

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIANGSU FAVORED NANOTECHNOLOGY CO., LTD.,

Petitioner,

v.

P2I LTD.,

Patent Owner.

CASE: IPR2024-00380
Patent No. 11,041,087

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

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Pursuant to the Board’s Order (Paper 6), Petitioner submits this Reply to Patent Owner’s (“PO”) § 325(d) arguments in its Preliminary Response (“POPR”).

I. INTRODUCTION

As the Petition stated (Paper 1 at 60-62), the Cohen, Francesch, and Legein references were not substantively addressed during prosecution. Accordingly, Petitioner’s persuasive showing that these references render obvious the challenged claims is sufficient to show material error under *Advanced Bionics* and its progeny. PO’s arguments to the contrary misapply the law and should be rejected.

II. ARGUMENT

A. The POPR Distorts and Misapplies *Advanced Bionics*

Advanced Bionics explains that the second step of the Section 325(d) framework involves analysis of *Becton, Dickinson* “factors (c), (e), and (f) [to determine] whether the petitioner has demonstrated a material error by the Office.” IPR2019-1469, Paper 6 at 9-10 (Feb. 13, 2020) (precedential). Though PO acknowledges this “legal standard” (Paper 5 at 5), it disregards the *Becton, Dickinson* factors entirely in disputing material error. *See id.* at 10-13. Rather than address the relevant factors, PO argues no material error was made because “reasonable minds can disagree” about the significance of the prior art references. *Id.* PO’s approach, which intentionally ignores *the degree to which the prior art was substantively*

addressed during prosecution, is plainly contrary to *Advanced Bionics* and the four-plus years of Board decisions applying it.

**B. Petitioner Has Sufficiently Demonstrated “Material Error”
Under Part Two of the *Advanced Bionics* Framework.**

5 “*Advanced Bionics* recognizes that the showing of material error necessary to satisfy the second step of the framework varies, *depending on the degree to which the previously-presented art was substantively addressed* by the Office.” *Quasar Science, LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10 at 14 (Oct. 10, 2023) (emphasis added).

10 The Petition explained that “none of [the Cohen, Francesch, and Legein] references were ever used in a rejection or even mentioned by the examiner.” Paper 1 at 60. PO could not and did not dispute this in its POPR. Moreover, PO disclosed these references via IDS only *after* the examiner had already indicated allowable subject matter. *Id.* at 60. *See, e.g., Home Depot USA, Inc. v. Lynk Labs, Inc.*,
15 PGR2023-00016 at 35-36, Paper 8 at 36 (Aug. 4, 2023) (noting in addressing factor (c) that relevant IDS was filed only after initial notice of allowance).

Unable to show that the examiner substantively addressed the Cohen, Francesch, and Legein references, PO emphasizes its disclosure of certain documents from an IPR proceeding on related U.S. Patent No. 10,421,876 (the “’876 patent”)
20 where Cohen and Francesch were used in certain obviousness combinations. *See* Paper 5 at 12-13. The ’876 claims did not require using aryl monomers and were

therefore materially different from the '087 claims at issue here.¹ More importantly, like the Cohen, Francesch, and Legein references themselves, the '876 IPR documents were never substantively addressed during prosecution of the '087 patent. *See* Ex. 1028 ('087 file history). Accordingly, the '876 IPR documents do not undercut Petitioner's showing of material error. *See Advanced Bionics*, Paper 6 at 10 ("If the record of the Office's previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive.").

PO invites the Board to **assume** that the examiner must have "concluded that Cohen and Francesch were non-analogous art" because PO made that argument in the '876 IPR proceeding and the institution decision invited the parties to address that issue further during the trial. *See* Paper 5 at 13. But PO points to **nothing** in the '087 file history that shows the examiner zeroed in on that particular argument from the IPR documents—let alone accepted it—and PO's self-serving assumption is therefore unwarranted. Notably, PO does not even attack Cohen and Francesch as non-analogous art in its POPR **in the present case**, presumably because those

¹ The '876 IPR petition, unsurprisingly, did not discuss aryl monomers. *See* Ex. 2004. Accordingly, PO's contention that the "same arguments" were previously considered by the Office is plainly incorrect. *See* Paper 5 at 8-10.

references taught polymer production using the same crosslinkers and aryl monomers recited in the '087 patent's claims.

“Where, as here, the Office has not substantively addressed prior art other than an Examiner initialing an IDS ..., the petitioner may show material error by showing that the Office failed to reject the claims over the asserted art.” *Quasar*, Paper 10 at 14. The Petition here made that showing by demonstrating that the prior art renders obvious the challenged claims. *See, e.g., Chemtronics USA, Inc. v. Flatfrog Labs AB*, IPR2024-00014, Paper 11 at 25-26. (Apr. 22, 2024) (“[R]elevant to [*Becton, Dickinson*] factor (f), the evidence presented in the Petition is meritorious, which further demonstrates that the combination of the cited prior art was overlooked during prosecution.”); *Quasar*, IPR2023-00611, Paper 10 at 15 (relying on petitioner’s showing a reasonable likelihood that the challenged claims were unpatentable “to conclude that the Office’s prior failure to apply these references against the pending claims was an error that was material to the patentability of these claims”). The POPR contains ***no arguments challenging the merits*** of either invalidity ground set forth in the Petition. *See* Paper 5.

Additionally, with respect to *Becton, Dickinson* factor (e), the examiner suggested that the prior art did not teach or suggest the specifically recited crosslinkers as a reason for indicating allowable subject matter. Paper 1 at 61 (citing Ex. 1028 at 150-151). The Petition directly attacked that assessment of the prior art, noting

that “Cohen and Francesch taught ... using aryl acrylate monomers *with crosslink-
ing reagents covered by the '087 claims*” Paper 1 at 61 (emphasis added). PO
has not disputed that point. Although the examiner’s explanation preceded the Oc-
tober 2020 IDS disclosing Cohen and Francesch, the examiner never provided
5 modified or alternative reasons for allowance in recognition of Cohen’s and Fran-
cesch’s teachings. *See* Ex. 1028. This further indicates the examiner overlooked
the key disclosures of the Cohen and Francesch references.

In *Chemtronics*, the Board found that the petitioner demonstrated that a ref-
erence (Han) presented during the original prosecution disclosed a feature the ex-
10 aminer specifically suggested was lacking in the prior art. IPR2024-00014, Paper
11 at 19. As a result, the Board reasoned that *Becton, Dickinson* factors (c) and (f)
weighed against discretionary denial. *Id.* Similarly here, factors (c) and (f) weigh
against denying institution because Cohen and Francesch expressly disclose what
the examiner concluded was lacking in the prior art.

15 **III. CONCLUSION**

For the reasons set forth above and in the Petition (*see* Paper 1 at 60-62),
each of *Becton, Dickinson* factors (c), (e), and (f) shows that the second part of the
Advanced Bionics framework is not met here and discretionary denial under Sec-
tion 325(d) would be improper.

Dated: May 9, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of this **PETITIONER'S
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