

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

US CONEC LTD.,
Petitioner

v.

SENKO ADVANCED COMPONENTS, INC.,
Patent Owner

Case IPR2024-00119
Patent No. 11,415,760

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF PRELIMINARY
RESPONSE TO THE PETITION FOR INTER PARTES REVIEW**

TABLE OF CONTENTS

I.	The Pre-CIP Assignment Was Sufficient to Assign the ‘760 Patent.....	1
II.	The 2022 Assignment Is Irrelevant.....	4
III.	The '760 Patent is Entitled to the Earlier Priority	5
IV.	The So Called “Irregularities/Inconsistencies” in Wong Are Immaterial.....	6
V.	Patent Owner’s Additional Evidence Should Be Considered	6

TABLE OF AUTHORITIES

Page(s)

Cases

<i>DDB Techs., L.L.C. v. MLB Adv. Media, L.P.</i> , 517 F.3d 1284 (Fed. Cir. 2008)	2
<i>FilmTec Corp. v. Allied-Signal Inc.</i> , 939 F.2d 1568 (Fed. Cir. 1991)	2, 4
<i>Hulu, LLC v. Sound View Innovations, LLC</i> , Case IPR2018–01039, Paper 15 (PTAB Apr. 3, 2019)	1
<i>Regents of Univ. of New Mexico v. Knight</i> , 321 F.3d 1111 (Fed. Cir. 2003)	3
<i>Univ. of Rochester v. G.D. Searle & Co.</i> , 358 F.3d 916 (Fed. Cir. 2004)	6
<i>Univ. of West Virginia v. VanVoorhies</i> , 278 F. 3d 1288 (Fed. Cir. 2002)	3

Statutes

35 USC § 102	5
35 USC § 261	6

Other Authorities

37 CFR § 3.21	1
37 CFR § 42.23(b)	7
MPEP 302	6

EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Eric Pearson
2002	The New Oxford American Dictionary 2 ^{ed} Definition of “Slide”
2003	Webster’s New International Dictionary 2 ^{ed} Unabridged Definition of “Slide”
2004	Merriam-Webster’s Collegiate Dictionary 11 ^{ed} Definition of “Slide”
2005	File History U.S. Patent Application No. 15/044,838
2006	Recorded Assignment of U.S. Patent Application No. 14/521,414
2007	Recorded Assignment of U.S. Patent Application No. 14/996,865
2008	Declaration of Yoko Tanaka
2009	Jeffrey Gniadek Employment Agreement

Emphasis added throughout unless otherwise indicated

Petitioner has failed to carry its burden of proof that U.S. Patent No. 9,599,778 (“Wong”) qualifies as prior art.¹ The assignment from an ancestor application in the priority chain recorded in the ‘760 Patent was effective to assign the ‘760 patent, and Petitioner remarkably fails to cite any authority for its contrary position. As such, the subsequent “2022 Assignment” has no legal effect on the ownership of the previously assigned ‘760 Patent. Further, none of the purported errors in either the Wong or ‘760 Patent assignments prevented transfer of ownership.

I. The Pre-CIP Assignment Was Sufficient to Assign the ‘760 Patent

Petitioner does not articulate any legitimate dispute that the assignment recorded against the ‘760 Patent was from the great-grandparent to the ‘760 Patent—U.S. Pat. App. No. 14/996.865 (“the ‘865 Application”).² Further, the continuity of

¹ *Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018–01039, Paper 15 at 13 (PTAB Apr. 3, 2019) (finding that the “reasonable likelihood that the petitioner w[ill] prevail” standard for institution applies to the issue of whether the asserted references qualify as prior art).

² Petitioner argues that the Pre-CIP Assignment does not include the application number of the ‘865 Application and does not have the same title as the ‘760 Patent. Neglected from Petitioner’s argument was that the Pre-CIP Assignment met the requirements of 37 CFR § 3.21 as it accurately identified the title *of the* ‘865

the ‘760 Patent back to the ‘865 Application is clearly identified on the face of the ‘760 Patent and in the records of the Patent Office:

Continuity

Parent data						
Application #	Description	Parent application #	Filing or 371 (c) date	Status	Patent #	AIA
17/494,291	is a Continuation of	16/695,901	11/26/2019	Patented	11152748	Yes
16/695,901	is a Continuation of	16/213,244	12/07/2018	Patented	10520690	Yes
16/213,244	is a Continuation of	15/044,838	02/16/2016	Patented	10158194	Yes
15/044,838	is a Continuation in-part of	14/996,865	01/15/2016	Patented	9595786	Yes

Instead, the crux of Petitioner’s argument is that intervening continuations-in-part always require a new assignment, “notwithstanding any CIP language in the original assignment.” Reply: 2. Notably, Petitioner provides no authority for this argument, and for good reason—the argument is contrary to the precedent.

State law governs the interpretation of contracts generally, but the question of whether a patent assignment clause creates an automatic assignment of future patent applications has been found to be “intimately bound up with the question of standing in patent cases” such that there is a body of controlling federal case law. *DDB Techs., L.L.C. v. MLB Adv. Media, L.P.*, 517 F.3d 1284, 1289 (Fed. Cir. 2008). To be certain, “an assignment of an expectant interest [*i.e.*, an interest in future inventions or patent applications] can be a valid assignment.” *FilmTec Corp. v. Allied-Signal Inc.*, 939 F.2d 1568, 1573 (Fed. Cir. 1991) (“If the contract expressly grants rights in future inventions, ‘no further act [is] required once an invention [comes] into being,’ and

Application and was executed concurrently with the filing of that application.

‘the transfer of title [occurs] by operation of law.’”).

Likewise, written assignments that extended to continuation-in-part applications have indeed been considered enforceable. For example, both *Univ. of West Virginia v. VanVoorhies*, 278 F.3d 1288, 1292-94 (Fed. Cir. 2002) and *Regents of Univ. of New Mexico v. Knight*, 321 F.3d 1111, 1119-23 (Fed. Cir. 2003), enforced written assignments that extended to continuations and continuations-in-part.

Here, the Pre-CIP Assignment expressly and unmistakably assigned any continuations or continuations-in-part to Patent Owner:

“Assignor does hereby sell, assign, transfer and set over unto Assignee ... the entire right, title interest in and to said Invention as set forth in the above-mentioned application, **including** any applications which claim priority to the above referenced application, any applications to which the above referenced applications claim priority and **any continuations, continuations-in-part**, divisions, reissues, re-examinations or extensions thereof, and any and all patents of the United States and foreign countries which may be issued for said Invention. EX2007 (emphasis added).

By explicitly stating that it “hereby ... assign[ed]” any continuations and continuations-in-part, the Pre-CIP Assignment automatically transferred the rights to any latter continuations or continuations-in-part. The Pre-CIP Assignment was effective and by virtue of the assignment, ownership of the ‘760 Patent automatically vested in Patent Owner. Accordingly, the assignment provision quoted above applied to the ‘760 Patent and was effective at the time of filing of the application resulting in common ownership of the ‘760 Patent and Wong that bars Wong from

qualifying as prior art under 102(a)(2).

II. The 2022 Assignment Is Irrelevant

Because the Pre-CIP Assignment was effective, Mr. Gniadek was divested of any rights in the ‘760 Patent; thus rendering the 2022 Assignment immaterial as to the ‘760 Patent. *FilmTec*, 939 F.2d at 1573 (“Once the invention is made and an application for patent is filed, however, legal title to the rights accruing thereunder would be in the assignee ... and the assignor-inventor would have nothing remaining to assign.”). Accordingly, the 2022 Assignment submitted as Exhibit 1030 was entirely extraneous and has no legal effect with respect to the ‘760 Patent.

As relevant background the inventor from whom the 2022 Assignment was received—Mr. Gniadek—is extremely ill. EX2008: ¶7. Out of concern that Mr. Gniadek may become permanently incapacitated, a catch-all assignment was prepared for any IP that Mr. Gniadek had worked on in his career. EX2008: ¶8.

Contrary to Petitioner’s misleading spin, the 2022 Assignment clearly was a catch-all, confirmatory assignment.³ Rather than being directed specifically to the

³ Petitioner argues that the 2022 Assignment was not confirmatory by pointing out that a Patent Assignment Cover Sheet in a related case submitted the assignment as a “New Assignment.” Reply: 4-5. But as Petitioner readily admits elsewhere in its Reply, the “recording of the assignment is merely a ministerial act.” Reply: 6.

‘760 Patent or its patent family, the subject matter of the assignment was identified within a five-page long, single-spaced appendix listing in excess of 100 patent applications. Exhibit 1030.

Nor was the Assignment contradictory to the ‘760 Patent—or any other patent or patent application—having already been validly assigned to Patent Owner. The 2022 Assignment expressly acknowledged there was “an obligation of assignment of each invention ... at the time the invention was made.” EX1030; *see also* EX2009: 2(b) (employment agreement clause obligating assignment).⁴ The 2022 Assignment also acknowledged that the listed patent applications may have already been assigned by including an exception to his representations and warranties for “any rights, titles and/or interests that have arisen to Assignee under law or that have already been transferred to Assignee.” EX1030.

III. The ‘760 Patent is Entitled to the Earlier Priority

Petitioner raises an argument regarding the use of the word “slideably” injecting new matter in the ‘760 Patent. The POPR adequately explained the basis for support for the use of the word “slideably” in the claims, including by reference to figures that were submitted with the ‘865 Application. POPR: 9-10. Petitioners

⁴ Under 35 USC § 102, merely being “subject to an obligation of assignment” is enough to qualify for the Subsection (b)(2)(C) exception.

arguments go to whether Section 112 requires *in haec verba* support in the specification, rather than ownership. See *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920 (Fed. Cir. 2004) (finding *in haec verba* description not required).

IV. The So Called “Irregularities/Inconsistencies” in Wong Are Immaterial

In yet an additional attempt to muddy the waters, Petitioner identifies further petty “irregularities/inconsistencies” in the Wong Assignment—Exhibit 2006. Petitioner points out that one of the execution pages lacked notarization and included a typed, rather than handwritten date. But none of 35 USC § 261, MPEP 302, nor any other authority requires notarization and a handwritten date for an assignment to be effective. Petitioner also points out that the assignment was not immediately recorded, but again the recording of the assignment is merely a ministerial act and there is no legal obligation to file ownership records with the Patent Office.

V. Patent Owner’s Additional Evidence Should Be Considered

Petitioner had nearly a year to develop the invalidity grounds it raised in its Petition. Petitioner decided to do so by relying on a patent that on its face indicated it was owned by the Patent Owner. Petitioner had the burden of proof to establish that its asserted references qualified as prior art as part of its *prima facie* case for unpatentability. Petitioner failed to address the readily apparent common ownership within its Petition.

Contrary to Petitioner’s out of context quote, Patent Owner did not express

that it “d[id] not have a full explanation” for the absence of discussion regarding the 2022 Assignment in the POPR. Patent Owner takes its duty of candor serious, but is unaware of any duty to comb the record of each patent within the ‘760 Patent’s family to invent artificial inconsistencies. Even had Patent Owner recognized there was a superfluous assignment absent from the ‘760 Patent’s assignment records, there still would have been little reason to address it. It was the Pre-CIP Assignment that was in effect as of “the effective filing date of the claimed invention” and the 2022 Assignment was 100% consistent with the Pre-CIP Assignment.

The Board’s email granting additional pre-institution briefing did not address whether additional evidence was permitted. Petitioner took this silence as permission to submit additional evidence—namely Exhibits 1029 and 1030. Now Petitioner has the audacity to suggest that after it presented new argument **and additional evidence** necessary to establish its *prima facie* case for unpatentability, Patent Owner should be barred from responding in kind.⁵

Patent Owner does not object to the submission of Exhibit 1030, but due process demands that Patent Owner be permitted its opportunity to respond by having its own additional evidence considered.

⁵ It is unclear that 37 CFR § 42.23(b) is applicable as pre-institution sur-replies are outside the contemplation of the rules.

Dated: May 17, 2024

Respectfully submitted,

/Kurt F. James/

Kurt F. James, Reg. No. 33,716

STINSON LLP

7700 Forsyth Boulevard, Suite 1100

St. Louis, MO 63105

T: 314-345-7010; F: 314-863-9388

Email: kurt.james@stinson.com

*Counsel for Patent Owner, Senko Advanced
Components, Inc.*

CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e), the undersigned certifies that on May 17, 2024, a copy of the foregoing PATENT OWNER'S SUR-REPLY IN SUPPORT OF PRELIMINARY RESPONSE TO THE PETITION FOR INTER PARTES REVIEW, along with the supporting exhibits, were served via email on the following:

Jason D. Eisenberg (Reg. No. 43,447)
Ian Soule (Reg. No. 74,290)
Yangbeini Wang (Reg. No. 80,005)
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1101 K Street NW
Washington, DC 20005
T: 202-371-2600
F: 202-371-2540
jasone-PTAB@sternekessler.com
isoule-PTAB@sternekessler.com
bwang-PTAB@sternekessler.com
PTAB@sternekessler.com

By: /Kurt F. James/
Lead Counsel for Patent Owner
Kurt F. James
Reg. No. 33,716