

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

PATENT OWNER'S REPLY

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
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TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. ARGUMENT.....	1
A. Petitioner Overlooks The Entirety of the Prosecution History	1
B. The Office <i>Did</i> Consider Petitioner’s References; The Record is <i>Not</i> Silent on This Front	2
C. Petitioner Merely Contests the Examiner’s Reasonable Judgement and Thus Fails to Establish “Material Error”	4
III. CONCLUSION.....	5

I. INTRODUCTION

Petitioner concedes that institution should be denied under § 325(d) absent a showing of “material error.”¹ But the Examiner was well aware of the references Petitioner relies on and most of the arguments it advances here. In the words of another Panel, the record reflects that it is “highly unlikely” that the Examiner (repeatedly) overlooked these references and arguments.

At bottom, Petitioner takes issue with the Examiner’s conclusion on an issue on which reasonable minds can disagree. This is not “material error” and *Advanced Bionics* directs the Board to defer to the Examiner’s reasonable conclusion. Institution should therefore be denied under § 325(d).

II. ARGUMENT

A. Petitioner Overlooks The Entirety of the Prosecution History

Petitioner emphasizes that its references at issue were formally cited in an IDS after the first Office Action issued (which indicated allowable subject matter). Reply at 2. But, as Patent Owner demonstrated in the POPR, the Examiner “reviewed” IPR2020-01198 in September 2020, *before* issuing the first Office Action. POPR at 2; Ex. 1028 at 155.

¹ “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute inter partes review.” *Advanced Bionics*, 8–9.

At that time, the entirety of the record of IPR2020-01198 that the Examiner reviewed consisted of the Petition and its accompanying references. The Examiner’s “review” – which, again, preceded any IDS – by definition encompassed each of references cited in this Petition *and* the substance of Petitioner’s arguments as to Cohen and Francesch. *See* POPR at 7-9.

Petitioner further overlooks that – in addition to (re-)considering the references (when cited in an IDS after the first Office Action), the Examiner further considered the substance of their contents when the references were substantively analyzed in the contents of further IDS’s. *See* POPR at 3-4, 8-9 (recounting multiple additional IDS filings containing submissions from IPR2020-01198 and directed to the substance of Cohen and Francesch).

B. The Office *Did* Consider Petitioner’s References; The Record is *Not* Silent on This Front

Petitioner draws the Board’s attention to *Becton, Dickinson* factor (c) which considers whether “the record of the Office’s previous consideration of the art is not well developed or silent[.]” Reply at 2-3. Here, the record is anything but. As outlined above, the Office carefully considered the references at issue (and the bulk of Petitioner’s arguments) in IPR2020-01198. And the Examiner independently reviewed the record, and the underlying references and submissions on *multiple* other occasions. Far from being “silent,” the record reflects the Office’s

consideration of these issues on multiple occasions across multiple proceedings.

In comparable scenarios, other Panels have found that when it is “highly unlikely” an Examiner simply overlooked certain references, discretionary denial under § 325(d) is appropriate *even when the references are not substantively addressed in an Office Action*.

For example, In IPR2022-00853, “Petitioner argue[d] that the Examiner erred because... the references relied upon... were... merely cited in an IDS[.]” *Miltenyi Biomedicine GmbH v. University of Pennsylvania*, No. IPR2022-00853, Paper 11 at 45 (P.T.A.B. Oct. 11, 2022). Nevertheless, the Panel rejected this argument and denied institution under § 325(d) because the references were “discussed at length” during prosecution of the parent application, by the same Examiner. *Id.* at 46-47. In such a context, the Panel found it “highly unlikely that the Examiner was unaware of” the references. *Id.*²

So too here. The record reflects that the Examiner was well aware of each of

² See also *Fitesa Simpsonville, Inc. v. Procter & Gamble Co.*, No. IPR2023-01450, Paper 11 at 20 (P.T.A.B. Mar. 20, 2024) (denying institution under § 325(d) where references were substantively addressed during prosecution of parent application: “[W]e find the evidence of record insufficient to establish that the Office erred. Rather, Petitioner merely disagrees with the Examiner's findings and conclusions which is insufficient to establish material error by the Office.”)

Petitioner's references *and* the bulk of Petitioner's arguments, both before *and* after issuing Office Actions and (multiple) Notices of Allowance. POPR at 8-11. It is "highly unlikely" the Examiner was simply unaware of the references.

C. Petitioner Merely Contests the Examiner's Reasonable Judgement and Thus Fails to Establish "Material Error"

At bottom, in both the Petition and in its Reply, Petitioner points to its alleged grounds of unpatentability in hopes of showing "material error" by the Examiner. This – by definition – is insufficient:

Petitioner's alleged grounds of unpatentability cannot establish material error *per se* under our binding precedent... "If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute inter partes review"....**Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework ("material error") would collapse into one.**

Vital Connect, Inc. v. Bardy Diagnostics, Inc., No. IPR2023-00381, Paper 7 at 20 (P.T.A.B. July 11, 2023) (quoting *Advanced Bionics*) (emphasis added).

As outlined in the POPR, instead of meeting its burden to demonstrate material error, Petitioner simply second guesses the Examiner's reasonable judgment. POPR at 11-13. This is insufficient:

"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.*

The record reflects that the Examiner considered Cohen and Francesch and the bulk of Petitioner’s arguments based on them. As reflected in the Board’s decision in IPR2020-01198, the question of whether Cohen and Francesch were non-analogous art was, at minimum, an issue on which reasonable minds can disagree. It was therefore reasonable for the Examiner to conclude that Cohen and Francesch were non-analogous art. POPR at 12-13.

Petitioner, of course, disagrees. But on an issue on which reasonable minds can disagree, it was not a material error for the Examiner to conclude otherwise. This is particularly so in view of the present record where it was “highly unlikely” that the Examiner simply overlooked these references and arguments.³

III. CONCLUSION

For the foregoing reasons, and those outlined in the POPR, the Board should exercise its discretion to deny institution of trial.

³ See *Miltenyi*, No. IPR2022-00853, Paper 11 at 47 (“On a clean record, this Panel may have viewed the record differently from the Examiner, but we cannot say that the Examiner overlooked Milone or erred in the issuance of the ’140 patent claims.”).

Respectfully submitted,

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Dated: May 16, 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 May 16, 2024 on Petitioner, who has consented to service by electronic means.

Respectfully submitted,
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