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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLUIDMASTER, INC.,
Petitioner,

v.

DANCO, INC.
Patent Owner.

Case No. IPR2024-00633
U.S. Patent No. 9,139,993 B1

PATENT OWNER'S SURREPLY TO THE PETITION

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I. INTRODUCTION

In Petitioner’s Reply to Patent Owner’s Response (Paper 16, hereinafter “Reply”), Petitioner argues that (1) its Petition is not deficient, despite basing its arguments on figures lacking annotations; (2) Patent Owner has not cited any meaningful factual support for its priority date argument, despite multiple admissions by Petitioner and its expert that restrictors, a predictable genus of a valve, was well known at the time of the invention; and (3) Petitioner’s cited art is allegedly more material than the art cited during prosecution, despite both sets of references having similar and consistent deficiencies. Each of these arguments is unavailing and should be rejected by the Board for at least the reasons that follow.

II. PETITIONER’S PETITION IS DEFICIENT ON ITS FACE AND PETITIONER IMPROPERLY REQUESTS THE BOARD RELY ON EVIDENCE OUTSIDE OF THE PETITION

It is undeniable that Petitioner’s Petition is deficient, as Petitioner readily acknowledges that “labels for several figures were inadvertently omitted in whole or in part.” *Id.*, 6. In an attempt to remedy these deficiencies, Petitioner insists that its Petition “must be read alongside the *Cameron* Declaration.” *Id.*, 5. Thus, despite its vociferous hand waiving, Petitioner is impermissibly attempting to incorporate by reference, and rely upon, information from its expert declaration that *is not present* in its Petition to support its arguments – instead of filing a corrected petition as myriad PTAB rulings instruct. *Id.*, 5-6.

Petitioner’s attempt at incorporation openly flouts the law, as “[a]rguments must not be incorporated by reference from one document into another document.”

37 C.F.R. § 42.6(a)(3) Without the incorporation of information present only in Petitioner's expert declaration, the Petition clearly fails to contain a "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence," as required by *Board* rules. *Fidelity Nat'l Info. Servs., Inc. v. DataTreasury Corp.*, IPR2014-00489, 9 (PTAB Aug. 13, 2014) (Paper 9)("[The Board], therefore, decline[s] to consider information presented in a supporting declaration, but not discussed sufficiently in a petition"); *see also Cisco Systems, Inc., v. C-Cation Techs., LLC*, Case IPR2014-00454, 9-10 (PTAB Aug. 29, 2014) (Paper 12) (Informative) (expanded panel decision explaining that arguments not made in the Petition will not be considered). For example, the *Petition* states that it "will be referring to the annotated figures from Guoxin and Ho provided below" to show how the '993 Patent is allegedly obvious over Guoxin in view of Ho. Paper 1, 29-31. However, the referenced figures that follow either contain incomplete annotations or no annotations at all. The Petition is thus deficient on its face and fails to present any cognizable argument.

Petitioner contends "[t]his is not an instance where a petitioner seeks to import arguments from one document into another." Paper 16, 7-8. Yet, that is *exactly* what Petitioner hopes to do here. Because the Petition wholly relies on incomplete annotations, Petitioner is forced to point to information beyond the Petition to create a *prima facie* case of obviousness that is clearly and otherwise absent in the Petition itself. As discussed *supra*, this blatant attempt to incorporate information and arguments from Petitioner's expert declaration is clearly impermissible under Board

rules and precedent. Petitioner has failed to file motions to correct its Petition and/or file new petitions and is now time barred from utilizing appropriate corrective means for advancing its arguments. The Board can and should exercise its discretion to deny institution of the Petition under 35 U.S.C. §§ 312 (a)(3) and 314(a) as the Petition is deficient on its face under 37 C.F.R. § 42.104(b)(4) and § 42.104(b)(5).

III. THE '993 PATENT IS ENTITLED TO ITS EARLIEST PRIORITY DATE AND SCHUSTER IS NOT PRIOR ART

Petitioner appears to take the position that the claim term “water flow regulator” is such an unpredictable and imaginative departure from “bowl fill valve,” that the '993 Patent is not entitled to its 2004 priority date. Paper 16, 2-5. This argument is unavailing for a several reasons. First, the general rule that “disclosure of a species provides sufficient written description support for a later filed claim directed to the genus” directly applies here. *See, e.g., Bilstad v. Wakalopulos*, 386 F.3d 1116 (Fed. Cir. 2004); *see also, e.g., Hynix Semiconductor Inc. v. Rambus Inc.*, 645 F.3d 1336 (Fed. Cir. 2011). And while Petitioner failed to cite this rule in advancing its position that Schuster is allegedly prior art to the '993 Patent, it certainly does not dispute the existence of the rule upon Reply.

Instead, Petitioner now attempts to distinguish the circumstances from those presented in *Bilstad* and *Hynix*, taking the position that these cases are “inapposite because [the categorical rule] ignores the factual nature of the inquiry that must be conducted.” Paper 16, 3. Petitioner relies on *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997), a case decided well before the Federal Circuit

articulated its genus/species rulings in *Bilstad* and *Hynix*, for the absurd proposition that because the term “water flow regulator” does not explicitly appear in the specification, the inventors did not have possession of the same. *Id.* But even *Lockwood*, like *Hynix* and *Bilstad*, does not require the use of “the exact terms” when claiming inventions disclosed in the specification. *Lockwood* at 1572 (internal citations omitted). Rather, *Lockwood* only requires that “the specification must contain an equivalent description of the claimed subject matter.” *Id.*

Here, Petitioner does not attempt to argue that Patent Owner claimed an invention different or inequivalent from that disclosed in the '993 Patent. Rather, Petitioner's argument is simply that the term “water flow regulator” was not explicitly recited in the specification, and as such, the '993 Patent is not entitled to its earliest priority date. *See generally* Paper 1, 14, 91-98 (“PO fails to point to any disclosure in the applications preceding the '993 patent that support a finding that the inventors possessed an invention that extended beyond valves prior to January 27, 2014.”). However, as noted above, this is simply not the law.¹

Second, the '993 Patent expressly provides written description support for the term “water flow regulator.” For example, the '993 Patent describes a “bowl fill valve” such that “the flow of water is *regulated* so that enough water flows out of

¹ The Federal Circuit has recognized only two exceptions to “the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus.” *Bilstad* at 1125. The first exception is for unpredictable fields, like areas of polymer chemistry, and the second exception is for cases where the inventor expressly disclaims other members of the genus. *Id.* at 1125-26. Neither of these exceptions apply here.

the bowl fill valve 109 to fill a toilet bowl without wasting any water down a drain.” ’993 Patent at 2:36-39 (emphasis added). Thus, a genus for regulating water to fill a toilet bowl is explicitly disclosed in the specification of the ’993 Patent and was included in the earliest filing of March 11, 2004. As such, the claims of the ’993 Patent are clearly entitled to their earliest priority date.

Third, even if explicit support for the genus term is not found in the specification (which it is), the members of the genus are disclosed (and predictable) as both fluid flow regulators and fluid flow valves were both known at the time of the invention. In fact, Petitioner explicitly admits in its Petition that “fluid flow restrictors...and other mechanisms for controlling water flow were...well known” at the time of the invention. Paper 1, 19. Again, “[i]n the mechanical world—a fairly predictable field—it is wholly conceivable” that disclosure of a species “may convey to one skilled in the art” that the inventors had possession of the genus. *Bilstad* at 1126 (internal citation omitted). Petitioner and its expert do not dispute that regulators, restrictors, and valves were known in the art at the time of the invention, nor do they contend that a water flow regulator would work differently or in an unpredictable manner as compared to a bowl fill valve. EX1004, ¶83 (“toilet fill valves with various mechanisms to control the flow of water to the toilet bowl during a flush cycle were well known in the art.”). In other words, Petitioner does not argue that “bowl fill valves” and “water flow regulators” are unpredictable or would perform differently, and the Cameron Declaration concedes that such devices would operate identically. *Id.*, ¶84 (conceding that both a bowl fill valve and a bowl fill

restrictor would “reduce the flow of water to the overflow tube.”). According to *Bilstad*, it is important to consider “[i]f the difference between members of the group is such that the person skilled in the art would not readily discern that other members of the genus would perform similarly to the disclosed members, i.e., if the art is unpredictable, then disclosure of more species is necessary to adequately show possession of the entire genus.” *Id.*

Here, the terms “water flow regulator” and “bowl fill valve” are operably the same such that “the flow of water is regulated so that enough water flows out of the bowl fill valve 109 to fill a toilet bowl without wasting any water down a drain.” ’993 Patent, 2:36-39. Thus, the water flow regulator genus of the challenged claims was adequately supported by the written description of each of the priority documents showing a bowl fill valve for regulating, which was understandable and predictable based on those disclosures in view of the state of the art showing various types of regulators, valves, and restrictions, and was possessed by the inventors at the time of the priority dates that encompass the water flow regulator at issue. It is again noted that the Office clearly reviewed the claim term “water flow regulator” and found it to be supported, as the Office rejected claims 4 and 17, pertaining to the water flow regulator’s ability to be clamped to the extended portion of the body, as allegedly lacking written description, but did not reject the term “water flow regulator” in any claim. EX1002, 50.

As demonstrated above, the ’993 Patent is entitled to its earliest priority date of March 11, 2004. As a result, Schuster is not prior art to the ’993 Patent.

IV. THE PETITION RELIES ON THE SAME OR SUBSTANTIALLY THE SAME REFERENCES ALREADY PRESENTED TO THE OFFICE

There is no dispute that both Brown and Bjerke were considered by the Office. Moreover, the Reply concedes that Brown, a reference relied upon by Petitioner in multiple grounds, is listed on the face of the patent, and thus was already considered by the Office during prosecution. Paper 16, 1. Notably, the Reply is silent on the fact that the Patent Owner Response emphasizes that Bjerke was also considered by the Office. *See id.* Instead, Petitioner’s only attempted differentiation of its cited prior art in the Reply merely argues that “Guoxin, Ho, and Brown do not use DeMarco’s manner of connection.” *Id.* Petitioner alleges “Guoxin, Ho, and Brown do not use DeMarco’s manner of connection but rather show the claimed connection.” *Id.*

Importantly, such argument does not even attempt to negate the fact that Guoxin and Ho, like the primary reference DeMarco cited by the Office during prosecution, are both silent as to whether the purported “extended portion” is integrally molded with the purported body of the toilet fill valve, which is required by all claims of the ’993 Patent. *See, e.g.,* EX1001, 9:60-12:24. Nowhere in Ho are the essential ’993 Patent claim terms “integrally” or “molded” found. Likewise, Guoxin does not disclose the fundamental requirement that the extended portion (the “bowl fill valve” of the ’993 Patent) is “molded” or, more specifically, “*integrally* molded” with the body (the “toilet fill valve”). Petitioner’s original argument that the claim phrase “integrally molded” somehow includes components that are “molded *separately*” and only then “attached to one another” summarily reads the essential limitation of “integrally molded” out of independent claims 1, 8, and 14 of

the '993 Patent. *See* EX1001, 2:16-26 (“Specifically, the bowl fill valve 109 may be ***molded as a portion of the toilet fill valve 100.***”) (emphasis added). “In this respect, the term ‘integral’ refers to the fact ***that the bowl fill valve 109 and the toilet fill valve 100 comprise a single structure.***” *Id.* (emphasis added).

Consequently, the Board should deny institution of the Petition because it is based on patents or publications that are either the same or substantially the same as prior art already considered by the Office with respect to at least the “integrally molded” requirement of all challenged claims of the '993 Patent. *See* 35 U.S.C. § 325(d); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Precedential) (PTAB Dec. 15, 2017); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Precedential) (PTAB Dec. Feb. 13, 2020).

V. CONCLUSION

For at least the reasons discussed above, the Petition fails to establish a reasonable likelihood that Petitioners would prevail with respect to any challenged claim of the '105 Patent.

Dated: July 18, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 18th day of July 2024, a complete and entire copy of the foregoing Patent Owner's Surreply to the Petition was served on counsel of record for Petitioners, as follows:

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