2023-01256
U.S. Patent No. 7,198,416

**PATENT OWNER'S RESPONSE CONCERNING PETITIONER'S
RELIANCE ON NEW ARGUMENTS AND EVIDENCE**

The answer to the Board's 9/23/24 question, whether Petitioner relied upon new arguments and evidence in its Reply (Paper 24), is yes. Petitioner's introduction of EX2018 and EX1020 ("the Grann Patents") is not about a newly-raised claim construction issue, but is a belated effort to fill gaps in the Petition.

The new evidence includes at least the Grann Patents, corresponding deposition testimony in EX1017, and portions of EX1016 that are directed to EX2018, EX1020, and EX1017. The Petition does not mention the Grann Patents, but they were clearly knowable by Petitioner prior to filing the Petition. Eric Grann, an inventor on the '416 Patent, is the inventor on EX2018 and EX1020. EX2018 is addressed repeatedly in the File History, EX1002. *See* 12/5/06 Amendment and Response (EX1002 p.37), and the accompanying Grann Declaration (EX1002 p.46). *See also id.* p.109 (identifying EX2018 as "related art"). And the Grann Patents are listed in the Power of Attorney. EX1002 p.9.

The new arguments emanate from Reply §III, where Petitioner argues that the Grann Patents disclose a "pre-existing mechanical design," and argues that "[a] POSITA would have known of the earlier Grann Patents, and they confirm Petitioner's position that a POSITA would have had the motivation and knowledge to add integration, passive alignment, and a pre-aligned connector with a stop to any of the grounds." Reply pp.10, 11.

This theme, based on EX2018 and EX1020, is woven throughout the Reply.

Section III is cited at least three times. Reply p.8, p.12 (“even if Inneos’ constructions are adopted, the claims would have been obvious”); p.15 (arguing that integration, passive alignment and pre-aligned connector were well-known and standard). Dr. Willner’s supplemental declaration (EX1016) discusses the Grann patents and EX1017 at EX1016 ¶¶70-71, concerning Ground 1. Dr. Willner cross-cites to this discussion. *Id.* ¶¶ 5, 6. He also cites to the Ray deposition testimony. *E.g., id.* ¶ 80. Then he repeatedly references his testimony “above” in ways suggestive that it includes these passages. *E.g., id.* ¶¶ 79, 80, 81, 83, 85, 86, 140. Petitioner’s Reply also repeatedly cites EX1016 ¶¶70-71 to emphasize the Grann Patents. *E.g.,* Reply p.3 (citing EX1016 ¶¶64-74), p.15 (citing EX1016 ¶¶65-74), p.18 (citing EX1016 ¶¶63-74). Dr. Willner testified that he relies on the Grann Patents to supply motivation to modify Kurita and/or combine Kurita with other references. EX2056 at 26:21-28:23, 33:22-36:7.

The cases cited by Petitioner are inapposite. In *Axonics, Inc. v. Medtronic, Inc.*, 75 F4th 1374 (Fed. Cir. 2023), Patent Owner advanced a new claim construction after the Board’s institution decision (*id.* at 1378), and in response Petitioner shifted its theories based on the same prior art as the grounds in the Petition (*id.* at 1379). Thus, the narrow question decided in *Axonics* is based on these two factors (new construction post-institution and same prior art). *See id.* at 1380, 1382, 1383-1384. Neither of those factors is present here. Similarly, *Life*

Spine, Inc. v. Globus Medical, Inc., IPR2022-01434 (Paper 49) (PTAB Mar. 20, 2024) is distinguishable. First, it involved a motion to strike, not a request to disregard new evidence and arguments. Second, in *Life Spine*, Petitioner relied on the same prior art reference as in the Petition. *Id.* at *47. Here, the Grann Patents were not cited in the Petition. Third, to the extent Petitioner cites the Board’s ruling in *Life Spine* for the proposition that a Petitioner may offer new theories in response to a claim construction consistently advanced by Patent Owner including in the POPR, it is contrary to the Federal Circuit’s *Axonics* ruling.

Inneos did not proffer a new construction in its post-institution Response. Its proposed constructions of “optical combiner” and “stopped single optical fiber” have been consistent all along. POPR (Paper 12) pp.11, 20; POR (Paper 18) pp.16, 26; *Inneos LLC v. Opticis Co., Ltd.*, No. 23-cv-185-MCS-ADS at Dkt. 78 pp.1-2 (C.D. Cal. Nov. 8, 2023); *id.* at Dkt. 81 pp.6, 19, 2023 WL 11893939 (C.D. Cal. Dec. 15, 2023). Petitioner addressed Inneos’ constructions in its Reply to Inneos’ POPR. These constructions were not “*introduced* in a patent owner’s response or the Board’s institution determination,” *Everstar Merch. Co. Ltd. v. Willis Elec. Co., Ltd.*, No. 2021-1882, 2022 WL 1089909, *4 (Fed. Cir. Apr. 12, 2022) (emphasis added), and *Everstar* is distinguishable. The Board should disregard Petitioner’s new arguments and evidence. *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1366-1367 (Fed. Cir. 2023) (affirming refusal to consider new argument).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on October 4, 2024, that a true and correct copy of the foregoing was served on Counsel for Petitioner via filing through the P-TACTS, as well as by delivering a copy via electronic mail to the following email address(es):

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