

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.

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Case IPR2016-01360  
Patent 8,909,094 B2

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Before JAMESON LEE, THOMAS L. GIANNETTI, and  
SHEILA F. McSHANE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a); 37 C.F.R. § 42.108

## I. INTRODUCTION

### A. *Background*

On July 8, 2016, a Petition (Paper 2, “Pet.”) was filed to institute *inter partes* review of claims 1, 7–9, and 29 of U.S. Patent No. 8,909,094 B2 (Ex. 1001, “the ’094 patent”). Patent Owner filed a Preliminary Response (Paper 5, “Prelim. Resp.”) on August 29, 2016. We authorized Petitioner to file a reply and Patent Owner to file a sur-reply. Paper 7. Petitioner filed a Reply (“Reply”). Paper 8. Patent Owner filed a Sur-Reply (“Sur-Reply”). Paper 10.

We exercise discretion to not institute *inter partes* review of claims 1, 7–9, and 29 of the ’094 patent.

### B. *Related Matters*

The parties indicate that the ’094 patent was involved in an investigation before the International Trade Commission: *In the Matter of Certain Toner Supply Containers And Components Thereof*, Inv. No. 337-TA-960 (U.S. Int’l Trade Comm’n) (July 10, 2015). Pet. 2; Paper 4, 2

The ’094 patent was the subject patent in IPR2015-01954, in which the Board declined, on March 9, 2016, to institute *inter partes* review of any claim of the ’094 patent. Concurrent with the filing of the instant Petition on July 8, 2016, Petitioner filed two other petitions for *inter partes* review of the ’904 patent. Those petitions are now pending in IPR2016-01359 and IPR2016-01361. Petitioner identifies the petition in IPR2015-01359 as “Second Petition,” the instant Petition in this proceeding as “Third Petition,” and the petition in IPR2016-01361 as “Fourth Petition,” all relative to the petition filed in IPR2015-01954, which we will refer to as “First Petition.”

*C. The '094 Patent*

Of all challenged claims, claims 1 and 29 are independent and both are directed to a “toner supply container.”

*D. Evidence Relied Upon*

Reference		Date	Exhibit
Kato	U.S. Patent No. 6,118,951	Sept. 12, 2000 filed Jan. 12, 1998	Ex. 1008
Matsuoka	U.S. Patent No. 5,903,806	May 11, 1999	Ex. 1009
Yoshiki	U.S. Patent No. 5,765,079	June 9, 1998	Ex. 1006
Ikesue	U.S. Patent No. 5,598,254	Jan. 28, 1997	Ex. 1010
Koide	Japanese Patent Application Pub. No. 10-171230	June 26, 1998	Ex. 1007

Petitioner also relies on a Declaration of Brian Springett, Ph.D. (Ex. 1011). Petitioner additionally relies on a Declaration of Hui-Wen Hsieh (Ex. 1012), submitted with Petitioner’s Reply.

*E. The Asserted Grounds of Unpatentability*

References	Basis	Claim Challenged
Yoshiki, Koide, Kato, Matsuoka, and Ikesue	§ 103(a)	1 and 7–9
Yoshiki, Koide, and Ikesue	§ 103(a)	29

II. ANALYSIS

1. Overview

Institution of *inter partes* review is discretionary. See 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). A number of factors are considered in

deciding whether to exercise discretion not to institute review, including:

- (a) the finite resources of the Board;
- (b) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review;
- (c) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (d) 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 of it;<sup>[1]</sup>
- (e) whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;<sup>[2]</sup>
- (f) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and
- (g) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.

*LG Electronics, Inc. v. Core Wireless Licensing S.A.R.L.*, Case IPR2016-00986, slip op. at 6–7 (PTAB Aug. 22, 2016) (Paper 12); *NVIDIA Corp. v.*

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<sup>1</sup> See *Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 4 (PTAB Dec. 10, 2014) (Paper 25) (Informative), and slip op. at 6 (PTAB July 7, 2014) (Paper 17); *Toyota Motor Corp. v. Cellport Sys., Inc.*, Case IPR2015-01423, slip op. at 8 (PTAB Oct. 28, 2015) (Paper 7).

<sup>2</sup> See *Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00628, slip op. at 11 (PTAB October 20, 2014) (Paper 21) (discouraging filing of a first petition that holds back prior art for use in later attacks against the same patent if the first petition is denied); *Toyota Motor Corp.*, slip op. at 8 (“the opportunity to read Patent Owner’s Preliminary Response in IPR2015-00634, prior to filing the Petition here, is unjust.”).

*Samsung Elecs. Co.*, Case IPR2016-00134, slip. op. at 6–7 (PTAB May 4, 2016) (Paper 9) (“Nvidia”).

2. The First Petition—Filed in IPR2015-01954

The instant Petition is not the first petition filed by Petitioner challenging claims 1, 7–9, and 29 of the ’094 patent. The first petition was filed on September 25, 2015, in IPR2015-01954, alleging two grounds of unpatentability for claims 1, 7–9, and 29:

(a) that claims 1, 8, and 9 are anticipated by Matsuoka, under 35 U.S.C. § 102(b); and

(b) that claims 1, 7–9, and 29 are unpatentable as obvious over Matsuoka, under 35 U.S.C. § 103.

3. The Decision Denying Institution in IPR2015-01954

The First Petition (in IPR2015-01954) was denied on March 9, 2016. Ex. 3001.<sup>3</sup> More than 9 months passed between Petitioner’s filing of the First Petition, on September 25, 2015, and Petitioner’s filing of the Third Petition, in this proceeding, on July 8, 2016. During that time, Patent Owner filed a preliminary response in IPR2015-01954, addressing, *inter alia*, why Petitioner’s challenge in the First Petition against claims 1, 7–9, and 29 was deficient. Also during that time, the Board rendered a decision in IPR2015-01954, declining to institute *inter partes* review for any challenged claim of the ’094 patent and explaining why Petitioner’s challenge against claims 1, 7–9, and 29 was deficient.

Specifically, the Board rejected Petitioner’s treating rotary power transmitting member 44 of Matsuoka’s copier’s developing agent

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<sup>3</sup> *General Plastic Industrial Co., LTD v. Canon Inc.*, Case IPR2015-01954 (PTAB March 9, 2016) (Paper 9).

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