

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP Inc.,

Petitioner

v.

MEMJET TECHNOLOGY LIMITED,

Patent Owner

Case IPR2016-00537
Patent No. 7,156,492

REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 7,156,492 CHALLENGING CLAIMS 1, 2, 4, and 5

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EXHIBIT LIST

<i>Exhibit #</i>	<i>Description</i>
Ex. 1001	U.S. Patent No. 7,156,492 to Silverbrook <i>et al.</i>
Ex. 1002	Declaration of Stephen Pond, Ph.D. ("Pond Decl.")
Ex. 1003	File History of U.S. Patent 7,156,492
Ex. 1004	U.S. Patent No. 5,565,900 to Cowger <i>et al.</i>
Ex. 1005	WO 01/02172 A1 to Silverbrook <i>et al.</i>
Ex. 1006	U.S. Patent No. 6,428,142 to Silverbrook <i>et al.</i>
Ex. 1007	U.S. Patent No. 5,682,186 to Bohorquez <i>et al.</i>
Ex. 1008	Curriculum Vitae of Stephen Pond, Ph.D.
Ex. 1009	<i>Foster's Australia Limited v. Cash's (Australia) Pty Ltd</i> [2013] FCA 527
Ex. 1010	General Correspondence re AU Pat. No. 2002240728 (excerpted)
Ex. 1011	Australian Patent Regulations 1991 (excerpted)
Ex. 1012	Australian Patents Act 1990 (excerpted)

I. INTRODUCTION

As authorized by the Board (IPR2016-00537, Paper 8.), this Reply addresses misrepresentations made in Patent Owner's Preliminary Response regarding whether one of the references raised in the Petition, namely U.S. Patent No. 6,428,142 (hereinafter "'142 patent"), qualifies as prior art under pre-AIA 35 U.S.C. § 103(c) (hereinafter "pre-AIA 103(c)").

On May 9, 2016, Patent Owner filed its Preliminary Response arguing that pursuant to pre-AIA 103(c), the '142 patent does not qualify as prior art because, at the time of the alleged invention of U.S. Patent No. 7,156,492 (hereinafter "'492 patent"), both were owned by Silverbrook Research Pty. Ltd. (hereinafter "SR"). Under pre-AIA 103(c), a prior art patent cannot be relied upon to show obviousness if it was owned by, or was under obligation to be assigned to, the same entity as the challenged patent "at the time the claimed invention was made." Patent Owner asserts that the claimed "invention was made" when the Australian Provisional Patent (PR3996), to which the challenged '492 patent claims priority, was filed, i.e., on March 27, 2001. Prelim. Resp. at 19-20. Thus, assuming *arguendo* that this date is correct, the '142 patent qualifies as prior art unless Patent Owner can show that on March 27, 2001, both PR3996 and the '142 patent were owned by, or under an obligation to be assigned to, the same entity.¹ Patent

¹ To avoid prior art in the related district court litigation, Patent Owner asserts a priority date of *no later than October 19, 2000*. Patent Owner cannot choose

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