

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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

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

Case No. IPR2016-01360

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## 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,” Ex. 1009) (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 For Ground 2, Petitioner argued that the toner cartridge 30 could be withdrawn from the Matsuoka copier with the copier’s power transmitting member 44 still attached to the toner cartridge’s fixed cover 32.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 the subject Third Petition which seeks *inter partes* review of claims 1, and 7-9 under §103 as being obvious over Yoshiki (Ex. 1006) and Koide (Ex. 1007), in view of Kato (Ex. 1008), Matsuoka (Ex. 1009) and Ikesue (Ex. 1010) (Ground 1), and claim 29 as being obvious over Yosiki and Koide, in view of just Ikesue (Ground 2). Because the Third 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 THIRD 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 Third Petition. See Preliminary Response (Paper 5) at pp. 4-11. 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 Third Petition Does Not Present The Same Or Substantially The Same Prior Art Or Arguments As The First Petition**

The first Petition relied upon Matsuoka (Ex. 1009) as the principal reference. The subject Third Petition, on the other hand, relies upon Yoshiki (Ex. 1006) and Koide (Ex. 1007) as the principal references. Thus, the first Petition and the Third Petition present different prior art. See Third Petition (Paper 2) at pp. 2-3. As pointed out in the Third Petition, this ground was not considered by the Examiner during prosecution of the ‘820 patent. Id. at p. 21.

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 Third Petition, Petitioner relies upon just the toner cartridges disclosed in Yoshiki and Koide, without resort to correlating any copier component with a limitation recited in a challenged claim as part of its invalidity arguments. In Ground 1 of the Third Petition, Matsuoka is used only to evidence a motivation to combine, not as a principal reference. See Third Petition at pp. 33-34. Thus, the Third Petition does not present the same or

substantially the same prior art or arguments as the first Petition. See *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). Moreover, Matsuoka is not used at all in Ground 2 of the Third Petition.

For this reason alone, the Third 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 Yoshiki (Ex. 1006) and Koide (Ex. 1007) differ significantly from Matsuoka (Ex. 1009) such that the institution decision on the first Petition cannot be used as a “roadmap” for the Third Petition. See *Id.* at p. 9; *Atlas Copco*, IPR2015-01421, Decision (Paper 8) at pp. 7-8.

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

NVIDIA Factors (4) and (6) cut against a denial of the Third 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. 1012, Hsieh Decl. at ¶¶3-4.

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