

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**JIANGSU FAVORED NANOTECHNOLOGY CO., LTD.,**

**Petitioner**

**v.**

**P2I LTD.,**

**Patent Owner**

**Case No. IPR2024-00380  
U.S. Patent No. 11,041,087**

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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**LIST OF EXHIBITS**

| <b>EXHIBIT NO.</b> | <b>TITLE</b>                                                                      |
|--------------------|-----------------------------------------------------------------------------------|
| 1001               | U.S. Patent No. 11,041,087 (“’087 Patent”)                                        |
| 1028               | Petitioner’s “excerpted” File History for U.S. Patent No. 11,041,087              |
| 2001               | October 8, 2020 IDS and references, as submitted in the ’087 patent (Part 1 of 2) |
| 2002               | October 8, 2020 IDS and references, as submitted in the ’087 patent (Part 2 of 2) |
| 2003               | December 20, 2020 IDS and references, as submitted in the ’087 patent             |
| 2004               | IPR Petition IPR2020-01198 (“–01198 Petition”)                                    |
| 2005               | Patent Owner’s Preliminary Response in IPR2020-01198                              |
| 2006               | Decision of institution in IPR2020-01198                                          |

## **I. INTRODUCTION**

Patent Owner P2i respectfully submits this Preliminary Response to Petitioner Jiangsu Favored's Petition. Institution should be denied under 35 U.S.C. § 325(d) because the Petition relies *exclusively* on art and arguments that were already before the Office and there was no material error during prosecution.

Before issuing a first Office Action, the Examiner reviewed another IPR proceeding (IPR2020-01198) initiated with respect to the '087 Patent's parent. In that proceeding, two (of three) of Petitioner's references – and the substance of Petitioner's arguments – were presented. These references – and the arguments Petitioner advances based on them here – were then considered by the Examiner *multiple times* during prosecution of the '087 Patent.

By this Petition, Petitioner seeks to *again* rehash art and arguments that were presented and considered during examination. At bottom, Petitioner second guesses the Examiner's reasonable evaluation of these references and arguments. But where (as here) reasonable minds can disagree, no *material* error is present and § 325(d) directs the Board to defer to the Examiner and deny institution.

For these reasons, and others presented below, the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny the Petition.

## **II. RELEVANT PROSECUTION HISTORY**

The '087 Patent was filed on August 22, 2019 as a continuation of U.S. Patent

No. 10,421,876 (the “’876 Patent”). Ex. 1028 (’087 Patent File History) at 34.

On July 20, 2020, Petitioner sought review of the ’876 Patent in IPR2020-01198. Ex. 2004 (Petition for IPR2020-01198; the “–01198 Petition”). The –01198 Petition outlined multiple grounds for institution, including (as relevant here) based on the Cohen and Francesch references. *Id.* at 31-34 (Ground 1, relying on Cohen) and 57-58 (Ground 4, relying on Francesch).

In or about September 2020, the Examiner began examination of ’876 Patent. Ex. 1028 at 155. That included a “review” of IPR2020-01198, including the –01198 Petition:

|                                                                                                                   |                                              |                                                                  |
|-------------------------------------------------------------------------------------------------------------------|----------------------------------------------|------------------------------------------------------------------|
| <b><i>Search Notes</i></b><br> | <b>Application/Control No.</b><br>16/547,728 | <b>Applicant(s)/Patent Under Reexamination</b><br>COULSON et al. |
|                                                                                                                   | <b>Examiner</b><br>NICOLE M BUIE-HATCHER     | <b>Art Unit</b><br>1767                                          |

| <b>Search Notes</b>                                                    |             |                 |
|------------------------------------------------------------------------|-------------|-----------------|
| <b>Search Notes</b>                                                    | <b>Date</b> | <b>Examiner</b> |
| Inventor name search, DAV and PE2E Search                              | 09/10/2020  | NMB             |
| Reviewed appln 15/735130                                               | 09/10/2020  | NMB             |
| IPR2020-01198 Reviewed Inter Partes Review of US Patent No. 10,421,876 | 09/10/2020  | NMB             |
| Global Dossier                                                         | 09/10/2020  | NMB             |
| Scifinder. see search history                                          | 09/10/2020  | NMB             |

*Id.*

On September 18, 2020, the Examiner issued a first Office Action, rejecting most of the pending claims based on a proposed combination of four references. *Id.*

at 145-150.

On October 8, 2020, P2i submitted an IDS. *Id.* at 196-199. As relevant here, this IDS cited Cohen, Legein, and Francesch (the references cited in this Petition). It also cited and attached a copy of the –01198 Petition. *Id.*; Ex. 2001 (full copy of October 8, 2020 IDS) at 8-97.

On December 15, 2020, P2i submitted an amendment in response to the Office Action. Ex. 1028 at 213-221. An IDS was also filed, citing and attaching additional submissions from IPR2020-01198. *Id.* at 231-232; Ex. 2003 (full copy of December 15, 2020 IDS) at 31-226.

On or about December 18, 2020, the Examiner (further) considered Cohen, Legein, Francesch, the –01198 Petition, and the other submissions from IPR2020-01198. Ex. 1028 at 255-261 (“Date Considered 12/18/2020”)

On December 30, 2020, the Examiner issued a Notice of Allowance. *Id.* at 241-248.

On March 24, 2021, P2i submitted an IDS with additional documents from IPR2020-01198, including the Board’s decision of institution. *Id.* at 267-269; Ex. 2006 (full copy of Board’s decision in IPR2020-01198, as submitted in the March 24, 2021, IDS).

On March 29, 2021, the Examiner considered the Board’s decision (Ex. 1028 at 279) and, on April 5, 2021 issued another Notice of Allowance (*id.* at 276-277).

On May 5, 2021, P2i submitted an IDS with further documents from the IPR2020-01198 proceeding. *Id.* at 281-283. The Examiner considered these documents and issued yet another Notice of Allowance. *Id.* at 298-301. The '087 Patent then issued. *Id.* at 304.

### III. LEGAL STANDARD

Institution of inter partes review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). 35 U.S.C. § 325(d) provides that the Director may elect not to institute a proceeding when a petitioner raises “the same or substantially the same” art or arguments the USPTO has previously considered. *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph).

The Director will discretionarily deny institution when two conditions are satisfied: (1) “the same or substantially the same art previously was presented to the Office” or “the same or substantially the same arguments previously were presented to the Office”; and (2) the petitioner does not “demonstrate[] that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 13, 2020) (precedential).

In applying the *Advanced Bionics* two-part framework, the Board considers a

number of non-exclusive factors, as set forth in *Beckton, Dickinson*, IPR2017-01586, Paper 8 at 17-18 (the “Becton, Dickinson factors”):

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

For part one of the *Advanced Bionics* two-part framework, the Board evaluates Becton, Dickinson factors (a), (b), and (d). *Advanced Bionics*, Paper 6 at 10. If it is determined that the same or substantially the same art or arguments were previously presented to the USPTO, the Board then considers Beckton, Dickinson factors (c), (e) and (f) in part two of the *Advanced Bionics* framework. *Id.*

Factors (a), (b), and (d) relate to whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether

the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.*

Only if the same or substantially the same art or arguments were previously presented to the Office will the Board consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

#### **IV. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(D)**

Section 325(d) directs that denial is warranted when the same art *or* arguments were presented during prosecution. Here *both* were considered *multiple times* during prosecution.

Moreover, the Petition fails to show any *material* error by the examiner. At best, the Petition rehashes arguments that were previously presented to the Office and on which reasonable minds can disagree. Petitioner’s disagreement with the Examiner’s reasonable conclusions is not a material error.

Absent such error, *Advanced Bionics* directs the Board to defer to the Examiner’s evaluation. The Petition should therefore be denied.

##### **A. *Advanced Bionics* Part I – The Office Considered the Same Prior Art or Arguments During Prosecution**

Part one of the *Advanced Bionics* framework is easily met because the three references relied upon in the Petition were all considered during prosecution.

## 1. The Office Considered the Same Prior Art

*All* of Petitioner’s references – Cohen, Legein, and Francesch – appear on the face of the ’087 Patent. Ex. 1001 at 1-2. All were thus presumptively considered during prosecution. *Shire LLC v. Amneal Pharms., LLC*, 802 F.3d 1301, 1307 (Fed. Cir. 2015).

Moreover, “[p]reviously presented art includes... art provided to the Office... on an Information Disclosure Statement (IDS)[.]” *Advanced Bionics*, Paper 6 at 7–8. *All* of Petitioner’s references were cited in an IDS during prosecution of the ’087 Patent. Ex. 1028 at 196 (citing Cohen), 198 (Legein and Francesch). The Examiner also initialed each reference, indicating it had been considered. *Id.* at 257, 259.<sup>1</sup>

This alone satisfies part one of the *Advanced Bionics* framework. Yet it is notable that during prosecution the Office also considered substantially the same *arguments* as Petitioner advances here:

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<sup>1</sup> References need not be applied in a rejection to have been previously presented to the Office. *See, e.g., Apotex Inc. v. Auspex Pharms., Inc.*, IPR2021-01507, Paper 9 at 25 (PTAB Mar. 9, 2022) (“A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office.”).

## **2. The Office Considered Substantially the Same Arguments**

In addition to considering Petitioner's references during prosecution, the Office was presented with substantially the same *arguments*.

While the '087 Patent was awaiting examination, Petitioner initiated an IPR proceeding as to the '087 Patent's parent (U.S. Patent 10,421,876; the "'876 Patent"). Ex. 2004 (Petition for IPR2020-01198; the "–01198 Petition").

The –01198 Petition (and its underlying arguments) was considered by the Examiner *before* issuing the first Office Action on the '087 Patent. *See* Ex. 1028 at 55 (Examiner's "Search Notes," showing that on September 10, 2020, the Examiner "reviewed" IPR2020-01198). The –01198 Petition was also cited in an IDS and was considered *again* during prosecution of the '087 Patent. Ex. 1028 at 259 (citing petition for IPR2020-01198).<sup>2</sup> Later, the Examiner twice considered additional documents from IPR2020-01198 (including the Board's decision of institution), issuing a Notice of Allowance in both instances. Ex. 1028 at 276-279, 298-301.

Notably, the –01198 Petition relied on two of the three references – Cohen

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<sup>2</sup> Petitioner's submission did not include copies of the underlying documents from IPR2020-01198. P2i attaches them here as Exs. 2004 (Petition in IPR2020-01198), 2005 (Patent Owner's Preliminary Response in IPR2020-01198) and 2006 (Board's Decision of Institution in IPR2020-01198).

and Francesch – that Petitioner relies upon here. *See* Ex. 2004, e.g., at 31-34 (Ground 1, relying on Cohen) and 57-58 (Ground 4, relying on Francesch).

More specifically, the –01198 Petition cited Cohen with respect to its teaching of “divinyl tetramethyl disiloxane (DVTMDS)” as a “crosslinking reagent.” Ex. 2004 at 31-34. Petitioner cites Cohen here for the *same* purpose. *See, e.g.*, Petition at 31 (“Cohen described crosslinked copolymers made using the crosslinking reagent DVTMDS...”).

Similarly, the –01198 Petition cited Francesch for its teaching of “polymer coatings... that could subsequently be used to attach a biotin ligand for versatile surface functionalization... [t]he disclosed copolymer coatings were produced by plasma polymerization using a fluorinated methacrylate (pentafluoro-phenyl methacrylate) [(“PFM”)] with BDVE as a crosslinker.” Ex. 2004 at 57-58.<sup>3</sup> Here, Petitioner cites Francesch for the same: “Francesch described using plasma deposition to apply crosslinked polymeric coatings to silicon wafers using a hydrophobic aryl acrylate monomer (PFM) and two different crosslinkers (BDVE and 1,7-octadiene).” Petition at 47.

Accordingly, not only were all of Petitioner’s *references* considered during

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<sup>3</sup> The -01198 Petition further notes that “The other crosslinker Francesch described [is] 1,7-octadiene[.]” Ex. 2004 at 58 n.6. *Cf.* Petition at 47.

prosecution of the '087 Patent, but in two (of three) instances, substantially the same *arguments* were presented as well.

The Petition thus satisfies part one of the *Advanced Bionics* framework by any standard.

**B. *Advanced Bionics* Part II – No Material Error**

Since the Office previously considered the same art and arguments, the Board should deny the Petition unless the Petitioner shows material error in the Office's prior consideration. *Advanced Bionics* at 8-9.

Here, Petitioner makes no showing of material error. At best, Petitioner highlights an issue about which reasonable minds can disagree and disputes the Examiner's conclusion. That is no "material error" and *Advanced Bionics* directs the Board to exercise its discretion to deny the Petition under such a circumstance.

**1. The Office Was Absolutely "Aware" of Cohen and Francesch, as Well as Petitioner's Arguments**

As outlined above, not only were substantially the same arguments (with respect to Cohen and Francesch) previously presented, but the Examiner also considered them *several times*. Ex. 1028 at 55 (Examiner "reviewed" IPR2020-01198 before issuing first Office Action); *id.* at 259 (Examiner *again* considering the -01198 Petition, including substantially the same arguments presented here with respect to Cohen and Francesch).

As also noted, part one of the *Advanced Bionics* framework is undisputedly

met. The inquiry thus shifts to “whether petitioner has demonstrated a material error by the Office.” *Advanced Bionics* at 10.

On this front, Petitioner barely musters a response.<sup>4</sup> It argues in passing that “there was error during prosecution” and claims the Examiner “was simply not aware” of the teachings of Cohen, Legein, and Francesch. Petition at 61-62.

But, as outlined above, this is not only implausible but *false*. The Examiner independently considered the –01198 Petition (containing the substance of Petitioner’s arguments as to Cohen and Francesch) *before* issuing the first Office Action (and, again, prior to issuing a Notice of Allowance). Ex. 1028 at 55. Moreover, *all* of Petitioner’s references were presented to and considered by the Examiner. *Id.* at 196-199.

Instead, Petitioner takes issue with the Examiner’s conclusions regarding these references and arguments. But where (as here) reasonable minds can disagree

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<sup>4</sup> Notably, though Petitioner purports to address § 325(d) (Petition at 60-62), the Petition conspicuously fails to cite *Advanced Bionics*. As detailed below, “[t]his is a case where reasonable minds can differ[.]” *Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2021-01223, Paper 9 at 31 (PTAB Jan. 18, 2022). As such, “the paucity of analysis provided by Petitioner in the Petition tips the scales in favor of a discretionary denial.” *Id.* (denying institution based on § 325(d)).

concerning the treatment of art or arguments, no “material error” is present.

**2. There Was No Material Error Because, at Minimum, Reasonably Minds Can Disagree Concerning Cohen and Francesch**

“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* at 9. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.*

During the IPR2020-01198 proceeding, P2i argued that Cohen and Francesch were non-analogous art (and thus could not be cited in an obviousness rejection). *See* Ex. 2005 (P2i’s Preliminary Response in IPR2020-01198) at 42-44 (Cohen is non-analogous art), 45-46 (Francesch is non-analogous art).

In its decision in IPR2020-01198, the Board carefully considered P2i’s arguments (as well as Petitioner’s arguments in opposition – *see* Ex. 2003 at 220-223) and ultimately *took no position on the issue*. Ex. 2006 at 17-20 (considering whether Cohen was non-analogous art), 39-40 (considering whether Francesch was non-analogous art). And though the Board granted institution in IPR2020-01198 (consistent with the standard it was required to apply at that juncture), in both instances it “encourage[d] the parties to develop the record further on this point during trial.” *Id.* at 20, 40.

The Board’s rejection of Petitioner’s arguments in IPR2020-01198 that Cohen and Francesch unquestionably qualified as analogous art (and instead directing the parties to “develop the record further”), reinforces that, at minimum, *reasonable minds can disagree* on the issue. And, as noted above, the Examiner undisputedly considered the IPR2020-01198 proceedings – as well as Cohen and Francesch – on *multiple occasions* during prosecution of the ’087 Patent. Having undertaken such consideration, the Examiner nevertheless allowed the ’087 Patent. In doing so, the Examiner concluded that Cohen and Francesch were non-analogous art.

Petitioner, of course, takes issue with the Examiner’s conclusion. But, in view of the Board’s decision in IPR2020-01198, this conclusion – again, that Cohen and Francesch were non-analogous art – was an issue on which, at minimum, reasonable minds can disagree. Were that not the case, the Board could have easily sided with Petitioner on the issue. Instead, the Board markedly took *no position*, acknowledging the potential merits of P2i’s position as well. This reinforces that, at minimum, reasonable minds can – and do – disagree on this issue. It was therefore reasonable for the Examiner to conclude that Cohen and Francesch were non-analogous art.

Doing so was no error, but, in any event, was no *material* error. And without such a material error, *Advanced Bionics* directs the Board to “to defer to previous Office evaluations of the evidence of record[.]” *Advanced Bionics* at 9.

**V. CONCLUSION**

For the foregoing reasons, the Board should exercise its discretion to deny institution of trial.

Respectfully submitted,  
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Dated: April 22, 2024

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**CERTIFICATE OF WORD COUNT**

The undersigned hereby confirms that the foregoing Patent Owner's Preliminary Response complies with the type-volume limitation of 37 C.F.R. § 42.24(a). Excluding the items listed in 37 C.F.R. § 42.24(a) as not included in the word count, this Response contains less than 14,000 words, calculated by the word-processing system used to prepare it.

Dated: April 22, 2024

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the foregoing document was electronically served on April 22, 2024 on Petitioner, who has consented to service by electronic means.

Respectfully submitted,  
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