

Filed on behalf of: Canon Kabushiki Kaisha

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.

Case IPR2016-01359

U.S. Patent 8,909,094

PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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**I. DISCRETIONARY DENIAL IS WARRANTED
PURSUANT TO 35 U.S.C. § 314(a)**

Petitioner's focus on 35 U.S.C. § 325(d) is a red herring. Here, Patent Owner relies on 35 U.S.C. § 314(a), which is separate and independent from §325(d), and affords the Board discretion to deny institution based on factors beyond the "same or substantially the same prior art or arguments" basis. Pursuant to § 314(a), and independent from § 325(d), the factors outlined in *NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9 (P.T.A.B. May 4, 2016) can warrant denying institution of a follow-on petition. *See id.* at 6-14 (denying institution on two "alternative" grounds, § 314(a) and § 325(d), each supported by "[s]eparate [r]easoning"); *Great West Cas. Co. v. Intellectual Ventures II LLC*, IPR2016-00453, Paper 12, at 5-14 (P.T.A.B. June 9, 2016) (same). Patent Owner's preliminary response provides ample reason why the Board should deny institution based on the *NVIDIA* factors (all of which cut against Petitioner here), and Patent Owner was not required to make a separate showing under § 325(d).¹ *See* Paper 5, at 4-10.

¹ The decision in *Microsoft Corp. v. Bradium Techs. LLC*, IPR2016-00449, Paper 9 (P.T.A.B. July 27, 2016) upon which Petitioner relies declined to deny institution under § 325(d), and did not address the *NVIDIA* factors.

II. PETITIONER'S BELATED PRIOR ART SEARCHES DO NOT JUSTIFY ITS SERIAL FILINGS

Contrary to Petitioner's argument, the *NVIDIA* factors weigh in favor of, not against, denying institution. Petitioner does not deny that it has known about Ikesue since at least as early as May 8, 2012. Petitioner asserts it did not know about Suzuki until May 2016, but fails to address whether it "should have known about" that reference earlier. *See NVIDIA*, IPR2016-00134, Paper 9, at 7 ("(4) 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 about it*") (emphasis added). Decisions giving rise to *NVIDIA* factor 4 establish that the "should have known about" language relates to the "availability" of the reference and is akin to the estoppel standard ("reasonably could have raised"). *See NVIDIA*, IPR2016-00134, Paper 9, at 7, n.3; *Conopco, Inc. v. Procter & Gamble Co.*, IPR2014-00506, Paper 25, at 4-5 (P.T.A.B. Dec. 10, 2014) (discussing "known or available" and relationship to the estoppel standard); *Toyota Motor Corp. v. Cellport Sys., Inc.*, IPR2015-01423, Paper 7, at 8 (P.T.A.B. Oct. 28, 2015) ("known or available"). Thus, *NVIDIA* relates to prior art that a "skilled searcher conducting a diligent search reasonably could have been expected to discover." 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

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