

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ROOT TECHNOLOGY CO., LTD.
Petitioner

v.

CHIARO TECHNOLOGY LTD.,
Patent Owner

Case IPR2024-00953
U.S. Patent No. 11,413,380

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

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Patent Trial and Appeal Board

United States Patent & Trademark Office

P.O. Box 1450

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Patent Owner has clearly and consistently articulated its right and desire to defend itself against Petitioner's repeated attacks on the '380 patent. EX3001, 1; EX1017, 24:10-14; POPR, 1-3. The Board affirmed that right, denying Petitioner's request for administrative dismissal and rightly rebuffing Petitioner's attempt to "seek[] a do-over." EX1017, 13:19-21, 32:20-33:4; Paper 8, 3, 6.

Petitioner ostensibly sought the instant Reply to address discretionary denial issues in the present proceeding. EX3003, 1. But first, Petitioner grossly mischaracterized the record in an attempt to disparage Patent Owner for declining to support Petitioner's offer of dismissal "in lieu of a second," do-over IPR. Paper 16, 1. Next, Petitioner referenced *General Plastics* arguments in its follow-on petition that are inapposite to this proceeding. *Id.* Neither this Brief, nor the Board's finite resources, are best served by engaging in Petitioner's distractions.

Turning to § 325(d), Petitioner asked the Board to narrowly apply the statute, essentially requiring the exact Chang-Weber-Guthrie combination to have previously been overcome at the Office. Paper 16, 1-2. But § 325(d) should not be applied so narrowly here. Rather, Petitioner's reliance on *Amazon.com* is misplaced. In *Amazon.com*, "the prosecution history record show[ed] that the various IDSs include at least about a few hundred references" and "[n]othing in the record indicate[d] that the Examiner substantively considered" the asserted prior art. *Amazon.com, Inc. v. M2M Solutions LLC*, IPR2019-01205, Paper 14 at 15-16

(PTAB 2020). The facts here are in sharp contrast where: 1) Chang was one of only five references cited in the IDS filed on September 5, 2021, 2) was retrieved by the Examiner multiple times during prosecution, and 3) was applied by the same Examiner during examination of a co-pending parent application. POPR, 28-29. Thus, unlike in *Amazon.com*, the present record is replete with evidence “indicat[ing] that the Examiner substantively considered” Chang. *Id.*; *see also Miltenyi Biomedicine GmbH v. The Trustees of the University of Pennsylvania*, IPR2022-00853, Paper 11 at 47 (PTAB 2022).

In addition, Weber is “substantially the same” as prior art already considered by the Office. POPR, 31-37. Not only was much of Weber discussed in Khalil, but the teachings that one could reasonably draw from Weber were already present in Khalil—a reference applied and overcome during prosecution. POPR, 8, 11-12, 32-33, 34-37. Denial of this petition under § 325(d) would be consistent with the Board’s prior rulings. POPR, 36-37.

Regarding § 314(a) and *Fintiv*, Petitioner made no attempt to rebut Patent Owner’s arguments and instead fixated on parallel litigation of the ’380 patent in the *Willow* case. POPR Reply, 2-3. Contrary to Petitioner’s allegations, the POPR provides a full analysis of the *Fintiv* factors, with each factor addressed in turn first with regard to the *Shenzhen Root* case. POPR, 45-58. The discussion of the *Willow* case merely demonstrates that the validity of the ’380 patent will be adjudicated

before the issuance of a final written decision in this proceeding. POPR, 47-48, 50-51 (discussing the *Willow* case with respect to *Fintiv* factors 2 and 3).

Moreover, Petitioner's Reply amply confirms that Petitioner is not a party to the *Willow* case, is unaware of the case schedule, and thus provides an ignorant analysis of the *Willow* case that is simply wrong. POPR Reply, 3. A *Markman* hearing took place on September 24, 2024, discovery is well underway, and recently-filed amended counterclaims have already been answered. Docket for Case No. 2:23-cv-00229-JRG (E.D. Texas), 21-22 (Docket Nos. 37, 39, 42, and 46), 25 (Docket Nos. 74-75), and 31 (Docket Nos. 93 and 102). Thus, any assertion that *Willow* is not proceeding as scheduled is pure speculation. And, unlike *Intel*, Petitioner failed to provide a stipulation to "mitigate[], to an extent, concerns of potentially conflicting decisions and duplicative efforts." *Compare Intel Corp. v. Besang Inc.*, IPR2023-00991, Paper 12 at 19-21 (PTAB 2023), with *TCO AS v. NCS Multistage Inc.*, PGR2020-00077, Paper 16 at 11-12 (PTAB 2021).

The PTAB "has discretion to institute an *inter partes* review under" each of 35 U.S.C. § 314(a) and 35 U.S.C. § 325(d). *General Plastic Ind. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB 2017). Here, stopping Petitioner's attempted "abuse of the review process" requires the Board to deny institution of this and the later-filed do-over petition, as will be further presented in Patent Owner's Preliminary Response in IPR2024-01296. *Id.*

Respectfully submitted,
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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the foregoing **PATENT OWNER'S
SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE** was served in its entirety electronically via e-mail
on October 21, 2024, on the following counsel of record for Petitioner:

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