

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFEVAC, LLC,

Petitioner

v.

DCSTAR INC.,

Patent Owner

IPR2025-00454

Patent 11,478, 575

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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Patent Owner's Exhibit List

2001	Declaration of RAM.SHAW PTE.LTD
2002	Declaration of Ligui He
2003	IDEAR Trademark
2004	IDEAR reference
2005	Cultures Inc. Amazon Profile
2006	First cease and desist letter
2007	Second cease and desist letter
2008	IDEAR Amazon listing
2009	U.S. Patent No. 10,052,115 (Lih) (Google Patents)
2010	Zhongnan CNIPA Supplementary Search
2011	U.S. Patent No. 4,971,053 (Tarrats) (Google Patents)
2012	IDEAR reference (Ex. 2004) Annotated
2013	PCT Appl. No. WO2015167709A1 (Lih) (Google Patents)
2014	U.S. Patent No. 3,939,830 (Costa) (Google Patents)
2015	Korean Patent No. 102,229,619 (Yuchang) (Google Patents)
2016	Chinese Patent No. 112,932,633 (Zhongnan) (Google Patents)
2017	Prosecution history index for Zhongnan
2018	Petitioner's prior PGR Petition (PGR2023-00032)
2019	U.S. Patent No. 11,478,575 (Google Patents)

I. Introduction

Pursuant to the “Interim Processes for PTAB Workload Management” Memorandum dated March 26, 2025, Patent Owner submits this brief in support of discretionary denial. As explained more fully below, Petitioner’s primary reference is not prior art under 35 U.S.C. § 102(b)(1)(B) and each of the *General Plastic* and *Advanced Bionics* factors favor discretionary denial of institution.

First, Petitioner’s primary reference, Zhongnan, is disqualified as prior art under 35 U.S.C. § 102(b)(1)(B) because the subject matter disclosed in Zhongnan had, before such disclosure, been publicly disclosed by another who obtained the subject matter directly or indirectly from the inventor. Without Zhongnan, both Grounds 1 and 2 fail, and Petitioner cannot demonstrate a reasonable likelihood of prevailing with respect to at least one challenged claim under 35 U.S.C. § 314(a).

Second, the Director should exercise her discretion and deny institution of this IPR as an improper follow-on proceeding under *General Plastic*. Petitioner had the opportunity to pursue a decision on the merits against the ’575 Patent in its prior proceeding, PGR2023-00032. Pet. at 65. That PGR petition (Ex. 2018) was denied institution on November 29, 2023—more than a year before the current petition was filed. PGR2023-00032, Papers 2, 11; Pet. at 65. Also, as explained below, Petitioner would have been aware of Zhongnan at the time of filing its prior petition had it undertaken a reasonably diligent search. Petitioner not only filed this second IPR petition long after the Board denied institution of PGR2023-00032 but also after strategically waiting ***more than eight months*** after being aware of Zhongnan so it could maximize its use of the full record in the prior proceeding. This is the type of gamesmanship the Board’s discretionary denial precedent seeks to prevent.

Third, Petitioner relies on art (Zhongnan) that is substantially the same as art that was before the Office during prosecution—specifically a reference referred to

as the IDEAR reference (“IDEAR,” Ex. 2004).¹ Relatedly, the central issue in this IPR, whether subject matter disclosed in IDEAR disqualifies Zhongnan, is substantively the *exact same issue* that the Examiner considered during prosecution when she concluded that IDEAR was not prior art because it was obtained from the inventor. The cumulative nature of these issues favor denying institution. Lastly, the Petition makes no mention of material error by the Office, failing to carry its burden under *Advanced Bionics*.

For these reasons, and as explained more fully below, the Director should exercise her discretion and deny institution.

II. The Cited Art

A. Zhongnan (Ex. 1004)

Chinese Patent Application No. 202110259986.4 (hereinafter “Zhongnan”) titled TRACHEAL FOREIGN BODY SUCTION DEVICE AND METHOD, was filed March 10, 2021, and published June 11, 2021. Zhongnan, relates to the removal of foreign bodies from the trachea. Petitioner alleges Zhongnan qualifies as prior art under 35 U.S.C. 102(a)(1). Pet. at 20. That statute states that a “a person shall be entitled to a patent unless – (1) the claimed invention was . . . described in a **printed publication** . . . before the effective filing date of the claimed invention.” Zhongnan is alleged to be a printed publication as its June 11, 2021 publication date.

Notably, Petitioner does not allege that Zhongnan is prior art as of its filing date. This is because Zhongnan fails to meet the requirements of 35 U.S.C. § 102(a)(2) to qualify as prior art as of that date. Under the statute, an application may only be accorded its filing date for prior art purposes if it is “published or deemed published under section 122(b),” i.e., received in the United States Patent

¹ A clearer version of IDEAR is provided as Ex. 2008.

and Trademark Office. *See also* MPEP § 2151 (indicating that 35 U.S.C. 102(a)(2) may be based only on U.S. patent documents). Zhongnan was neither filed under the Patent Cooperation Treaty (PCT), nor was it later filed in the United States. Therefore, Zhongnan’s filing date of March 10, 2021 is irrelevant to this proceeding, and the earliest possible prior art date of Zhongnan is its publication date of June 11, 2021.²

B. Yuchang (Ex. 1008)

Korean Patent Application No. 10-2021-0004323 (hereinafter “Yuchang”) titled REMOVAL APPARATUS FOR ESOPHAGEAL FOREIGN SUBSTANCES, was filed January 13, 2021, and published March 18, 2021. Yuchang relates to a device for removing foreign substances from the esophagus and is alleged to be prior under 35 U.S.C. § 102(a)(1). Yuchang is a Korean Patent Application with no relation to a U.S. or PCT filing. Thus, the earliest possible prior art date for Yuchang under 35 U.S.C. § 102(a)(2) is its March 18, 2021 publication date.

III. The Director Should Exercise Her Discretion and Deny Institution Under 35 U.S.C. §§ 314(a) and 325(d).

The Director has discretion to institute an *inter partes* review under 35 U.S.C. §§ 314(a) and 325(d). *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a) (stating “[t]he Director *may not* authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable

² Because this date is less than one year before the effective filing date of the challenged patent, Zhongnan may be disqualified as prior art under 35 U.S.C. § 102(b)(1) as explained in more detail below.

likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition” (emphasis added)); 35 U.S.C. § 325(d) (stating “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director *may* take into account whether, and reject the petition or request because, *the same or substantially the same prior art* or arguments previously were presented to the Office”). Institution of review is entrusted to the Director’s discretion. *See* 37 C.F.R. § 42.108(a), § 42.4(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016).

Here, 35 U.S.C. § 314(a) supports discretionary denial. As described below, Zhongnan is not prior art under 35 U.S.C. § 102(b)(1)(B) because an inventor-originated public disclosure occurred before Zhongnan’s publication date. Without Zhongnan, both Grounds 1 and 2 fail, and Petitioner cannot demonstrate a reasonable likelihood of prevailing with respect to at least one challenged claim under 35 U.S.C. § 314(a). For at least this reason, the Director should exercise her discretion and deny institution.

Further, Board precedent supports denying institution under 35 U.S.C. §§ 314(a) (follow-on petitions) and 325(d) (same/similar prior art previously considered). First, the Petition is an improper follow-on petition—Petitioner unsuccessfully challenged the ’575 Patent in PGR2023-00032. Though there is no *per se* rule prohibiting follow-on petitions after the Board has denied one or more first-filed petitions against the same patent, the Board is prescient of the potential for abuse and inequities borne by patent owners facing serial petitions. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisa*, IPR2016-01357, Paper 19, at 17-18 (PTAB 2017) (precedential in relevant part). As such, as part of its exercise of discretion under 35 U.S.C. § 314(a), the Board considers a non-exhaustive list of factors set forth in *General Plastic*. IPR2016-01357, Paper 19, at 17-18 (PTAB 2017) (precedential in relevant part). These factors all favor denying

institution. Second, in exercising its discretion under 35 U.S.C. § 325(d), the Board uses a two-part framework laid out in its precedential *Advanced Bionics* decision. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6, at 8 (PTAB 2020) (precedential). The Petition fails to address the *Advanced Bionics* factors. Also, as described below, Petitioner's strategic decision to stage its arguments to get the proverbial second bite at the apple is precisely what the Board sought to prevent with its binding precedent. Institution should be denied.

A. Zhongnan is Not Prior Art Under 35 U.S.C. § 102(b)(1)(B).

For each of Grounds 1 and 2, Petitioner relies primarily on Zhongnan, which as explained below, is not prior art under 35 U.S.C. § 102(b)(1)(B) because there was an earlier inventor-originated public disclosure.

Petitioner alleges that the Zhongnan publication qualifies as 35 U.S.C. §102(a)(1) prior art as of its June 11, 2021 publication date. Pet. at 20. Although, Zhongnan initially qualifies under 35 U.S.C § 102(a)(1) as of its publication date, that is not the end of the analysis. Under the AIA, section 102(b) expressly provides various exceptions to disclosures like Zhongnan. The statute provides:

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if . . . the subject matter disclosed had, before such disclosure, been ***publicly disclosed by*** the inventor . . . or ***another who obtained the subject matter disclosed directly*** or indirectly ***from the inventor . . .***.”

35 U.S.C. §§ 102(b)(1)(B).

Patent Application 17/393,249, which issued as the challenged patent, was filed on **August 3, 2021**. The alleged publication date of Zhongnan under 35

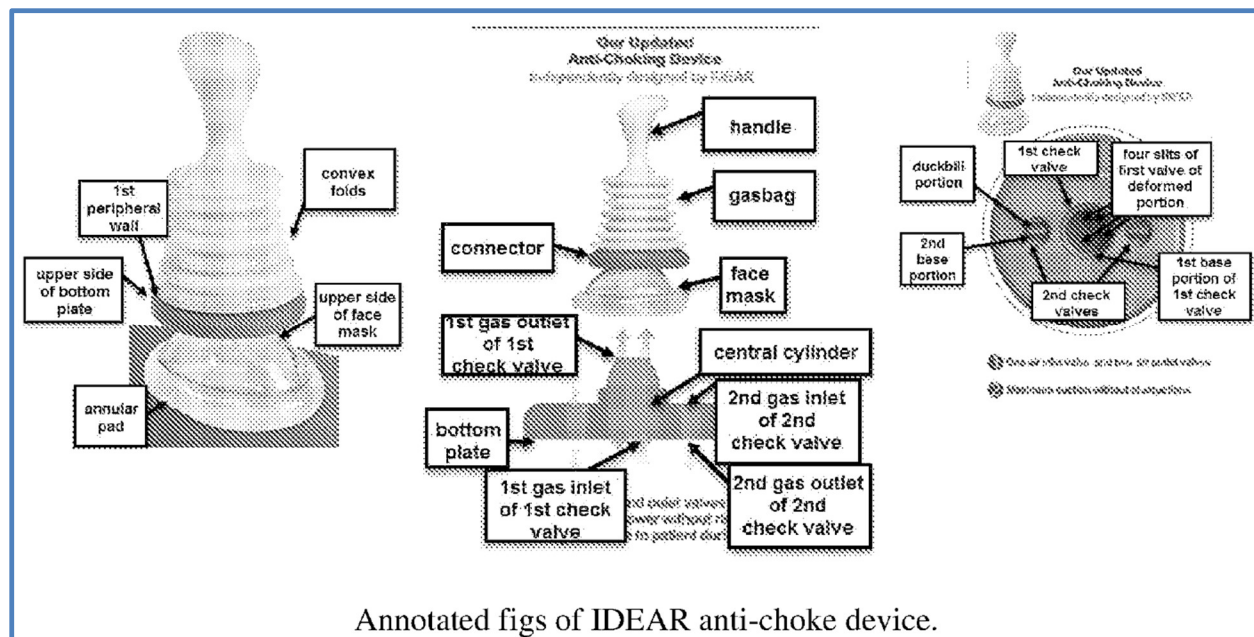
U.S.C. §102(a)(1) is **June 11, 2021**—less than two months earlier. *Supra*, II. A. Thus, Zhongnan’s publication date falls within the one-year grace period under 35 U.S.C. § 102(b)(1). Therefore, any disclosure by or originating from the inventor after August 3, 2020 and before June 11, 2021 disqualifies Zhongnan as prior art. 35 U.S.C. §§ 102(b)(1)(A)-(b)(1)(B).

A prior public disclosure originating from the inventor, Ligui He, was made in the form of the IDEAR disclosure (Ex. 2004), which was publicly disclosed on an Amazon storefront doing business as Cultures, Inc. as early as **April 28, 2021**. Ex. 2001, ¶¶ 5-6. In fact, this same IDEAR public disclosure was cited by the Examiner during prosecution of the challenged patent in an Office Action dated March 22, 2022.³ Ex. 1002 at 132-144. In the Action, the Examiner rejected the claims under 35 U.S.C. 102(a)(1) “based upon a public use or sale or other *public availability of the invention*: IDEAR⁴ anti-choke device has been listed on sale *on Amazon since April 28, 2021*.” *Id.* at 134-135. The Examiner also presented a

³ It is notable that Petitioner’s original PGR petition included a detailed discussion of the prosecution history of the challenged patent including how Patent Owner disqualified IDEAR as prior art. Ex. 2018 at 23. In contrast, the current Petition—where that discussion would have been *much more relevant* to disqualifying Zhongnan—*omitted any mention of IDEAR* or of how Patent Owner overcame IDEAR during prosecution. Pet. at 10-11.

⁴ The IDEAR anti-choking device cited by the Examiner as prior art during prosecution is the same document referenced above as IDEAR and appended hereto as Ex. 2004.

marked-up version of IDEAR, clearly showing that all claim elements of the challenged patent were publicly disclosed in IDEAR:



Id.

Patent Owner overcame this rejection by pointing out that the “subject matter of IDEAR is attributable to the inventor” and “originated from the inventor.” *Id.* at 126. Patent Owner’s argument was supported by a Declaration of inventor Ligui He (“He Declaration”) stating that “***IDEAR is based on the subject matter of the present application... IDEAR is based on the conception or development of the subject matter disclosed and claimed in the present application which are attributable to me.***” *Id.* at 131; Ex. 2002. Satisfied that the He Declaration disqualified IDEAR as prior art, the Examiner withdrew her rejection in the following office action. *Id.* at 103 (indicating “Applicant’s arguments . . . with respect to the rejection(s) [based on IDEAR] have been fully considered and are persuasive.”).

The public nature of the IDEAR disclosure was acknowledged by Petitioner in a pair of letters to Cultures, Inc. in 2021 and 2022. On September 8, 2021—only

36 days after the challenged patent was filed in the patent office—Petitioner sent a first cease and desist letter (Ex. 2006) to Cultures, Inc.⁵ In that letter, Petitioner cited the IDEAR anti-choking device on the Amazon storefront listing (Ex. 2004) as purported evidence of infringement of one of Petitioner’s patents. Petitioner sent a second cease and desist letter (Ex. 2007) on July 13, 2022 stating “Cultures Inc. (‘Cultures’) is selling suction products under the IDEAR brand name . . . [and] at least the following IDEAR products shown in table 1 (collectively, the “Accused Products”), may infringe . . .” a LifeVac patent.⁶ Below is a table from Petitioner’s second cease and desist letter that provides a list of the “Accused Products” and includes a “*Date First Available*” listed as April 28, 2021. Ex. 2007.

⁵ The date of the first cease and desist letter was six months before the Examiner cited IDEAR during prosecution (Ex. 1002 at 132-145), showing that the Petitioner and the Examiner independently discovered the IDEAR reference and supporting the conclusion that IDEAR was “publicly disclosed” under 35 U.S.C. § 102(b)(1)(B).

⁶ The Cease and Desist Letters (Exs. 2006, 2007) constitute authorized party admissions and are not hearsay. Federal R. Evid. 801(d)(2).

Table 1 – Cultures Inc. Accused Products on Amazon.com

ASIN	Date First Available	Amazon Storefront
B093NTJ3L5	April 28, 2021	https://www.amazon.com/s?me=A23276YMZUF0ZS&marketplaceID=ATVPDKIKX0DER
B093PNYMF8	April 28, 2021	https://www.amazon.com/s?me=A23276YMZUF0ZS&marketplaceID=ATVPDKIKX0DER
B093NZN5C7	April 28, 2021	https://www.amazon.com/s?me=A23276YMZUF0ZS&marketplaceID=ATVPDKIKX0DER
B09DGBTLN7	August 24, 2021	https://www.amazon.com/s?me=A23276YMZUF0ZS&marketplaceID=ATVPDKIKX0DER
B09DGDF44G	August 24, 2021	https://www.amazon.com/s?me=A23276YMZUF0ZS&marketplaceID=ATVPDKIKX0DER
B09XHYC4TQ	April 8, 2022	https://www.amazon.com/Choking-Rescue-Device-Suction-Portable/dp/B09XHYC4TQ/ref=sr_1_1?crid=727D0UGX0C08&keywords=B09XHYC4TQ&qid=1651512845&sprefix=b09xhyc4tq%2Caps%2C118&sr=8-1
B09XTK23YW	April 13, 2022	https://www.amazon.com/IDEAR-Essential-Apparatus-Obstructed-Material/dp/B09XTK23YW/ref=sr_1_6?keywords=IDEAR&qid=1651511444&sr=8-6

Ex. 2007 at 2. As shown above, much like the Examiner during prosecution, Petitioner conceded in its cease and desist letters that the Amazon storefront showing the *IDEAR anti-choking device was publicly available as early as April 28, 2021*.

IDEAR is a federally registered trademark in the United States under U.S. Registration No. 6,693,596, which is registered to RAM.SHAW PTE. LTD., a limited liability company incorporated under the laws of Singapore (hereinafter “RAM.SHAW”) Ex. 2003; Ex. 2001, ¶ 2. RAW.SHAW has maintained a long-term partnership with DCSTAR, the owner of the challenged patent, and has submitted a declaration in support of this Discretionary Denial Brief. Ex. 2001, ¶ 3. In the

declaration, RAM.SHAW testified that it authorized the Amazon store doing business as Cultures Inc. to use the IDEAR trademark to market and sell IDEAR-branded products in the United States, including the anti-choking device shown in Exhibit 2004. *Id.*, ¶ 4. Below is an annotated version of the IDEAR reference showing that, although low resolution, it includes the Amazon Standard Identification Number (“ASIN”) number B093NZN5C7. Ex. 2012 at 3.



Id. RAM.SHAW confirmed that the IDEAR reference cited by the Examiner during prosecution (Ex. 2004) shows Cultures Inc.’s anti-choking device having the ASIN number B093NZN5C7. *Id.*, ¶ 5; Ex. 2004 at 3. The exact same ASIN number is also specifically listed in Petitioner’s cease and desist letter, which shows that Petitioner’s letter cited the same IDEAR document that the Examiner cited during prosecution. Ex. 2007 at 2. As the authorized trademark owner of IDEAR, RAM.SHAW also confirmed that the Amazon storefront featured in IDEAR (Ex. 2004) was publicly disclosed at least as early as April 28, 2001. *Id.* at ¶ 5. Like the He Declaration submitted during prosecution of the ’575 patent, RAM.SHAW testified that the subject matter described in IDEAR (Ex. 2004) was obtained directly or indirectly from Ligui He. Ex. 2001, ¶ 6.

Additional support that the public disclosure in IDEAR was obtained directly or indirectly from Ligui He can be found on Cultures, Inc.’s IDEAR Amazon storefront, which indicates that its products are licensed from the owner of the challenged patent, DCSTAR Inc.:

About Seller

Our store sells products under the U.S.-registered IDEAR brand (Registration No. 6693596). The technology used in IDEAR products is licensed from DCSTAR INC.

Ex. 2005 at 1.

The Federal Circuit has held that to be “publicly disclosed” under the § 102(b)(1)(B) prior art exception requires that the ***subject matter be made available to the public***. *Sanho Corp. v. Kaijet Tech. Int’l Ltd. Inc.*, 108 F.4th 1376, 1381–83 (Fed. Cir. 2024). Based on the above discussion and evidence, the IDEAR disclosure was available to the public on the Amazon storefront and therefore constitutes a public disclosure under 35 U.S.C. § 102(b)(1)(B) at least as of April 28, 2021, which was before Zhongnan’s June 11, 2021 publication date.

Additionally, an analysis of the prior art exceptions under 35 U.S.C. § 102(b)(1)(B) requires a comparison of the features of the alleged prior art reference to those in the prior public disclosure. The Manual of Patent Examining Procedure explains this analysis as follows:

What is required for subject matter in an intervening grace period disclosure to be excepted under AIA 35 U.S.C. 102(b)(1)(B) is that the same subject matter as in the intervening disclosure must have been previously publicly disclosed by the inventor or a joint inventor (or by another who obtained the subject matter therefrom).

M.P.E.P. § 2153.02. In this case, Petitioner alleges that Zhongnan discloses all of the features of claims 1-2, 7, 13 and 14. Pet. at 21-43. Similarly, the Examiner alleged that IDEAR disclosed all of the features of claims 1-3, 5, and 7-17. Ex. 1002 at 132-142. It follows that all claim features alleged to be present in Zhongnan are also shown in IDEAR. As a result, taking Petitioner’s allegations as

true for purposes of this briefing, it necessarily follows that IDEAR publicly disclosed all relevant features of Zhongnan, thereby disqualifying it as prior art.

In summary, Zhongnan is not prior art under 35 U.S.C. § 102(b)(1)(B) because: (i) the IDEAR disclosure originated from the inventor of the '575 Patent and was publicly disclosed before Zhongnan's publication date, and (ii) the IDEAR disclosure illustrates all of the relevant features contained in Zhongnan. Because the Petition relies primarily on Zhongnan in each of its Grounds 1 and 2, both Grounds are unlikely to prevail. For at least this reason, the Director should exercise her discretion and deny institution.

B. Institution should be denied under *General Plastic*.

Petitioner had the opportunity to pursue a decision on the merits against the '575 Patent in its prior PGR. Petitioner's repeated attacks on the same claims of the same patent are precisely the exploitation of post-grant proceedings the Board seeks to prevent under *General Plastic*. IPR2016-01357, Paper 19, at 17. These tactics warrant discretionary denial.

General Plastic "recognize[d] the potential abuse of the review process by repeated attacks on patents" and provided guidance for denying such petitions under 35 U.S.C §314(a). PTAB Consolidated Trial Practice Guide 56 (Nov. 2019) (citing *General Plastic*, IPR2016-01357, Paper 19, at 16–17). In that precedential decision, the Board set forth a non-exhaustive list of factors that may be used to determine if a follow-on petition warrants denial:

1. Whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. Whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. Whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. The finite resources of the Board; and
7. The requirements under 35 U.S.C. §316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, IPR2016-01357, Paper 19, 15–16. No single factor is dispositive, and “not all the factors need to weigh against institution for [the Board] to exercise [its] discretion under §314(a).” *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-02150, Paper 11 at 7 (PTAB 2018) (emphasis added). Rather, the factors are “part of a balanced assessment of all relevant circumstances in the case . . . and are not intended to represent all situations where it may be appropriate to deny a petition.” PTAB Consolidated Trial Practice Guide at 56 (citing *General Plastic*, IPR2016-01357, Paper 19, at 15-16).

Recognizing that institution imposes a tremendous burden on the Board and a patent owner, the *General Plastic* factors are meant to prevent a petitioner from pursuing serial challenges and strategically using the Board's prior decisions and patent owner's arguments as a roadmap to refine the petitioner's case. IPR2016-

01357, Paper 19 at 17. Indeed, the central issue is balancing the equities between a petitioner and a patent owner. *Id.* at 15-19. Here, Petitioner’s tactical use of PTAB proceedings should not be permitted to proceed as it would constitute an inefficient use of Board and party resources. The *General Plastic* factors uniformly point toward denial of institution.

1. LifeVac Challenged the Same Claims of the ’575 Patent in PGR2023-00032 (*General Plastic* Factor One)

LifeVac filed its petition seeking PGR review of the ’575 Patent on May 15, 2023. Ex. 2018; Pet. at 65. Nearly two years later, LifeVac filed the instant Petition directed to the same claims of the same patent. Pet. at 65.

In assessing *General Plastic* factor one, the Board has previously found that as little as a single overlapping claim challenged in two serial petitions with “minimal overlap” may weigh “in favor of invoking our discretion to deny institution of a second petition.” *Club Champion LLC v. True Spec Golf LLC*, IPR2019-01569, Paper 9 at 9, 6 (PTAB 2020); *see also Metall Zug Ag et al. v. Carl Zeiss Meditec AG*, IPR2020-01074, Paper 8 at 5-6 (PTAB 2021) (discretionarily denying serial petitions with only a “relatively minimal degree of overlap”). Given that PGR2023-00032 was filed against the same claims of the same patent, *General Plastic* factor one weighs strongly in favor of denying institution.

2. LifeVac Should Have Known of Zhongnan and Yuchang (*General Plastic* Factor Two)

The second *General Plastic* factor considers “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition *or should have known of it.*” IPR2016-01357, Paper 19 at 16 (emphasis added). This factor includes considering whether the prior art in the later petition could have been found with reasonable diligence. *Id.* at 9, 20 (describing “[w]hat a petitioner ‘could have raised,’” as including “prior art which a skilled searcher

conducting a diligent search reasonably could have been expected to discover.”) (citing *Apotex Inc. v. Wyeth LLC*, IPR2015-00873, Paper 8 at 6 (PTAB 2015)). The Petition is an improper follow-on petition based on art that Petitioner should have known about under *General Plastic*.

In assessing factor two, institution has been denied when the newly asserted prior art: (i) consists of publicly available patent documents; (ii) has similar classifications or are in a related field to the challenged patent; and/or (iii) uses “common terms” as the challenged patent. *See, e.g., Shanghai Lunion Info. Techs., Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2018-00995, Paper 12 at 17 (PTAB 2018) (the references were “patent documents having similar classifications as the [challenged patent]” and “presumably could have been uncovered with a reasonably diligent search”); *Longi Green Energy Tech. Co. v. Hanwha Sols. Corp.*, IPR2020-00047, Paper 18 at 9 (PTAB Apr. 27, 2020) (petitioner “should have known” of prior art that addressed a “related field” to the challenged patent); *American Honda Motor Co., Inc. et al v. Intellectual Ventures II LLC*, IPR2018-00348, Paper 10 at 16 (PTAB 2018) (a reasonably diligent search would have likely identified at least some of the patent documents given the terms in common with the challenged patent). All three factors are present here.

Petitioner asserts—without submitting any evidentiary support—that it undertook a reasonably diligent search when filing its prior petition but was only able to locate Zhongnan and Yuchang after the Board denied institution. Pet. at 68-69. This argument does not withstand scrutiny. Both Zhongnan and Yuchang are published patent documents. There is no indication Zhongnan and Yuchang were not locatable using typical patent searching methods. Rather, Petitioner argues the initial search did not uncover the references because they “were not indexed as a searchable U.S. Patent.” Pet. at 69. Petitioner cannot cite to any Board precedent or decision which limits a reasonable search under factor two to U.S. Patents alone,

and no such decision exists. In fact, the Board has held to the contrary, denying institution though the initial search was “wide in scope, covering U.S. patent and non-patent publications, *as well as foreign art.*” *Apple Inc. v. Zomm, LLC*, IPR2019-01030, Paper 8 at 9 (PTAB 2019). Indeed, it would be improper to permit petitioners to file a first petition based on a myopically narrow search within one jurisdiction, only to permit them a second bite at the apple in a later petition based on a more extensive search.

At the outset, when a user enters “US10,052,115” into Google Patents (the patent number for Lih, one of the primary references Petitioner cited in the initial PGR petition), Zhongnan immediately *appears in the resulting “Cited By” field*. Ex. 2009 at 6; Ex. 2018 at 18 (stating Ground 2 challenges “Anticipation by U.S. 10,052,115 (“Lih”)”). This means that Google Patents identified Zhongzan as *one of only eighteen patent documents* that cited to Lih, e.g., during examination.

US10052115B2 - Choking interv x +

patents.google.com/patent/US10052115B2/en?q=US10%2c052%2c115

Cited By (18)

Publication number	Priority date	Publication date	Assignee	Title
US11633530B2	2021-08-03	2023-04-25	Dcstar Inc	Suction device for sucking obstruction in respiratory tract and use method therefor
WO2024137424A1 *	2022-12-21	2024-06-27	John Bergeron	Choking intervention device
Family To Family Citations				
US11324877B2	2009-12-17	2022-05-10	Dechoker LLC	Airway assist device
US11701462B2	2016-07-15	2023-07-18	Dechoker LLC	Airway assist device
DE102017115283A1	2017-07-07	2019-01-10	Domma & Marx GbR (vertretungsberechtigter Gesellschafter: Peter Domma, 66287 Quierschied)	Device for removing particles from the throat and respiratory tract
KR102251873B1 *	2019-02-22	2021-05-13	배정환	Esophageal foreign substances removal device
USD1057936S1	2020-06-08	2025-01-14	Dechoker LLC	Airway assist device
TW202146065A *	2020-06-08	2021-12-16	美商迪秋可公司	Airway assist device
CN112932633A *	2021-03-10	2021-06-11	武汉大学中南医院	Device and method for sucking foreign body in trachea
US11478575B1 *	2021-08-03	2022-10-25	Dcstar Inc	Removal device for removing obstruction in respiratory tract and connector
USD1021084S1 *	2021-08-30	2024-04-02	Dcstar Inc	Bellows device
US11446460B1	2021-10-08	2022-09-20	Dechoker LLC	Pressure regulated airway assist device
DE202022102066U1	2022-04-19	2022-04-27	Nabil Chehade	Device for removing objects blocking the respiratory airway
US12017035B2	2022-08-30	2024-06-25	Dechoker LLC	Keyed interlocking airway assist device
US12239343B1 *	2023-11-15	2025-03-04	Dcstar Inc	Respiratory obstruction removal device
USD1050428S1 *	2024-06-27	2024-11-05	Dcstar Inc	Bellows device
USD1051352S1 *	2024-07-29	2024-11-12	Wei Liu	Anti suffocation device
USD1051353S1 *	2024-07-31	2024-11-12	Yudi Liu	Choking rescue device

* Cited by examiner, † Cited by third party, ‡ Family to family citation

Ex. 2009 at 6. Similarly, Yuchang (KR102229619B1) appears in the “Cited By” field of the Google Patents page for Tarrats (U.S. 4,971,053)—another primary reference that Petitioner relied on in its prior PGR petition. Ex. 2011 at 6; Ex. 2018 at 25.

US10675393B1 *	2009-12-17	2020-06-09	Dechoker LLC	Airway assist device
KR102229619B1 *	2021-01-13	2021-03-18	주식회사 유창바이오	Removal Apparatus For Esophageal Foreign Substances
US11324877B2 *	2009-12-17	2022-05-10	Dechoker LLC	Airway assist device

Ex. 2011 at 6. Moreover, when the patent number for Costa (U.S. Patent No. 3,939,830)—another primary reference cited in Petitioner’s prior PGR petition—is entered into Google Patents, the “Cited By” field lists both the Tarrats reference

and Lih's PCT publication (WO2015167709A1), each of which further links to Zhongnan and Yuchang, respectively, as discussed above. Ex. 2014 at 5.

US4790818A *	1983-08-18	1988-12-13	Deluca James T	Method for clearing epiglottal passages
US4971053A *	1988-07-19	1990-11-20	Edward Tarrats	Suction mask to relieve choking
US5345929A *	1990-06-11	1994-09-13	Jansson Lars Erik	Pumping device

US20140163325A1 *	2012-12-11	2014-06-12	Gloria Hartston	Mouthpiece
WO2015167709A1 *	2014-01-09	2015-11-05	Life Vac Llc	Choking intervention device and method of use thereof
AU2014277849B2 *	2008-02-14	2017-05-11	Solventum Intellectual Properties Company	Devices and methods for treatment of damaged tissue

Ex. 2014 at 5. *Given these clear and readily accessible citation trails, it would have been reasonable for Petitioner to look at patent publications citing one of its primary references in determining which arguments to include in its prior petition.*⁷ Google Patents, a popular free patent search tool, would have been a reasonable, if not an obvious, place to start searching. Such basic and simple search strategies would have been employed in any reasonably diligent search and would have quickly revealed Zhongnan and Yuchang.

In addition, a Google Patents search using the basic keyword “LifeVac” results in four search results, including Petitioner’s PCT application WO2015167709A1. Simply clicking that search result reveals Zhongnan

⁷ The Petition for PGR2023-00032 was filed on May 15, 2023. Ex. 2018 at 62. Lih was cited in a supplementary search during prosecution of Zhongnan nearly a year earlier on May 27, 2022. Ex. 2010; Ex. 2017 (showing the supplementary search (Ex. 2010) citing Lih was dated May 27, 2022). Thus, Zhongnan would have appeared on the Google Patents page for the Lih reference well before the filing of its original PGR petition.

(CN112932633A) in the “Cited By” field. Ex. 2013 at 6. Thus, ***Petitioner’s own PCT application links to Zhongnan*** as a related document, as shown below.

TW202146065A *	2020-06-08	2021-12-16	美商迪欧可公司	Airway assist device
CN112932633A *	2021-03-10	2021-06-11	武汉大学中南医院	Device and method for sucking foreign body in trachea
US11478575B1 *	2021-08-03	2022-10-25	Dcstar Inc	Removal device for removing obstruction in respiratory tract and connector

Id. To suggest that Zhongnan could not have been found through a reasonably diligent search and instead required some sort of “scorched Earth” search strategy simply cannot be sustained.

The search conducted by the Examiner during prosecution of the ’575 Patent is also instructive. The examiner included numerous Chinese and Korean patent publications as semantic search inputs. Ex. 1002 at 66, 71, 112, and 117. A reasonable search would have included, at a minimum, Chinese patent publications and would have uncovered Zhongnan and Yuchang.

Additionally, a reasonably diligent search would have uncovered Zhongnan and Yuchang because the references are in a similar field as the ’575 Patent and the references Petitioner previously cited in its prior PGR. Ex. 2018. Specifically, Zhongnan (Ex. 2016 at 1) and Yuchang (Ex. 2015 at 1) share the same CPC classification (A61B17/50) as the challenged patent (Ex. 2019 at 1), as well as Costa (Ex. 2014 at 1)—another reference cited by Petitioner in the prior PGR. Ex. 2018 at 18. Further, this classification is closely related to Lih’s classification (A61B17/24). Ex. 2009 at 1. These classification similarities offer another straightforward path by which Zhongnan and Yuchang could have been identified through a reasonably diligent search.

Lastly, and contrary to Petitioner’s claims otherwise, Zhongnan and Yuchang use similar terms as the ’575 Patent. The ’575 Patent relates to “a removal device for removing an obstruction in a respiratory tract.” Ex. 1001 at 1:8-

9; *see also* Pet. at 6 (stating “[t]he ’575 Patent is directed to a first aid anti-choking device for removing an obstruction in a respiratory tract.”). As Petitioner acknowledges, “Zhongnan discloses a tracheal foreign body suction device (i.e., an anti-choking device)” and “Yuchang relates to an anti-choking apparatus for removing foreign substances from the esophagus.” Pet. at 21, 43. Petitioner argues, in part, that a reasonably diligent search would not have uncovered Zhongnan and Yuchang because their translations yielded terms which do not appear in the ’575 Patent and provides a few such examples. Pet. at 69-70. In so doing, Petitioner ignores key terms in the challenged patent that *are* shared with the translations of Zhongnan and Yuchang. For example, the translation of Zhongnan uses the terms “mask,” “obstruction,” “airway,” and “negative pressure,” all of which are present in the ’575 Patent. Ex. 1005 at 2-3; Ex. 1001 at 1:14, 1:21, 2:2, 2:15. As another example, the translation of Yuchang uses the terms “choking,” “removal device,” and “obstruction,” all of which are present in the ’575 Patent. Ex. 1009 at 5, 21; Ex. 1001 at 1:8, 1:14, 1:29. What is more, during prosecution of the ’575 Patent, the Examiner used numerous terms present in the translations of Zhongnan and Yuchang. Ex. 1002 at 65, 68-73, and 117 (using the terms “choking,” “suction,” “airway,” “mask,” “negative,” “obstruction,” and “blockage”); Ex. 1009 at 5-7; Ex. 1005 at 2-3. A reasonably diligent search would have uncovered Zhongnan and Yuchang at least because the references share several terms with the ’575 Patent and the examiner’s search terms during prosecution. IPR2018-00348, Paper 10 at 16.

Even taking Petitioner at its word, Petitioner’s initial search was far too limited in scope to constitute a reasonably diligent search under the second factor of *General Plastics*. Zhongnan and Yuchang are patent publications locatable using basic patent searching methods, and they share numerous terms with the ’575 Patent and examiner’s search during prosecution. As such, Petitioner should have

known about Zhongnan and Yuchang, and its explanation to the contrary cannot withstand basic scrutiny. *General Plastics* factor two weighs strongly in favor of denying institution.

**3. Petitioner Unfairly Benefits From the PGR2023-00032 Record
(*General Plastic* Factor Three)**

Petitioner’s strategic delay in filing the Petition is a transparent attempt to benefit from information acquired during the course of PGR2023-00032 to refine its arguments in this proceeding. The Board was precisely concerned with such abuse in *General Plastics*. IPR2016-01357, Paper 19, at 17 (noting “[t]he absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review” and “factor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study” information obtained in prior proceedings.).

General Plastics, in particular, expresses concern with follow-one petitions that rely on different prior art and present different arguments than were presented in an initial petition. *Id.* at 11 (stating “[t]he shift in the prior art asserted and arguments in serial proceedings is of particular concern here” and “the newly-asserted prior art . . . was a shift in [p]etitioner’s positions and arguments from the first-filed petitions based on the analysis articulated in our [d]ecisions [d]enying [i]nstitution of those petitions”) (internal citations and quotations omitted). The Board’s concern in *General Plastics* is precisely at stake here. The prior proceeding relied on different art and different arguments than the Petition. *See* § I, *supra*.

After being denied institution in the prior proceeding, Petitioner essentially decided on a new strategy: to “try harder.” Petitioner obtained new counsel and apparently commissioned a new search for different references and refined its

arguments—all while armed with the knowledge of the deficiencies of the prior art cited in the initial proceeding. Petitioner had the benefit of all of the parties’ briefing, the Board’s Institution Decision, and expert declarations. *Nichia Corp v. Document Security Sys., Inc.*, IPR2019-00398, Paper 10 at 16-17 (PTAB 2019) (denying institution where the petitioner had a nearly complete record of the proceeding prior to filing follow-on petition). Petitioner conceded as much. Pet. at 70. Having the benefit of the prior proceeding’s record, Petitioner could unfairly refine its arguments against the same claims in the Petition.⁸ Thus, *General Plastic* factor three weighs strongly in favor of denying institution.

4. Petitioner Knew About Zhongnan and Yuchang for Over Eight Months Before Filing the Petition (*General Plastic* Factors Four and Five)

Petitioner alleges that it became aware of Zhongnan and Yuchang on April 29, 2024, but waited over eight months to file the Petition on January 31, 2025. Pet. at 70. To explain its delay, Petition blames complications in receiving

⁸ In addition to shifting course with its prior art references, Petitioner also strategically refined its strategy by modifying its POSA definition based on arguments presented in the earlier proceeding. *Compare* IPR Pet. at 11-12 *with* PGR Pet. at 18-19 (changing POSA definition from an individual having knowledge of “medical devices in general” to knowledge of “medical devices in general *and* . . . a working knowledge of respiratory devices”) (emphasis added). *See also* footnote 3, *supra* (discussing change in description of prosecution history to suit current IPR challenge).

information about the initial search that was conducted for the prior proceeding. *Id.* at 71. This is unsupported attorney argument. And even if true, this is an insufficient excuse, especially in view of the Board’s concern that petitioners may unfairly benefit from prior filings in serial petitions described above. IPR2016-01357, Paper 19, at 10. Further, ***the new prior art searches did not begin until four months after⁹ Petitioner had received denial of institution in PGR2023-00032.*** Pet. at 70.

Regardless of the reason, Petitioner ultimately waited over a year between the denial of institution in the prior proceeding and the filing of the new Petition. Factors four and five weighed against institution in *General Plastics*, though the delay in that case was nine months. IPR2016-01357, Paper 19, at 10. Petitioner’s conspicuous attempt to stagger its attack and use the prior PGR proceeding as a roadmap for the present petition is precisely what *General Plastics* sought to prevent. *Id.* at 17. Accordingly, factors four and five weigh strongly against institution.

5. Petitioner’s Delay Unreasonably Tolls the Board’s Finite Resources and Expediency Under 35 U.S.C §316(a)(11) (*General Plastic* Factors Six and Seven)

Petitioners’ wait-and-see approach taxes the Board’s finite resources in favor of its own tactics. The Board has explained that “multiple, staggered petition filings . . . are an inefficient use of the inter partes review process and the Board’s resources.” *Shanghai Lunion Information Technologies, Ltd. v. Telefonaktiebolaget*

⁹ Petitioner allegedly requested search quotes on April 4, 2024; the denial of institution decision in the prior PGR proceeding issued on November 29, 2023. Pet. at 70.

LM Ericsson, IPR2018-00995, Paper 12 at 20 (quoting *General Plastic*, IPR2016-01357, Paper 19 at 21). This efficiency consideration is frustrated because ***Petitioner waited over a year to file the Petition after receiving denial of institution in the prior proceeding*** and now seeks to have the Board consider yet again the same claims previously considered in that proceeding.

Petitioner argues that “the integrity of the patent system is challenged by allowing the ’575 Patent to continue to exist.” Pet. at 65. On the contrary: the integrity of the patent system is challenged by allowing the Petition to go forward. The Board, more than a year earlier, already considered the same claims of the ’575 Patent. The *General Plastics* panel recognized this concern stating “[t]he Board’s resources would be more fairly expended on first petitions rather than on a follow on petition like the Petition in this case.” IPR2016-01357, Paper 19 at 17 (quoting *LG Elecs. Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2016-00986, Paper 12 at 12 (PTAB 2016)). This follow-on Petition needlessly expends Board resources and frustrates Congress’s intent in enacting the AIA. See H.R. Rep. No. 112-98, pt.1, at 48 (2011) (stating “[i]n utilizing the post-grant review process, petitioners, real parties in interest, and their privies are precluded from improperly mounting multiple challenges to a patent . . .”). For the foregoing reasons, factors six and seven weigh strongly against institution.

C. Institution Should Be Denied Under *Advanced Bionics* Because the Office Considered Substantially the Same Prior Art During Prosecution and Petitioner Has Not Demonstrated the Office Erred.

The Petition presents substantially the same art and arguments that the Office previously analyzed during prosecution of the ’575 Patent. Accordingly, the Director should exercise her discretion and deny institution.

The Board has established a two-part framework to determine whether it

should exercise its § 325(d) discretion:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of the first part of the framework is satisfied, whether the Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

Under the first part of the framework, the Board first considers “whether the same or substantially the same” art or arguments “previously were presented to the Office.” *Id.* Only if the first part is met will the Board consider “whether the Petitioner has demonstrated that the office erred in a material manner to the patentability of the challenged claims.” *Id.* The Board uses the following six non-exclusive factors (*Becton Dickinson* factors) to guide their analysis of the *Advanced Bionics* framework:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioners rely on the prior art or Patent Owner distinguishes the prior art;

- (e) whether Petitioners have pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Id. at 9-10 (citing *Becton Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB 2017) (precedential in relevant part) (“*Becton Dickinson*”). *Becton Dickinson* factors (a), (b), and (d) pertain to the first part of the *Advanced Bionics* framework, and factors (c), (e), and (f) to the second part. *Id.* at 10. “If a condition in the first part of the framework is satisfied and the Petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8-9.

Here, both *Advanced Bionics* steps support denial. First, the Petitioner raises substantially the same prior art and arguments as those considered by the examiner during prosecution of the ’575 Patent. Second, Petitioner failed to show that the Office erred in a manner material to patentability when it allowed the ’575 Patent over the already-considered references and arguments.

1. Institution Should Be Denied Because the Office Considered Substantially the Same Art and Arguments

Petitioner primarily relies on Zhongnan in each of its Grounds. Pet. at 20. While Zhongnan was not considered during prosecution of the ’575 Patent, Zhongnan is substantially the same as art that was considered during prosecution, including the IDEAR reference. Thus, the first part of the *Advanced Bionics* framework is satisfied.

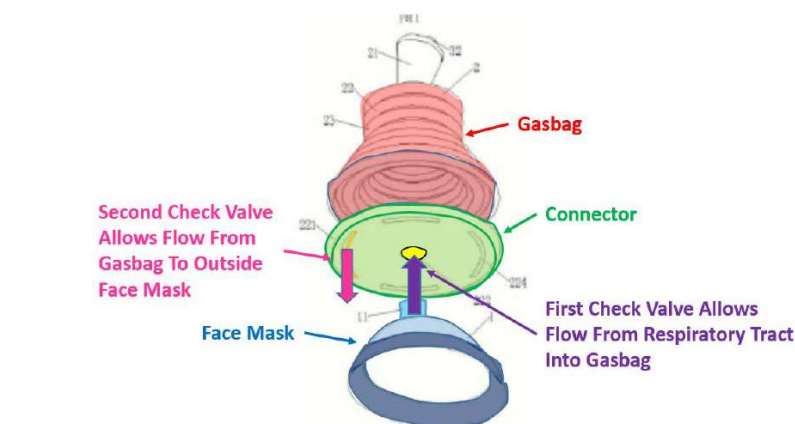
New prior art references are “substantially the same” as prosecution-applied references when there are no material differences between them, i.e., they are

substantially similar to each other. *Wolfspeed, Inc. v. Trs. of Purdue Univ.*, IPR2022-00761, Paper 13 at 7-8 (Director Vidal 2023); *see also Evapco Dry Cooling, Inc., v. SPG Dry Cooling USA*, IPR2021-00687, Paper 11 at 24-25 (PTAB 2021) (finding a newly asserted reference not cited during prosecution as being substantially the same as the references that were before the Examiner during prosecution).

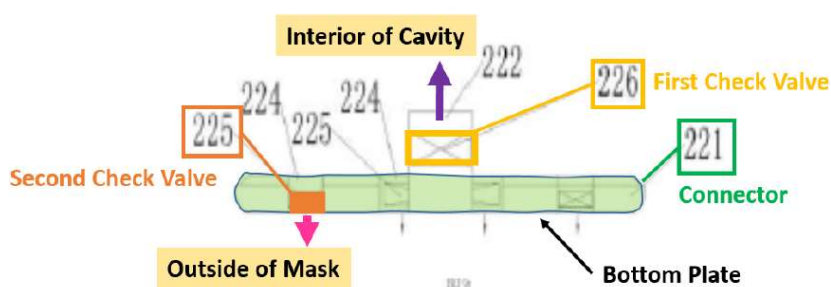
Likewise, newly asserted art is “cumulative” when the art’s relevant teachings provide nothing more than what was taught by previously presented prior art. *Gardner Denver v. Utex Industries, Inc.*, IPR2020-00333, Paper 12 at 13-14 (PTAB 2020) (denying institution upon finding that newly asserted references were no more relevant than references that were presented during prosecution); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11 at 16-17 (PTAB 2020) (denying institution upon finding that the newly applied reference was cumulative to a reference previously presented, even though the previously-presented reference was not considered for the same limitation in reexamination).

Petitioner fails to identify any material difference or teaching in the references now relied upon compared to those previously considered by the Office. Instead, Petitioner states, without explanation, that the references are “neither cumulative nor redundant to the prior art considered in the prosecution of the ’575 Patent.” Pet. at 64. The record indicates otherwise.

The Office laboriously considered IDEAR during prosecution, mapping each claim feature to alleged disclosures. Ex. 1002 at 135-143. There are no material differences between Zhongnan and IDEAR. Indeed, Petitioner alleges Zhongnan discloses *the same claim features* the Office alleged IDEAR disclosed during prosecution. Petitioner's annotated figures from Zhongnan and the Office's annotated showing of IDEAR are illustrative.



Pet. at 37; Ex. 1005, FIG. 2; Ex. 1002 at 135.



Pet. at 37; Ex. 1005, FIG. 3; Ex. 1002 at 135. As shown above, the relevant features in Zhongnan are also present in IDEAR rendering it cumulative to art fully considered during prosecution.

Additionally, as discussed above, Zhongnan is disqualified as prior art based on the prior public disclosure of IDEAR. The analysis required to determine whether IDEAR disqualifies Zhongnan is effectively the *exact same analysis* that the Examiner conducted during prosecution in deciding that IDEAR was not prior art. In other words, if the Examiner was correct that IDEAR was a public disclosure of the claimed invention and that it was obtained directly or indirectly from the inventor, then Zhongnan cannot be prior art over the challenged patent. For this reason, the subject Petition asks the Board for a “do-over” of a legal analysis that the Examiner already conducted. Such cumulative analyses are improper in follow-on petitions, and they should be rejected here.

Petitioner argues Zhongnan discloses the same elements as were alleged in IDEAR during prosecution. Pet. at 37; Ex. 1002 at 135-143. Each of *Becton Dickenson* factors (a), (b), and (d) weigh in favor of denying institution because there are no material differences or new teachings in Zhongnan compared to IDEAR. Accordingly, the arguments and art in the Petition are substantially the same as those previously considered by the Office under the first *Advanced Bionics* step. Institution should be discretionarily denied.

2. The Petition Fails to Identify a Material Error in Examination

Petitioner fails to carry its burden to show the Office materially erred in its evaluation of the prior art at least because *the Petition makes no mention of material error at all*. Petitioner’s entire discussion of 35 U.S.C. § 325(d) is one conclusory sentence. Pet. at 64. In it, Petitioner makes no allegation—much less a material showing—of Office error. The Petition’s failure to address this requirement of *Advanced Bionics* (*Benton Dickenson* factors (c), (e), and (f)) weighs in favor of denying institution.

IV. Conclusion

The Director should exercise her discretion and deny institution. Petitioner's primary reference is not prior art under 35 U.S.C. § 102(b)(1)(B) because there was an inventor-originated public disclosure prior to the publication date of Zhongnan. Without Zhongnan, both Grounds 1 and 2 fail, and Petitioner cannot demonstrate a reasonable likelihood of prevailing with respect to at least one challenged claim.

Further, all of the *General Plastics* and *Advanced Bionics* factors favor discretionary denial of institution. Petitioner had an opportunity to pursue a decision on the merits against the '575 Patent in its prior PGR proceeding and needlessly delayed over a year before filing the present Petition. In so doing, Petitioner gained an unfair advantage in having the full record of the prior PGR to roadmap its current Petition. Additionally, the Office considered substantially the same prior art and issues during prosecution. Specifically, Petitioner's primary reference, Zhongnan, does not materially differ or present any new teachings over the IDEAR reference considered during prosecution. Similarly, the Examiner's conclusion that IDEAR was not prior art because it was obtained from the inventor of the challenged patent fully resolves that Zhongnan cannot constitute prior art.

The subject Petition constitutes a tactical serial filing, and it is unfair to Patent Owner and the Board to relitigate issues already considered. *General Plastics* and *Advanced Bionics*, coupled with the importance of balancing PTAB workload, warrant denying institution.

Filed: April 25, 2025

Respectfully submitted,

By: Justin L. Krieger/

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Lead Attorney for Patent Owner

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of 37 CFR § 42.24(a)(1)(i). This brief contains 7,996 words as measured by the word processing software used to prepare the document, exclusive of table of contents, mandatory notices, certificates of service and compliance and appendix of exhibits.

The undersigned further certifies that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman 14 point font.

Dated: April 25, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on April 25, 2025, Patent Owner's Brief in Support of Discretionary Denial (Paper 6), Patent Owner's Exhibit List (Paper 7), and Exhibits 2001 through 2019 have been served via email on Counsel for Petitioner at the email address as indicated in their Mandatory Notices Under 37 C.F.R. § 42.8:

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