

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Chemtronics USA, Inc.
Petitioner,

v.

FlatFrog Laboratories AB
Patent Owner

Case IPR2024-00013
Patent 11,281,338

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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I. INTRODUCTION

Patent Owner (“PO”) does not challenge the substance of Chemtronics’s arguments, but instead spends nearly 60 pages manufacturing procedural defects and arguing for discretionary denial under 35 U.S.C. § 325(d). These arguments are meritless. Chemtronics’s Petition presents new combinations of references and new arguments not previously considered by the Office. Thus, the Board should decline Patent Owner’s request for discretionary denial under § 325(d).

II. GROUNDS 1A AND 1B: CHEN ’975 IN VIEW OF KLEIN

There is no basis for discretionary denial regarding Grounds 1A and 1B under 35 U.S.C. § 325(d). First, these grounds do not rely on the same or substantially the same art previously considered by the Office.

Patent Owner argues that Chen ’975 was considered by the Office because a related disclosure (“Chen-WO”) was before the Office during prosecution of a parent application to the ’338 Patent (the ’916 Patent). POPR at 29. While Chen-WO was cited in an IDS (Ex. 2002 at 246) and mentioned in an interview request and post-allowance interview summary filed by applicant (*id.* at 253, 1234),¹ Chen-WO was

¹ The Examiner’s interview summary form is marked “NA” in a space identifying prior art discussed in the interview. Ex. 2002 at 1169.

never “relied on by the Office during an Office Action” during prosecution of the parent ’916 Patent, as Patent Owner argues. POPR at 27. Nor was Chen-WO “considered by the Office to reject the parent ’916 Patent claims.” *Id.* at 29. Both of these statements by Patent Owner are simply wrong.

In any event, even if the citation to Chen-WO during prosecution of the parent ’916 Patent indicates consideration of the reference, that is insufficient for a discretionary denial. As the PTAB has previously found, “it is not enough to satisfy the first part of the *Advanced Bionics* framework that Patent Owner overcame the same or substantively similar art or arguments *for materially different claims in different patent applications.*” *Roofr Inc. v. Pictometry Inter. Corp.*, IPR 2023-00435, Paper 16 at 5-6 (PTAB July 21, 2023) (emphasis added). Here, Patent Owner’s own chart (POPR at 34-35) shows the significantly different claim scopes of the two patents whose prosecution is being compared. For example, in the parent ’916 Patent claims, a first portion includes first and second projections extending downward from the first portion with a gap between the projections that corresponds with a mating portion of an optical element that engages with this gap. These limitations are not present in the ’338 claims. As a further example of the substantive differences between the patents, the ’338 claims recite a “substrate configured to support at least one of the plurality of light emitters such that the at least one of the plurality of light emitters transmits a portion of light in a plane extending over the

touch surface” which is not claimed in the '916 Patent. These examples demonstrate that the '338 and '916 Patents claims contain different limitations, such that the claims are materially different from one another.

Yet Patent Owner relies on misleading boldfacing of high-level, facial similarities in its chart to distract from these material differences between the two patents. POPR at 34-35. For instance, Patent Owner boldfaces “first portion” in both columns, but ignores the fact that the first portion of the '916 Patent is parallel to the *touch surface*, whereas the first portion of the '338 patent is parallel to the *edge surface*. As another example, Patent Owner mistakenly boldfaces “second projection” in the '916 claims and “second portion” in the '338 claims, even though they are two entirely different limitations. Thus, the claims of the two patents are substantively different, such that any alleged consideration of Chen-WO against the '916 claims is of limited relevance to the unpatentability of the '338 claims.

Moreover, Patent Owner's argument is moot because the Petition's grounds utilize Chen '975 *in combination with Klein*, a new reference not presented during prosecution. Petition at 22, 49. As the Petition explains, “[h]ad the Patent Office applied Chen '975 *and Klein* during prosecution ... the '338 patent would not have issued.” Petition at 23 (emphasis added). Patent Owner's argument that Grounds 1A and 1B rely on previously considered art fails entirely to consider the inclusion of Klein. POPR at 29-35. But this inclusion, alone, is sufficient to avoid denial under

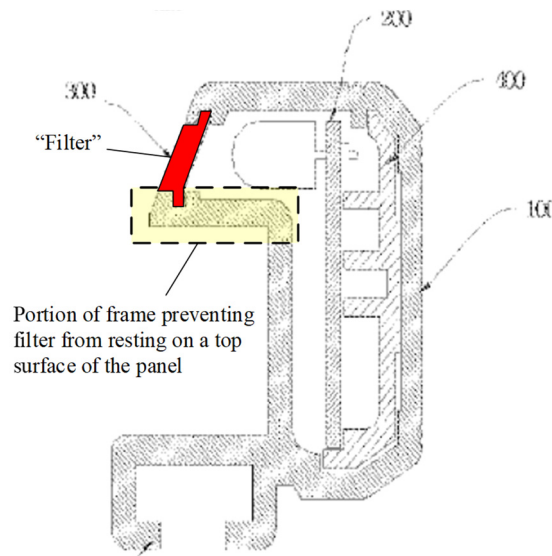
§ 325(d). *Samsung Elecs. Co. v. Dodots Licensing Sols. LLC*, IPR2023-00756, Paper 9 at 21-22 (PTAB Oct. 11, 2023) (determining that prior art and arguments were not the same or substantially the same where a previously presented reference was relied on in the Petition in combination with new references). Thus, Grounds 1A and 1B do not rely on the same or substantially the same art as considered by the Office.

Nor do these Grounds rely on previously considered arguments. Yet again, Patent Owner uses high-level, facial similarities between art relied upon by the Examiner and Klein (i.e., use of an “optical filter”) to distract from the substantively different disclosures of Klein. As the Petition explains in great detail, Klein provides additional details relevant to the unpatentability of the challenged claims. Petition at 33-36. For example, Klein explicitly discloses an optical overlay that provides “sealing and waterproofing” and “rests” on the edge surface of the panel, features that directly read on the claim limitations. *Id.* at 33-34.

Patent Owner misleadingly argues that “the Office already considered and rejected this very argument (combining a reference for their teachings of a filter strip being the required sealing element)” (POPR at 43), ignoring the significant contributions of Klein’s optical overlay. As Patent Owner acknowledges, the ’338 claims were allowed over the cited prior art (most notably the “closest prior art” reference, “Weishan”) based on the addition of the “sealing element configured to rest on the edge portion of the top surface” limitation. POPR at 44; Ex. 1002 at 23. But

this is the exact limitation that Klein teaches which was not present in the previously considered art. Patent Owner's argument that "substituting the teachings of Weishan with those of Klein does nothing to advance any different arguments than those already considered by the Office" ignores this fact.

Klein explicitly discloses that its overlay provides "sealing and weatherproofing" (Ex. 1006 at 5:53); Weishan does not. Klein's optical overlay rests on an edge portion of the top surface of the panel (Petition at 36; Ex. 1006 at Figs. 8 and 9); Weishan's filter does not. In fact, Weishan's filter fundamentally cannot meet this limitation, as shown below:



(Ex. 2005 at Fig. 5 (cropped and annotated)). Accordingly, Klein provides an optical overlay having significantly different properties from previously considered filters and is therefore non-cumulative. Because even "a single non-cumulative reference in combination with references discussed during prosecution is enough to decline a § 325(d) denial," there is no basis here for discretionary denial of Grounds 1A and 1B.

Oticon Medical AB v. Cochlear Ltd., IPR2019-00975, Paper 15 at 16, 19-20 (PTAB Oct. 16, 2019).

III. GROUND 2: CHEN '812

There is also no basis for discretionary denial regarding Ground 2. The Petition expressly acknowledged that Chen '812 was one of the 800+ references cited by Patent Owner during prosecution of the '338 patent and explained that there is no evidence that the reference was substantively considered. Petition at 54. Patent Owner claims "[Chen '812] was specifically considered by the Office prior to allowance" (POPR at 27; *see also id.* at 28, 36.), but cannot point to anything on the record showing substantive consideration of the reference beyond mere citations in an IDS. The Board has repeatedly found that the citation of a reference on an IDS, without more, is generally insufficient for a §325(d) denial. *Scientific Design Co. Inc. v. Shell Oil Co.*, IPR2022-00158, Paper 7 at 24-26 (PTAB Apr. 4, 2022) (declining to exercise discretion under § 325(d) and "credit[ing] Petitioner's argument that although the references 'were cited in an IDS, together with 111 references, none of them was used in any rejections, or otherwise addressed by the examiner'"). Therefore, Chen '812's presence on an IDS alongside dozens of other references, without any actual consideration by the Examiner during prosecution, is insufficient to meet the first prong of the *Advanced Bionics* test.

Patent Owner's reference to invalidity contentions and a claim chart against the '916 patent cited during prosecution of the '338 patent has minimal, if any, relevance. POPR at 38. In fact, Patent Owner's argument that the cited claim chart "contains the same arguments now made in the Petition" (POPR at 40) is flat-out wrong. The cited claim chart merely mentions Chen '812 among a long list of references evidencing the knowledge of a POSA. Ex. 2004 at 1. The chart itself is directed to the ActivePanel 4.5 Product, not "AP4.5 in view of Chen '812" as Patent Owner intimates. Ex. 2004; POPR at 40. As Patent Owner's own comparison shows, Chen '812 and APR4.5 differ significantly in orientation and structure (POPR at 41), and the suggestion that consideration of arguments relating to AP4.5 against different patent claims amounts to consideration of arguments of Chen '812 against the '338 patent is misleading at best. As discussed in Section II above, the '916 claims and '338 claims are materially different from one another. Moreover, there is no evidence that the Examiner actually considered the claim chart aside from its presence on the IDS. For these reasons, the claim chart does not constitute previously considered art under the first prong of *Advanced Bionics*.

Nevertheless, the Petition provided ample explanation as to why the Office materially erred in allowing the claims over Chen '812. Petition at 54. The Petition explains that, "[t]o the extent the examiner considered Chen '812 and determined that it does not disclose the claimed 'first portion' configured to 'support the substrate[,]'

... this is inconsistent with patentee's interpretation of the claims." *Id.* Specifically, Patent Owner has interpreted claim 1 of the '338 patent as encompassing an air gap between the claimed "first portion" and the "substrate" in its patent-infringement complaint against Chemtronics. *Id.*; *see also* Ex. 1012 at 3. The Examiner could not have appreciated that the "first portion configured to support the substrate" would include an air gap without considering the claim chart associated with the litigation. Thus, there is no basis here for discretionary denial based on Ground 2.

IV. GROUND 3: PARK IN VIEW OF KLEIN

Finally, there is no basis for discretionary denial regarding Ground 3. Patent Owner does not even argue that the Park and Klein references were previously considered by the Office, and as explained above in Section II, Chemtronics's reliance upon Klein constitutes entirely new arguments not advanced during prosecution.

V. CONCLUSION

On the basis of the Petition, un rebutted on substance, and the reasons provided above, trial should be instituted.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Reply to Patent Owner Preliminary Response to of U.S. Patent No. 11,281,338, was served on March 6, 2024 via electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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