

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIGHLEVEL, INC.,

Petitioner

v.

ETISON LLC D/B/A CLICKFUNNELS,

Patent Owner

IPR2025-00234

Patent No. 10,846,357

**PATENT OWNER'S SUR-REPLY
IN SUPPORT OF ITS PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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35 U.S.C. § 325(d)	1, 2
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Prosecution History Excerpts of U.S. Patent Application No. 15/880,226 (“’357 file history”)
2002	U.S. Patent Pub. No. 2017/0147364 (“Shaposhnikov”)
2003	U.S. Patent Pub. No. 2008/0263135 (“Olliphant”)
2004	U.S. Patent Pub. No. 2012/0151329 (“Cordasco”)
2005	U.S. Patent No. 8,799,829 (“Grosz”)

I. INTRODUCTION

Petitioner's Reply does not identify any material difference between the disclosures of the asserted art in the Petition and the prior art considered and applied by the Examiner, let alone explain how the Petition relies on any such material difference. The Reply does not address the POPR's comparison of the asserted art in the Petition with the prior art of record during prosecution to identify any material difference. In an attempt to obscure that the Petition's asserted art is substantially the same as that considered and applied during prosecution, Petitioner relies on proposed rulemaking that was never implemented—aiming to disqualify some of the prior art of record from the analysis.

To the contrary, the record evidence demonstrates that Petitioner's asserted art provides nothing beyond that already presented to the Office and applied by the Examiner when allowing the claims. Denial of institution is warranted.

II. INSTITUTION OF THE PETITION SHOULD BE DENIED UNDER SECTION 325(d)

A. A Reference Not of Record During Prosecution May Nevertheless Present Substantially the Same Prior Art Under Section 325(d)

Petitioner argues that “none of the five new references were previously before the Office.” Reply, 1. But whether references were applied during prosecution is not the inquiry in *Becton-Dickinson* factors (a) and (b). An “[un]applied” reference from prosecution may nevertheless be found to present cumulative and/or

substantially the same prior art as a Petition, and serve as a basis for the Board denying institution under §325(d). *Advanced Bionics*, IPR2019-01469, Paper 6, at 7-8 (Feb. 13, 2020). Here, the disclosure in the asserted art relied on in the Petition was also in the references before the Examiner, even if the asserted art itself was not.

The POPR cites multiple decisions where the Board exercised its discretion to deny institution under 35 U.S.C. § 325(d) where the references asserted in the Petition were not of record during prosecution but were substantially the same as the references of record, whether or not those references of record were applied. POPR, 28-29. This practice is consistently applied in the Board’s decisions. *Ecto World LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 10, at 10-11 (Mar. 5, 2025); *Dorco Co., Ltd. v. The Gillette Co., LLC*, IPR2017-00500, Paper 7, slip op. at 15 (Jun. 21, 2017) (denying institution under §325(d) based on references that were not previously presented to the Office); *Fitesa Simpsonville, Inc. v. The Procter and Gamble Co.*, IPR2023-01450, Paper 11, at 11-12 (Mar. 20, 2024) (citing *Advanced Bionics*, at 7-8 (“[p]reviously presented art includes art made of record by the Examiner ... such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.”)).

Moreover, the decisions relied on by Petitioner are inapposite. The *Cisco* proceeding is not relevant, as it addresses a reference that was not of record because

the applicant did not provide a legible copy. Reply, 1 (citing *Cisco Sys., Inc. v. Netsocket, Inc.*, IPR2023-00607, Paper 11 at 22 (Sept. 26, 2023)). And unlike *K/S HIMPP v. Bragi GmbH*, PO here provides evidence that the art relied on in the Petition is cumulative of art that was in front of the Office. *Id.* (citing IPR2023-01205, Paper 8, at 20 (Mar. 19, 2024)).

B. Petitioner Does Not Identify Any Material Difference

The Reply does not identify material differences between the disclosures in the asserted art relied on in the Petition and the prior art considered by the Examiner—only citing to the Petition without explanation of what the purported differences are, or why they would be material to the '357 Patent's claims.

Petitioner alleges that “Coursol includes disclosures that PO argued were missing from [] Shaposhnikov.” Reply, 2-3. Other than mentioning the independent claim, the Reply does not present any evidence in support of its contention. As set forth in the POPR, the disclosure relied on from Coursol is substantially the same as that in Shaposhnikov. POPR, 15-26. For the “webpage tabs” element, the Reply avers that Coursol “initializes a ‘website containing default set of web pages.’” Reply, 2-3 (citing Petition, 28-29, 34). But the POPR already explained why Shaposhnikov discloses substantially the same thing as Coursol’s “About,... Products,... Gallery,... Contact” pages. POPR, 35-37. The Reply just points back

to the same disclosure in Coursol that the POPR shows to be substantially the same as the disclosure in the references considered and applied during prosecution.

Petitioner also alleges that Karidi and Sayed include disclosure missing in Olliphant. Reply, 3-4. Here again, Petitioner does not address the POPR's comparisons showing the asserted prior art references are substantially the same as the prosecution references, and that the Petition applies those references in the same manner as during prosecution.

Turning to the Grosz reference, Petitioner does not dispute that Grosz was cited in an IDS, acknowledged as considered by the Examiner, and is listed on the face of the '357 Patent. Instead, Petitioner relies on proposed rulemaking that was never implemented to assert that Grosz was not "meaningfully considered." Reply, 4 n.3. That is simply incorrect. There are numerous Board decisions which deny institution and that have expressly found that references cited in an IDS, but not applied, may present substantially the same prior art. POPR, 28-29.

The Reply also alleges that the POPR's Grosz comparison was cobbled together to suggest linked webpages for a user to make a purchase. Reply, 4. But as explained in the POPR, the Examiner already determined that such linked webpages do not meet the claim language. POPR, 31-32, 34-35, 42-44, 54-55.

Lastly, Petitioner alleges that the “disclosures in the new references” (Reply, 2) must be addressed. But those disclosures have already been addressed—as they are substantially the same as the prior art considered and applied during prosecution.

C. Petitioner Has Not Provided Sufficient Evidence That the Examiner Erred

The Petitioner carries the burden of showing material differences between prior art references, particularly where PO makes an initial contrary showing. *Advanced Bionics*, 10-11, 16–17, 19. But Petitioner fails to demonstrate any such material difference or material error by the Office. At most, Petitioner disagrees with the Examiner’s allowance of the claims—this is not material error. *Advanced Bionics*, at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”). The Examiner provided reasons for allowance of the claims. Petitioner has not provided sufficient evidence that warrants reconsideration of the Examiner’s decision.

III. CONCLUSION

Accordingly, Patent Owner requests that the Board exercise its discretion and deny of institution of *Inter Partes* Review because the Petition presents the same, or substantially the same, already-examined prior art and arguments already considered by the Office.

DATED: April 4, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that a copy of the **Patent Owner's Sur-Reply in Support of Its Preliminary Response Under 37 C.F.R. § 42.107** was served on Petitioner by causing it to be sent by email to counsel for Petitioner at the following email addresses:

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