

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

U.S. Patent No. 11,281,338

PATENT OWNER'S PRELIMINARY SUR-REPLY

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

	Page
I. 35 U.S.C. § 325(d) Favors Denial of Institution	1
II. <i>Advanced Bionics</i> Part 1 is Satisfied—The Petition’s Art <i>And</i> Arguments Were Previously Presented	2
A. The Same or Substantially the Same Art Was Presented.....	2
1. Chen-975’s Disclosure Was Considered by the Office	2
2. Chen-812 Was Considered by the Office	4
B. The Same or Substantially the Same Arguments Were Presented	5
III. <i>Advanced Bionics</i> Part 2 is Satisfied—Petitioner Failed to Demonstrate Office Error	7

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics LLC v. MED-EL Elek. Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	4, 8
<i>II-VI, Inc. v. Alexander Soto</i> , IPR2021-01359, Paper 10 (PTAB Feb. 15, 2022).....	4
<i>Medtronic CoreValve LLC v. Speyside Med. LLC</i> , 2021 WL 3137302 (PTAB Jul. 23, 2021).....	8
<i>Nespresso USA, Inc. v. K-fee System GmbH</i> , IPR2021-01221, Paper 9 (PTAB Jan. 18, 2022)	5, 8
<i>Nokia of Am. Corp. v. Alexander Soto and Walter Soto</i> , IPR2023-00681, Paper 10 (PTAB Nov. 3, 2023).....	3
<i>Parse Biosciences, Inc. v. 10X Genomics, Inc.</i> , 2023 WL 8789872 (PTAB Dec. 19, 2023).....	2
<i>Roofr Inc. v. Pictometry Inter. Corp.</i> IPR2023-00435, Paper 16 (PTAB Jul. 21, 2023)	3
<i>Sci. Design Co. Inc. v. Shell Oil Co.</i> IPR2022-00158, Paper 7 (PTAB Apr. 4, 2022)	5
<i>Vital Connect, Inc. v. Bardy Diagnostics, Inc.</i> , IPR2023-00381, Paper 7 (PTAB Jul. 11, 2023).....	2, 5

PATENT OWNER'S EXHIBIT LIST

No.	Reference	Referred To As
2001	U.S. Patent No. 10,739,916	'916 Patent
2002	Prosecution History of U.S. Patent No. 10,739,916	'916 Patent Prosecution History
2003	Promethean's Invalidity Contentions	Promethean Invalidity Contentions
2004	Exhibit 8 Claim Chart, Promethean Invalidity Contentions	Exhibit 8 Claim Chart, Promethean Invalidity Contentions
2005	WO2014131221 (Weishan) and accompanying Google Patents English Translation	Weishan

I. 35 U.S.C. § 325(D) FAVORS DENIAL OF INSTITUTION

Petitioner's Reply concedes facts establishing that the Petition's core references were previously presented to the Office (satisfying *Advanced Bionics* Part 1), and fails to offer **any** evidence of Examiner error. Petitioner relies on pre-*Advanced Bionics* authority to support its arguments (Petition, 54), and incorrectly argues that references submitted in Information Disclosure Statements ("IDS"), or evaluated in parent applications, are not "presented" to the Office.

For Grounds 1A, 1B and 3 where a "new" reference is utilized, the arguments are substantially the same as those considered during prosecution. Petitioner's own figures and annotations confirm that the "new" Klein reference suffers from the same flaws as the Weishan reference, which was overcome for allowance.

For *Advanced Bionics* Part 2, despite a second opportunity, the Reply **fails entirely to address Examiner error** for any of Grounds 1A, 1B or 3. Petitioner does not even mention *Becton Dickinson* factors (c), (e), or (f). For Ground 2, Petitioner focuses on issues irrelevant to Examiner error (*e.g.*, district court infringement theories), with arguments unsupported by any evidence that the Examiner evaluated either the claims, or Chen-812, in error. Thus, Petitioner has failed to demonstrate **any** Examiner error and *Advanced Bionics* Part 2 is satisfied.

The Board should defer to the Office's prior evaluations of the Petition's art and arguments, and exercise its discretion to deny institution under § 325(d).

**II. *ADVANCED BIONICS* PART 1 IS SATISFIED—THE PETITION'S
ART AND ARGUMENTS WERE PREVIOUSLY PRESENTED**

A. The Same or Substantially the Same Art Was Presented

1. *Chen-975's Disclosure Was Considered by the Office*

Petitioner does not dispute that Chen-WO is “substantially the same art” as Chen-975, which is used in this IPR as the main reference for Grounds 1A and 1B. They are related, and effectively identical. POPR, 29-33; *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 16 (PTAB Jul. 11, 2023) (finding parent application “substantially the same” art). Instead, Petitioner only disputes that Chen-WO was “considered” (Reply, 2), but misapplies § 325(d) authority.

Petitioner concedes that Chen-WO was *both cited in an IDS, and substantively discussed with the same Examiner during interviews*, in the '338 Patent's immediate parent application. Reply, 1. The Applicant conducted an Examiner interview with rejections pending, and discussed Chen-WO. POPR, 17-18; Ex. 2002, 249-253. Chen-WO was discussed *again in a second interview* regarding proposed claim amendments. POPR, 18-19; Ex. 2002, 1234. This led to an Office Action allowing the claims, accompanied by the Examiner's sign-off that Chen-WO was considered. POPR, 22-23; Ex. 2002, 1158, 1229. This satisfies *Advanced Bionics Part 1. Parse Biosciences, Inc. v. 10X Genomics, Inc.*, 2023 WL 8789872, at *6 (PTAB Dec. 19, 2023) (finding Part 1 met when “the Applicant submitted an [IDS] identifying cited art . . . in the first non-provisional application

in the '357 patent's family before the *same Examiner* of the '357 patent").

Petitioner argues that prior art considered by the same examiner in the '338 Patent's parent application should not satisfy Part 1 because the two patents allegedly have "different claim scopes." Reply, 2. But the '338 Patent prosecution history evidence belies this attorney argument. *The '338 Patent claims received a nonstatutory double patenting rejection over the parent '916 Patent claims.* POPR, 11-13; Ex. 1002, at 595-96. The Examiner explicitly noted that "[a]lthough the claims at issue are not identical, they are *not patentably distinct* from each other" because they "*all recite similar features.*" Ex. 1002, 597. Applicant responded by submitting a terminal disclaimer. EX. 1002, 585, 116. Petitioner's Reply ignores this explicit evidence demonstrating the similarity of the claims. Reply, 2-3. Thus, there is no doubt that this same Examiner was aware of the art he considered during examination of the '338 Patent's parent application.¹ POPR, 33-36; *Nokia of Am.*

¹ Petitioner's citation to *Roofr Inc. v. Pictometry Inter. Corp.* (Reply, 2) does not apply because that proceeding dealt with "materially different claims," which is in stark contrast to the present case where the Examiner found the claims to be "not patentably distinct." IPR2023-00435, Paper 16, 5-6 (PTAB Jul. 21, 2023); Ex. 1002, 595-96. Although Petitioner's Reply attempts to identify differences in the exact

(Footnote continued)

Corp. v. Alexander Soto and Walter Soto, IPR2023-00681, Paper 10, 20 (PTAB Nov. 3, 2023) (finding parent prosecution history to apply in equal force for Prong 1); *II-VI, Inc. v. Alexander Soto*, IPR2021-01359, Paper 10, 19-20 (PTAB Feb. 15, 2022) (same).

2. *Chen-812 Was Considered by the Office*

Chen-812—relied on for the entirety of Ground 2 in this Petition—was also considered. It was cited in an IDS during prosecution of the challenged '338 Patent, which was signed and initialed by the Examiner: “*All References Considered Except Where Lined Through.*” POPR, 36-37; Ex. 1002, 89. It was also cited in invalidity charts provided to the Examiner. Ex. 1002, 90-91; Ex. 2003, 16; Ex. 2004, 1.

Petitioner argues that “Chen ‘812’s presence on an IDS . . . without any actual consideration by the Examiner during prosecution, is insufficient to meet the first prong of the *Advanced Bionics* test.” Reply, 6. But, “[p]reviously presented art includes art made of record by the Examiner, ***and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.***” *Advanced Bionics LLC v. MED-EL*

claim language between the '916 and '338 Patents (Reply, 2-3), it fails to explain any ***relevance*** of these differences, let alone address the Examiner’s findings that the two sets of claims were “not patentably distinct.”

Elek. Geräte GmbH, IPR2019-01469, Paper 6, 7-8 (PTAB Feb. 13, 2020); *Vital Connect, Inc.*, IPR2023-00381, Paper 7, 14 (“The examiner also certified that he considered all references listed in the IDS ‘except where lined through,’ and Oster is not lined through.”). Chen-812’s presence on the signed IDS alongside “dozens of other references” (Reply, 6) does not change this. *Nespresso USA, Inc. v. K-fee System GmbH*, IPR2021-01221, Paper 9, 13-14 (PTAB Jan. 18, 2022) (rejecting the argument that references were not “considered” when presented in a voluminous IDS signed by the Examiner). There can be no dispute that Chen-812 was considered by the Office.² *Advanced Bionics* Part 1 is satisfied.

B. The Same or Substantially the Same Arguments Were Presented

In addition to the Petition’s main references, the Petition’s *same arguments* have also been considered by the Office.

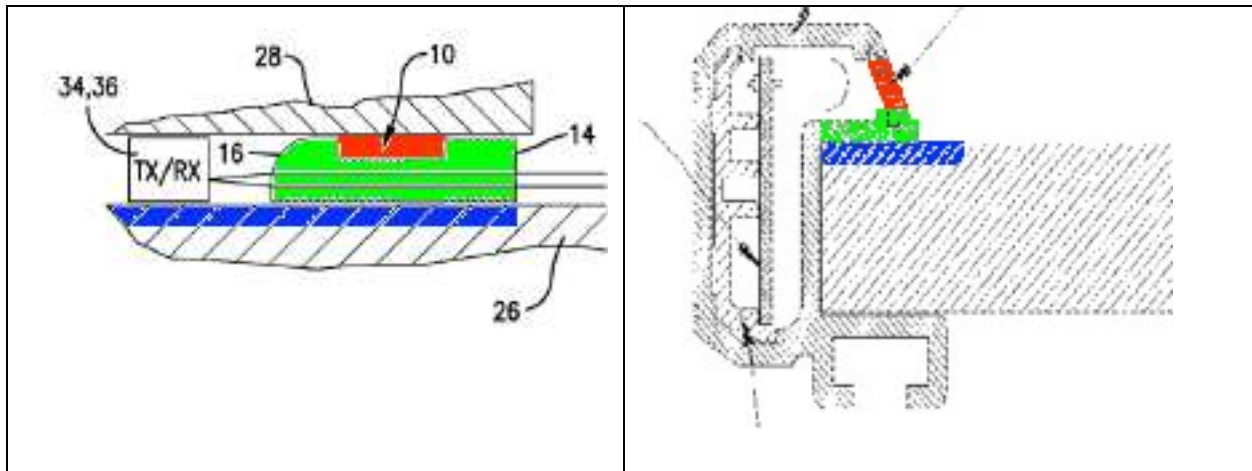
Petitioner contends that the addition of Klein (Ex. 1006) is a “new reference”

² Petitioner’s citation to *Scientific Design Co. Inc. v. Shell Oil Co.*, confirms Part 1 is satisfied here. IPR2022-00158, Paper 7, 25 (PTAB Apr. 4, 2022) (“Thus, the art relied upon in the Petition was presented to the Office in an IDS during examination.”). *Scientific Design* exercised discretion to institute based on other arguments surrounding Part 2 and Examiner error. *Id.*, 25. As explained *infra*, Petitioner failed to make any similar Part 2 arguments in its Petition or Reply.

not considered by the Office. Reply, 3. But Petitioner ignores that its *argument* using Klein is effectively the same as that considered by the Office. POPR, 42-51. During prosecution, the Applicant added the claimed “sealing element configured to rest on the edge portion of the top surface” to overcome Weishan, which did not have a sealing element resting on the top surface. POPR, 45-48. Despite Petitioner’s selective presentation of Klein in its Reply at 5, a closer look confirms that Klein and Weishan suffer from the same flaws.

Petitioner argues that Klein’s optical overlay provides “sealing and weatherproofing,” and “rests on an edge portion of the top surface of the panel.” Reply, 5. But Petitioner’s own citations confirm that *Klein’s optical overlay itself does not provide any sealing*—instead a “groove 40 is configured to retain a *gasket for sealing* or weatherproofing the display. . . .” *Id.*; Ex. 1006, 5:52-54. Petitioner’s own annotated figures show that *Klein’s sealing gasket does not rest on an edge portion of the top surface of the panel*. Petition, 35; Ex. 1006, 6-8. The Petition depicts the gasket in yellow, resting upon optical overlay 10—*not the top surface of the panel*. *Id.* Thus, Klein suffers from the same flaw that Petitioner highlights in Weishan (Reply, 5), which Patent Owner overcame during prosecution—in both references the sealing element (red) is resting on an intermediate surface (green), *not* an edge portion of the panel top surface (blue):

Klein, Ex. 1006, Fig. 8	Weishan, Ex. 2005, Fig. 7
-------------------------	---------------------------



Accordingly, the use of Klein provides nothing new over Weishan. POPR, 42-51.

For the same reasons, Ground 3—Park in view of Klein—presents arguments cumulative to those already considered. POPR, 42-43. Like all other Grounds presented, Ground 3 relies on Park as allegedly disclosing all limitations except the “sealing element.” Petition, 81. Ground 3 uses Klein for the “sealing element,” thus providing the *same argument* as Grounds 1A-1B. Petitioner never responds to the POPR that Ground 3’s use of Park in view of Klein is cumulative. Reply, 8.

III. *ADVANCED BIONICS* PART 2 IS SATISFIED—PETITIONER FAILED TO DEMONSTRATE OFFICE ERROR

As it relates to Grounds 1A-1B, and 3, the Petition and Reply is devoid of *any* argument, let alone evidence, demonstrating Examiner error. For Ground 2, Petitioner did not analyze *any* of *Becton Dickinson* factors (c), (e), or (f) to assess Examiner error. Reply, 7-8; Petition, 54 (relying on pre-*Advanced Bionics* caselaw). Instead, Petitioner’s sole argument is based on an irrelevant issue—*how Petitioner contends Patent Owner is interpreting its claims in district court litigation. Id.* But

the Petition does not proffer **any** claim constructions. Nor does Petitioner argue that the Examiner construed the claims incorrectly, or offer any district court rulings that would suggest the Examiner erred when interpreting the scope of the claims against references such as Chen-812.

Moreover, Petitioner has provided **no evidence** that the Examiner interpreted Chen-812's disclosure incorrectly. "If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *Advanced Bionics*, IPR2019-01469, Paper 6, 9; *Medtronic CoreValve LLC v. Speyside Med. LLC*, 2021 WL 3137302, at *11-12 (PTAB Jul. 23, 2021) (rejecting argument that "to the extent the Examiner may have understood the claims to require [a particular feature], such an interpretation is error" because "Petitioner does not identify any claim construction the examiner provided."). Also, "[t]o the extent Petitioner argues that the relative strength of the grounds stated in the Petition, standing alone, supports a finding of material Examiner error, that argument is not developed adequately and, therefore, is unpersuasive on this record." *Nespresso USA*, IPR2021-01221, Paper 9 at 25.

Thus, Petitioner's sole "Examiner error" argument is devoid of evidence, and amounts to nothing more than a disagreement in district court about Patent Owner's infringement theories. *Advanced Bionics* Part 1 and 2 are satisfied and the Board should exercise its discretion to deny institution under § 325(d).

Case IPR2024-00013; Patent No. 11,281,338
Patent Owner's Preliminary Sur-Reply

Dated: March 18, 2024

Respectfully submitted,

By:/ B. Clayton McCraw/
B. Clayton McCraw
Registration No. 68,258
MAYER BROWN LLP
1221 Avenue of the Americas
New York, NY 10020-1001
Telephone: (212) 506-2649
CMcCraw@mayerbrown.com

Cliff A. Maier
Registration No. 59,526
Mayer Brown LLP
3000 El Camino Real
Palo Alto, CA 94206-2112
Telephone: 650-331-2026
CMaier@mayerbrown.com

Michael A. Molano
Registration No. 39,777
Mayer Brown LLP
3000 El Camino Real
Palo Alto, CA 94206-2112
Telephone: 650-331-2035
MMolano@mayerbrown.com

Amanda Streff Bonner
Registration No. 65,224
Mayer Brown LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: 312-701-8645
asbonner@mayerbrown.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of March, 2024, a copy of the attached
PATENT OWNER'S PRELIMINARY SUR-REPLY was served by electronic
mail to the attorneys of record, at the following addresses:

Matthew W. Johnson
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
mwjohnson@jonesday.com

Joshua R. Nightingale
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
jrnightingale@jonesday.com

Ashvi S. Patel
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
ashvipatel@jonesday.com

Stephen M. Bradley
JONES DAY
1221 Peachtree Street N.E., Suite 400
Atlanta, GA 30361
sbradley@jonesday.com

Christian A. Roberts
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
croberts@jonesday.com

Case IPR2024-00013; Patent No. 11,281,338

Patent Owner's Preliminary Sur-Reply

Dated: March 18, 2024

Respectfully submitted,

By:/ B. Clayton McCraw/
B. Clayton McCraw
Registration No. 68,258
MAYER BROWN LLP
1221 Avenue of the Americas
New York, NY 10020-1001
Telephone: (212) 506-2649
CMcCraw@mayerbrown.com

Cliff A. Maier
Registration No. 59,526
Mayer Brown LLP
3000 El Camino Real
Palo Alto, CA 94206-2112
Telephone: 650-331-2026
CMaier@mayerbrown.com

Michael A. Molano
Registration No. 39,777
Mayer Brown LLP
3000 El Camino Real
Palo Alto, CA 94206-2112
Telephone: 650-331-2035
MMolano@mayerbrown.com

Amanda Streff Bonner
Registration No. 65,224
Mayer Brown LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: 312-701-8645
asbonner@mayerbrown.com

Counsel for Patent Owner