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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION,
Petitioner,

v.

ONE-E-WAY, INC.
Patent Owner.

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Case IPR2016-01638
Patent 9,282,396

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# PATENT OWNER ONE-E-WAY'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW

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## I. INTRODUCTION

Petitioner fails to present any reasonable likelihood that at least one of the claims challenged in the petition is unpatentable, thus, the petition should be denied. 37 C.F.R. §108(c).

Petitioner presents a single ground for invalidity of U.S. Patent No. 9,282,396 (the ’396 patent). Pet. 2. That sole ground is that the ’396 patent is obvious under 35 U.S.C. § 103 in view of Patent Owner One-E-Way, Inc.’s own earlier publication (the ’196 publication) of its 2001 application. *Id*. Petitioner argues that a break in the continuity of Patent Owner’s chain of co-pending applications precludes the ’396 patent from claiming priority to the 2001 application and thus avoiding the ‘196 publication as prior art. Pet. 9, 13-19.

Petitioner argues that the alleged break in continuity occurred in Patent Owner’s 2003 continuation-in-part (CIP) application (the ’012 application). *Id*. Petitioner alleges that continuity of disclosure was broken because Patent Owner did not incorporate by reference the disclosure of the 2001 parent application when the 2003 CIP application was initially filed. *Id*.

As explained below, well-settled Board and Federal Circuit decisions make clear that a CIP application may be amended prior to abandonment or issuance to incorporate by reference material from a parent application. Such an amendment is entirely proper because subject matter is not “new matter” in a CIP if it derives

from a parent application. Thus, because Patent Owner properly incorporated its 2001 application before the 2003 application issued, there was never any break in continuity of disclosure as alleged by Petitioner.

When the Board reviews the petition and this preliminary response, the only conclusion to be made is that the ’396 Patent has priority dating back to the 2001 application, and thus the ’196 publication, which published from the 2001 application, is not prior art under 35 U.S.C. § 103. As such, Petitioner’s sole ground for invalidity must be rejected, and the Board should deny the Petition.

## II. PETITIONER’S FACTUAL BACKGROUND

For purposes of this Response, Patent Owner does not dispute the description regarding the ’396 Patent, or the facts regarding the prosecution history of the ’396 Patent, as set forth in the “Factual Background” section of the Petition. Pet. 2-7. Also, Patent Owner does not dispute Petitioner’s figure showing the ‘396 patent’s chain of priority back to the original 2001 application, which is set forth below:

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