UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLYMPUS CORPORATION, OLYMPUS CORPORATION OF THE AMERICAS, and OLYMPUS AMERICA INC., Petitioners,

v.

MAXELL LTD., Patent Owner.

Case: IPR2018-00904

U.S. Patent No. 8,339,493

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,339,493

Mail Stop Patent Board Patent Trial and Appeal Board U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450



TABLE OF CONTENTS

I.	INT	RODUCTION	age 1		
II.	BACKGROUND				
11.					
	A.				
	B.	Overview of the '493 Patent Invention and Claims	4		
	C.	Summary of the Proposed Grounds of Unpatentability and the References Cited	7		
III.	CLA	AIM CONSTRUCTION	8		
IV.	THE BOARD SHOULD REJECT THIS SERIAL ATTACK ON THE '493 PATENT PURSUANT TO 35 U.S.C. § 314(A)10				
	A.	Factor 1: "whether the same petitioner previously filed a petition directed to the same claims of the same patent"	13		
	В.	Factor 2: "whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it"	14		
	C.	Factor 3: "whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition"	15		
	D.	Factor 4: "the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition"	18		
	E.	Factor 5: "whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent"	18		
	F.	Factor 6: "the finite resources of the Board"	19		
	G.	Factor 7: "the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review"	20		
V.	THE PETITION ALSO FAILS ON THE MERITS21				
	A.	The Level of Ordinary Skill in the Art			



	B.	The S	Scope and Content of the Prior Art	24
	C.	The Differences Between the Prior Art and the Challenged Claims		
		1.	Grounds 1 and 2: Petitioners Fail To Establish That Any Claim Is Obvious Over Misawa '482 and Misawa '607	26
		2.	Grounds 3 and 4: Petitioners Failed to Establish that Claims 1-5 Are Obvious Over Misawa '607 in View of Okino '947 and Further in View of The Knowledge of a POSITA	36
		3.	None of the Four Grounds Has a Likelihood of Succeeding Because the Petition Fails to Identify Which Claim Elements Are Missing from the Primary Reference.	39
	D.	Seco	ndary Considerations of Nonobviousness	41
VI.	DEFI	CIEN	TION SHOULD BE DENIED AS A RESULT OF CIES IN THE DECLARATION OF PETITIONER'S DEXPERT	41
	A.	Mr. Parulski's "Omnibus" Declaration Provides a Separate Basis for Denying the Petition.		
	B.		Parulski's Declaration is Unsupported and Simply Repeats anguage of the Petition	42
VII.	THE PETITION EVADES THE BOARD'S WORD LIMIT BY USING ATYPICAL, IMPROPER CITATIONS			44
VIII	CONCLUSION			



TABLE OF AUTHORITIES

Page(s)
Cases
Abiomed, Inc. v. Maquet Cardiovascular, LLC, IPR2017-02134, Paper 7 (P.T.A.B. Apr. 16, 2018)11, 13, 19, 20
ActiveVideo Networks, Inc. v. Verizon Comm's, Inc., 694 F.3d 1312 (Fed. Cir. 2012)27
Actware Sols., Inc. v. Eagle View Techs., Inc., IPR2017-00021, Paper 9 (P.T.A.B. Apr. 14, 2017)16
Am. Honda Motor Co. v. Intellectual Ventures II LLC, IPR2018-00349, Paper 9 (P.T.A.B. June 27, 2018)12, 16
Apple v. Contentguard Holdings, Inc., IPR2015-00356, Paper 9 (P.T.A.B. June 26, 2015)41, 42
Facebook, Inc. v. Sound View Innovations, LLC, IPR2017-01003, Paper 14 (P.T.A.B. Sept. 1, 2017)45
Ferring B.V. v. Watson Labs., IncFlorida, 764 F.3d 1401 (Fed. Cir. 2014)
Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19 (P.T.A.B. Sep. 6, 2017)11, 12, 17, 20
Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)21
Guangdong Alison Hi-Tech Co., Ltd. v. Aspen Aerogels, Inc., IPR2017-00152, Paper 8 (P.T.A.B. Mar. 23, 2017)27, 29, 36
Halliburton Energy Serv., Inc. v. Schlumberger Tech. Corp., IPR2017-02072, Paper 11 (P.T.A.B. April 12, 2018)32
Harmonic Inc. v. Avid Tech., Inc., 815 F.3d 1356 (Fed. Cir. 2016)11



TABLE OF AUTHORITIES (continued)

	Page(s)
Initiative for Meds., Access & Knowledge (I-MAK), Inc. v. Gilead Pharmasset LLC, IPR2018-00122, Paper 10 (P.T.A.B. May 21, 2018)	32
Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359 (Fed. Cir. 2016)	22
InTouch Techs., Inc. v. VGo Commc'ns, Inc., 751 F.3d 1327 (Fed. Cir. 2014)	22
Kinetic Techs., Inc. v. Skyworks Sols., Inc., IPR2015-00529, Paper 8 (P.T.A.B. Sep. 23, 2014)	43
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)	21, 27
LG Elecs., Inc. v. Cellular Commc'ns Equip. LLC, IPR2016-00197, Paper 7 (P.T.A.B. Apr. 29, 2016)	39, 40
LG Elecs. Inc. v. Core Wireless Licensing S.A.R.L., IPR2016-00986, Paper 12 (P.T.A.B. Aug. 22, 2016)	20
Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157 (Fed. Cir. 2006)	22
Olympus Corp. v. Maxell, Ltd., IPR2018-908, Paper 2 (P.T.A.B. June 20, 2018)	8
Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp., IPR2018-00761, Paper 15 (P.T.A.B. Sep. 5, 2018)	12
Snap-On Inc. v. Milwaukee Elec. Tool Corp., IPR2015-01242, -01243, -01244	44
St. Jude Med., LLC v. Snyders Heart Valve LLC, IPR2018-00105 -00106 -00107	44 45 46



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

