

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COOLER MASTER CO., LTD.,
Petitioner,

v.

AAVID THERMALLOY LLC,
Patent Owner.

Case IPR2019-00337
Patent 7,066,240

PATENT OWNER PRELIMINARY RESPONSE

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
LIST OF EXHIBITS	iv
I. Introduction.....	1
II. Nakamura Is Not Prior Art	1
A. Legal Background	2
B. Nakamura Is Not A Patent Or Printed Publication	10
III. The Board Should Exercise Its Discretion To Deny The Petition	15
IV. Conclusion	21
CERTIFICATE OF COMPLIANCE.....	23
CERTIFICATE OF SERVICE	25

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Activision Blizzard, Inc. v. Acceleration Bay, LLC</i> , No. IPR2015-01951, Paper 107 (P.T.A.B. Mar. 23, 2017)	3
<i>Alcatel-Lucent USA Inc. v. Oyster Optics, LLC</i> , No. IPR2018-00257, Paper 14 (P.T.A.B. June 4, 2018)	passim
<i>Apotex Inc. v. Celgene Corp.</i> , No. IPR2018-00685, Paper 8, 2018 Pat. App. LEXIS 8795 (P.T.A.B. Sept. 27, 2018)	2, 3
<i>Blue Calypso, LLC v. Groupon, Inc.</i> , 815 F.3d 1331 (Fed. Cir. 2016)	3, 5
<i>Bruckelmyer v. Ground Heaters, Inc.</i> , 445 F.3d 1374 (Fed. Cir. 2006)	passim
<i>Chevron Oronite Co. LLC v. Infineum USA L.P.</i> , No. IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018)	17, 18, 21
<i>Coalition for Affordable Drugs IV LLC v. Pharmacyclics, Inc.</i> , No. IPR2015-01076, Paper 33 (P.T.A.B. Oct. 19, 2015)	8, 9, 13, 14
<i>eBay Inc. v. MoneyCat Ltd.</i> , No. CBM2014-00091, Paper 50, 2015 Pat. App. LEXIS 12504 (P.T.A.B. Sept. 23, 2015)	6, 7, 11
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , No. IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)	15, 16, 18
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	15
<i>In re Cronyn</i> , 890 F.2d 1158 (Fed. Cir. 1989)	7, 11
<i>In re Wyer</i> , 655 F.2d 221 (C.C.P.A. 1981)	passim

TABLE OF AUTHORITIES

	Page(s)
<i>Sandoz Inc. v. AbbVie Biotechnology Ltd.</i> , No. IPR2018-00002, Paper 11 (P.T.A.B. Mar. 6, 2018)	10
<i>Sandoz Inc. v. AbbVie Biotechnology Ltd.</i> , No. IPR2018-00002, Paper 13, 2018 Pat. App. LEXIS 5868 (P.T.A.B. May 3, 2018)	9, 10, 14
<i>SAS Inst. Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018).....	15, 18
<i>ServiceNow Inc. v. Hewlett-Packard Co.</i> , No. IPR2015-00707, Paper 12 (P.T.A.B. Aug. 26, 2015).....	9
STATUTES	
35 U.S.C. § 311(b)	2
35 U.S.C. § 314(a)	15
OTHER AUTHORITIES	
MPEP § 901.04(III).....	6, 7

LIST OF EXHIBITS

Exhibit 2001 - World Intellectual Property Organization, *Handbook on Industrial Property Information and Documentation*, “Recommendation Concerning Bibliographic Data on and Relating to Patents and SPCS,” Standard ST.9, June 2013. Retrieved from <https://www.wipo.int/export/sites/www/standards/en/pdf/03-09-01.pdf>.

I. INTRODUCTION

Patent Owner Aavid Thermalloy LLC (“Aavid”) submits this preliminary response to the Petition (Paper 2) by Cooler Master Co., Ltd. (“Petitioner”) requesting *inter partes* review (“IPR”) and cancellation of claims 9-13 (“the challenged claims”) of U.S. Patent No. 7,066,240 (“’240 patent,” Ex. 1001).

The Board should deny the Petition and decline to institute IPR of the ’240 patent because Petitioner has failed to establish a reasonable likelihood that it will prevail with respect to any of the challenged claims. Two of Petitioner’s four grounds for challenging the claims (including the only grounds challenging claims 11 and 13) rely on Nakamura (Ex. 1004), which is not prior art because it is not a “patent or printed publication.” Patent Owner submits no substantive arguments in this Preliminary Response with respect to the two remaining grounds (that do not rely on Nakamura) because Petitioner has failed to provide evidence sufficient to warrant institution. But even if Petitioner had presented sufficient evidence as to those two remaining grounds, the Board should exercise its discretion to deny the Petition because instituting IPR would acquiesce to Petitioner’s abuse of the process and harassment of Patent Owner, and would not be an efficient use of the Board’s time and resources.

II. NAKAMURA IS NOT PRIOR ART

A petition for *inter partes* review can request cancellation of patent claims “only on a ground that could be raised under §102 or §103 on the basis of prior art

consisting of patents or printed publications.” 35 U.S.C. § 311(b). The Petitioner submits four grounds for challenging the validity of claims 9-13 of the '240 Patent. Claims 9 and 10 are challenged as obvious based on Morikawa (Ex. 1003) in view of Nakamura (Ex. 1004), and claims 11 and 13 are challenged as obvious based on Morikawa in view of Takahashi (Ex. 1005) and Nakamura. In addition, claims 9, 10, and 12 are challenged as obvious based on Morikawa alone, and claim 12 is challenged as obvious based on Morikawa in view of Takahashi.

Petitioner, however, fails to present evidence that Nakamura was a “patent or printed publication” prior to the invention of the '240 patent, not to mention more than one year prior to the '240 patent’s May 12, 1999 priority date. In fact, based on the evidence presented, Nakamura is neither a patent nor a printed publication. The Petition therefore should be denied, as it fails to establish a reasonable likelihood that Petitioner will prevail in these proceedings.

A. Legal Background

A petitioner for *inter partes* review bears the burden of presenting evidence sufficient to establish the existence of prior art that renders a claim unpatentable. *Apotex Inc. v. Celgene Corp.*, No. IPR2018-00685, Paper 8, at 27, 2018 Pat. App. LEXIS 8795, at *36 (P.T.A.B. Sept. 27, 2018) (citing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015)). This requires “a threshold showing that the reference relied upon was publicly accessible as a

printed publication prior to the effective filing date of a challenged patent.” *Id.* at 27-28 (citations omitted). In this regard, the Federal Circuit has consistently held that a reference will be considered publicly accessible if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence[] can locate it.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

“Public accessibility” requires more than mere technical accessibility. *Activision Blizzard, Inc. v. Acceleration Bay, LLC*, No. IPR2015-01951, Paper 107, at 13 (P.T.A.B. Mar. 23, 2017). The party that “wishes to characterize the information, in whatever form it may be, as a ‘printed publication’ should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981) (citing *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elecs. Indus., Inc.*, 450 F.2d 1164, 1171 (3d Cir. 1971)).

Whether foreign patent applications qualify as prior art has long been evaluated on a case-by-case basis, but courts have consistently looked for indicators that a document would have been identifiable or locatable through a

reasonably diligent search. Such indicators include the manner in which the document was made available to the public, and whether the document was properly classified, indexed, and abstracted. As the Federal Circuit's predecessor explained in *Wyer*:

[T]he question to be examined under § 102(b) is the accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded. Access involves such factual inquiries as classification and indexing. In other words, such a reference is a "printed publication" and a bar to patentability upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

655 F.2d at 226 (quotations omitted).

In *Wyer*, the Court acknowledged a long line of cases "holding that a foreign patent application laid open for public inspection is not a printed publication" but concluded the foreign patent application at issue was publicly accessible in light of the extensive evidence presented by the appellee. *Id.* at 226-27. The party relying on the prior art document (an Australian patent application) produced detailed evidence that the document had been classified, and that equipment was made available to the public at the Australian Patent Office and its sub-offices for

reproducing diazo copies of the application on an enlarged screen and for producing enlarged paper copies for purchase by the public. *Id.* at 226.

Importantly, the Court emphasized there was no genuine dispute that the application had been properly classified, indexed, and abstracted, ultimately concluding that the evidence supported a finding that the Australian application was sufficiently accessible to the public and persons skilled in the pertinent art to qualify as a “printed publication.” *Id.*

As later acknowledged by the Federal Circuit, “[t]he existence of a published abstract that would have allowed one skilled in the art exercising reasonable diligence to locate the foreign patent application and the fact that the application was classified and indexed in the patent office[] were central to the *Wyer* court’s conclusion that the application was ‘publicly accessible.’”

Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1379 (Fed. Cir. 2006).

Being indexed in a meaningful way offers assurance that an ordinarily skilled artisan, exercising reasonable diligence, will be able to locate a particular reference. *Blue Calypso*, 815 F.3d at 1349.

Indeed, in *Bruckelmyer*, the Federal Circuit reiterated the importance of a research aid like indexing to enable a skilled artisan to find the relevant document. 445 F.3d at 1378-79. There, two figures had been cancelled from a Canadian patent application prior to its issuance as a published patent, but the figures

remained in the original application file wrapper. *Id.* at 1376. The Court did not rely on the mere fact that the application had been “laid open” for inspection by the general public, but instead focused on whether the published patent served as a “research aid” for a person of ordinary skill in the art to find the figures in the laid open application. *Id.* at 1379. The published Canadian patent was classified, indexed, and provided reference to the laid open application, and therefore provided “the roadmap that would have allowed one skilled in the art to locate” the underlying application that contained the figures. *Id.* Accordingly, the drawings were deemed to have been publicly accessible.

The Board has relied on the presence of INID codes as evidence that a foreign patent document was adequately indexed. *eBay Inc. v. MoneyCat Ltd.*, No. CBM2014-00091, Paper 50, at 24, 2015 Pat. App. LEXIS 12504, at *35 (P.T.A.B. Sept. 23, 2015). INID Codes (“INID” is an acronym for “Internationally agreed Numbers for Identification of (bibliographic) Data”) are standardized parenthetical numbers for identifying specific bibliographic data that are typically printed on the face of patent documents, such as filing date, date(s) of making available to the public, publication date, title, patent classification(s), field(s) of search, etc. *See* Ex. 2101. INID codes provide a means whereby the various data appearing on the first page of patent documents can be identified without knowledge of the language used and the laws applied. *See* MPEP § 901.04(III). INID Codes are “now used

by most patent offices and have been applied to U.S. patents since August 4, 1970.” *Id.* In *eBay*, the Canadian patent application in question included INID codes, and therefore the Board found that the Canadian Patent Office had adequately indexed the document and determined that the document was publicly accessible. CBM2014-00091, Paper 50, at 24.

Aside from cases involving foreign patent applications like *Wyer* and *Bruckelmyer*, the Federal Circuit has consistently required similar evidence to demonstrate public accessibility for other types of documents. In *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989), the Court rejected an argument that three student theses were “printed publications,” finding that the documents were not cataloged or indexed in a meaningful way. *Id.* at 1161. Even though the title of each thesis had been listed with the respective author’s name on cards, the only research aid for finding each document was based on the student’s name, which bore no relationship to the subject of the respective thesis. *Id.* Without a meaningful indexing system, the documents were not reasonably accessible and therefore could not be considered printed publications. *Id.*

The unifying principle running through each of these cases is that demonstrating “public accessibility” requires some evidence of a meaningful system that would have enabled a skilled artisan to locate and retrieve the document employing reasonable diligence. And it is not enough simply to

demonstrate that a document is publicly accessible today—the evidence in the petition must show that the document was publicly accessible *before* the invention of the patent or its critical date. The Board’s past decisions further illustrate this requirement.

In *Coalition for Affordable Drugs IV LLC v. Pharmacyclics, Inc.*, No. IPR2015-01076, Paper 33 (P.T.A.B. Oct. 19, 2015), for example, the Board denied institution of IPR because the petitioner had not met its initial burden of production to show that the document in question was a printed publication. *Id.* at 6. The petitioner asserted that the patent owner had published the document in question more than one year before the earliest filing date, but offered no evidence to show that it was publicly accessible. *Id.* at 6-7. The Board rejected petitioner’s reliance on conclusory statements by the petitioner’s expert that the document was prior art because the expert did not attest to any personal knowledge of public accessibility or dissemination of the document. *Id.* at 7. Even though the document itself noted that it had been “updated” prior to the earliest filing date, the petitioner failed to explain how that date related to the asserted date of publication or offer evidence of publication practices that would explain how the information would have been disseminated or made available to the public. *Id.* at 7-8. The Board concluded that

“[w]ithout such information, there is no support for a conclusion that [the document] was publicly accessible” before the earliest filing date. *Id.* at 8.¹

Similarly, in *Sandoz Inc. v. AbbVie Biotechnology Ltd.*, No. IPR2018-00002, Paper 13, 2018 Pat. App. LEXIS 5868 (P.T.A.B. May 3, 2018), the Board criticized the petitioner for “merely assert[ing], without further elaboration, that [a] drug product was approved in December 2002 and that [the product’s 2002 and 2003 labels] are ‘prior art FDA approved label[s].’” *Id.* at 9. The Board went on to explain:

Petitioner also does not direct us to any source-identifying information from the FDA (*e.g.*, a copy of the labels on the FDA's website), a publication date, or other indicia indicating when Humira 2002 Label or Humira 2003 Label became publicly available. **Nor does the Petition include or cite to information related to how one might have obtained a copy of Humira 2002 Label or Humira 2003 Label, or whether the labels were generally accessible during the relevant timeframe such that persons interested and ordinarily skilled in the subject matter or art exercising**

¹ Also, in at least one other case, the Board dismissed dates on the face of an exhibit and indications of availability as inadmissible hearsay when those dates were offered for the truth of that information. *See ServiceNow Inc. v. Hewlett-Packard Co.*, No. IPR2015-00707, Paper 12 at 16-17 (P.T.A.B. Aug. 26, 2015).

reasonable diligence could have located them. *Kyocera*, 545 F.3d at 1350. Such evidence could include in this case, for example, testimony from a person interested in the art explaining how one could have located the labels by searching the FDA's website; or evidence of indexing on the internet such that a search “using any combination of search words, would have led to the [labels] appearing in the search results,” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349 (Fed. Cir. 2016).

Id. at 10 (emphasis added). Without sufficient evidence in the petition to show the labels were either disseminated or otherwise locatable by the public interested in the art, the Board held that the petitioner failed to meet its burden and denied institution. *Id.* at 13, 14.²

B. Nakamura Is Not A Patent Or Printed Publication

In the present case, Nakamura is alleged to be an unexamined Japanese Utility model application. Ex. 1004. Nakamura is not a “patent,” nor does it qualify as a prior art “printed publication.” Indeed, Petitioner has failed to submit

² The Board in *Sandoz* also denied the petitioner’s request to file a reply to arguments in patent owner’s Preliminary Response that certain asserted references were not publicly available. *Sandoz Inc. v. AbbVie Biotechnology Ltd.*, No. IPR2018-00002, Paper 11, at 3-4 (P.T.A.B. Mar. 6, 2018).

any evidence that Nakamura was publicly accessible before the May 12, 1999 priority date.

It is apparent from a review of Nakamura itself that the reference does not qualify as prior art. First, unlike the foreign patent applications in *Wyer* and *Bruckelmyer*, Nakamura does not include an abstract. *See* Ex. 1004. In addition, nothing in the Nakamura reference itself or the other information in the record suggests that Nakamura was classified, particularly before the '240 patent's effective filing date of May 12, 1999. *See id.* The lack of any classification is strikingly different from the other references identified by the Petitioner such as Takahashi (Ex. 1005) and Morikawa (Ex. 1003), the latter of which is alleged to be a Japanese patent application filed the same year as Nakamura. Each of these other references at least contains ascertainable classification codes on its face. *Compare* Ex. 1004 *with* Ex. 1005 at 1, INID Code 51, *and* Ex. 1003 at 1, INID Code 51.

Moreover, like the documents cited in *Cronyn*, and unlike the foreign patent applications in *Wyer*, *Bruckelmyer*, and *eBay*, Nakamura includes no indication that it was indexed in a meaningful way. *See* Ex. 1004. Nakamura also does not include INID codes, in contrast to the foreign patent application in *eBay*. *Compare* Ex. 1004 *with* Ex. 1005 at 1 *and* Ex. 1003 at 1. INID codes have been used for decades by many patent offices throughout the world, including the Japanese Patent Office—even Morikawa includes INID codes, and it was allegedly filed the

same year as Nakamura. *Compare* Ex. 1004 at 1 *with* Ex. 1003 at 1. If Nakamura had been published, the publication date (among other data) would be provided on the first page of the document, and identified with the appropriate INID code(s). Yet, Nakamura has no INID codes to identify any relevant bibliographic data, further indicating that Nakamura was not indexed in any meaningful way that would have permitted the document to be found after a reasonably diligent search.

Petitioner fails to provide any evidence that would suggest that a person of ordinary skill in the art would have been able to locate and retrieve Nakamura prior to the May 12, 1999 priority date. In contrast to the party in *Wyer* that submitted detailed evidence of the availability of special equipment for viewing and even making copies of the Australian patent application, Petitioner has submitted no evidence whatsoever of any actual dissemination of Nakamura, or any means by which Nakamura might have been accessed by interested members of the public. There also is no evidence that Nakamura was abstracted, classified, and indexed, unlike the document in *Wyer*. And unlike *Bruckelmyer*, there is no evidence that a corresponding utility model was granted, indexed, and classified such that it might have aided a researcher in finding Nakamura. In fact, there is no evidence of anything in Nakamura or elsewhere in the record that would have enabled a skilled artisan to locate and retrieve the document employing reasonable diligence prior to May 12, 1999.

Petitioner merely states in its Petition that “Nakamura is a ‘Japanese Unexamined Utility Model Application Publication in the Year 1975’ published in 1975. It thus qualifies as prior art under 35 U.S.C. § 102(b). (Pokharna, ¶75.)” Petition at 41; *see also id.* at viii (description of Ex. 1004). Despite including a citation to the declaration of Petitioner’s technical expert, Dr. Himanshu Pokharna, the cited portion of the declaration simply includes a virtually identical, unsubstantiated statement. (Ex. 1002, ¶75.) Moreover, Dr. Pokharna admits elsewhere in his declaration that his conclusory assertions regarding Nakamura’s alleged status as prior art are not based on personal knowledge but rather his “understand[ing] that each of the references [relied on in the grounds for challenging claims 9-13] qualifies as prior art to the ’240 patent because each reference was filed and/or published before May 12, 1999, the earliest claimed filing date for the ’240 patent.” Ex. 1002 at ¶ 18 *and id.* at ¶ 7 (description of Ex. 1004). Dr. Pokharna does not attest to any personal knowledge of the dissemination or public availability of Nakamura, and therefore does nothing to evidence the alleged year of publication. *See Coalition for Affordable Drugs*, No. IPR2015-01076, Paper 33 at 7.

Petitioner’s and Dr. Pokharna’s conclusory assertions are not evidence and are not supported by the Nakamura reference or any other information in the record. In fact, the text “Publication in the Year 1975” that is quoted in the

Petition and in Dr. Pokharna's declaration does not appear anywhere in Nakamura or in Petitioner's English translation of Nakamura. *See* Ex. 1004. Petitioner's and its expert's lack of citation to the record is telling. *See* Petition at 41; Ex. 1002 ¶ 75.

Furthermore, while Petitioner's English translation of Nakamura adds a parenthetical "(1975)" after "S50-55262," no such parenthetical is included in the original document. *Compare* Ex. 1004 at 1 *with id.* at 13. And Petitioner's translator provides no explanation of the basis for inserting the parenthetical. *See* Ex. 1004 at 1-12. Instead, Petitioner's translator simply states that he "translated 'Japanese Unexamined Utility Model Application Publication S50-55262 (1975)' and that this translation is a true and accurate translation from Japanese to English." *See* Ex. 1004 at 12. Petitioner's translator does not even set forth a basis from which to conclude that he is qualified to provide such a translation. *See* Ex. 1004 at 12.

In sum, Nakamura is not prior art. It does not include an abstract, does not identify any classification, has no indexing, and does not identify any date prior to May 12, 1999 on which Nakamura was available to and locatable by the public. *See* Ex. 1004. And as with the documents discussed in *Coalition for Affordable Drugs* and *Sandoz*, Petitioner fails to present any evidence that might otherwise suggest that Nakamura was publicly accessible. Accordingly, Petitioner has failed

to provide evidence sufficient to warrant institution on its grounds for challenging claims 9-13 of the '240 patent based on Nakamura.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION

Patent Owner submits no substantive arguments in this Preliminary Response with respect to remaining grounds 1 and 3 challenging claims 9, 10, and 12, as Patent Owner believes Petitioner has failed to provide evidence sufficient to warrant institution. But even if the Board were inclined to disagree, under 35 U.S.C. § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). Even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, institution of review remains discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018).

In *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, No. IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) (precedential), the Board “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” *Id.* at 17 (citing H.R. Rep. No. 112-98, pt. 1, at 48 (2011)). “Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.” *Id.* In addition, “[a]llowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.” *Id.* at 17

n.14 (quoting *Butamax Advanced BioFuels LLC v. Gevo Inc.*, No. IPR2014-00581, Paper 8 at 12-13 (P.T.A.B. Oct. 14, 2014) (citing H.R. Rep. No. 112-98, pt. 1, at 48 (2011))). In order to “take undue inequities and prejudices to [patent owners] into account,” the Board identified a non-exhaustive list of factors that may be considered in deciding whether to exercise its discretion to deny institution. No. IPR2016-01357, Paper 19 at 16-17. Some of the factors include:

- whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- 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;
- 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;
- 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; and
- the finite resources of the Board.

Id. And “not all the [*General Plastic*] factors need to weigh against institution for [the Board] to exercise [its] discretion under § 314(a).” *Alcatel-Lucent USA Inc. v. Oyster Optics, LLC*, No. IPR2018-00257, Paper 14 at 18 (P.T.A.B. June 4, 2018)

In *Alcatel-Lucent*, for example, the Board denied institution of a second petition that was filed less than six weeks after the same petitioner filed a first petition. No. IPR2018-00257, Paper 14 at 25-26. The *Alcatel-Lucent* Board placed little weight on the petitioner's receipt of the patent owner's preliminary response in a related IPR shortly before the second petition was filed. *Id.* at 22. Rather, the Board heavily weighed the fact that the petitioner knew of nearly all of the prior art asserted in the second petition at the time of filing the first petition, and the petitioner did not explain when it became aware of the additional reference. *Id.* at 18-21, 25. The petitioner also failed to identify the length of time that elapsed between when the petitioner learned of the prior art and when it filed the second petition, which weighed in favor of denying the petition. *Id.* at 22-23. Furthermore, consideration of the efficient use of the Board's resources weighed in favor of denying the petition, since the delay in filing the second petition created timing issues and made it more difficult to consolidate trials. *Id.* at 24.

More recently, in *Chevron Oronite Co. LLC v. Infineum USA L.P.*, No. IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018), the Board exercised its discretion to deny institution of *inter partes* review based on consideration of the efficient use of the Board's time and resources. No. IPR2018-00923, Paper 9 at 11. The petitioner failed to demonstrate a reasonable likelihood of prevailing with respect to most, but not all, of the challenged claims. *Id.* Based on guidance from

the PTO following the *SAS* decision, the Board considered the “number of claims and grounds that meet the reasonable likelihood standard.” *Id.* at 10-11 (citing U.S. Patent & Trademark Office, *SAS Q&As*, Part D (June 5, 2018)). Although the petitioner arguably demonstrated a reasonable likelihood of prevailing with respect to a small number of claims, the Board denied the petition altogether because instituting a trial for those claims would not be an efficient use of the Board’s time and resources. *Id.* at 11.

In the present case, at least five of the *General Plastic* factors weigh against instituting IPR. First, as with the serial filings in *General Plastic* and *Alcatel-Lucent*, the present Petition is a second or serial filing by the same petitioner challenging the same claims. As explained by the Board in *General Plastic*, “[m]ultiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.” No. IPR2016-01357, Paper 19 at 17. They also “are an inefficient use of the *inter partes* review process and the Board’s resources.” *Id.* at 21. Here, Petitioner previously filed the petition in IPR2019-00144 challenging claims 9-13 of the ’240 patent, the same claims that are challenged in the present Petition. Such similar, serial challenges to the same patent by Petitioner “risks harassment of patent owners and frustration of Congress’s intent” and should not be allowed. *See General Plastic*, No. IPR2016-01357, Paper 19 at 17 n.14 (citations omitted).

Second, Petitioner previously had detailed knowledge of *every* reference cited in the Petition, including Morikawa, which Petitioner identifies as “new art” and relies on with respect to all four grounds in the present Petition. *See* Petition at 5-6. All of the prior art in the present Petition was submitted by the Petitioner in the previous -00144 petition, and Peitioner was well aware of the contents of all three Japanese references. *See* IPR2019-00144, Ex. 1004, Ex. 1005, and Ex. 1023. Accordingly, the evidence with respect to this factor weighs even more heavily in favor of denying this follow-on Petition than the evidence that was before the Board in *Alcatel-Lucent*.

Third, like in *Alcatel-Lucent*, the Petitioner has not identified when it first became aware of any of the prior art references, But the fact that all of the references were submitted as exhibits in the -00144 petition demonstrates that Petitioner was well aware of each document when the previous petition was filed. In fact, Petitioner apparently had sufficient time to obtain and review an English translation of all three Japanese documents, since these translations were also provided in the -00144 petition. *See* IPR2019-00144, Ex. 1004, Ex. 1005, and Ex. 1023. As in *Alcatel-Lucent*, this factor weighs in favor of denying the Petition.

Fourth, Petitioner has not provided an adequate explanation for the delay between the filings of multiple petitions directed to the same claims of the same patent. Petitioner merely states, “[t]he additional grounds raised in this Petition –

and the other concurrently filed petitions – have also been filed within an acceptable amount of time given that new arguments needed to be formulated for four new petitions.” *See* Petition at 7. This is similar to the dodging and opaque statements made by the petitioner in *Alcatel-Lucent* because Petitioner’s proffered explanation does not provide any actual reason why Petitioner needed to formulate “new arguments,” much less why two weeks is an acceptable amount of time for doing so. Again, as noted above, Petitioner was well aware of all of the prior art references when the previous petition was filed, and no evidence in the record supports the assertion that additional time was warranted.

Fifth, with respect to the Board’s finite time and resources, Patent Owner notes that the present Petition is one of two petitions relating to the ’240 patent, along with IPR2019-00144, and one of eight total petitions filed against three patents in this family (see also IPR2019-00144, -00145, -00146, -00147, -00333, -00334, and -00338). The present Petition was filed about two weeks after the -00144 petition was filed, comparable to the delay in *Alcatel-Lucent*, and the time difference makes it more difficult for the cases to be consolidated. Instituting a trial on the second petition would further tax the Board’s resources.

Additionally, since Nakamura is not prior art (see Section II above), the Petition does not demonstrate a reasonable likelihood of prevailing with respect to two of the four grounds. Indeed, without Nakamura, Petitioner has not presented

any suitable grounds whatsoever for challenging claims 11 or 13. As with *Chevron*, instituting a trial based only on challenges to claims 9, 10, and 12 would be not be an efficient use of the Board's time and resources.

In view of the above, the Board should exercise its discretion and deny the Petition.

IV. CONCLUSION

The Board should deny the Petition and decline to institute IPR of the '240 patent because Petitioner fails to establish a reasonable likelihood of prevailing with respect to any of the claims. Two of Petitioner's four grounds rely on Nakamura, which is not prior art. Regarding the remaining challenged claims (claims 9, 10, and 12) and in the event the Board concludes that Petitioner's evidence might otherwise be sufficient to warrant institution, the Board should exercise its discretion to deny the Petition because instituting IPR would acquiesce to Petitioner's abuse of the process and harassment of Patent Owner, and would not be an efficient use of the Board's time and resources.

Respectfully submitted,

MICHAEL BEST & FRIEDRICH LLP

Dated: April 3, 2019

/ Kenneth M. Albridge, III /

Kenneth M. Albridge, III, Reg. No. 76,128

MICHAEL BEST & FRIEDRICH LLP

1 S. Pinckney Street, Suite 700

Madison, WI 53703

Telephone: (608) 257-3501

Facsimile: (608) 283-2275

and

J. Donald Best (*pro hac vice* to be requested)

MICHAEL BEST & FRIEDRICH LLP

1 S. Pinckney Street, Suite 700

Madison, WI 53703

Telephone: (608) 257-3501

Facsimile: (608) 283-2275

Kevin P. Moran, Reg. No. 37,183

MICHAEL BEST & FRIEDRICH LLP

Two Riverwood Place

N19 W24133 Riverwood Drive, Suite 200

Waukesha, WI 53188

Telephone: (262) 956-6510

Facsimile: (262) 956-6565

Brian J. N. Marstall, Reg. No. 73,023

MICHAEL BEST & FRIEDRICH LLP

1000 Maine Avenue SW, Suite 400

Washington, DC 20024

Telephone: (202) 747-9563

Facsimile: (202) 347-1819

Attorneys for Patent Owner

**CERTIFICATE OF COMPLIANCE
UNDER 37 C.F.R. § 42.24(d)**

The undersigned hereby certifies under 37 C.F.R. § 42.24(d) that the foregoing document complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(1)(i). The Preliminary Response contains 5,219 words, as calculated by Microsoft Word, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

MICHAEL BEST & FRIEDRICH LLP

Dated: April 3, 2019

/ Kenneth M. Albridge, III /
Kenneth M. Albridge, III, Reg. No. 76,128
MICHAEL BEST & FRIEDRICH LLP
1 S. Pinckney Street, Suite 700
Madison, WI 53703
Telephone: (608) 257-3501
Facsimile: (608) 283-2275

and

J. Donald Best (*pro hac vice* to be requested)
MICHAEL BEST & FRIEDRICH LLP
1 S. Pinckney Street, Suite 700
Madison, WI 53703
Telephone: (608) 257-3501
Facsimile: (608) 283-2275

Kevin P. Moran, Reg. No. 37,183
MICHAEL BEST & FRIEDRICH LLP
Two Riverwood Place
N19 W24133 Riverwood Drive, Suite 200
Waukesha, WI 53188
Telephone: (262) 956-6510
Facsimile: (262) 956-6565

Brian J. N. Marstall, Reg. No. 73,023
MICHAEL BEST & FRIEDRICH LLP
1000 Maine Avenue SW, Suite 400
Washington, DC 20024
Telephone: (202) 747-9563
Facsimile: (202) 347-1819

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a copy of the foregoing document was served by electronic mail upon the following:

Erik B. Milch, Reg. No. 42,887
emilch@cooley.com
cm-aavid@cooley.com
zpatdcdocketing@cooley.com

Andrew C. Mace, Reg. No. 63,342
amace@cooley.com

Mark R. Weinstein
mweinstein@cooley.com

Reuben Chen
rchen@cooley.com

Kyle Chen
kchen@cooley.com

Dated: April 3, 2019

/ Kenneth M. Albridge, III /
Kenneth M. Albridge, III, Reg. No. 76,128