

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,

Petitioner

v.

MEMJET TECHNOLOGY LIMITED,

Patent Owner

Patent No. 8,678,550

PETITION FOR *INTER PARTES* REVIEW OF

U.S. PATENT NO. 8,678,550

CHALLENGING CLAIMS 1-4

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1)	2
A. Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1).....	2
B. Related Matters under 37 C.F.R. § 42.8(b)(2)	2
C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)	3
D. Service Information under 37 C.F.R. § 42.8(b)(4).....	4
III. PAYMENT OF FEES UNDER 37 C.F.R. § 42.103.....	4
IV. GROUNDS FOR STANDING UNDER 37 C.F.R. § 42.104.....	4
V. THE '550 PATENT AND ITS PROSECUTION	4
A. Summary of the Prosecution History	4
B. Brief Description of the Patent.....	5
VI. THE PRIOR ART.....	9
A. Summary of the Prior Art.....	9
B. Brief Description of the Prior Art	9
VII. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED	10
A. Claims for Which Review Is Requested	10
B. Statutory Grounds of Challenge.....	10
C. Proposed Claim Constructions	10
1. “laminated ink distribution stack”	11
2. “transitional ducts”.....	14
VIII. DETAILED GROUNDS FOR UNPATENTABILITY	15

TABLE OF CONTENTS

(continued)

	Page
A. Priority Date for the '550 Patent	16
1. The '550 Patent's Purported Chain of Priority	16
2. The '751 Applicant Failed to Comply with the Relevant Requirements	18
3. The Priority Date of the '751 Application and '550 Patent Is October 28, 2004	23
B. Ground 1	24
1. Ground 1: Claims 1-4 Are Anticipated under 35 U.S.C. § 102(b) by Silverbrook WO '849	24
C. Claim Chart for Ground 1	45
IX. CONCLUSION.....	59

EXHIBIT LIST

<i>HP Exhibit #</i>	<i>Description</i>
Ex. 1001	U.S. Patent No. 8,678,550 to Silverbrook
Ex. 1002	Declaration of Stephen Pond, Ph.D.
Ex. 1003	File History of U.S. Patent 8,678,550
Ex. 1004	PCT Pub. No. WO 01/89849 A1 to Silverbrook
Ex. 1005	Curriculum Vitae of Stephen Pond, Ph.D.
Ex. 1006	Excerpt from American Heritage College Dictionary (4th ed. 2007)
Ex. 1007	Excerpt from McGraw-Hill Dictionary of Scientific and Technical Terms (5th ed. 1994)
Ex. 1008	Certified Translation of Final Judgment in Docket No. 21 O 20498/15 before Regional Court of Munich I dated January 29, 2016
Ex. 1009	File History of U.S. Patent No. 6,966,625
Ex. 1010	Memjet's Responsive Claim Constructions served March 7, 2016 in Case No. 3:15-cv-01769-BEN-BLM (S.D. Cal.)

I. INTRODUCTION

As will be shown below, claims 1-4 of U.S. Patent No. 8,678,550 (“the ’550 patent,” Ex. 1001) should be found unpatentable under pre-AIA 35 U.S.C. § 102. By failing to comply with statutory requirements, the ’550 patent is not entitled to the priority of the earliest date claimed. In one of the applications that precedes the ’550 patent in its purported chain of priority, the applicant attempted to make an improper and untimely priority claim in violation of the patent statute. In particular, the applicant failed to comply with the statute which requires a showing that the delayed priority claim was unintentional and a payment of the requisite fee. Rather, the purported priority claim came by way of an amendment, which the applicant stated was merely an “update[] . . . to show the appropriate continuity details.” The applicant failed to inform the Examiner that the priority claim was new (and untimely). Removing this invalid priority claim, the earliest priority date to which the ’550 patent is entitled is October 28, 2004.

Moreover, years earlier, the applicant filed three PCT applications having disclosures nearly identical to that of the ’550 patent, namely PCT Application Nos. PCT/AU00/00594, PCT/AU00/00596, and PCT/AU00/00597. Because these PCT applications published on November 29, 2001, more than one year before the ’550 patent’s earliest *valid* priority date, they clearly invalidate the ’550 patent under 35 U.S.C. § 102(b). For simplicity, only one of the PCT publications is

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