

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECTO WORLD, LLC and SV3, LLC
Petitioner

v.

RAI STRATEGIC HOLDINGS, INC.
Patent Owner

U.S. Patent No. 11,925,202

Case IPR2024-01280

**PATENT OWNER'S AUTHORIZED RESPONSE TO
PETITIONER'S REQUEST FOR DIRECTOR REVIEW**

I. The Board Correctly Applied *Advanced Bionics* Part One

The Board applied binding, precedential authority to correctly determine that *Advanced Bionics* part one is satisfied. Paper 10 (“DI”) at 9-11. Specifically, the Board recognized that *all* of the petition’s art was previously presented to the Office via an IDS, which is sufficient to meet part one under the precedential *Advanced Bionics* decision. *Id.* at 10-11. The Board did not err in correctly applying this precedential authority to find part one satisfied.

The Request (at 5-7) alleges that the Board has “inconsistently handled” the issue of whether art cited on an IDS is “previously presented” art for Section 325(d), citing non-precedential decisions issued before and after *Advanced Bionics*. If the earlier decisions conflict with *Advanced Bionics*, they are irrelevant as being superseded by *Advanced Bionics*. *Dell Inc. v. Realtime Data LLC*, IPR2017-00176, 2018 WL 2386900, at *6 (PTAB May 25, 2018).

And none of the post-*Advanced Bionics* decisions holds that art presented on an IDS is insufficient to satisfy *Advanced Bionics* part one. In fact, the *Sci. Design Co.* panel found part one *satisfied* because “the art relied upon in the Petition was presented to the Office in an IDS during examination.” IPR2021-01537, Paper 7 at 24 (PTAB Mar. 18, 2022). The three other cited cases all involved IPR petitions that applied new references, with the Board finding part one not satisfied as a result. IPR2023-00607, Paper 11 at 20-22 (PTAB Sept. 26, 2023); IPR2024-00906, Paper

11 at 11-19 (PTAB Dec. 11, 2024); IPR2024-01077, Paper 8 at 15-20 (PTAB Jan. 28, 2025). None of these cases conflict with the *Advanced Bionics* “precedent hold[ing] that providing a document to the Office in an [IDS] is sufficient to satisfy prong one.” *Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 18 at 15-16 (PTAB June 13, 2023).

Petitioner also contends that “the *combinations* of references in the Petition were not presented or considered during prosecution.” Request at 5 (emphasis by Petitioner). But satisfying part one does not require a petition’s combination of references to be previously considered,¹ and the *Posco* and *Tommy John* cases cited in the Request do not hold otherwise. *Posco*, IPR2024-01377, Paper 11 at 18 (PTAB Jan. 8, 2025); *Tommy John*, IPR2024-01163, Paper 12 at 25-26 (PTAB Jan. 8, 2025).

The Request (at 7) also speculates without any evidence that “the Examiner was not afforded the opportunity to seriously consider any of [the petition’s] references.” To the contrary, Primary Examiner Phu H. Nguyen confirmed that he considered all of the petition’s cited references. POPR at 35-36; Ex. 1002 at 228-84. Examiner Nguyen has been examining the ’202 patent family since 2006, and was aware of the IPR references at least as early as 2015 (for Takeuchi, Kim, and

¹ In *Advanced Bionics*, IPR was denied under § 325(d) despite the petition presenting new obviousness combinations not previously before the Office.

Susa) and 2018 (for Pienemann). POPR at 36; Ex. 2007 at 108-09, 112; Ex. 2008 at 195. Petitioner’s criticisms about the number of references cited during prosecution and Applicant declining to identify references to be paid “particular attention” are misplaced (POPR at 37) and irrelevant to the issue of whether Applicant “previously presented” the petition’s art to the Office. Applicant did.

II. The Board Correctly Applied *Advanced Bionics* Part Two

Petitioner did not address *Advanced Bionics* part two in the petition, and the Board could not have erred regarding an argument not presented to it. Specifically, Petitioner took the (erroneous) position that *Advanced Bionics* part one is not satisfied and so did not address part two. Pet. at 110 (“[u]nder part one, the same art or arguments were *not* previously presented to the Office, ending the inquiry”). This is not a matter of the Board introducing “a new *ipsis verbis* requirement” or “elevating form over substance” (Request at 9, 14-15): Rather, the petition entirely failed to address *Advanced Bionics* part two. Pet. at 110-11. Likewise, the Request’s argument (at 10) that the Board erred in not expressly addressing *Becton, Dickinson* factors (c), (e), and (f) fails because the petition never addressed them either.

The Board was not obligated to scour the entirety of the petition for statements potentially relevant to *Advanced Bionics* part two. *See, e.g., Google*, IPR2022-01197, Paper 18 at 22-23. Moreover, none of the petition’s statements cited in the Request show material error by the Examiner. The statements (at 7-8, 110) that

“the ’202 patent issued after very limited examination,” “the Examiner was not afforded the opportunity to seriously consider any of these references,” and “the claimed concepts were well-known before the ’202 patent, and as such [the patent] should not have been allowed” are generic. They do not explain “with specificity” what “the previous error is” nor “why that error is material to the patentability of the challenged claims.” *Google*, IPR2022-01197, Paper 18 at 22-23 (citing *Advanced Bionics* at 8-9).

Likewise, POPR (at 38-39), the petition’s statement that “none of [the applied] references (let alone in the combinations presented herein) were applied in any office action” does not satisfy Petitioner’s burden to show material error. *See, e.g., Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7 at 19 (PTAB July 11, 2023). And the Request does not explain how the petition’s presentation of “a claim construction issued in a prior IPR,” “Patent Owner’s [alleged] admissions in prior IPRs,” and expert testimony “not available to the Examiner during prosecution” allegedly establish material Examiner error. They do not: The Examiner correctly allowed the ’202 Patent over the petition’s art, and the post-allowance information cited in the petition does not show otherwise. POPR at 14-33. *See, e.g., Google*, IPR2022-01197, Paper 18 at 25.

The Request (at 11-12) also cites IPR2024-01406, which includes grounds based on Takeuchi. But unlike the petition here, the IPR2024-01406 petition

included new art (Gupta) not previously presented to the Office. And unlike the IPR2024-01406 petition, the petition here did not even attempt to explain how Takeuchi allegedly discloses a core claim limitation—the claimed “*electrical resistance* heater,” which stands in contrast to a general “heater.” In IPR2024-01406, the Board found that **four of the five** grounds failed to meet the “reasonable likelihood” standard for institution. The fifth ground, Takeuchi § 102, was found to barely meet that standard because Petitioner’s declarant provided “some” reasoning to support his assertion that Takeuchi’s “heater” is an “electrical resistance heater.” Petitioner here presented no such reasoning. POPR at 14-19.

Ultimately, though, **both IPRs** should be denied under *Fintiv* in view of the parallel ITC investigation. As Patent Owner explained in its Request for Director Review in IPR2024-01406 (Paper 31), the ITC is adjudicating the validity of the ’202 Patent and has set a **November 24, 2025** target date for completing its investigation, **months before FWDs would issue in either of the IPRs** (Factor 2). *Id.* at 9-10. There is extensive overlap between the ITC case and the present IPR, with the ITC Respondents challenging the ’202 Patent over the petition’s grounds (Factor 4). The other *Fintiv* factors likewise favor denial for the reasons explained in the IPR2024-01406 Request for Director Review, including that the ITC will likely adjudicate the validity of the ’202 Patent over the only ground found to meet the “reasonable likelihood” standard in IPR2024-01406, Takeuchi § 102.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Patent Owner's Authorized Response to Petitioner's Request for Director Review was served via email on the date below, upon the following:

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