

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHEMTRONICS USA, INC.,
Petitioner,

v.

FLATFROG LABORATORIES AB,
Patent Owner

Case: IPR2024-00015

U.S. Patent No. 10,775,935

PATENT OWNER'S PRELIMINARY SUR-REPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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I. 35 U.S.C. § 325(D) FAVORS DENIAL OF INSTITUTION

Petitioner's Reply concedes that Han was previously presented to the Office (satisfying *Advanced Bionics* Part 1). For allegedly "new" references, Petitioner manufactures irrelevant distinctions from the previously considered art, in order to mask that the Petition's arguments remain substantially the same to those considered by the Examiner. 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 Was Presented to the Office.

Petitioner does not dispute that Han—a referenced utilized in *every* Ground—was previously considered by the Examiner. POPR, 19-23; Reply, 1-2. Petitioner's challenge instead focuses on its inclusion of allegedly "new" references in the Grounds. Reply, 1-2. However, Petitioner "disregards the conjunctive 'or' that appears in [35 U.S.C. § 325(d)]. Where *either* the prior art references advanced *or* the arguments raised in a petition previously were presented to the Office, the inquiry shifts to whether the petitioner establishes a material error." *Nespresso USA, Inc. v. K-fee System GmbH*, IPR2021-01221, Paper 9, 12-13 (PTAB Jan. 18, 2022).

Here, (i) Han was expressly considered by the Office, (ii) the Petition's prior art combinations and corresponding arguments are substantially the same as those

overcome during prosecution, and (iii) Petitioner's allegedly "new" references (Cheng, Zhao, Cao, and Shin) offer nothing more than substantially the same disclosure as the art considered by the Examiner. *Dropworks, Inc. v. The Univ. of Chicago*, IPR2021-00100, Paper 9, 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."). Thus, *Advanced Bionics* Part 1 is satisfied for the Petition's art and arguments.

B. The Petition's *Arguments* Are Substantially the Same as Those Previously Considered.

Petitioner's Reply focuses almost exclusively on its position that Han presents allegedly new arguments over prior prosecution. Reply, 1-6. As an initial matter, Han was *expressly considered* by the Examiner, so it cannot be said that Han presents anything new. POPR, 19-23. Critically, Petitioner never substantively responds to the POPR's evidence that the Petition's *combinations* are substantially the same arguments as those considered by the Examiner. POPR, 24-30.

The Examiner utilized Kukulj for a touch surface and frame elements. POPR, 8-9; Ex. 1013, 505-508. The Examiner further utilized Kukulj for parabolic curvature. *Id.* However, the Examiner acknowledged that Kukulj did not teach *using the frame* to induce curvature, and then added Christiannson for its disclosure of inducing curvature in the touch surface. *Id.* The Examiner ultimately allowed the

claims over this combination, and Petitioner's arguments are substantially the same.

In fact, Petitioner's arguments are even more attenuated, requiring a third reference to reach the same concepts. Petitioner uses Cheng/Cao for the same frame elements as Kukulj. POPR, 24-25; Pet. 27, 73. Petitioner adds Han for a touch surface with parabolic curvature (like the Examiner's use of Kukulj's parabolic disclosure, as well as Christiannson's curvature). POPR, 25-29; Pet. 27, 73. Then Petitioner adds Zhao/Shin for using the frame to induce curvature, just like the Examiner's use of Christannson. *Id.* ***Petitioner's Reply never addressed that its arguments are substantially the same as those considered during prosecution.***

As shown below, even in isolation, each of the Petition's references are used substantially the same as previously considered art during examination.

1. *The Cheng/Cao Arguments are Substantially the Same.*

Petitioner argues that "Cheng and Cao are significantly different from Kukulj" because "Kukulj is directed to using parabolic reflectors." Reply, 6. But ***that is irrelevant*** because Petitioner does not use Cheng or Cao for satisfying "parabolic" limitations.¹ ***Instead, the Examiner's use of Kukulj is substantially similar to***

¹ Petitioner's citation for this point is inapposite because it is directed to a non-final rejection when the Examiner utilized Kukulj alone (Ex. 1013, 606-608), and before combining Kukulj with Christiannson (for inducing curvature). *Id.*, 505-508.

Petitioner's use of Cheng and Cao—i.e., teaching a touch surface with frame elements but without inducing curvature. Pet. 27, 73; Ex. 1013, 505-507.

Petitioner further asserts that “Cheng and Cao disclose frame elements not disclosed by Kukulj but which, alone or in obvious combination with the Petition’s other references, are present in the ’935 Patent’s claims. *See generally* Petition at Sections V.B and C.” Reply, 6. But Petitioner’s argument is perfunctory and devoid of ***any evidence***, let alone explanation of what particular frame elements are different from Kukulj in any manner that is relevant to the ’935 Patent claims. In fact, Petitioner cites the ***entirety of both Grounds*** and effectively asks the Board to scour these Grounds to dig up undisclosed differences between Kukulj and Cheng/Cao. Reply, 6. Petitioner’s attempt to improperly collapse § 325(d) analysis with the institution standard should be rejected. *Nespresso USA, Inc. v. K-fee 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.”). Thus, Cheng/Cao offer substantially the same arguments as prosecution. POPR, 24-30.

2. The Han Arguments Are Substantially the Same.

Despite the fact that Han was expressly considered by the Examiner (*supra*, II.A), Petitioner spends six pages of its Reply arguing that Han provides disclosure that was not previously considered.

Petitioner argues that “the Examiner’s previously considered Christiannson and Kukulj references do not disclose a touch screen parabolically curved in both an Ax and Ay direction. Han does.” Reply, 2-3. But that is irrelevant—the claims require that “configuring the frame assembly to support the plate includes *inducing* a parabolic curvature in the touch surface” (claim 1) and “the plate has a first curvature in the touch surface *when not installed* in the frame assembly, and wherein the plate has a second curvature along the width and along the length in the touch surface *when the plate is installed in the frame assembly*, said second curvature is parabolic” (claim 7). Petitioner uses Han *solely for parabolic curvature*, and never argues that Han discloses the claimed *frame inducing* curvature limitations. Pet. 40-41, 89. For this, Petitioner instead relies on a Zhao or Shin.

Thus, the Petition uses Han combined with Zhao/Shin in the same way the Examiner used Kukulj (for parabolic curvature) combined with Christiannson (frame inducing curvature). *Petitioner fails to address that these arguments are substantially the same as those considered by the Examiner.* POPR, 24-30.

Additionally, nothing about Han’s touch screen provides new disclosures for these limitations, which were a focus during examination. POPR, 14-15. Not only was Han considered by Examiner, but it discloses *shaping* the surface of the glass to be curved, *not inducing any curvature by the frame assembly*. Ex. 1005, [0074]-[0077]. Thus, Han’s “Ax and Ay direction” disclosure alone is irrelevant—like

Kukulj, Han lacks any disclosure of using the frame to induce curvature. Petitioner uses Zhao/Shin for that limitation, like the Examiner's use of Christiannson. Thus, the Petition's use of previously-considered Han is substantially the same as the arguments made during prosecution.²

3. *The Zhao/Shin Arguments are Substantially the Same.*

Zhao and Shin present substantially the same argument as the Examiner's use of Christiannson—all of these references are relied on for inducing curvature in the touch screen, and are combined with another reference allegedly disclosing the claimed frame elements (*e.g.*, Kukulj, Cheng, Cao). *Supra* II.B. Like Kukulj, which the Examiner also used for parabolic curvature, Petitioner utilizes Han. *Id.*

Although Petitioner argues that “Han *in combination with* i) Cheng and Zhao and ii) Cao and Shin . . . discloses the very elements PO concedes Christiannson does not: ‘. . . a frame assembly to support the plate including inducing a parabolic

² Petitioner spends an entire page of its Reply arguing that Patent Owner misreads the claims. Reply, 4. But it is Petitioner that clearly misunderstands Patent Owner's arguments. Nowhere does Patent Owner require any curvature “through the thickness of the plate.” *Id.* And while a frame inducing curvature in a touch surface would induce curvature on both surfaces, this is irrelevant because Han does not disclose a frame for inducing any curvature.

curvature in the touch surface” (Reply, 7), Petitioner *never disputes* that Zhao and Shin are used *in the exact same way* as how the Examiner used Christiannson during prosecution—to disclose inducing curvature, and combined with references disclosing the remaining frame elements. *Supra* II.B; POPR, 25-30; Pet. 27, 73.

Petitioner never identifies any relevant differences between how it combines Zhao/Shin with references such as Cheng/Cao and Han, versus how the Examiner used Christiannson with Kukulj. Petitioner simply makes the unsupported assertion that Grounds 1-2 are different because they use different references, and cites broadly to the entirety of both Grounds. Reply, 7. Petitioner has failed to rebut the POPR showing that Petitioner's *arguments* are substantially the same.

III. *ADVANCED BIONICS* PART 2 IS SATISFIED

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, LLC v. MED-EL Elek. Geräte GmbH*, IPR2019-01469, Paper 6, 20 (PTAB Feb. 13, 2020). *Petitioner fails to develop any argument for Examiner error.*

The closest Petitioner ever comes to arguing Examiner error is by stating its belief that the Petition arguments are “stronger.” Reply, 7 (without any citation to the Petition). 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 LLC v. Valtrus Innovations LTD*, IPR2022-01197, Paper 18, 25 (PTAB Jun. 13, 2023) (“Petitioner points generically to 26 pages of its Petition and does not identify any specific evidence in support of its argument, and furthermore fails to explain how the expert testimony of record in this case serves to show, if at all, that the Examiner erred”).

Further, contrary to situations where the examination record is not well-developed, the claimed “inducing a parabolic curvature in the touch surface” (POPR, 22) limitations were the focus during prosecution and the Examiner considered substantially the same art and arguments presented in this Petition with respect to that limitation. *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 is satisfied and institution should be denied under § 325(d).

Case IPR2024-00015; Patent No. 10,775,935
Patent Owner's Preliminary Sur-Reply

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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