

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL PLASTIC INDUSTRIAL CO., LTD.

Petitioner

v.

CANON KABUSHIKI KAISHA

Patent Owner

U.S. Patent No. 8,909,094

Issue Date: December 9, 2014

Title: SEALING MEMBER, TONER ACCOMMODATING CONTAINER
AND IMAGING FORMING APPARATUS

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. §108(c)**

Case No. IPR2016-01359

I. INTRODUCTION

On September 25, 2015, Petitioner General Plastic filed its first Petition seeking *inter partes* review of claims 1, 8, 9, 11, 17, 18, 28 and 38 of U.S. Patent No. 8,909,094 (“the ‘094 patent,” Ex. 1001) under 35 U.S.C. §102(b) as being anticipated by Matsuoka U.S. Patent No. 5,903,806 (“Matsuoka”) (Ground 1) and claims 1, 7-9, 11, 16-18, 29 and 38 under §103 as being obvious over Matsuoka (Ground 2). Under Ground 1, Petitioner correlated the recited sealing member with Matsuoka toner cartridge’s fixed cover 32 and the copier’s rotary power transmitting member 44 that become engaged only when the toner cartridge 30 is inserted into the copier. For Ground 2, Petitioner argued that the toner cartridge 30 could be withdrawn from the Matsuoka copier with the copier’s power transmitting member 44 still attached to the toner cartridge’s fixed cover 32. The Board denied institution on both Grounds 1 and 2 of the first Petition.

On July 8, 2016, Petitioner General Plastic *timely* filed its Second Petition which seeks *inter partes* review of claims 1, 7-9 and 29 under §103 as being obvious over Suzuki (Ex. 1006) and Ikesue (Ex. 1007). Because the Second Petition was timely filed, Patent Owner has not been unduly prejudiced. See *Microsoft Corp. v. Bradium Techs. LLC*, IPR2016-00449, Decision (Paper 9) at p. 8 (P.T.A.B. July 27, 2016) (“the one year statutory time bar for filing a petition imposed by 35 U.S.C. §315(b) provides a self-limiting mechanism that protects

Patent Owner from prejudice resulting from serial attacks by the same Petitioner.”).

II. THE SECOND PETITION SHOULD NOT BE DENIED FOR REASONS WITHIN THE BOARD’S DISCRETION

Patent Owner Canon seeks to have the Board exercise the discretion accorded to it under just 35 U.S.C. §314(a) to deny the subject Second Petition. See Preliminary Response (Paper 5) at pp. 4-10. However, in all of the cases cited by Patent Owner, the Board exercised its discretion to deny institution under §§314(a)/324(a) and §325(d). See *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, Decision (Paper 9) at pp. 6-14 (P.T.A.B. May 4, 2016); *Great West Cas. Co. v. Intellectual Ventures II LLC*, IPR2016-00453, Decision (Paper 12) at pp. 5-14 (P.T.A.B. June 9, 2016); *Conopco, Inc. v. Procter & Gamble Co.*, IPR2014-00506, Decision (Paper 25) at pp. 4-5 (P.T.A.B. Dec. 10, 2014); *Travelocity.com L.P. v. Cronos Techs., LLC*, CBM2015-00047, Decision (Paper 7) at pp. 6-7 & 10-13 (P.T.A.B. June 15, 2015); *Samsung Elecs. Co. v. Rembrandt Wireless Techs, LP*, IPR2015-00118, Decision (Paper 14) at pp. 4-7 (P.T.A.B. Jan. 28, 2015); *Roche Molecular Sys., Inc. v. Illumina, Inc.*, IPR2015-01091, Decision (Paper 18) at pp. 12-14 (P.T.A.B. Oct. 30, 2015).

Patent Owner has not pointed to any Board decision denying a petition solely under §314(a)/ §324(a), without a finding pursuant to §325(d) that “the same

or substantially the same prior art or arguments previously were presented to the Office” in an earlier filed petition.

A. The Second Petition Does Not Present The Same Or Substantially The Same Prior Art Or Arguments As The First Petition

The first Petition relied upon Matsuoka. The subject Second Petition, on the other hand, relies upon Suzuki (Ex. 1006) and Ikesue (Ex. 1007). Thus, the first Petition and the Second Petition present different prior art. See Second Petition (Paper 2) at pp. 2-3. As pointed out in the Second Petition, Suzuki was not considered by the Examiner during prosecution of the ‘094 patent. Id. at p. 20.

In the first Petition, Petitioner correlated a structural element of Matsuoka’s copier (i.e., rotary power transmitting member 44) with limitations recited in the challenged claims. See *General Plastic v. Canon*, IPR2015-01954, Decision (Paper 9) at pp. 14-26 (P.T.A.B. Mar. 9, 2016). In the Second Petition, Petitioner relies upon just the toner cartridges disclosed in Suzuki and Ikesue, without resort to any copier components as part of its invalidity arguments. Thus, the Second petition does not present the same or substantially the same prior art or arguments as the first Petition.

For this reason alone, the Second Petition should not be denied under §314(a) or §325(d). See *Microsoft*, IPR2016-00449, Decision (Paper 9) at p. 8 (“Whether Petitioner initially failed to locate references that, in combination, disclose the claimed features or failed to argue them successfully in its first

petition, alone, does not immunize Patent Owner from challenges raised in a second properly filed petition.”). Moreover, each of Suzuki and Ikesue differ significantly from Matsuoka such that the institution decision on the first Petition cannot be used as a “roadmap” for the Second Petition. See *Id.* at p. 9; *Atlas Copco Airpower N.V. v. Kaeser Kompressoren SE*, IPR2015-01421, Decision (Paper 8) at pp. 7-8 (P.T.A.B. Dec. 28, 2015).

B. As Of The Filing Of The First Petition, Petitioner Was Unaware Of Suzuki

NVIDIA Factors (4) and (6) cut against a denial of the Second Petition under §314(d). On September 25, 2015, Petitioner filed its first Petition. On March 9, 2016, the Board denied institution on the first Petition. On April 8, 2016, Petitioner filed a request for rehearing. On or about April 11, 2016, Petitioner initiated two new prior art searches. See Ex. 1009, Hsieh Decl. at ¶¶3-4.

Petitioner first found Suzuki on May 3, 2016 and transmitted a copy thereof to its IPR counsel on June 3, 2016. See *Id.* at ¶¶7-8. On July 1, 2016, a certified English translation of Suzuki was obtained. See Ex. 1006 at p. 12. Patent Owner contends that Suzuki teaches nothing beyond Ikesue. See Preliminary Response at p. 8. Patent Owner is simply wrong. In Suzuki, when the inner cap 3 is pulled away from the container main unit 2, a rotational force applied to the inner cap’s protruding portion 13 will rotate the container main unit 2. See Second Petition at pp. 27-28. Patent Owner has not shown that the rotation of Ikesue’s lid 15 would

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