UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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REACTIVE SURFACES LTD. LLP,

Petitioner,

v.

TOYOTA MOTOR CORPORATION,

Patent Owner.

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Case IPR2016-01914

Patent No. 8,394,618 B2

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PATENT OWNER'S BRIEF IN RESPONSE TO THE JANUARY 12, 2018 ORDER

Ex parte Schulhauser is inapplicable to the challenged claims. Specifically, the fact that the "facilitating" limitation of independent claim 1 includes the phrase "when contacted by a fingerprint" does not make that limitation a "conditional" claim element. *Schulhauser* involved a very different type of claim, one that *explicitly* recited two separate, and mutually exclusive, methods, with each method being *explicitly* contingent on the occurrence of a specified event. In contrast, claim 1 here recites a single method of "facilitating the removal of a fingerprint on a substrate or a coating," one that, *by definition*, has to involve contact with a fingerprint. The Board should hold that the "facilitating" limitation is a necessary element of the challenged claims, and that the "when" clause connotes a merely temporal aspect, requiring the "facilitating" action to occur only after there is contact with a fingerprint, which, indeed, is the only time that such "facilitati[on]" could logically occur. Further, because the prior art fails to teach or suggest the "facilitating" limitation, the Board should uphold the patentability of claims 1-11.

In *Schulhauser*, the claims recited "[a] method of monitoring of cardiac conditions incorporating an implantable medical device in a subject." 2016 Pat. App. LEXIS 2437, *2-3. The first two steps required "collecting . . . electrocardiac signal data" from the subject and "comparing [said] data with a threshold electrocardiac criteria." Then, the claims provided for two *mutually exclusive* paths. If the signal data was *not within* the threshold criteria, the claims required

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"triggering an alarm state." Conversely, if the signal data was *within* the threshold criteria, the claims required a series of further monitoring steps instead of the "triggering" step. The Board therefore concluded that the claims "as written" actually covered "at least two methods," with one of the two being performed to the exclusion of the other depending on whether the signal data was "within" or "not within" the threshold criteria. *Id.*, *10. Further, because the claims would be literally infringed by either of the two methods, the prior art needed to disclose only one of the two in order to render the claims unpatentable. *Id.*, *12 (citing the rule that "that which would infringe if later anticipates if earlier"). Since the prior art taught the triggering of an alarm state in response to the signal data not being within the threshold criteria, the examiner's rejection was affirmed. *Id.*, *11-12.

The claims at issue here are very different from those in *Schulhauser*. The *Schulhauser* claims specified two "mutually exclusive" "conditions precedent" (the signal data being either within or not within the threshold criteria) and described two separate methods that would have to be carried out depending on which of the two conditions precedent occurred. 2016 Pat. App. LEXIS 2437, *8, 10. Because the conditions precedent were mutually exclusive, it would have been impossible to practice the claimed invention while performing *both* methods at the same time. The steps involved in each method were therefore plainly "conditional" on the occurrence of a particular event. Here, in contrast, claim 1 is not written in the

alternative. Instead, the claim is directed to a single "method of facilitating the removal of a fingerprint on a substrate or a coating" comprising "providing a substrate or a coating," "associating a lipase [therewith] such that said lipase is capable of enzymatically degrading a component of a fingerprint," and "facilitating the removal of a fingerprint by vaporization from [said] substrate or coating when contacted by a fingerprint." The claim does not purport to describe an alternative method of "facilitating the removal of a fingerprint on a substrate or a coating" wherein the substrate or the coating is never contacted by a fingerprint.

In fact, common sense dictates that a method of facilitating the removal of a fingerprint from a surface *requires* that a fingerprint first be deposited thereon. Thus, the phrase "when contacted by a fingerprint" in the "facilitating" limitation does not suggest that that limitation is conditional ("conditional" in the sense that the claimed method could be completed with or *without* it). To the contrary, the "facilitating" limitation is a necessary element, one that imbues the claim with "meaning," "purpose," and "utility." *See* PO Resp. 20-22 (citing *Griffin v. Bertina*, 285 F.3d 1029 (Fed. Cir. 2002)). The phrase "when contacted by a fingerprint" suggests only a *temporal* aspect: the removal of the fingerprint is not facilitated until after the fingerprint is deposited on the surface. This reading makes sense as a matter of both "logic" and "grammar." *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369-70 (Fed. Cir. 2003) (where a method claims requires, "as a matter

of logic or grammar," a particular order of steps, it will be construed as such).

A "whereby" or "wherein" clause that "states a condition . . . material to patentability . . . cannot be ignored in order to change the substance of the invention." *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1330 (Fed. Cir. 2003); *see also Griffin*, 285 F.3d at 1335; *Biodelivery Sciences Int'l, Inc., v. RB Pharms Ltd.*, IPR2014-00325, Paper 43 at 5-6 (P.T.A.B. Jun. 30, 2015). The "facilitating" limitation is no different. The action described there ("facilitating the removal of a fingerprint by vaporization from the lipase associated substrate or coating when contacted by a fingerprint") is indisputably "material to patentability." *See Hoffer*, 405 F.3d at 1330. Indeed, it captures the whole "essence of the invention." *See* PO Resp. 20-22. As such, the limitation "cannot be ignored" through a construction that would turn it into a merely conditional (unnecessary) element. *See Hoffer*, 405 F.3d at 1330; *see also Ex parte Hehenberger*, No. 2015-007421, 2017 Pat. App. LEXIS 960, *7 (P.T.A.B. Jan. 31, 2017) (Delmondo, APJ, concurring) (*Schulhauser* does not apply where construing a claim element as conditional "would render the entire claim *meaningless*" (emphasis added)).

The Board decisions cited in the January 12 Order are not to the contrary. In *Kaundinya* and *Zhou*, the claims were drafted in the same format as those in *Schulhauser*, specifying two mutually exclusive conditions precedent and providing for two different sets of instructions depending on which of the two

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