UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

_____

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Alexandria, Virginia 22313-1450

Submitted Electronically via the Patent Review Processing System

PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

Page

I. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)

A. Rabbe is cumulative of at least Wheaton and Oger.

There is nothing new in Rabbe (EX1005) that was not disclosed in Wheaton (EX2015) and Oger (EX2016). Petitioner's Reply merely shows that Rabbe is also cumulative of many other references considered during prosecution. *See* Paper 15 ("Reply"), 2. Petitioner does not dispute that Wheaton and Oger disclosed the same "basic features" as those in Rabbe. *Id.* In fact, Petitioner concedes that the features of Rabbe's floor tray relied upon in the Petition are "shared not just by Wheaton and Rabbe, but ***by myriad references in this crowded field***," including at least ***six*** other references considered by the Examiner during prosecution (Exs. 1012, 1019, 1020, 1023, 1025, and 1026). *See* Reply, 2; EX1001, Field (56) References Cited.

In deciding whether to deny institution under § 325(d), the Board considers "the similarities and material differences between the asserted art and the prior art involved during examination." *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (P.T.A.B. Dec. 15, 2017). Neither the Petition nor the Reply identifies any ***material*** difference between Rabbe and the references considered in prosecution. Petitioner alleges that Rabbe's "raised edges . . . [that] conform to the topography of the interior and do not change the aesthetics," "raised edges . . . of unequal heights conforming to the interior contour of the vehicle," and sides that "perfectly conform to the contour of the vehicle interior at the feet of the

driver" distinguish it from Wheaton and Oger. Reply, 3. But these conformance features are not unique to Rabbe and were disclosed in Wheaton and Oger.

Like Rabbe, Wheaton discloses a floor tray "produced in a size to fit the foot well[.]" EX2015, 2:1-3. The sides "press outward against the sides of the foot wells of the vehicle" and the tray is "***shaped to conform to the side and rear margins of a car floor area*** occupied by a passenger's feet." *Id.*, 3:18-25, 3:46-49. Similarly, Oger describes that "[a]t the front edges of the side parts 6 and 7 of the floor covering, higher borders or walls 12 and 14 are provided which ***slope forwardly and upwardly to lie on the foot rests of the car***." EX2016, 2:10-13. Thus, Wheaton and Oger, like Rabbe, disclosed sides or raised edges that conform to the vehicle interior.

Rabbe's disclosure that its sides "perfectly conform" to the vehicle interior does not render it materially different. As discussed, Wheaton and Oger disclosed substantially similar conformance features. Additionally, the Examiner considered many references describing floor trays that "fit your vehicle like a glove" (EX2019, 1-2), "fit perfectly" (EX2020, 2), or are "custom molded for exact fit" (EX2021, 1) and still allowed the claims. Paper 11 ("POPR"), 34-36. Tellingly, Petitioner does not address these references, let alone explain why Rabbe's disclosure is not substantially similar.

B. Yung is cumulative of Yang '667 and Yang '342

Petitioner does not dispute that Yung (EX1006) is substantially the same as

Yang '667 (EX2012) and Yang '342 (EX2013), both of which were considered during prosecution. Rather, Petitioner jumps to part two of the *Advanced Bionics* test in a belated, superficial attempt to show that the Examiner erred. But *Advanced Bionics* makes clear that "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH,* IPR2019-01469, Paper 6 at 9 (P.T.A.B. Feb. 13, 2020). Petitioner's single, conclusory assertion that "the examiner clearly erred in applying Yung" because Yung allegedly discloses hollow baffles (Reply, 4) is insufficient to demonstrate that the Office erred in a manner ***material*** to the patentability of the challenged claims. Even if Yung disclosed the claimed arrangement of baffles, Petitioner fails to address the Examiner's conclusion that the art does not show "an obvious combination of hollow baffles as recited in claim 1." EX1002, 117.

C. Wheaton, Oger, Yang '667, and Yang '342 were considered.

Under *Advanced Bionics*, previously presented art includes "art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS)[.]" *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8. Petitioner wrongly suggests that Patent Owner admitted Wheaton and Oger were not considered during prosecution. *See* Reply, 1-2. But that is incorrect. Wheaton, Oger, Yang '667, and Yang '342 were cited in an IDS, along with Office Actions applying Wheaton and Oger to

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