UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA, LLC
Petitioner

v.

MACNEIL IP LLC
Patent Owner

Case No. IPR2020-01139
Patent No. 8,382,186

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF CONTENTS

I. INTRODUCTION

Out of the 150+ references cited during prosecution, MacNeil cherry picks two and asserts that the Board should refuse to institute pursuant to Section 325(d). But the two references MacNeil selected were not even applied during prosecution of the '186 patent and they both lack key features of the prior art cited by Yita in the unpatentability ground. MacNeil also asserts that Yung (EX1006) does not involve thermoforming, but this is incorrect as a technical matter and only provides a factual dispute that should be resolved in favor of institution.

II. Patent Owner's Section 325(d) Argument Should be Rejected.

In determining whether discretionary denial under Section 325(d) is appropriate, the Board follows a "two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020). Under *Advanced Bionics*, here the Board should *not* exercise its discretionary denial authority.

First, the art and arguments are not the same or substantially as previously presented to the Office. MacNeil admits that both Wheaton (EX2015) and Oger

(EX2016) were not considered during prosecution of the '186 patent—they were only "considered by the Office in other, parent applications." POPR, 32. Those "other" applications also had a different examiner than the patent at issue here. EX2017; EX2018. Moreover, MacNeil's argument is based on the faulty premise that if two references share several common features, they are necessarily cumulative. For example, MacNeil identifies five features of Wheaton that are allegedly shared by Rabbe: (1) "a car floor tray for collecting snow, water, dirt and the like … in the area generally occupied by a passenger's feet," (2) the tray is "produced in a size to fit the foot well" in a vehicle, (3) the tray "includes a substantially rectangular mat panel," (4) the tray "press[es] outward against the sides of the foot wells of the vehicle," and (5) the tray provides a "waterproof cover for any underlying carpeting" that collects water and may be "removed from the automobile and dumped" for cleaning. POPR, 32-33. But these basic features are shared not just by Wheaton and Rabbe, but by myriad references in this crowded field. *See, e.g.*, EX1003, ¶51 (discussing EX1012), 53-55, 58, 62 (discussing EX1013, EX1014, EX1015, and EX1017), 64-65 (discussing EX1019 and EX1020), 66, 69, 75 (discussing EX1021, EX1023, and EX1024), 92 (discussing EX1025 and EX1026). Likewise, MacNeil claims Rabbe is cumulative of Oger (EX2016) because Oger "discloses a 'flexible floor covering for automobiles' that is 'waterproof' and 'can be readily lifted and removed from the vehicle to dump water

collected therein[.]'" POPR, 33. But again, these basic elements are common to *many* prior art references in this field.

Rabbe includes relevant teachings that are *not* found in either Wheaton or Oger. For example, neither Wheaton nor Oger disclose a floor tray including "raised edges … [that] conform to the topography of the interior and do not change the aesthetics desired by the manufacturer" or "raised edges … of unequal heights conforming to the interior contour of the vehicle." EX1005, Abstract, 2:8-10. Notably, Rabbe discloses a floor tray where "the sides…perfectly conform to the contour of the vehicle interior at the feet of the driver." *Id.*, 1:1-6. These disclosures from Rabbe relate to the claimed panels "substantially conforming to a floor of a vehicle foot well" and "closely conforming to a … foot well wall." EX1003, ¶89; *see also* ¶123. Wheaton and Oger lack these important features so they are not "substantially the same" as Rabbe. Finally, as MacNeil acknowledges (POPR, 30), Yita's unpatentability ground is not based solely on Rabbe, but includes reliance on both Gruenwald and Yung. *See, e.g.*, EX1003, ¶123. Thus, the Petitioner presents a different argument to the Office.

Second, MacNeil's Section 325(d) argument also relies on the fact that Yung (EX1006) was included in an IDS, which itself does not support denial under Section 325(d). POPR, 31; *Pure Storage, Inc. v. Realtime Data LLC*, IPR2018-00549, Paper 7, 11 (P.T.A.B. July 23, 2018. Instead, under part two of *Advanced Bionics*, and as

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