

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDUCTEV, INC.
Petitioner,

v.

WITRICITY CORPORATION,
Patent Owner.

Case IPR2024-00105
Patent 10,027,184

**PATENT OWNER'S PRELIMINARY SUR-REPLY
TO PETITIONER'S PRELIMINARY REPLY**

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STATUTES

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**THE BOARD SHOULD DENY INSTITUTION UNDER
35 U.S.C. §325(D) AND *ADVANCED BIONICS***

Pursuant to the Board's authorizing email (Ex. 1034), Patent Owner submits this preliminary sur-reply to Petitioner's Preliminary Reply and shows the Board that it should exercise its discretion to deny institution under the *Advanced Bionics* two-part analysis and §325(d).

As highlighted in Patent Owner's Response, for each of its four grounds, Petitioner relies on Fells as its primary reference, either alone (Ground 1) or in combination with another reference (Grounds 2, 3, and 4). Petitioner does not assert that any of the claims of the '184 Patent are anticipated by Fells or any other reference. Instead, Petitioner only argues that the claims of the '184 Patent are obvious with Fells and the combination of a POSA or an additional reference.

I. *ADVANCED BIONICS* PART ONE: THE SAME OR SUBSTANTIALLY THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED TO THE USPTO.

In its Reply, Petitioner concedes that Fells and Cook were previously presented to the Office. In its Ground 1, Petitioner only relies on the Fells reference. In Ground 2, Petitioner relies on Fells in combination with Cook. As noted in Patent Owner's Preliminary Response, both Fells and Cook were before the Office during prosecution of the '184 Patent. Accordingly, *Advanced Bionics* Part One is met for Petitioner's Grounds 1 and 2. Petitioner does not contest this conclusion.

Regarding Grounds 3 and 4, the Petition only included one conclusory sentence stating that because the Ono (Ground 3) and Wang (Ground 4) references were not presented to the Office during prosecution of the '184 Patent, *Advanced Bionics* Part One was not met. Regarding Ground 3, in its Preliminary Response, Petitioner clearly states that Fells and Ono both disclose to a POSA the “enclosure housing” element of Claim 12: “A POSA would have understood that the dotted lines in Fells’ diagrams indicates an ‘integrated’ enclosure encompassing all components within the dotted lines” (Pet. Resp. at 62) and “Ono further teaches that the primary coil and detector coil are mounted inside of a ‘primary enclosure24’.” Pet. Resp. at 61. In its Preliminary Reply, Petitioner makes the nonsensical argument that because it argued that to the extent one suggests that Fells does not disclose an enclosure, then Ono makes the disclosure so the references are not substantially the same.

But for the purposes of the element for which Petitioner relies on Ono – an “enclosure housing” element of Claim 12 – Petitioner’s own argument states that they are substantially the same because Petitioner argues both Fells and Ono disclose the “enclosure housing” element of Claim 12.¹

¹Nothing in Patent Owner’s Preliminary Sur-reply should be construed as an admission by Patent Owner regarding what Petitioner contends the prior art references disclose related to the elements of the claims in the '184 Patent. Rather,

Moreover, Petitioner's Preliminary Reply also fails to address the fact that in its Petition, the Petitioner argues that Cook-086 also discloses a "housing" and therefore is substantially the same as Ono regarding the housing element. PO Preliminary Response at 9. Thus, for Petitioner's Ground 3, *Advanced Bionics* Part One is met.

Similarly, in Ground 4, Petitioner argues that Wang discloses the Claim 13 element requiring delivery of power in excess of 3.3 kW. But as explained in PO's Preliminary Response, Petitioner argued that Cook disclosed this same feature to a POSA. PO Preliminary Response at 10-11. So for the power feature for which Petitioner relies upon Wang, is the same or substantially the same as the references (Cook) previously considered by the Office.

II. *ADVANCED BIONICS* PART TWO: PETITIONER FAILED TO ASSERT OR SHOW A MATERIAL ERROR MADE BY THE EXAMINER.

Regarding Part Two of the §325(d) analysis, Petitioner's *entire* argument is *a single, conclusory sentence*: because Fells and Cook were not discussed during prosecution and were one of a number of prior art references, the Examiner must have overlooked disclosures in Fells (importantly, Petitioner does not make this

Patent Owner's arguments are that, based on what Petitioner claims the references disclose, the same or substantially the same prior art was previously considered by the Office.

argument regarding Cook). Petitioner's single, conclusory sentence does not meet its burden to demonstrate a material error by the Office. *See* PO Preliminary Response at 12-15. The Board has ruled consistently that mere silence regarding references presented to and considered during prosecution does not show material error by the Examiner. *Microsoft Corp. v. ThroughPuter, Inc.*, IPR2022-00757, Paper 10 at 21 (PTAB Nov. 1, 2022) (denying institution and rejecting petitioner's argument that the Office did not take substantive action showing consideration of cited art because "the lack of a rejection itself is not dispositive of whether there was material error.").

Moreover, even if one assumes *arguendo* that Fells and Cook individually disclose elements of the claims, this alone does not demonstrate material error. During prosecution, the Examiner allowed Claim 1 because none of the prior art of record discloses or suggests the claimed features *in combination*. The Examiner therefore did not find Claim 1 patentable because the Examiner overlooked Fells or Cook disclosing any one or more features now relied on in the Petition. Instead, the Examiner found the claims nonobvious over the prior art (including Fells and Cook) in any proper combination. *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 19 (PTAB Nov. 8, 2022) (exercising §325(d) discretion to deny petition

where petitioner failed to show material error as no rejection was issued over IPR references while each was before examiner or cumulative).²

Finally, ignoring Petitioner's conclusory, single sentence argument, the arguments and rationale explained in the file history of the '184 Patent and evidence provided in Patent Owner's Preliminary Response and herein establish that, at the very least, reasonable minds can disagree regarding the Patent Office's treatment of the cited art, including *Fells and Cook*. Hence, *Petitioner has not shown an error material to patentability. Advanced Bionics, LLC v. MED-EL Elek. Gerate GmbH*, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (“[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.”).

III. CONCLUSION

For the reasons explained above, both parts of the *Advanced Bionics* analysis confirm that the Board should exercise its discretion under §325(d) to deny institution.

² See also *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14, at 19 (PTAB Mar. 27, 2023) (exercising §325(d) discretion to deny petition where petitioner argued the references in the record were not discussed by the Examiner).

Dated: April 11, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that a copy of the *Patent Owner's Preliminary Sur-Reply to Petition* has been served on Petitioner as provided in 37 C.F.R. §42.6(e) via electronic mail transmission addressed to the persons at the address of record as follows:

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