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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. IPR2024-00635
U.S. Patent No. 10,934,698 B1

PATENT OWNER'S SURREPLY TO THE PETITION

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I. INTRODUCTION

In Petitioner’s Reply to Patent Owner’s Response (Paper 17, hereinafter “Reply”), Petitioner argues that (1) its Petition is not deficient, despite basing its arguments on figures lacking annotations; and (2) 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.*, 3. In an attempt to remedy these deficiencies, Petitioner insists that its Petition “must be read alongside the Cameron Declaration.” *Id.*, 2. 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.*, 2-3.

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, Paper 9 (PTAB Aug. 13, 2014) ("[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, Paper 12, 9-10 (PTAB Aug. 29, 2014) (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 '698 Patent is allegedly obvious over Guoxin in view of Ho. Paper 1, 27-29. However, some of the referenced figures that follow either contain incomplete annotations or no annotations at all. *See, e.g., id.*, 32-36. 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 17, 5. 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.

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

Petitioner's first reply argument is entitled "Guoxin, Ho, and Brown Are Different From and More Material Than Demarco." Paper 17, 1. There is no dispute that both Brown and Bjerke were considered by the Office. Brown, for example, is listed on the face of the patent, and thus was already considered by the Office during prosecution. EX1002, INID 56.

Notably, the Reply is silent on the fact that the Patent Owner Response emphasizes that Bjerke was also considered by the Office. *See id.*; EX1002, 63-67 (Final Office Action rejecting all claims using a combination of DeMarco and Bjerke). Consequently, Bjerke as a secondary reference was overcome by Patent Owner during prosecution through amendment and argument. Petitioner conveniently forgets its materially false statement in its Petition that it was

presenting to the Board “prior art not considered during prosecution of the ’698 patent that discloses the features that Patent Owner ... contended were missing from the prior art.” *See* Paper 1, 1.

Instead, Petitioner’s only attempted differentiation of its cited prior art in the Reply merely argues that “Guoxin and Ho do not use DeMarco’s manner of connection.” Paper 17, 2. Petitioner alleges “Guoxin and Ho 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 devoid of any disclosure of a “protrusion configured to insert into a recess of the toilet fill valve and retain the bowl fill valve to the toilet fill valve, the protrusion being configured to snap fit into the recess.” *See, e.g.,* EX1002, 94-105; 61-70. Accordingly, Petitioner is left to rely on a tertiary reference Bjerke, already duly considered by the Office, for the allegation of obviousness based on Bjerke’s snap connection. Petitioner’s Reply is also devoid of any facts, evidence, or argument warranting reconsideration of the Office’s prior consideration of Bjerke in granting the ’698 Patent.

The result of Petitioner’s misplaced reliance is that neither Guoxin nor Ho, like DeMarco, discloses or suggests the required protrusion, recess, and snap fit of the ’698 Patent, and neither is a more material reference than DeMarco. As

established in Patent Owner's Preliminary Response, Petitioner's proposed combination of Guoxin and Ho merely substitutes the primary reference cited during prosecution, DeMarco, with a different primary reference, Guoxin, and reutilizes Bjerke, despite Bjerke being overcome by Patent Owner during prosecution. This is impermissible. *See Nu Mark LLC v. Fontem Holdings 1, B.V.*, IPR2016-01309, Paper 11 (Dec. 5, 2016) (decision denying institution due to Petition citing "substantially the same art or arguments as those previously presented to the Office").

Accordingly, in view of Petitioner's reliance on the references already considered by the office and comparable references containing the same deficiencies as the prior art of record in prosecution – namely the absence of a protrusion configured to insert into a recess of the toilet fill valve and retain the bowl fill valve to the toilet fill valve via a snap-fit – the Petition is deficient and should not be instituted. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8-9 (Precedential) (PTAB Dec. Feb. 13, 2020) (in this circumstance "the Director generally will exercise discretion not to institute inter partes review").

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 "protrusion"

requirement of all challenged claims of the '698 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).

IV. **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 '698 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 Surreply to the Petition was served on counsel of record for Petitioners, as follows:

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