

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. IPR2016-01361

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. 2203) (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 For Ground 2, Petitioner argued that the toner cartridge 30 could be withdrawn from the Matsuoka copier with the copier’s power transmitting member 44 still attached to the toner cartridge’s fixed cover 32.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 Fourth Petition which seeks *inter partes* review of claims 1, 7-9, 11, 16-18, 29 and 38 under §103 as being obvious over Yasuda (Ex. 1006). Because the Fourth 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 FOURTH 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 Fourth Petition. See Preliminary Response (Paper 5) at pp. 5-9. 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 Fourth 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. 2203). The subject Fourth Petition, on the other hand, relies upon Yasuda (Ex. 1006). Thus, the first Petition and the Fourth Petition present different prior art. See Fourth Petition (Paper 2) at pp. 2-3. As pointed out in the Fourth Petition, Yasuda 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 Fourth Petition, Petitioner relies upon just the toner cartridge disclosed in Yasuda, without resort to correlating any copier component with a limitation recited in a challenged claim as part of its invalidity arguments. Thus, the Fourth Petition does not present the same or substantially the same prior art or arguments as the first Petition.

For this reason alone, the Fourth 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, Yasuda (Ex. 1006) differs significantly from Matsuoka (Ex. 2203) such that the institution decision on the first Petition cannot be used as a “roadmap” for the Fourth 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 Yasuda

NVIDIA Factors (4) and (6) cut against a denial of the Fourth 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. 1008, Hsieh Decl. at ¶¶3-4.

On May 9, 2016, Petitioner’s outside search firm first located Yasuda, which was transmitted to Petitioner’s IPR counsel on that same day. See Ex. 1008, Hsieh Decl. at ¶¶6 & 8. Patent Owner contends that Petitioner should be charged with earlier knowledge of Yasuda because Yasuda is listed on the face of Matsuoka. See Preliminary Response at pp. 7-8. However, while Patent Owner cited Matsuoka during prosecution of the ‘094 patent, it did not cite Yasuda. See Ex. 1001 at p. 2. Petitioner should not be held to a higher standard than Patent Owner. See 37 C.F.R. §1.56; Cf. Ex. 1008 at ¶8.

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