UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REACTIVE SURFACES LTD. LLP,

Petitioner,

v.

TOYOTA MOTOR CORPORATION,

Patent Owner.

Case IPR2016-01914

Patent No. 8,394,618 B2

PATENT OWNER'S SUR-REPLY

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Patent Owner submits this Sur-Reply pursuant to the Order of November 17.

I. The Newly Relied-Upon Wang Reference Does Not Suggest the Use of Lipase for Facilitating Evaporative Fingerprint Removal.

In an attempt to remedy the deficiencies in the prior art relied upon in the Petition, Petitioner submits the Wang reference and suggests that it somehow shows that "stain removal by catalytic action and evaporation were well-known." Reply 9-10 (capitalization omitted). In fact, Wang was already considered by the Office during prosecution. As the applicants successfully argued then, while Wang discloses that enzymes such as lipase can degrade the components of a bioorganic stain, it lacks any teaching that such degradation can facilitate *the removal a fingerprint stain by vaporization*. Ex. 1012 at 10. Petitioner's expert Dr. Rozzell admitted as much in his deposition, including on examination by Petitioner's own counsel. Ex. 2017 at 54:12-18 ("**Q:** . . . [I]n totality, considering the disclosures of Wang, do these disclosures provide for the removal of a bioorganic stain by evaporation? **A:** . . . I don't believe so. I believe the focus is on breaking down the components but not explicitly disclosing evaporation."); *see also id.* at 11:8-12:13.

Thus, the prior art, including Wang, gave no expectation that degrading the components of a bioorganic stain into smaller molecules would facilitate the removal of the stain by vaporization. As argued by the applicants in prosecution, Wang in particular provided "no expectation that the activity of a lipase associated coating or substrate will actually promote removal of [a] fingerprint as opposed to

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merely degrading one or more component parts and leaving those component parts on the surface of the material," which "may explain why [Wang] requires washing with [deionized] water to actually remove the [decomposed] stain." Ex. 1012 at 10-11 (emphasis added); *see* Ex. 1025 ¶ [0051] (removing an egg-white stain degraded with protease by "wash[ing] with DI water"). In his deposition, Dr. Rozzell admitted that there would be no expectation that breaking down the components of a fingerprint stain into smaller molecules with lipase would necessarily make the stain less visible. Ex. 2017 at 59:22-60:12; *cf.* Inst. Dec. 5-6 (construing the phrase "facilitating the removal of a fingerprint by vaporization" in claim 1 to require a reduction in "visually apparent" bioorganic material). Wang does not suggest, never mind teach, the methods of the '618 patent.

II. Petitioner's Belated Evidence Does Not Establish That Buchanan Was "Publicly Accessible."

The Institution Decision noted that Petitioner's case hinges on the testimony of Dr. Rozzell. Inst. Dec. 7-8, 16-17, 23-24. The only support *he* offers for his assertions regarding the alleged obviousness of using lipase in a method of facilitating the removal of fingerprints by vaporization is the Buchanan paper. *See* Ex. 1010 ¶¶ 32-34, 40-41. Because the reply evidence belatedly submitted by Petitioner does not show that Buchanan was in fact "publicly accessible" before the '618 patent's priority date, Dr. Rozzell's testimony (already described in the Institution Decision as "border[ing] on conclusory") should be given no weight.

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A reference is "publicly accessible" if it has been "[1] disseminated or [2] otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014). Petitioner has not shown that Buchanan was ever "disseminated" to persons in the relevant field—*i.e.*, bioactive materials scientists. While the Pepper declaration (cited at page 25 of the Reply) asserts that Buchanan appeared in the "Proceedings"[1] of a conference sponsored by the Society of Photo-Optical Instrumentation Engineers and entitled "Forensic Evidence Analysis and Crime Scene Investigation," *see* Ex. 1023 at 1, the target audience for this conference would have been forensic scientists (as its name plainly suggests). Petitioner's own expert Eric Ray (a trained forensic scientist) admits that such persons do not qualify as POSITAs in the field of the '618 patent. Ex. 2018 at 9:8-10:6 (Mr. Ray testifying that he "would not consider [himself] to be a POSITA . . . because of [his] lack of experience in lipase-coated surfaces"). Because the target audience of the conference did not include persons in the relevant field, the fact that the Buchanan paper might have been presented there does not establish its "public accessibility." *See Coalition for Affordable Drugs VIII, LLC v. The Trustees of The Univ. of Pa.*, IPR2015-01835, Paper 56 at

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[1] A conference proceeding is a collection of research papers presented at a conference. *See, e.g.*, http://libguides.gatech.edu/confproc.

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19 (Mar. 6, 2017) (a slide set presented at an investor day was not sufficiently disseminated because there was no evidence that "the target audience would have been an ordinary artisan in the relevant field").

Not only is there no evidence that Buchanan was ever "disseminated" to the relevant POSITAs, but there is also no evidence that it was "otherwise made available" to an extent that a reasonably diligent POSITA could locate it. For example, the record lacks any evidence that a copy of the conference proceedings in which Buchanan allegedly appeared was received and catalogued by any library or online database prior to the relevant date. *Cf. Marvell Semiconductor, Inc., v. Intellectual Ventures I LLC*, IPR2014-00553, Paper 57 at 7-9 (Nov. 30, 2015) (finding that a conference proceedings paper was "publicly accessible" where the petitioner provided a declaration from a university librarian with knowledge of the library's "normal practices for recording the receipt of and cataloging and shelving of conference proceedings" as well as the catalog record for the paper). The fact that Buchanan was apparently referenced in a handful of other forensics papers, *see* Reply 25; Ex. 1018 ¶¶ 47-53, does not prove that it was sufficiently available to the relevant research community; at most, this suggests that the paper might have been circulated among forensic scientists and crime scene investigators.

III. The Ray Declaration Does Not Bolster Petitioner's Case.

With its Reply, Petitioner has introduced a declaration from a brand new

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