

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

R-PAC INTERNATIONAL CORP.,
Petitioner

v.

ADASA INC.,
Patent Owner

Case IPR2024-01416
U.S. Patent No. 9,798,967 C1

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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Petitioner RPac requests Director Review of the Institution Decision alleging the Board abused its discretion by, first, refusing supplemental briefing on 35 U.S.C. §325(d), before then exercising its discretion to deny institution. Paper 12 at 1. RPac is incorrect. No good cause existed for supplemental briefing on discretionary denial. RPac confirmed *Dummies* discloses known RFID concepts. RPac could not be surprised that PO agreed by asserting *Dummies* is cumulative of art raised during reexamination. Further, the reexamination record shows that the same teachings from Traub were considered and were applied in the same manner during reexamination as they are presented in the Petition. No error material to patentability could exist, therefore. Denial of supplemental briefing and discretionary denial of the Petition by the Board were the correct outcomes.

1. RPac's Deficient Argument on §325(d) in Its Petition

RPac must set forth its entire case for invalidity in its Petition, including argument and evidence on discretionary denial.¹ 37 CFR §42.22(a). Indeed, RPac sought to do so. Pet. at 66-70; 35 USC §325(d); *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020). Yet, despite identifying the controlling precedent in its Petition, RPac failed to provide

¹ The bifurcated briefing procedure set forth in the Director's Memorandum of March 26, 2025 is inapplicable to this IPR. PO's preliminary response deadline predated issuance of the Memo.

the requisite analysis to apply it.

At step one of *Adv. Bionics*, RPac argued only that ***the precise combination of Dummies and Traub*** was not previously considered by the Office, even as it readily admitted both references were separately considered. Pet. at 69-70. RPac made the choice to not address “whether the same or substantially the same ***arguments*** previously were presented to the Office.” 35 USC §325(d). In its Petition, RPac did not compare the art and argument it makes to those made during *ex parte* reexamination. RPac made no effort to ascertain whether its invalidity grounds are entirely cumulative of those overcome in reexamination, nor to refute any such contention. These omissions were mirrored in its expert declaration, which is devoid of any discussion of the art and argument asserted during reexamination, or discussion on discretionary denial under *Adv. Bionics*. Ex. 1005. RPac cannot explain away its strategic choice to not fully address discretionary denial, or to not consult its expert regarding the same. *Adv. Bionics*, Paper 6 at 9 (cumulative nature of the asserted art considered at step one).

At step two, RPac has the burden of showing the “Office erred in a manner material to the patentability of the Challenged Claims.” Id.; Pet. at 70. Rather than doing so, RPac merely realleges that the *Dummies*-Traub combination was not previously considered, then wrongly contends that the teachings of Traub were overlooked during reexamination. Id. RPac does not articulate any differences

material to patentability between *Dummies*-Traub and the reexam art combinations. RPac also provides no explanation for how Traub's teachings could have been overlooked during reexamination when ***the exact teachings RPac relies upon*** were raised throughout the reexamination, included within the petition, two office action rejections, and responses thereto. *See*, Ex. 1004 at 40-41, 69-72, 109-111, 162-165, 977-984. RPac is not entitled to submit "do over" briefing to cure these defects and cannot fault the Board for denying the request. Inst. Dec. at n.7.

2. No Good Cause Exists for Reply Brief on 35 U.S.C. §325(d)

In its POPR, PO correctly applied the *Adv. Bionics* to show that discretionary denial is appropriate. POPR (Paper 9) at 20-24. PO showed that the same passages from *Dummies* and Traub relied upon in RPac's Petition were considered during original prosecution and during *ex parte* reexamination. *Id.* at 21, 23. Further, the POPR correctly asserts that "[*Dummies*] is relied upon for only subject matter redundant to that presented in the TDS ***and generally known in the art***" while Traub is relied upon to purportedly teach the data structure limitations. *Id.* at 21-22.

The Petition admits the same. Pet. at 21-22 ("***preauthorizing ranges of EPC serial numbers*** was also known before the '967 patent."); Ex. 1005 at ¶¶65-69 (same); Pet. at 31-32 ("*Dummies*, however, ***does not provide a detailed explanation for how that allocation is done***" and a POSITA would "***look to other sources for solutions, such as Traub's***"; Ex. 1005 at ¶91-92 (same); Pet. at 33-34 ("***Traub***

discloses a simple technique to encode business information into the serial number portion (i.e., space) of *the known EPC* by merely *partitioning the leading bits of the serial number space* to indicate the location.”); Ex. 1005 at ¶95-96 (same); Pet. at 36-37 (showing EPC data structure); 38-39 (referring back to EPC data structure and to known concept of pre-authorizing ranges of serial numbers); Pet. at 40-41 (Traub shows “*partitioning* an EPC to encode the business information directly into the *leading bits of the EPC’s serial number*.”); Pet. at 42 (“the composition of *hierarchical identifiers* composed of bits, *like EPC*” were known).

RPac’s repeated affirmation that *Dummies* teachings were known to POSITAs belies its assertions that good cause exists for granting its request for supplemental briefing on §325(d). 37 C.F.R. §42.108(c); Ex. 3001. RPac could not be surprised that PO, and the Board, would *agree with RPac and its expert* that *Dummies’* teachings were commonly known and necessarily cumulative of *all prior art* in the reexamination, including Rowe and the TDS. Ex. 1005 at ¶113-115; Inst. Dec. at 16-19. Accordingly, the Board rightfully found no good cause justifying a reply.

3. Authorization of Reply Brief Would Have Been Futile

No argument RPac could make could walk back its affirmation that *Dummies’* teachings were commonly known. This, alone, confirms the soundness of the Board finding *Dummies* to be cumulative of at least the ‘200 Patent considered during reexamination. The relevant disclosures of each reference relate directly to

discussion of the standard EPC data structure adopted in the RFID industry. Pet. at 36-39; Ex. 1004 at 977, 979. Both also discuss assigning different ranges of serial number values to different manufacturing divisions. Id.

RPac cannot refute that “POSITAs would have recognized, or found it obvious *based on the knowledge of how fixed-length, hierarchical identifiers like EPCs* are composed, *Traub’s Figure 4B as disclosing the serial number portion of the EPC has been subdivided* to include a partition for the business information.” Pet. at 42. A POSITA’s knowledge *of the EPC format*, not *Dummies*, that is asserted along with Traub to allege obviousness for Limitations 1[e]-[f]. Thus, any allegation of error due to *Dummies*-Traub not being specifically considered is moot. Inst. Dec. at 19. RPac also cannot refute its reliance on the same teachings from Traub and its proffering *the same hypothetical* to exemplify Traub’s teachings used by the Examiner. *Compare*, Ex. 1004 at 70-71 (“in a 26-bit serial number, the six most significant bits... correspond to a particular block containing over a million serial numbers and therefore also correspond to a particular client site”) *with* Pet. at 43, Ex. 1005 at ¶122; Inst. Dec. at 23-28. Traub was not misapplied by the Examiner.

Nothing RPac could argue in reply would warrant a different outcome. The Board’s decisions were well-reasoned in view of the facts and PTAB precedent, and not an abuse of discretion. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

Date: May 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on May 1, 2025, a true and correct copy of the foregoing *Patent Owner's Response to Request for Director Review* was served via electronic mail upon counsel of record for Petitioners at the following addresses:

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