

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC Corporation, and
HTC America, Inc.,
Petitioners

v.

INVT SPE LLC,
Patent Owner

IPR Case No. IPR2018-01557
U.S. Patent No. 6,760,590

**PETITIONERS' REPLY TO PATENT
OWNER'S PRELIMINARY RESPONSE**

Pursuant to 37 C.F.R. § 42.108(c) and Paper 8 of this proceeding, Petitioners file this Reply in response to Patent Owner's Preliminary Response ("POPR"), pages 24-26, which alleges Petitioners have not established the public availability of the Gils reference ("Gils"). Patent Owner ("PO") is incorrect for many reasons.

First, the evidence establishing the Gils reference as 102(b) prior art is part of the record and cited in the Exhibit List, and PO does not rebut its substance.

To rely on a reference, a party need only "produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates." *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981) (citation omitted). At the institution stage, the Board looks for "only a threshold showing that an asserted reference is prior art." *GoPro Inc. v. Contour IP Holding LLC*, IPR2015-01078, Paper 59 at 6 (PTAB Feb. 16, 2017). Accordingly, "sufficient evidence, based on the current record, [need only] show a reasonable likelihood of prevailing on its asserted ground." *HTC Corp. v. Cellular Commc'ns Equip. LLC*, IPR2016-01503, Paper 7 at 16 (PTAB Feb. 13, 2017). Moreover, the Board has found citing a declaration in the List of Exhibits was adequate to insert an item on the record. *See, e.g., VigLink, Inc. v. Skimlinks, Inc.*, Nos. CBM2014-00184, CBM2014-00185, Paper 28 at 3 (PTAB Aug. 21, 2015) (finding a reference to a Declaration in the "List of Exhibits" was adequate to support the "cited" requirements in 37 C.F.R. § 42.6(c).).

Here, Petitioners submitted substantial evidence that Gils was publicly available in 1988 (Exs. 1023, 1025-1036, 1038-1041, 1043-1045), and detailed explanations of that evidence in a number of declarations (Exs. 1024, 1037, 1042). Moreover, all of the evidence and declarations were cited in the Exhibit List (Paper 1 at v-vii), which is sufficient for the Board to consider this evidence. *VigLink, Inc.* cited *supra*. PO does not debate this evidence. Thus, Petitioner's timely filed evidence surpasses the minimum threshold for institution. *HTC Corp.* cited *supra*.

Second, evidence regarding a reference's public availability is admissible post-institution. *See, e.g.*, 37 C.F.R. 42.123(a); *Apple Inc. v. Virnetx Inc.*, IPR2015-00810, Paper 21 at 2-3 (PTAB Nov. 2, 2015). Thus, even if the board found the petition as filed was deficient (which it was not), Petitioner could correct it after institution. The cases PO relies on to argue the opposite do not apply here.

For example, in *Apotex Inc. v. Celgene Corp.*, IPR2018-00685, Paper 8 (PTAB Sept. 27, 2018), petitioner asserted that a press release was published on a certain date without elaboration in the petition or a supporting declaration. *Id.* at 29-30. Similarly, in *Trane U.S., Inc. v. TAS Energy Inc.*, IPR2015-01665, Paper 12 (PTAB Feb. 4, 2016), testimony about a publication date was not given any weight because it was conclusory and no declaration or supporting evidence was provided. *Id.* at 12 n.7. Here, in stark contrast, the declarations and evidence submitted clearly explain and demonstrate how Gils was publicly available at several

international universities and libraries more than ten years before the '590 patent priority date. Thus, if doubt exists that the Gils reference was publicly available, there is no prejudice in permitting submission of such evidence post-institution.

Third, Petitioners' reliance on this evidence is not improper incorporation by reference, used to circumvent the word limit. Petitioners had over 500 words to spare in its Petition, and if needed, a mere string cite in the body of the Petition to the relevant exhibits (i.e., Exs. 1023-1045) would suffice. *C.f.* Final Rule, 77 Fed. Reg. 48,612, 48,617 (Aug. 14, 2012) (prohibiting incorporation by reference).

Nonetheless, PO unfairly seeks to take advantage of an inadvertent clerical error, as discussed in the Motion to Correct a Clerical Error filed concurrently herewith. As discussed therein, unintentional omission of the evidence listed in the Exhibit List, showing Gils is 102(b) prior art, was obvious given that the same corroborating evidence and declaration were cited in the body of the related petition for IPR2018-01556 (also relying on the Gils reference), filed the same day. Moreover, PO's ability to file a substantive POPR in this case, and its failure to argue Gils was not prior art in its POPR for IPR2018-01556, means PO will not be prejudiced if the Board considers the evidence.

For all these reasons, the Petition as filed should be instituted.

Dated: December 21, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned hereby certifies that, on December 21, 2018, a copy of the foregoing **PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** is being served in its entirety electronically on the following counsel via the email addresses listed below:

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