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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION, Petitioner,

v.

ONE-E-WAY, INC. Patent Owner.

Case IPR2016-01638 Patent 9,282,396

PATENT OWNER RESPONSE



I.	INTRODUCTION						
II.	PETITIONER'S FACTUAL BACKGROUND						
III.		PETITIONER'S DISCUSSION OF THE CHALLENGED '396 PATENT					
IV.	THE SOLE GROUND FOR INVALIDITY FAILS BECAUSE THE '396 PATENT CLAIMS HAVE A 2001 PRIORITY DATE						
	A.	Petitioner Does Not Dispute that the '396 Patent Properly Claims Priority to December 21, 2001—the Filing Date of the 2001 Parent Application—Nor Does Petitioner Dispute that as of that Same Date, Mr. Woolfork Was in Possession of the Inventions Claimed in the '396 Patent					
		1.		396 Patent Properly Claims Priority to the Application	.7		
			a.	Petitioner Does Not Dispute that Each Application in the '396 Patent Family Claims Priority to the Prior Applications in the Chain	.7		
		2.	Inven	Voolfork was in Possession of the tions Claimed in the '396 Patent as of Its tive Filing Date of December 21, 2001	.7		
			a.	The '396 Patent Complies, as it Must, With the Written Description Requirement as of the Filing Date Sought	.7		
			b.	There is No Dispute that Mr. Woolfork was in Possession of the Inventions Claimed in the '396 Patent as of December 21, 2001	.9		
	B.		_	uted that Mr. Woolfork Amended his 2003 ation to Disclose Subject Matter that He			



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Appli	cation,	y Disclosed in His Original 2001 , and that the Patent Office Allowed Each dment Without Objection10				
1.	Amen Subje	The Patent Examiners Reviewed Numerous Amendments and Plainly Understood that ubject Matter Already Disclosed in the 2001 Parent Application was Not New Matter				
	a.	The Patent Examiners Reviewed and Rejected Mr. Woolfork's Request to Add New Figures 2 and 3 to the 2003 CIP Because the Subject Matter Was Not Supported by the 2003 CIP or by the 2001 Parent Application				
	b.	The Patent Examiners Reviewed and Approved Adding Figures 2 and 3 from the 2001 Parent Application				
	c.	The Patent Examiners Reviewed and Rejected Mr. Woolfork's Request to Disclose Frequency Shift Keying in his 2003 CIP Application Because The Subject Matter Was Not Supported by the CIP or by the Parent 2001 Application				
	d.	The Patent Examiners Reviewed and Approved Mr. Woolfork's Request to Disclose Differential Phase Shift Keying in his 2003 CIP Application				
	e.	Supervisory Patent Examiner Sinh Tran Reviewed and Approved Mr. Woolfork's Request to Incorporate By Reference the Entirety of the 2001 Parent Application				
2.		Determinations Made by the Patent iners that Mr. Woolfork's Amendments				



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		Did Not Introduce New Matter are Entitled to Deference	15			
C.	Und No 1 2003 had	The Great Weight of Authority is in Accord with the Understanding and Practice of the Patent Examiners: No New Matter was Introduced by Amending the 2003 CIP Application to Disclose Subject Matter that had Already Been Disclosed in the 2001 Parent Application				
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	7.	Ex parte Tianping Huang	31			
	8.	Ex parte Dae-Ho Choo and Sang-Uk Jung	32			
D.	The Cases Cited in the Petition Fail to Address the Present Facts and do Not Support Petitioner's Argument that Continuity of Disclosure was not Maintained During the Prosecution of the 2003 CIP Application					
	1.	The Zenon Case Does Not Address the Present Facts	34			
	2.	The Lockwood Case Does Not Address the Present Facts	35			
	3.	The Anascape Case Does Not Address the Present Facts	36			



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				Dart Industries, Inc. v. Banner Case Does Address the Present Facts	38
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			a.	The MPEP Does Not have the Force of Law	42
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