UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RF CONTROLS, LLC,
Petitioner

v.

A-1 PACKAGING SOLUTIONS, INC.,
Patent Owner

Patent 8,690,057
Issue Date: April 8, 2014

Title: RADIO FREQUENCY IDENTIFICATION SYSTEM FOR TRACKING AND MANAGING MATERIALS IN A MANUFACTURING PROCESS

Cases: IPR2014-01536
IPR2015-00119

PATENT OWNER RESPONSE
UNDER 37 C.F.R. § 42.120

Pursuant to 37 C.F.R. § 42.120, please consider the following Patent Owner Response to the Decision of Institution of *Inter Partes* Review 37 C.F.R. § 42.108, issued March 30, 2015, for IPR2014-01536, and the Decision of Institution of *Inter Partes* Review 37 C.F.R. § 42.108, issued April 29,2015, for IPR2015-00119, in the above-identified matter.

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I. Introduction

Patent Owner A-1 Packaging, Inc. (hereinafter "Patent Owner") respectfully submits its Response under 35 U.S.C. §§311–319 and 37 C.F.R. §42.120. It is timely filed by June 26, 2015 (the deadline listed in the IPR2014-01536 Scheduling Order entered on March 3, 2015).

A. Statement of Relief Requested

Pursuant to 35 U.S.C. §316, Patent Owner respectfully requests that the Patent Trial And Appeal Board ("the Board") find that originally issued claims 1, 17, and 27 of U.S. Patent No. 8,690,057 ("the '057 Patent," Exh. 1001) are not invalid and, specifically, that these claims are patentable in view of the grounds under consideration.

B. Grounds for Review

The present *inter partes* review is a consolidation of IPR2014-01536 and IPR2015-00119. The Board instituted the present consolidated *inter partes* review on the following grounds:

(1) Independent claim 1 as anticipated by Hofer/Bloy (Exh. 1008) (IPR2014-01536); and

(2) Independent claims 17 and 27 as anticipated by Hofer/Bloy (IPR2015-00119).

II. Legal Authority

A. Burden of Proof

In an *inter partes* review, "the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. § 316(e) (2011).

B. Anticipation

To invalidate a patent as anticipated, a petitioner must demonstrate that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

To determine the amount of a prior art disclosure necessary to find a patented invention 'not novel' or 'anticipated,' the test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269 (CCPA 1968). Merely reciting the subject matter is insufficient if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); *see also* MPEP § 2121. A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention. *See*

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