

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner

v.

VALTRUS INNOVATIONS LTD.,
Patent Owner

Case No. IPR2025-00419
Patent No. 7,936,738

PATENT OWNER PRELIMINARY RESPONSE

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PATENT OWNER’S UPDATED EXHIBIT LIST

No.	Exhibit Description
2001	Memorandum for Interim Processes for PTAB Workload Management, dated March 26, 2025
2002	Memorandum on Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated March 24, 2025
2003	Order Denying Motion to Stay in <i>Netlist, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-293, Dkt. No. 689 (E.D. Tex. Mar. 11, 2024) (Gilstrap, J.)
2004	Executed Summons in <i>Valtrus Innovations Ltd. v. SAP America, Inc. et al.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 10 (E.D. Tex.), served January 17, 2024
2005	Statistics from DocketNavigator for patent cases before Judge Gilstrap of the Eastern District of Texas, for cases filed between January 1, 2020 to March 31, 2025
2006	Federal Court Management Statistics—Profiles, Comparison of Districts Within Circuits, for 12-Month Period Ending December 31, 2024, available at https://www.uscourts.gov/data-table-report-names/federal-court-management-statistics
2007	Notice of Compliance with Service of Patent Owner’s Infringement Contentions in <i>Valtrus Innovations Ltd. v. SAP America, Inc. et al.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 10 (E.D. Tex.), confirming service of infringement contentions on March 11, 2024
2008	Memorandum and Order regarding motion to dismiss, in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 10 (E.D. Tex. Nov. 8, 2024) (public version)
2009	Seventh Amended Docket Control Order in <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , No. 2:21-cv-00113-JRG, Dkt. No. 203 (E.D. Tex.)
2010	Order denying stay in <i>Cardware Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00141-JRG, Dkt. No. 64 (E.D. Tex. Feb. 16, 2023)
2011	Complaint in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG (E.D. Tex Jan. 15, 2024)
2012	Petitioner’s email concerning prior art narrowing, dated May 1, 2025

No.	Exhibit Description
2013	Order consolidating <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00533-JRG (E.D. Tex.) and <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG (E.D. Tex), dated Feb. 24, 2025
2014	Patent Owner’s email concerning claim narrowing, dated April 10, 2025
2015	Third Amended Docket Control Order in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 141 (E.D. Tex. Apr. 20, 2025)
2016	Opening Brief in Support of Motion to Dismiss for Lack of Subject-Matter Jurisdiction, Under the First-to-File Rule, Lack of Personal Jurisdiction, and for Failure to State a Claim in <i>SAP Am. Inc. v. Valtrus Innovations, Ltd.</i> , No. 24-cv-756-GBW, Dkt. 14 (D. Del.)
2017	Reply in Support of Motion to Dismiss for Lack of Subject-Matter Jurisdiction, Under the First-to-File Rule, Lack of Personal Jurisdiction, and for Failure to State a Claim in <i>SAP Am. Inc. v. Valtrus Innovations, Ltd.</i> , No. 24-cv-756-GBW, Dkt. 32 (D. Del.)
2018	Excerpt from Petitioner’s Invalidity Contentions, served May 20, 2024, in <i>Valtrus Innovations Ltd. v. SAP America, Inc. et al.</i> , No. 2:24-cv-00021-JRG (E.D. Tex.)
2019	[Proposed] Fourth Amended Docket Control Order in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 147-1 (E.D. Tex. filed Apr. 30, 2025)
2020	European Patent Application EP 1 501 257 A1
2021	FlowCharts for Section 35 U.S.C. §102(e) Dates, Version 1.0 (Nov. 2002), available at https://www.uspto.gov/sites/default/files/web/offices/dcom/olia/aipa/102eflowchart.pdf

I. INTRODUCTION

On January 15, 2025, Petitioner SAP America, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1-10 and 33 (the “Challenged Claims”) of U.S. Patent No. 7,936,738 (“the ’738 Patent”; EX1101), asserting one Ground. In its sole Ground 1, Petitioner asserts that claims 1-10 and 33 are rendered obvious under 35 U.S.C. §103(a) by the *Forissier* reference. Petition (Paper 1), 15. On March 10, 2025, the Board issued a Notice of Filing Date Accorded for the Petition and set the time for filing Patent Owner’s Preliminary Response. Paper 5.

The Board should deny institution because Petitioner fails to meet its burden of demonstrating a reasonable likelihood of success that *Forissier* renders obvious any of the Challenged Claims. To do so, the Board need not look any further than the fact that Petitioner incorrectly asserts that *Forissier* is prior art under pre-AIA 35 U.S.C. §102(e) to the ’738 Patent based on *Forissier*’s original foreign application priority claim.

Petitioner’s analysis is wrong as a matter of law; an alleged prior art reference is *not* entitled to its foreign priority date for purposes of pre-AIA Section 102(e). *See In re Hilmer*, 359 F.2d 859, 862, 882-83 (CCPA 1966) (rejecting attempt to use foreign priority date for pre-AIA Section 102(e) analysis); *see also, e.g., In re Giacomini*, 612 F.3d 1380, 1384 (Fed. Cir. 2010) (explaining that *Hilmer* holds that a foreign priority date cannot be used as the effective filing date for a pre-AIA

Section 102(e) reference); MPEP §2136 (“Foreign application filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) or (b)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as pre-AIA 35 U.S.C. 102(e) dates for prior art purposes.”) (emphasis in original).

Because *Forissier* is not prior art, Petitioner has not—and cannot—meet its burden to show a reasonable likelihood of success for any Challenged Claim. *See, e.g., Unified Patents Inc. v. Dynamic Data Techs., LLC*, IPR2019-01085, Paper 12, 9 (PTAB Dec. 3, 2019) (“*Unified Patents I*”) (“Petitioner bears the burden, at the institution stage, of demonstrating a reasonable likelihood that a claim is unpatentable, and thus a reasonable likelihood that it will be able to establish at trial by a preponderance of the evidence that” the asserted prior art reference qualifies as prior art). And since Petitioner has failed to meet its burden to show that *Forissier* is prior art to the ’738 Patent, “Petitioner’s arguments and analysis of [*Forissier* is] moot[.]” *U.D. Elec. Corp. v. Pulse Elecs., Inc.*, IPR2019-00515, Paper 7, 14 (PTAB Aug. 6, 2019).

But even if settled precedent is ignored and *Forissier* were found to qualify as prior art under Section 102(e) based on its foreign priority (it does not), the Petition’s Ground would still fail for multiple reasons, including because: (1) *Forissier* is still not prior art for another independent reason (*i.e.*, because of the pre-

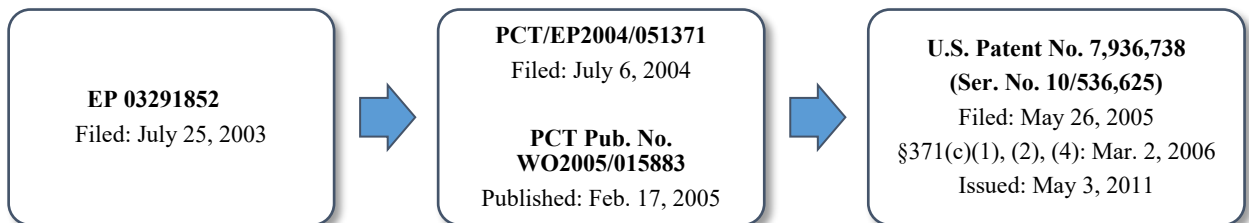
AIA 35 U.S.C. §103(c) common-ownership exclusion); and (2) *Forissier* does not disclose numerous claim limitations in the Challenged Claims.

Accordingly, Petitioner has failed to show a reasonable likelihood of success for any claim and Patent Owner respectfully submits that the Board should deny institution.

II. OVERVIEW BACKGROUND ON THE '738 PATENT AND *FORISSIER*

A. The '738 Patent's Priority Date of July 25, 2003

The '738 Patent, titled "Fault Tolerant Systems," issued as a U.S. patent on May 3, 2011. EX1101, Cover Page. Relevant to the analysis here, the '738 Patent priority chain is reflected in the following chart, showing a priority date of **July 25, 2003**:



EX1101, Cover Page; EX1102, 498, 547, 556 (identifying priority date, international application (*i.e.*, PCT) filing date, and §371 date), 513-515 (Transmittal dated May 26, 2005).

Petitioner agrees that, “for the purposes of [its IPR] Petition that **July 25, 2003**, is the effective filing date” of the ’738 Patent. Petition (Paper 1), 15 (emphasis in original).

The original foreign application, EP 03291852, shares an identical specification with the ’738 Patent (including the same disclosure, and the same 7 figures, and where the originally filed application claims are highly similar to, and closely track, the issued claims of the ’738 Patent). *Compare* EX1102, 558-581 (certified copy of original EP application provided for priority claim in application leading to the ’738 Patent) *with* EX1101 (’738 Patent); *see also* EX1102, 516-538 (U.S. application with identical disclosure, figures, and claims as original EP application); EX2020 (publication of EP application with same disclosure, figures, and claims).

The international application was published in English as WO2005/015883 and designated the United States. EX1102, 590-613; *see also* 547.

B. *Forissier*’s Section 102(e) Date is After July 25, 2003

U.S. Patent No. 7,936,763 (“*Forissier*”), titled “Method and Apparatus for Load-Balancing in a Distributed Processing System,” issued as a U.S. patent on May 3, 2011. EX1105, Cover Page. Relevant to the analysis here, Petitioner asserts that *Forissier* qualifies as prior art to the ’738 Patent only under pre-AIA Section 102(e). Petition (Paper 1), 22.

Forissier identifies, on its face, a PCT (*i.e.*, international application) filing date of May 18, 2004, and a PCT publication date of December 2, 2004 (*i.e.*, both after the '738 Patent's effective filing date).¹ Petitioner does not mention the international application of *Forissier* in its Petition, nor does Petitioner assert that the international application designated the United States or was published in English. *See* Petition (Paper 1), 19-22.²

III. THE LAW ON PRE-AIA SECTION 102(e) PRIOR ART

A. An Alleged Prior Art Reference Cannot Rely Upon its Foreign Priority Date for Section 102(e) Purposes

Pre-AIA 35 U.S.C. §102(e) provides that references may be considered as prior art where “the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) *a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent*, except that an international application filed under the treaty defined

¹ As explained in Sections III and IV.B.1, below, Petitioner is incorrect—as a matter of law—that *Forissier*'s foreign priority date (May 20, 2003) can be used for purposes of a pre-AIA Section 102(e) prior-art date.

² As explained in Section IV.B.2, below, there are no alternative dates that would result in *Forissier* being prior art to the '738 Patent.

in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States *only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*” 35 U.S.C. §102(e) (emphasis added).

This means that, for a reference to qualify as prior art under pre-AIA Section 102(e), its prior-art date can be as early as an international (PCT) filing date filed on or after November 29, 2000, so long as (i) the WIPO publication of the international application was in English and (ii) the international application designated the United States. *See* MPEP §2136 (“The prior art date of a reference under pre-AIA 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language.”); *see also* EX2021, 1 (Patent Office Flowchart explaining same, also found in MPEP §2136).

However, as the case law holds and the MPEP confirms, a foreign application filing date *cannot* be relied upon for pre-AIA Section 102(e) prior art purposes. *See Hilmer*, 359 F.2d at 862, 882-83 (rejecting attempt to use foreign priority date for pre-AIA Section 102(e) analysis); *Giacomini*, 612 F.3d at 1384 (explaining that *Hilmer* holds that a foreign priority date cannot be used as the effective filing date

for a Section 102(e) reference); *Signify N.A. Corp. v. Lepro Innovation Inc.*, 2024 WL 4149780, *4 (D. Nev. Sept. 10, 2024) (“It has been long-settled law that this language in [pre-AIA] Section 102(e) means that a published United States application or issued United States is prior art only as of its earliest filing date *in the United States* — not any earlier foreign priority date.”) (emphasis in original); MPEP §2136 (“Foreign application filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) or (b)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as pre-AIA 35 U.S.C. 102(e) dates for prior art purposes.”) (emphasis in original); MPEP §2136.03 (same); EX2021, 1 (Patent Office Section 102(e) Flowchart stating to “Consider benefit claims properly made under §119(e) to U.S. provisional applications, §120 to U.S. nonprovisional applications, and §365(c) involving IAs” but “Do NOT consider foreign priority claims” in determining a Section 102(e) prior-art date) (capitalization in original); MPEP §2136 (same flowchart with same statement).

The Federal Circuit has likewise explained the limitations of pre-AIA Section 102(e) prior-art dates. For example, in *Giacomini*, the Federal Circuit noted the requirement that an asserted prior art reference must have been deemed “filed in the United States” for a priority date to apply (which a foreign application priority filing date is definitively **not**):

Section 102(e) codified the ‘history of treating the disclosure of *a U.S. patent as prior art as of the filing date of the earliest U.S. application* to which the patent is entitled, provided the disclosure was contained in substance in the said earliest application.’ [*In re Klesper*, 397 F.2d 882, 885 (CCPA 1968) (emphasis added by *Giacomini* court)]. **According to *Hilmer*, an earlier foreign application does not shift a corresponding patent’s effective reference date because section 102(e) explicitly requires the earlier application to be ‘filed in the United States.’ *Hilmer*, 359 F.2d at 862 (quoting 35 U.S.C. §102(e)).** This court’s predecessor warned that **section 119 cannot be read with section 102(e) to modify the express domestic limitation. *Id.***

Giacomini, 612 F.3d at 1385 (italics in original; bolding added).³

While the AIA (which is not applicable here) changed the law, the MPEP has confirmed that the *Hilmer* doctrine continues to apply to all pre-AIA patents (like the ’738 Patent). This change in law, and the Office’s continued reliance on the *Hilmer* doctrine for pre-AIA patents, is reflected in the MPEP:

The AIA also eliminates the so-called *Hilmer* doctrine. **Under the *Hilmer* doctrine, pre-AIA 35 U.S.C. 102(e) limited the effective**

³ *Giacomini* also distinguished using a U.S. provisional from a foreign application for prior-art-date purposes; the former is allowed for pre-AIA Section 102(e), while the latter is not. *See* 612 F.3d at 1384-85. As explained in Section IV.B.1, below, this is a fatal flaw in Petitioner’s priority date analysis.

filing date for U.S. patents (and published applications) as prior art to their earliest U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). In contrast, AIA 35 U.S.C. 102(d) provides that if the U.S. patent document claims priority to one or more prior-filed foreign or international applications under 35 U.S.C. 119 or 365, the patent or published application was effectively filed on the filing date of the earliest such application that describes the subject matter. Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, the U.S. patent document is effective as prior art as of the filing date of the earliest such application, regardless of where filed. When examining an application to which the AIA changes in 35 U.S.C. 102 and 103 do not apply, **Office personnel will continue to apply the *Hilmer* doctrine, and foreign priority dates may not be used in determining pre-AIA 35 U.S.C. 102(e) prior art dates.** Note that the international filing date of a published PCT application may be the pre-AIA 35 U.S.C. 102(e) prior art date under pre-AIA law under certain circumstances.

MPEP §2154.01(b) (bolding added).

B. A Challenged Patent is Entitled to Claim Priority to its Foreign Priority Date as the Date of its Invention

A challenged patent is not subject to the same restrictions. In contrast to attempting to use a reference as pre-AIA Section 102(e) prior art, a patent being challenged (like the '738 Patent) is entitled to use its foreign priority date as its effective filing date for prior-art-defeating purposes because the foreign priority date is the date of its invention. *See Hilmer*, 359 F.2d at 864 (challenged patent is entitled

to use foreign filing date, while asserted prior-art reference is not); *see also Spansion, Inc. v. ITC*, 629 F.3d 1331, 1356 (Fed. Cir. 2010) (a reference is prior art under pre-AIA Section 102(e) “only if the reference patent’s effective filing date is before *the date of the invention*” of the challenged patent) (emphasis added). In other words, while pre-AIA Section 102(e) limits how a reference may be used as prior art, those limitations do not apply to the challenged patent. This is because there is only a geographical limitation for the alleged prior art reference (“filed in the United States”), but not for the challenged patent (which simply uses the invention date):

Requirements for Date of Reference to Qualify as §102(e) Prior Art	Requirement for Date of Challenged Patent
“the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another <i>filed in the United States</i> ... except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language”	“before the invention by the applicant for patent”

IV. THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY CLAIM BECAUSE THE SOLE GROUND RELIES ON A REFERENCE THAT IS NOT PRIOR ART TO THE '738 PATENT

The Petition fails to demonstrate a reasonable likelihood of success for any Challenged Claim. Petitioner's only Ground relies upon the *Forissier* reference, which is *not* prior art to the '738 Patent because (i) *Forissier* would only be eligible under pre-AIA §102(e) but (ii) it cannot use its foreign priority date (the only date that is prior to the '738 Patent).

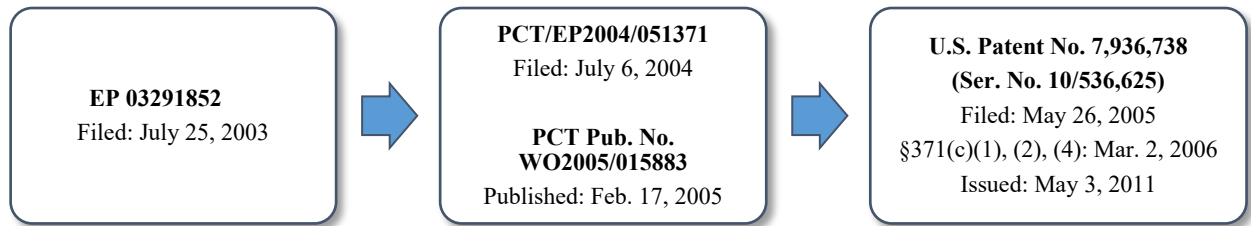
A. The Parties Agree the '738 Patent is Entitled to an Effective Filing Date of July 25, 2003

The '738 Patent claims original priority to a foreign application, filed on July 25, 2003:

(21)	Appl. No.:	10/536,625
(22)	PCT Filed:	Jul. 6, 2004
(86)	PCT No.:	PCT/EP2004/051371
	§ 371 (c)(1), (2), (4) Date:	Mar. 2, 2006
(87)	PCT Pub. No.:	WO2005/015883
	PCT Pub. Date:	Feb. 17, 2005
(65)	Prior Publication Data	
	US 2006/0143494 A1	Jun. 29, 2006
(30)	Foreign Application Priority Data	
	Jul. 25, 2003 (EP)	03291852

EX1101, Cover Page (blue highlighting added to show foreign priority).

The priority chain—beginning with the July 25, 2003, filing—is shown below:



EX1101, Cover Page; EX1102, 498, 513-515, 547, 556.

Petitioner has also asserted, in its Petition, that the '738 Patent is entitled to a priority date of July 25, 2003, for purposes of analyzing the obviousness of the Challenged Claims:

A. Effective Filing Date

The '738 patent ultimately claims priority to a foreign application, European Patent Application 03291852, filed July 25, 2003. Thus, Petitioner assumes for the purposes of this Petition that **July 25, 2003**, is the effective filing date.

Petition (Paper 1), 15 (**blue highlighting added**).

Thus, here, the Board need not consider anything further concerning the proper priority date of the '738 Patent to deny institution. *See Tianma Microelectronics Co. v. Japan Display Inc.*, IPR2021-01060, Paper 15, 8-10 (PTAB Jan. 5, 2022) (“Petitioner does not come forward with sufficient evidence to show the [challenged patent] is not entitled to its asserted ... foreign priority date” and thus “Petitioner has not established,” in its Petition, “a reasonable likelihood [of

success] that it will prevail in showing that the challenged claims are not entitled” to the foreign priority date).⁴

But regardless, Patent Owner agrees that July 25, 2003, is the proper date, consistent with the governing statute, case law, and MPEP. *See* pre-AIA 35 U.S.C. §102(e) (“before the invention by the applicant for patent...”); *Hilmer*, 359 F.2d at 862, 864, 882-83 (a challenged patent can rely upon its foreign priority claim because that is the “date of invention”); *Giacomini*, 612 F.3d at 1384 (“*Hilmer* distinguished a patent’s priority date under section 119 and effective reference date under section 102(e) in cases involving an earlier foreign application.”); *see also* Section III, above (discussing pre-AIA Section 102(e) law).

The use of the foreign filing date as the priority date for a challenged patent also aligns with the Federal Circuit’s treatment of the phrase “at the time of the invention” as being the “effective filing date.” *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (“the ordinary and customary meaning of a

⁴ The relevant dates are readily apparent from the face of *Forissier* and the ’738 Patent, making it entirely foreseeable that Patent Owner would explain how those dates apply in order to show that the Petition fails to demonstrate a reasonable likelihood of success. Thus, Patent Owner respectfully submits that no reply is warranted, should Petitioner seek leave to file one.

claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application”); *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1374 (Fed. Cir. 2009) (same and quoting *Phillips*, 415 F.3d at 1313); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991) (“the prima facie date of invention can fairly be held to be the filing date of the application”) (quotation omitted); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449 (Fed. Cir. 1986) (equating the “filing date” with “the time of the present invention” in obviousness analysis and noting that “the date of invention [is] presumed to be the filing date of the application until an earlier date is proved”).

Moreover, consistent with *Giacomini*, under pre-AIA 35 U.S.C. §119(a), a challenged patent (like the '738 Patent) is entitled to claim priority to its foreign filing date:

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, **previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, *shall have the same effect* as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the**

application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

Pre-AIA 35 U.S.C. §119(a) (emphasis added); *see also* MPEP §1842 (explaining timeline including entering national phase).

That is what happened for the '738 Patent: the applicant filed an EP application for a patent that was the same as the '738 Patent, and within twelve months, filed the PCT application, followed by the U.S. application. *See* Section II.A, above; *see also* EX1101, Cover Page (identifying chain); EX1102, 513-515 (Transmittal dated May 26, 2005), 498 547, 556 (identifying priority date, international application (*i.e.*, PCT) filing date, and §371 date), 516-538 (original U.S. application with same disclosure, figures, and claims as original EP application), 558-581 (certified copy of original EP application provided for priority claim in application leading to the '738 Patent, with same disclosure, figures, and claims); EX2020 (publication of EP application with same disclosure, figures, and claims); EX1101 ('738 Patent with same disclosures and figures as EP application, and claims that are highly similar to, and closely track, the original EP application claims); *see also* EX1102, 342-345 (applicant during prosecution explaining

exemplary support for claims, including application claim 1 and claim 35, which issued as independent claims 1 and 33 of the '738 Patent, respectively).

B. *Forissier*'s Section 102(e) Date is After July 25, 2003

1. Petitioner's Attempt to Use *Forissier*'s Foreign Priority Date is Wrong as a Matter of Law

Petitioner relies only on the foreign filing date of *Forissier* (May 20, 2003) to assert that *Forissier* qualifies as prior art under pre-AIA Section 102(e). *See* Petition (Paper 1), 19-22.

Petitioner's reliance on *Forissier*'s foreign filing date is wrong as a matter of law and dispositive of Petitioner's Ground. *See Hilmer*, 359 F.2d at 862, 882-83 (rejecting attempt to use foreign filing date for pre-AIA Section 102(e) analysis); *Giacomini*, 612 F.3d at 1384 (explaining that *Hilmer* holds that a foreign filing date cannot be used as the effective filing date for a pre-AIA Section 102(e) reference); *Klesper*, 397 F.2d at 885 (*Hilmer* clarified that "domestic and foreign filing dates stand on entirely different footings."); *Signify*, 2024 WL 4149780 at *4 ("It has been long-settled law that this language in [pre-AIA] Section 102(e) means that a published United States application or issued United States is prior art only as of its earliest filing date *in the United States* — **not any earlier foreign priority date.**") (italics in original; bolding added); *see also* Section III.A, above.

Giacomini is directly on point and controlling here. As the Federal Circuit in *Giacomini* explained, there is a fundamental distinction between claiming priority

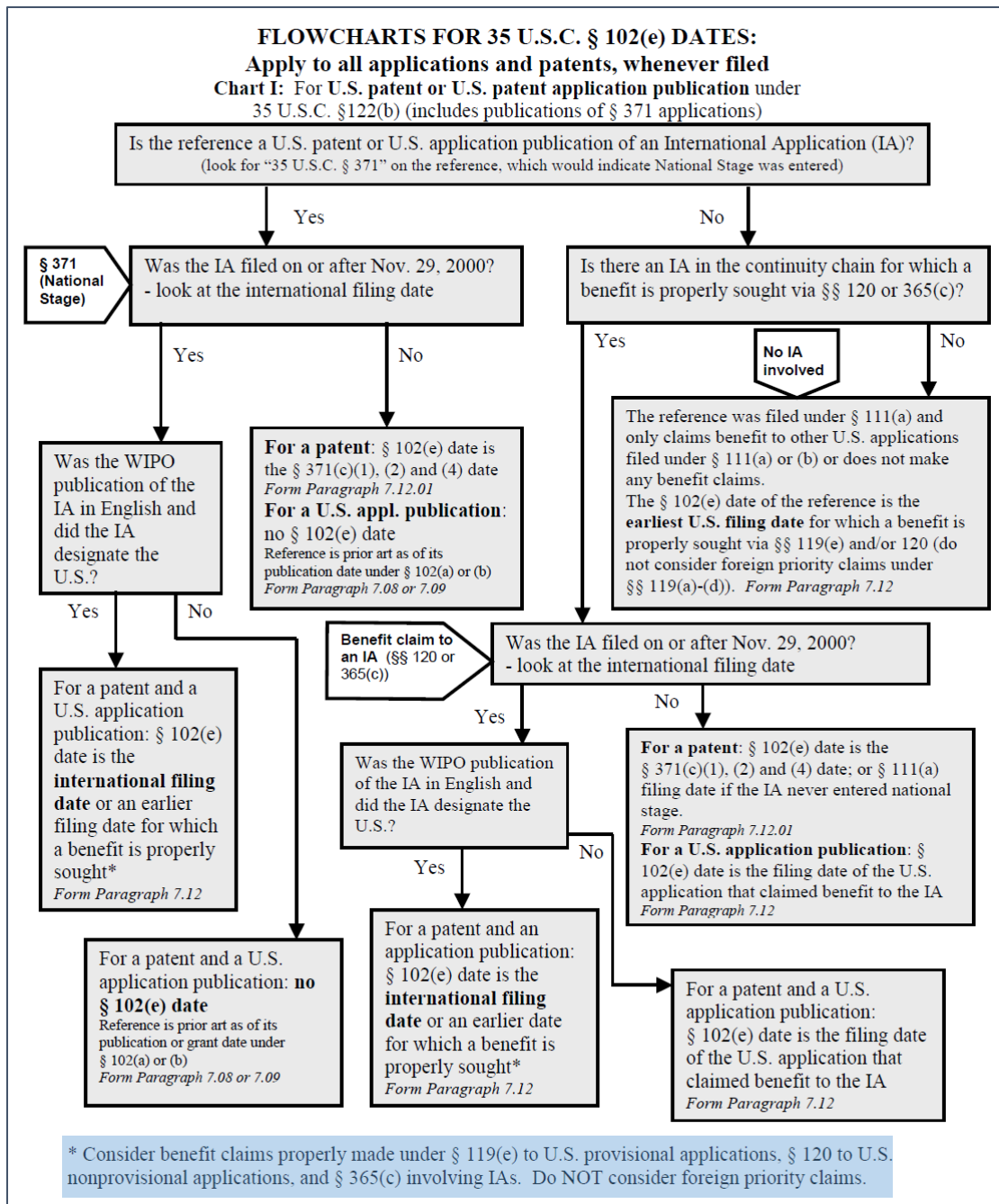
to a U.S. provisional application (which is allowed for a pre-AIA Section 102(e) prior-art assertion) and claiming priority to a foreign application (which is not allowed for a pre-AIA Section 102(e) prior-art assertion):

Giacomini misses an important distinction between *Hilmer* and the present case. ***Hilmer* involved an earlier foreign application while the present case deals with an earlier U.S. provisional application. See *Klesper*, 397 F.2d at 885 (*Hilmer* clarified that “domestic and foreign filing dates stand on entirely different footings.”).** Section 102(e) codified the “history of treating the disclosure of a U.S. patent as prior art as of the filing date of the earliest U.S. application to which the patent is entitled, provided the disclosure was contained in substance in the said earliest application.” *Id.* (emphasis added [by *Giacomini* court]). **According to *Hilmer*, an earlier foreign application does not shift a corresponding patent’s effective reference date because section 102(e) explicitly requires the earlier application to be “filed in the United States.” *Hilmer*, 359 F.2d at 862 (quoting 35 U.S.C. §102(e)).** This court’s predecessor warned that section 119 cannot be read with section 102(e) to modify the express domestic limitation. *Id.* **In contrast, an earlier provisional application is an application “filed in the United States.” 35 U.S.C. §102(e).** Treating a provisional application’s filing date as both the patent’s priority date and its effective reference date does not raise the alleged tension between sections 102(e) and 119. Given the “clear distinction between acts abroad and acts here,” *Hilmer*, 359 F.2d at 879, Giacomini’s reliance on *Hilmer* is misplaced. *Id.*

Giacomini, 612 F.3d at 1384-85 (italics in original; bolding added).

This is also consistent with the MPEP: “Foreign application filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) or (b)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as pre-AIA 35 U.S.C. 102(e) dates for prior art purposes.” MPEP §2136 (emphasis in original); MPEP §2136.03 (same and discussing *Hilmer*).

And it is consistent with the longstanding practice at the Patent Office that instructs that a U.S. provisional can be considered for a pre-AIA 35 U.S.C. §102(e) prior art date, but a foreign priority claim cannot:



EX2021, 1 (**blue highlighting added**) (“Consider benefit claims properly made under §119(e) to U.S. provisional applications, §120 to U.S. nonprovisional

applications, and §365(c) involving IAs. **Do NOT consider foreign priority claims.**”) (emphasis added); MPEP §2136 (same flow chart and statement).⁵

Petitioner’s only support for its position is two cases that are inapposite and apply only to U.S. provisionals, *not* foreign applications. *See* Petition (Paper 1), 19-20 (“Forissier is entitled to the filing date of EPA 03291191 because, as the below claim chart demonstrates, EPA 03291191 (Ex-1106) fully supports at least one claim of Forissier”) (citing *Benitec Biopharma Ltd. v. Cold Spring Harbor Laboratory*, IPR2016-00017, Paper 7, 7 (PTAB Apr. 6, 2016)) (which cites *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1381 (Fed. Cir. 2015)) (underline in original).

Both of Petitioner’s cases involved priority claims based on *U.S. provisional applications*. *See Benitec*, IPR2016-00017, Paper 7, 7 (Asserted prior art reference “Zamore issued from a non-provisional application filed on July 12, 2002, and claimed benefit of priority under 35 U.S.C. §119(e) of [U.S. Provisional App. No. 60/305,185], filed on July 12, 2001. Accordingly, Zamore is only available as prior art under §102(e) if Petitioner can show that Zamore is entitled to the earlier filing

⁵ As explained in Section IV.B.2, below, there are *no* other alternative dates under which *Forissier* would qualify as prior art (*i.e.*, every possible date is *after* July 25, 2003).

date of the '185 *provisional application*.”) (citation omitted; emphasis added); *Dynamic Drinkware*, 800 F.3d at 1381 (“A reference patent is only entitled to claim the benefit of the filing date of *its provisional application* if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with §112 ¶1.”) (emphasis added). Petitioner’s cases say nothing about foreign priority claims, which as explained above—according to the Federal Circuit, its predecessor court, and the Patent Office—cannot be considered for a pre-AIA Section 102(e) prior art date.

2. There is No Other Potential Alternative Date Under Which *Forissier* Could Qualify as Prior Art

Should Petitioner attempt, post-Petition, to switch to a different theory for *Forissier*, such attempt (aside from being improper) would not change the result: every possible alternative date for *Forissier* is ***after*** the '738 Patent’s July 25, 2003, date.

First, Petitioner does not assert in its Petition that *Forissier* qualifies as prior art under pre-AIA 35 U.S.C. §102(e) as of its international application filing date. *See* Petition (Paper 1), 19-22. Petitioner does not mention (or discuss at all) the international application (PCT No. PCT/EP2004/005487) or its publication (PCT

Pub. No. WO2004/105341). *See id.*⁶ Nor does Petitioner assert that the international application was both published in English and designated the United States. *See id.*; *see also* MPEP §2136 (“The prior art date of a reference under pre-AIA 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language.”); MPEP §2136.03 (detailing same); EX2021, 1 (Patent Office Flowchart explaining same); MPEP §2136 (same flowchart).

But even if the Petition did assert and demonstrate that *Forissier* met the qualifications to use its international filing date for pre-AIA Section 102(e) prior-art

⁶ Petitioner only discusses the foreign EP application and briefly mentions the corresponding publication of that foreign application. Petition (Paper 1), 19 (*Forissier* “claims priority to foreign application European Patent Application 03291191 (‘EPA 03291191’) (published as EP1480407A1), which was filed on May 20, 2003.”) (citing EX1106). But, even if Petitioner relied on the international application, as explained in this Section IV.B.2, *Forissier* would still not qualify as prior art based on its international filing date (May 18, 2004), which is after the ’738 Patent’s July 25, 2003, date.

purposes—which the Petition does not—*Forissier*’s earliest possible pre-AIA Section 102(e) date (May 18, 2004) would still be *after* the ’738 Patent’s effective filing date (July 25, 2003). EX1105, Cover Page; EX1101, Cover Page.⁷

Second, no other statutory section would qualify *Forissier* as prior art to the ’738 Patent. The only other possible statutory sections that could potentially qualify *Forissier* are pre-AIA Sections 102(a) or 102(b). But neither does, as *Forissier* was not patented or published until well after the ’738 Patent’s July 25, 2003, date. EX1105, Cover Page (*e.g.*, *Forissier*’s issue date is May 3, 2011). Notably, Petitioner agrees: Petitioner does not assert that any statutory section applies to

⁷ Under the evidence and theory Petitioner presented in the Petition, *Forissier* has no pre-AIA Section 102(e) date (because Petitioner does not mention the international application, let alone assert and evidence that the international application was both published in English and designated the United States). EX2021, 1 (Flowchart explaining that “For a patent [from a “WIPO publication of the IA” that was not both in English and designated the U.S.]... **no §102(e) date**[.] Reference is prior art as of its publication or grant date under §102(a) or (b)”) (emphasis in original); MPEP §2136 (same). So, under the Petition’s evidence and theory, the earliest possible prior-art date would be when *Forissier* issued on May 3, 2011. EX1105, Cover Page.

Forissier other pre-AIA Section 102(e). Petition (Paper 1), 22 (identifying only Section 102(e)).

Third, even if Petitioner attempted to switch, post-Petition, to a different *Forissier* reference, it also would not change the result. The PCT application published on December 2, 2004 and the U.S. patent application published on March 15, 2007. EX1105, Cover Page. Not only are these references not of record here and any attempt to change theories to use them would be improper, the references likewise are not prior art to the '738 Patent. Both published after the '738 Patent's foreign priority date (July 25, 2003), as well as after the '738 Patent's international application filing date (July 6, 2004). EX1101, Cover Page. The earliest possible date for the PCT application was when it published on December 2, 2004. *See* pre-AIA 35 U.S.C. §102(a). The earliest possible date for the U.S. patent application would be the same as *Forissier* (May 18, 2004), assuming the international application was published in English and designated the United States. *See* pre-AIA 35 U.S.C. §102(e); MPEP §2136.

Thus, regardless of what date may be used for *Forissier* (or any related reference), *Forissier* does not qualify as prior art because every possible prior-art date is ***after*** the '738 Patent's July 25, 2003, date.

* * * *

Accordingly, Petitioner has not and cannot show that *Forissier* qualifies as prior art, so its Petition fails to demonstrate a reasonable likelihood of success and should be denied. *See, e.g., Unified Patents I*, IPR2019-01085, Paper 12, 9 (“Petitioner bears the burden, at the institution stage, of demonstrating a reasonable likelihood that a claim is unpatentable, and thus a reasonable likelihood that it will be able to establish at trial by a preponderance of the evidence that” the asserted prior art reference qualifies as prior art); *Tianma Microelectronics*, IPR2021-01060, Paper 15, 8-10 (“Petitioner does not come forward with sufficient evidence to show ... the [challenged patent] is not entitled to its asserted ... foreign priority date” and thus “Petitioner has not established,” in its Petition, “a reasonable likelihood [of success] that it will prevail in showing that the challenged claims are not entitled” to the foreign priority date); *Unified Patents Inc. v. Custom Media Techs., LLC*, IPR2015-00516, Paper 9, 20-21 (PTAB June 25, 2015) (“Petitioner has not established that [a reference] qualifies as prior art” and thus “Petitioner has not demonstrated a reasonable likelihood [of success] that [challenged claims] are unpatentable as anticipated by or obvious over [the reference].”); *see also Dynamic Drinkware*, 800 F.3d at 1379 (“Dynamic, as the petitioner, had the burden of persuasion to prove unpatentability by a preponderance of the evidence, and this burden never shifted,” including to show that an asserted reference qualifies as prior art).

V. OTHER PROBLEMS WITH THE PETITION'S GROUND

Because *Forissier* is not prior art under pre-AIA Section 102(e) based on its foreign priority as a matter of law, Petitioner has not—and cannot—meet its burden to show a reasonable likelihood of success for any Challenged Claim. The Board need not reach any other issue to deny institution and thus Patent Owner has focused this Patent Owner Preliminary Response on this dispositive issue.

Notwithstanding, there are numerous other failures with the Petition's sole Ground. As one example: *Forissier* is also not prior art under pre-AIA Section 102(e) for Petitioner's obviousness ground for an additional, independent reason (*i.e.*, under the pre-AIA Section 103(c) common ownership exclusion).⁸

In short, *Forissier* is additionally not prior art because (i) it could only potentially be prior art under pre-AIA Section 102(e), (ii) *Forissier* and the '738 Patent have different inventors, and (iii) *Forissier* was assigned to, and under an

⁸ The Petition also fails to demonstrate that the prior art renders obvious the Challenged Claims, including that the prior art discloses several claim limitations of the Challenged Claims. While the Board need not consider these issues given the dispositive issue Patent Owner explained in Sections III and IV above, if the Board institutes, Patent Owner will explain in more detail in subsequent briefing why *Forissier* is not prior art and does not render obvious any of the Challenged Claims.

obligation to be assigned to, the same entity as the '738 Patent (Hewlett-Packard Development Company, L.P.), as of the '738 Patent's effective filing date (July 25, 2003). *See, e.g.*, EX1101, Cover Page ('738 Patent identifying Hewlett-Packard Development Company, L.P.); EX1102, 558 (original foreign application ultimately leading to the '738 Patent, filed on July 25, 2003, identifying Hewlett-Packard Development Company, L.P.); EX1105, Cover Page (*Forissier* identifying Hewlett-Packard Development Company, L.P.); EX1106, 3 (foreign priority application regarding *Forissier* filed on May 20, 2003, identifying Hewlett-Packard Development Company, L.P.).⁹

Thus, *Forissier* is additionally not prior art because of the pre-AIA Section 103(c) common-ownership exclusion. *See* Pre-AIA 35 U.S.C. §103(c)(1) ("Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."); *see also, e.g., Marvell Semiconductor, Inc. v.*

⁹ Like the foreign-priority issue, this issue is likewise apparent from the face of *Forissier* and the '738 Patent, and Petitioner's own cited documents. *See also* n.4, above.

Intell. Ventures I LLC, IPR2014-00552, Paper 79, 7 (PTAB Nov. 30, 2015) (“Because Webster is the principal reference in all challenges, if Webster is disqualified as prior art under §103(c), those challenges all fail.”); *Global Tel*Link Corp. v. Securus Techs., Inc.*, IPR2014-00824, Paper 36, 10-12, 23 (PTAB Dec. 2, 2015) (“Petitioner ... has not met its burden to demonstrate that [the reference] is not disqualified under §103(c)”); *U.D. Elec. Corp. v. Pulse Elecs., Inc.*, IPR2019-00515, Paper 7, 14-15 (PTAB Aug. 6, 2019) (“We agree with Patent Owner’s analysis and determine that [the reference] is prior art only under pre-AIA 35 U.S.C. §102(e), was subject to common ownership as the [challenged] Patent at the time of invention, and cannot be used ... to preclude patentability under pre-AIA 35 U.S.C. §103 because of section (c) of that statute.”); *Samsung Elecs. Am., Inc. v. Collision Commc’ns*, IPR2024-01500, Paper 14, 18-21 (PTAB Apr. 28, 2025) (reference was not prior art because of pre-AIA Section 103(c) common ownership exclusion where inventor had obligation to assign as of filing date to same company as challenged patent); *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00053, Paper 66, 20 (PTAB May 1, 2014) (finding “that the claimed invention was made on December 30, 1999, the effective filing date of the [challenged] patent”).¹⁰

¹⁰ The common-ownership exclusion is also at issue in a co-pending IPR filed by the same Petitioner against another of Patent Owner’s patents (IPR2025-00414).

And, if instituted, Patent Owner would explain in detail this pre-AIA Section 103(c) issue (and other issues).

VI. CONCLUSION

Petitioner improperly attempts to rely upon the foreign priority date of *Forissier*—the only reference in Petitioner’s only Ground—to assert that it qualifies as prior art under pre-AIA Section 102(e). This is wrong as a matter of law, dispositive of Petitioner’s Ground, and, while not the only dispositive issue, demonstrates denial of institution is warranted.

Because Petitioner has failed to show—and cannot show—that the *Forissier* reference qualifies as prior art to the ’738 Patent, Patent Owner respectfully submits that the Board should deny institution as Petitioner has failed to show a reasonable likelihood of success for any claim.

Dated: June 10, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. §42.24 (as determined by the Microsoft Word word-processing system used to prepare this paper) because it contains 6075 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Dated: June 10, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that the foregoing PATENT OWNER PRELIMINARY RESPONSE and Exhibits listed on the List of Exhibits that were not previously served in connection Patent Owner's Discretionary Denial Brief, were served on June 10, 2025, via electronic mail upon counsel of record for Petitioner at the following email addresses:

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