

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHEMTRONICS USA, INC.,
Petitioner,

v.

FLATFROG LABORATORIES AB,
Patent Owner

Case: IPR2024-00014

U.S. Patent No. 11,281,335

PATENT OWNER'S PRELIMINARY SUR-REPLY

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

No.	Reference	Referred To As
2001	Promethean's Invalidity Contentions	Promethean Invalidity Contentions
2002	Exhibit 2 Claim Chart, Promethean Invalidity Contentions	Exhibit 2 Claim Chart, Promethean Invalidity Contentions

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

Petitioner’s Reply concedes facts establishing that the overwhelming majority of the Petition references were previously presented to the Office (satisfying *Advanced Bionics* Part 1). For the “new” Cheng reference, Petitioner fails to address that it is cumulative to previously considered art, and that the *arguments* considered by the Examiner remain the same. And despite a second opportunity to address Examiner error, Petitioner fails to present *any* argument or evidence of error. *Advanced Bionics* Part 2 is satisfied and institution should be denied under § 325(d).

II. ADVANCED BIONICS PART 1 IS SATISFIED

A. Han, Shin, Cao, and Zhao Were Considered by the Office

All Grounds in the Petition utilize references previously presented to the Office—Han, Shin, Cao, and Zhao. POPR, 31-43. Petitioner’s Reply is based on repeated misstatements of law: that references presented in IDS disclosures are not considered (Reply, 1, 3-4). *Nespresso USA, Inc. v. K-fee System GmbH*, IPR2021-01221, Paper 9, 12-14 (PTAB Jan. 18, 2022) (rejecting argument that references were not “considered” when presented in a voluminous IDS).

Advanced Bionics is clear—“[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 Elek. Geräte GmbH*,

IPR2019-02649, Paper 6, 7-8 (PTAB Feb. 13, 2020); *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 14 (PTAB Jul. 11, 2023) (Art is “previously presented” when the examiner “certified that he considered all references listed in the IDS ‘except where line through,’ and [the reference] is not lined through.”). Nor do references need to be “substantively discussed” in rejections to satisfy Part 1. *Google LLC v. Valtrus Innovations LTD*, IPR2022-01197, Paper 18, 15-17 (rehearing) (PTAB Jun. 13, 2023) (collecting cases).

There can be no dispute that Han, Shin, and Cao were all considered by the Office in an IDS, and not lined through. Ex. 1032, 649, 57. Also, Promethean Invalidity Contentions (Ex. 2001-2002) applying Han, Shin, Cao and Zhao to similar claims were considered. *Id.*, 59-61. Thus, *Advanced Bionics* Part 1 is satisfied.

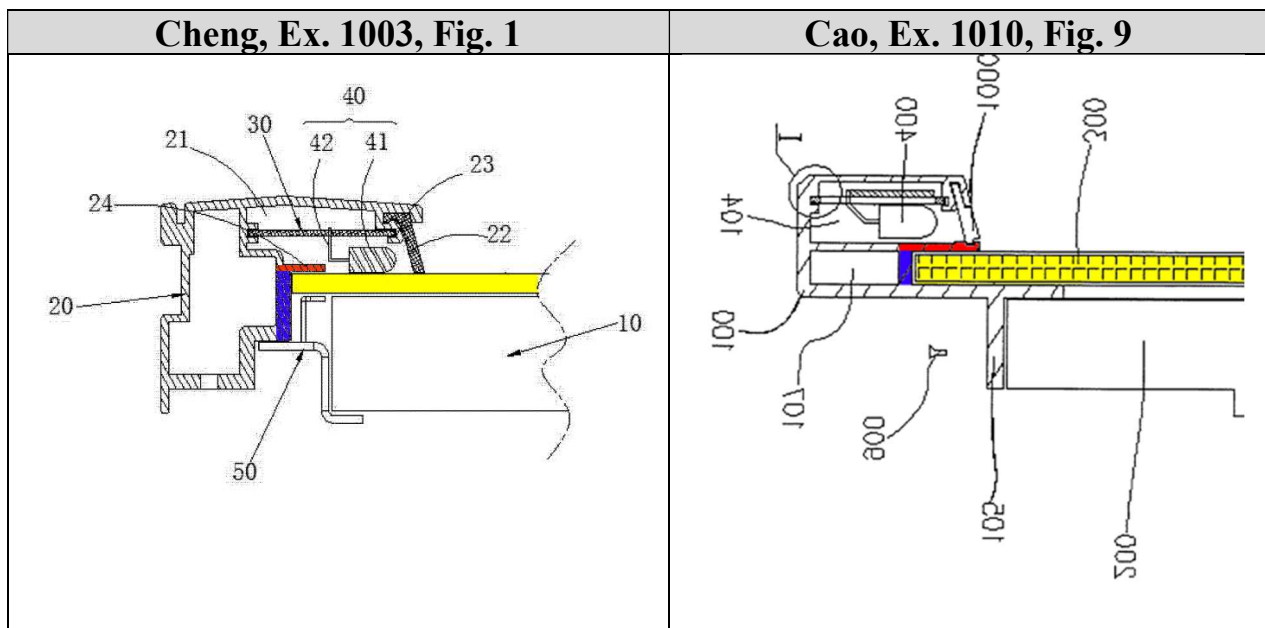
B. Petitioner's Arguments Were Previously Considered

1. Petitioner's Cheng Arguments Are Substantially the Same

Petitioner focuses solely on whether the Petition's Cheng reference is a “new reference” (Reply, 1, 2, 5-6), but ignores that § 325(d) covers art and arguments that are also “substantially the same” as those previously considered. *Dropworks, Inc. v. The Univ. of Chicago*, IPR2021-00100, Paper 9, at 14 (PTAB May 14, 2021) (“[A]nalysis under § 325(d) does not require that the teachings be identical or entirely cumulative, only that they are substantially the same.”).

Petitioner argues that “Cheng discloses entirely new structures not present in

the prior art considered during prosecution” (Reply, 2), ***but Cheng is substantially the same as the Cao reference considered during prosecution.*** Ex. 1032, 57, 59-61. The POPR repeatedly highlights that Cheng and Cao provide similar “frame assembly structure” disclosures. POPR, 51, 46. Petitioner ignores the fact that Cao was previously considered, and offers Cheng’s cumulative disclosure for the same frame limitations. Reply, 2-3. As shown below, both references disclose the same frame configuration that Petitioner contends is newly-addressed by Cheng—“the second frame element includes a first surface portion extending over an edge portion [red] of the plate [yellow] and a second surface portion arrange[d] substantially parallel to a surface[] of the plate that defines the plate thickness [blue]”:



Not only is Cheng’s ***disclosure*** cumulative of previously-considered Cao, but Petitioner’s ***arguments*** are substantially the same. Petitioner uses Cheng solely for

frame elements, and ***not*** the claimed curvature limitations. Pet., 37. ***Thus, the Petition combines frame art (Cheng/Cao) with curvature art (Han) in the same manner as Examiner arguments overcome during prosecution. POPR, 43-51.***

Cheng's frame assembly fails to offer ***any*** new disclosure addressing the key "curvature" limitations that were the focus of ***four*** Office Actions—"wherein the touch surface is curved relative to a flat plane defined in part by the short edge and the long edge" and "wherein all of the edges of the top surface of the plate are curved." POPR, 11-24. For these elements, Petitioner relies on Han or Zhao which were previously considered. Thus, Cheng is cumulative since "the principal piece of prior art relied upon in the Petition, was previously presented to the Office." *Motorola Mobility v. Maxell*, IPR2022-01287, Paper 11, 21 (PTAB Feb. 2, 2023).

In short, Cheng's disclosure is cumulative to references previously considered by the Examiner ***and*** the Petition's arguments combining Cheng's frame assembly with other curvature references are substantially the same as those already considered during prosecution. *Advanced Bionics* Part 1 is satisfied.

2. Petitioner's Han Arguments Are Substantially the Same

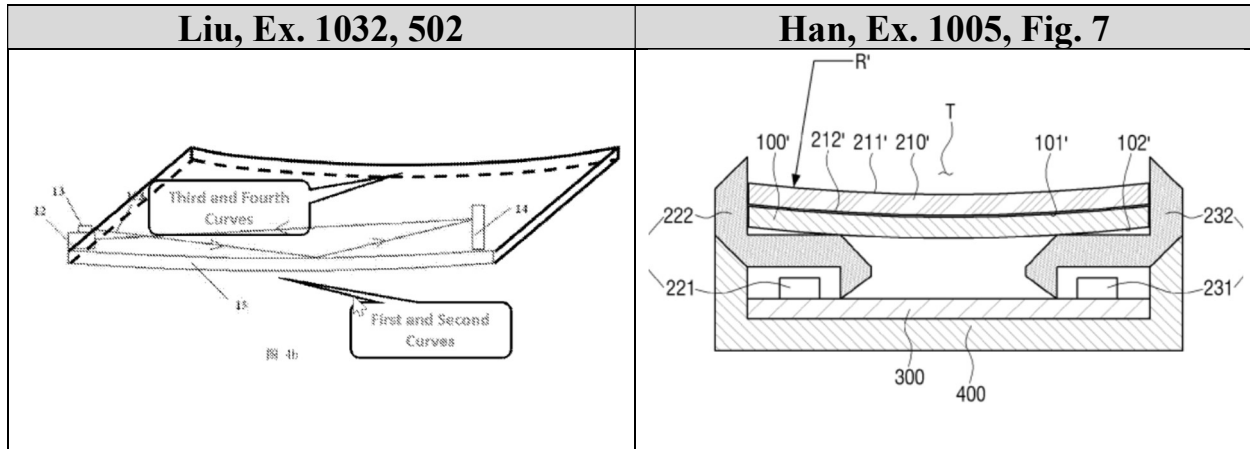
Petitioner's Reply attempts to characterize the previously-considered Han reference as providing "new, non-cumulative arguments that were not considered by the Office." Reply, 8 ("In contrast to Liu, Han discloses plate curvature along both an Ax and Ay direction.").

As an initial matter, the Examiner expressly considered the Han reference (Ex. 1032, 649) *and* Promethean Invalidity Contentions applying Han to similar claims requiring edge curvature. POPR, 35-37; Ex. 1032, 59-61. Even more, *the Promethean Invalidity Contentions presented Han for the very arguments that Petitioner repeats in the Petition.* POPR, 36-37; Ex. 2002, 4-5. These contentions explicitly argue that “Han discloses a parabolic curvature in the touch surface relative to a first axis and relative to a second axis perpendicular to the first axis. . . .” *Id.* Similar to the '335 Patent limitations requiring curved edges, the Promethean Invalidity Contentions addressed “inducing a parabolic curvature in the touch surface” and “wherein the first edge is curved and the second edge is curved.” *Id.* *Petitioner's Reply makes no attempt to respond to the POPR that Han was expressly considered for substantially similar curvature arguments.*¹

The Examiner's prosecution arguments using Liu are substantially the same as the Petition's use of Han. Although Petitioner argues that “Han discloses *plate curvature* along both an Ax and Ay direction” (Reply, 8), Petitioner ignores that *the '335 Patent claims require edge curvature, not just plate curvature.* The Examiner

¹ At best, Petitioner states in passing that the Promethean Invalidity Contentions address “different claim limitations,” but fails to explain *any relevant differences*, let alone argue how the analysis is not substantially the same. Reply, 4-5.

relied on Liu's disclosures of a "concave surface" for curvature (POPR, 48) in the same way Petitioner relies on Han's alleged "concavely curved touch surface" (POPR, 49). ***But neither Liu nor Han disclose curvature on all four edges:***



As Petitioner concedes, Ax/Ay curvature refers to *plate* curvature (i.e., *surface* curvature). But the only possible disclosure in Han regarding *edges* are Figs. 3-4, 6-7, which, at best, shows ***no more than two*** possible curved edges—just like Liu. Thus, Han provides substantially the same argument as Liu that was overcome during prosecution with claims requiring that “all of the edges” are curved. POPR, 31-37, 47-49. This makes sense given that the Examiner expressly considered both Han and Promethean Invalidity Contentions that applied Han to limitations such as “the first edge is curved and the second edge is curved,” and nonetheless allowed the '335 Patent claims.² Ex. 2002, 5. *Advanced Bionics* Part 1 is satisfied.

² Although nothing more is required to show substantially similar arguments, the

(Footnote continued)

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

Once “the ‘same or substantially the same prior art’” or arguments were previously presented to the Office, the Board evaluates “whether Petitioner sufficiently demonstrates that the Office erred.” *Advanced Bionics*, IPR2019-01469, Paper 6, 20. ***Petitioner fails to develop any argument for Examiner error.***

The closest Petitioner ever comes to arguing Examiner error is a generic reference to the Petition's Grounds and expert report. Reply, 5 (“As evidenced by the arguments supporting the Petition's Grounds and the testimony of Dr. Cairns, a substantive consideration of Han, Cao, Zhao, and Shin by the Examiner should have resulted in an Office Action citing those references. *See generally* Petition; Ex. 1033.”). This is plainly insufficient to establish Examiner error. “To 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, Inc.*, IPR2021-01221, Paper 9, 25; *Google*, IPR2022-01197, Paper 18, 25

POPR also explains how the Petition arguments are substantially the same as the Examiner's evaluation of additional references. POPR, 44-52. Nor does Petitioner ever argue how its use of Zhao or Shin is not substantially the same. Reply, 6-7.

(“Petitioner points generically to 26 pages of its Petition and does not identify any specific evidence in support of its argument, and ... fails to explain how the expert testimony of record in this case serves to show, if at all, that the Examiner erred”).³

Contrary to situations where the examination record is not well-developed, the claimed curvature limitations were extensively discussed across *four* Office Actions, and the Examiner considered substantially the same art and arguments presented in this Petition. *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7, 19 (PTAB Nov. 8, 2022) (“Although there was no rejection [] over the particular references cited . . . [t]here is no evidence that suggests the Examiner overlooked the [] teachings in the art presented during prosecution.”). Moreover, even in other cases where examination is not well-developed, that alone is insufficient. Petitioner must apply *Becton Dickinson* factors (e) and (f) with specific arguments and evidence, which the record is devoid of here. *Google*, IPR2022-01197, Paper 18, 20-23.

Advanced Bionics Parts 2 is satisfied and the Board should deny institution.

³ Petitioner’s remaining arguments (Reply, 3) improperly collapse the institution standard into evaluation of examiner error. *Nespresso USA, Inc. v. K-free System GmbH*, IPR2021-01221, Paper 11, 22 (PTAB May 6, 2022) (Rehearing) (“[U]nder Petitioner’s theory, any analysis of § 325(d) would collapse into whether to institute on the merits, obviating the need for the *Advanced Bionics* framework.”).

Dated: March 18, 2024

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of March, 2024, a copy of the attached
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Case IPR2024-00014; Patent No. 11,281,335

Patent Owner's Preliminary Sur-Reply

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