

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner

v.

BRADIUM TECHNOLOGIES LLC
Patent Owner

IPR2018-00952
U.S. Patent 9,253,239

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REPLY TO
PETITIONER'S OPPOSITION TO PATENT OWNER'S
CONTINGENT MOTION TO AMEND**

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Bradium’s motion to amend had several critical flaws any one of which should lead to denying its motion. Bradium’s reply did not cure these flaws; instead it highlighted them and introduced even more reasons to deny its motion.

I. INSUFFICIENT WRITTEN DESCRIPTION SUPPORT

Bradium must set forth support for its amendments in “the originally filed disclosure” and in the provisional application. 37 C.F.R § 42.121(b); *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00082, Paper 13, 7 (PTAB Apr. 25, 2018) (precedential). Bradium does not deny that it failed to cite the application of the ’239 Patent in its motion. Paper 48, 5-6. Remediating in the Reply is untimely and prejudicial. Unified must address these new arguments for the first time now with less time and pages than it would have in its Opposition. Thus, Bradium’s motion should be denied. Even if considered, the Reply does not meet the written description requirement as discussed below.

A. No Citations to the Original Disclosure

Bradium’s Reply merely cites to the issued patent—not the original disclosure as required. 37 CFR § 42.121(b)(1); *Western Digital Corp.*, Paper 13, 8. And the patent citations do not address most of the claim limitations. Paper 48, 7. Thus, Bradium failed 37 CFR § 42.121(b)(1) for at least these two reasons.

B. Erroneous Attempt to use Incorporation by Reference

To justify its failure to cite to the original application of the '239 Patent, Bradium incorrectly argues that “it is well established law that when a provisional application is incorporated by reference it becomes a part of the patent specification itself.” Paper 48, 5. Written description support is “[e]ssential material’ that may be incorporated by reference, but *only by way of an incorporation by reference to a U.S. patent or a U.S. patent application publication.*” 37 C.F.R § 1.57(d) (emphasis added); *see also Droplets Inc. v. E*TRADE Bank*, 887 F.3d 1309, 1318-1319 (Fed. Cir. 2018). A provisional application is neither a U.S. patent nor a U.S. patent application publication and, thus, cannot be incorporated by reference for the purposes of providing “essential material” satisfying § 112. *See, e.g.*, 37 C.F.R § 1.57(b) (requiring an application to be amended to incorporate inadvertently omitted material from a provisional application deemed to be incorporated by reference). Bradium’s failure is without excuse.

Bradium relies on *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000); but that case merely discusses that material incorporated by reference in a prior art document may be considered in an anticipation determination—not whether such material can be used to satisfy § 112.

C. Insufficient Support in the Provisional Application

The Opposition demonstrated that the provisional application failed to support the *predetermined color or bit per pixel depth* and *factor of two* limitations (both in

proposed claim 20) and the *determining priority* (proposed claim 21) limitation. Paper 42, 4-5. Rather than contesting this, Bradium improperly turns to the specification of the '239 Patent for each of these limitations—indeed, Bradium appears to admit that the provisional application teaches away from the *determining priority* limitation. Paper 48, 7. Because Bradium seeks to obtain an earlier priority date (Paper 39, 5) but its provisional application does not support all of the elements of its amendment, its motion to amend fails 37 CFR § 42.121(b)(2). Bradium also fails 37 CFR § 42.121(b)(1) by only citing to the '239 Patent itself rather than its original application. *Supra* Section I.A.

The Opposition also demonstrated that the *displaying the second portion using the third update data parcel* (proposed claim 20) limitation was unsupported. Paper 42, 3-4. Neither Bradium nor its expert contests this. Paper 48, 6; Ex. 2059, ¶49. Bradium's only argument is that this limitation contains a "typographical error" and should be rewritten. Paper 48, 2, 6. Thus, as written, the parties agree that it is unsupported. And Bradium should not be allowed to rewrite its amendment. *Infra* Section IV.

II. IMPROPER BROADENING

Bradium does not attempt to justify its proposed claims. Paper 48, 8-9. Thus, the motion to amend should be denied. Bradium desires to substantively rewrite the claims to remediate this. *Id.*, 2, 6. That is wrong as well. *Infra* Section IV.

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