

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COOLER MASTER CO., LTD.,
Petitioner,

v.

AAVID THERMALLOY LLC,
Patent Owner.

Case IPR2019-00147
Patent 7,100,680

PATENT OWNER PRELIMINARY RESPONSE

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Exhibit 2001 - World Intellectual Property Organization, *Handbook on Industrial Property Information and Documentation*, “Recommendation Concerning Bibliographic Data on and Relating to Patents and SPCS,” Standard ST.9, June 2013. Retrieved from <https://www.wipo.int/export/sites/www/standards/en/pdf/03-09-01.pdf>.

I. INTRODUCTION

Patent Owner Aavid Thermalloy LLC (“Aavid”) submits this preliminary response to the Corrected Petition (Paper 3) by Cooler Master Co., Ltd.

(“Petitioner”) requesting *inter partes* review (“IPR”) and cancellation of claims 1-3 (“the challenged claims”) of U.S. Patent No. 7,100,680 (“’680 patent,” Ex. 1001).

The Board should deny the Petition and decline to institute IPR of the ’680 patent because Petitioner has failed to establish a reasonable likelihood that it will prevail with respect to any of the challenged claims. Petitioner’s primary cited reference, Nakamura (Ex. 1004), which is common to all of its grounds for challenging patentability, is not prior art because it is not a “patent or printed publication.”

II. NAKAMURA IS NOT PRIOR ART

A petition for *inter partes* review can request cancellation of patent claims “only on a ground that could be raised under §102 or §103 on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). The Petitioner submits two grounds for challenging the validity of claims 1-3 of the ’680 Patent, both of which rely on Nakamura (Ex. 1004), either alone or in combination with Takahashi (Ex. 1005) and Yamamoto (Ex. 1024).

Petitioner, however, fails to present evidence that Nakamura was a “patent or printed publication” prior to the invention of the ’680 patent, not to mention

more than one year prior to the '680 patent's May 12, 1999 priority date. In fact, based on the evidence presented, Nakamura is neither a patent nor a printed publication. The Petition therefore should be denied, as it fails to establish a reasonable likelihood that Petitioner will prevail in these proceedings.

A. Legal Background

A petitioner for *inter partes* review bears the burden of presenting evidence sufficient to establish the existence of prior art that renders a claim unpatentable. *Apotex Inc. v. Celgene Corp.*, No. IPR2018-00685, Paper 8, at 27, 2018 Pat. App. LEXIS 8795, at *36 (P.T.A.B. Sept. 27, 2018) (citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015)). This requires “a threshold showing that the reference relied upon was publicly accessible as a printed publication prior to the effective filing date of a challenged patent.” *Id.* at 27-28 (citations omitted). In this regard, the Federal Circuit has consistently held that a reference will be considered publicly accessible if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence[] can locate it.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

“Public accessibility” requires more than mere technical accessibility. *Activision Blizzard, Inc. v. Acceleration Bay, LLC*, No. IPR2015-01951, Paper 107, at 13 (P.T.A.B. Mar. 23, 2017). The party that “wishes to characterize the information, in whatever form it may be, as a ‘printed publication’ should 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 and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981) (citing *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elecs. Indus., Inc.*, 450 F.2d 1164, 1171 (3d Cir. 1971)).

Whether foreign patent applications qualify as prior art has long been evaluated on a case-by-case basis, but courts have consistently looked for indicators that a document would have been identifiable or locatable through a reasonably diligent search. Such indicators include the manner in which the document was made available to the public, and whether the document was properly classified, indexed, and abstracted. As the Federal Circuit’s predecessor explained in *Wyer*:

[T]he question to be examined under § 102(b) is the accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded. Access involves such factual inquiries as classification and indexing. In other words, such a reference is a “printed publication” and a bar to

patentability upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.

655 F.2d at 226 (quotations omitted).

In *Wyer*, the Court acknowledged a long line of cases “holding that a foreign patent application laid open for public inspection is not a printed publication” but concluded the foreign patent application at issue was publicly accessible in light of the extensive evidence presented by the appellee. *Id.* at 226-27. The party relying on the prior art document (an Australian patent application) produced detailed evidence that the document had been classified, and that equipment was made available to the public at the Australian Patent Office and its sub-offices for reproducing diazo copies of the application on an enlarged screen and for producing enlarged paper copies for purchase by the public. *Id.* at 226.

Importantly, the Court emphasized there was no genuine dispute that the application had been properly classified, indexed, and abstracted, ultimately concluding that the evidence supported a finding that the Australian application was sufficiently accessible to the public and persons skilled in the pertinent art to qualify as a “printed publication.” *Id.*

As later acknowledged by the Federal Circuit, “[t]he existence of a published abstract that would have allowed one skilled in the art exercising reasonable diligence to locate the foreign patent application and the fact that the application was classified and indexed in the patent office[] were central to the *Wyer* court’s conclusion that the application was ‘publicly accessible.’”

Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1379 (Fed. Cir. 2006).

Being indexed in a meaningful way offers assurance that an ordinarily skilled artisan, exercising reasonable diligence, will be able to locate a particular reference. *Blue Calypso*, 815 F.3d at 1349.

Indeed, in *Bruckelmyer*, the Federal Circuit reiterated the importance of a research aid like indexing to enable a skilled artisan to find the relevant document. 445 F.3d at 1378-79. There, two figures had been cancelled from a Canadian patent application prior to its issuance as a published patent, but the figures remained in the original application file wrapper. *Id.* at 1376. The Court did not rely on the mere fact that the application had been “laid open” for inspection by the general public, but instead focused on whether the published patent served as a “research aid” for a person of ordinary skill in the art to find the figures in the laid open application. *Id.* at 1379. The published Canadian patent was classified, indexed, and provided reference to the laid open application, and therefore provided “the roadmap that would have allowed one skilled in the art to locate” the

underlying application that contained the figures. *Id.* Accordingly, the drawings were deemed to have been publicly accessible.

The Board has relied on the presence of INID codes as evidence that a foreign patent document was adequately indexed. *eBay Inc. v. MoneyCat Ltd.*, No. CBM2014-00091, Paper 50, at 24, 2015 Pat. App. LEXIS 12504, at *35 (P.T.A.B. Sept. 23, 2015). INID Codes (“INID” is an acronym for “Internationally agreed Numbers for Identification of (bibliographic) Data”) are standardized parenthetical numbers for identifying specific bibliographic data that are typically printed on the face of patent documents, such as filing date, date(s) of making available to the public, publication date, title, patent classification(s), field(s) of search, etc. *See* Ex. 2001. INID codes provide a means whereby the various data appearing on the first page of patent documents can be identified without knowledge of the language used and the laws applied. *See* MPEP § 901.04(III). INID Codes are “now used by most patent offices and have been applied to U.S. patents since August 4, 1970.” *Id.* In *eBay*, the Canadian patent application in question included INID codes, and therefore the Board found that the Canadian Patent Office had adequately indexed the document and determined that the document was publicly accessible. CBM2014-00091, Paper 50, at 24.

Aside from cases involving foreign patent applications like *Wyer* and *Bruckelmyer*, the Federal Circuit has consistently required similar evidence to

demonstrate public accessibility for other types of documents. In *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989), the Court rejected an argument that three student theses were “printed publications,” finding that the documents were not cataloged or indexed in a meaningful way. *Id.* at 1161. Even though the title of each thesis had been listed with the respective author’s name on cards, the only research aid for finding each document was based on the student’s name, which bore no relationship to the subject of the respective thesis. *Id.* Without a meaningful indexing system, the documents were not reasonably accessible and therefore could not be considered printed publications. *Id.*

The unifying principle running through each of these cases is that demonstrating “public accessibility” requires some evidence of a meaningful system that would have enabled a skilled artisan to locate and retrieve the document employing reasonable diligence. And it is not enough simply to demonstrate that a document is publicly accessible today—the evidence in the petition must show that the document was publicly accessible *before* the invention of the patent or its critical date. The Board’s past decisions further illustrate this requirement.

In *Coalition for Affordable Drugs IV LLC v. Pharmacyclics, Inc.*, No. IPR2015-01076, Paper 33 (P.T.A.B. Oct. 19, 2015), for example, the Board denied institution of IPR because the petitioner had not met its initial burden of production

to show that the document in question was a printed publication. *Id.* at 6. The petitioner asserted that the patent owner had published the document in question more than one year before the earliest filing date, but offered no evidence to show that it was publicly accessible. *Id.* at 6-7. The Board rejected petitioner’s reliance on conclusory statements by the petitioner’s expert that the document was prior art because the expert did not attest to any personal knowledge of public accessibility or dissemination of the document. *Id.* at 7. Even though the document itself noted that it had been “updated” prior to the earliest filing date, the petitioner failed to explain how that date related to the asserted date of publication or offer evidence of publication practices that would explain how the information would have been disseminated or made available to the public. *Id.* at 7-8. The Board concluded that “[w]ithout such information, there is no support for a conclusion that [the document] was publicly accessible” before the earliest filing date. *Id.* at 8.¹

Similarly, in *Sandoz Inc. v. AbbVie Biotechnology Ltd.*, No. IPR2018-00002, Paper 13, 2018 Pat. App. LEXIS 5868 (P.T.A.B. May 3, 2018), the Board

¹ Also, in at least one other case, the Board dismissed dates on the face of an exhibit and indications of availability as inadmissible hearsay when those dates were offered for the truth of that information. *See ServiceNow Inc. v. Hewlett-Packard Co.*, No. IPR2015-00707, Paper 12 at 16-17 (P.T.A.B. Aug. 26, 2015).

criticized the petitioner for “merely assert[ing], without further elaboration, that [a] drug product was approved in December 2002 and that [the product’s 2002 and 2003 labels] are ‘prior art FDA approved label[s].’” *Id.* at 9. The Board went on to explain:

Petitioner also does not direct us to any source-identifying information from the FDA (*e.g.*, a copy of the labels on the FDA's website), a publication date, or other indicia indicating when Humira 2002 Label or Humira 2003 Label became publicly available. **Nor does the Petition include or cite to information related to how one might have obtained a copy of Humira 2002 Label or Humira 2003 Label, or whether the labels were generally accessible during the relevant timeframe such that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence could have located them.** *Kyocera*, 545 F.3d at 1350. Such evidence could include in this case, for example, testimony from a person interested in the art explaining how one could have located the labels by searching the FDA's website; or evidence of indexing on the internet such that a search “using any combination of search words, would have led to the [labels] appearing in the search results,” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349 (Fed. Cir. 2016).

Id. at 10 (emphasis added). Without sufficient evidence in the petition to show the labels were either disseminated or otherwise locatable by the public interested in

the art, the Board held that the petitioner failed to meet its burden and denied institution. *Id.* at 13, 14.²

B. Nakamura Is Not A Patent Or Printed Publication

In the present case, Nakamura is alleged to be an unexamined Japanese Utility model application. Ex. 1004. Nakamura is not a “patent,” nor does it qualify as a prior art “printed publication.” Indeed, Petitioner has failed to submit *any evidence* that Nakamura was publicly accessible before the May 12, 1999 priority date.

It is apparent from a review of Nakamura itself that the reference does not qualify as prior art. First, unlike the foreign patent applications in *Wyer* and *Bruckelmyer*, Nakamura does not include an abstract. *See* Ex. 1004. In addition, nothing in the Nakamura reference itself or the other information in the record suggests that Nakamura was classified, particularly before the ’680 patent’s effective filing date of May 12, 1999. *See id.* The lack of any classification is strikingly different from the other references identified by the Petitioner such as

² The Board in *Sandoz* also denied the petitioner’s request to file a reply to arguments in patent owner’s Preliminary Response that certain asserted references were not publicly available. *Sandoz Inc. v. AbbVie Biotechnology Ltd.*, No. IPR2018-00002, Paper 11 at 3-4 (P.T.A.B. Mar. 6, 2018).

Takahashi (Ex. 1005) and Morikawa (Ex. 1023), the latter of which is alleged to be a Japanese patent application filed the same year as Nakamura.³ Each of these other references at least contains ascertainable classification codes on its face. *Compare* Ex. 1004 with Ex. 1005 at 1, INID Code 51, and Ex. 1023 at 1, INID Code 51.

Moreover, like the documents cited in *Cronyn*, and unlike the foreign patent applications in *Wyer*, *Bruckelmyer*, and *eBay*, Nakamura includes no indication that it was indexed in a meaningful way. *See* Ex. 1004. Nakamura also does not include INID codes, in contrast to the foreign patent application in *eBay*. *Compare* Ex. 1004 with Ex. 1005 at 1 and Ex. 1023 at 1. INID codes have been used for decades by many patent offices throughout the world, including the Japanese Patent Office—even Morikawa includes INID codes, and it was allegedly filed the *same year* as Nakamura. *Compare* Ex. 1004 at 1 with Ex. 1023 at 1. If Nakamura had been published, the publication date (among other data) would be provided on the first page of the document, and identified with the appropriate INID code(s). Yet, Nakamura has no INID codes to identify any relevant bibliographic data,

³ Although Morikawa was submitted by Petitioner as an exhibit, it is not relied on with respect to any grounds for challenging the claims in the present Petition.

further indicating that Nakamura was not indexed in any meaningful way that would have permitted the document to be found after a reasonably diligent search.

Petitioner fails to provide any evidence that would suggest that a person of ordinary skill in the art would have been able to locate and retrieve Nakamura prior to the May 12, 1999 priority date. In contrast to the party in *Wyer* that submitted detailed evidence of the availability of special equipment for viewing and even making copies of the Australian patent application, Petitioner has submitted no evidence whatsoever of any actual dissemination of Nakamura, or any means by which Nakamura might have been accessed by interested members of the public. There also is no evidence that Nakamura was abstracted, classified, and indexed, unlike the document in *Wyer*. And unlike *Bruckelmyer*, there is no evidence that a corresponding utility model was granted, indexed, and classified such that it might have aided a researcher in finding Nakamura. In fact, there is no evidence of anything in Nakamura or elsewhere in the record that would have enabled a skilled artisan to locate and retrieve the document employing reasonable diligence prior to May 12, 1999.

Petitioner merely provides an unsupported statement in its Petition that “Nakamura is a ‘Japanese Unexamined Utility Model Application Publication in the Year 1975’ that was filed on September 18, 1973 and published in 1975. It thus qualifies as prior art under 35 U.S.C. § 102(b).” Corrected Petition at 33; *see*

also id. at v (description of Ex. 1004). This conclusory assertion is not evidence and is not supported by the Nakamura reference or any other information in the record. In fact, the text “Publication in the Year 1975” that is quoted in the Petition does not appear anywhere in Nakamura or in Petitioner’s English translation of Nakamura. *See* Ex. 1004. Petitioner’s lack of citation to the record is telling. *See* Corrected Petition at 33.

Furthermore, while Petitioner’s English translation of Nakamura adds a parenthetical “(1975)” after “S50-55262,” no such parenthetical is included in the original document. *Compare* Ex. 1004 at 1 *with id.* at 13. And Petitioner’s translator provides no explanation of the basis for inserting the parenthetical. *See* Ex. 1004 at 1-12. Instead, Petitioner’s translator simply states that he “translated ‘Japanese Unexamined Utility Model Application Publication S50-55262 (1975)’ and that this translation is a true and accurate translation from Japanese to English.” *See* Ex. 1004 at 12. Petitioner’s translator does not even set forth a basis from which to conclude that he is qualified to provide such a translation. *See* Ex. 1004 at 12.

Meanwhile, Petitioner’s technical expert, Dr. Himanshu Pokharna, simply states that he “[has] been informed that Nakamura is a ‘Japanese Unexamined Utility Model Application Publication’ that was filed on September 18, 1973 and published in 1975.” Ex. 1002 at ¶ 52; *see also id.* at ¶ 18 *and id.* at p. 4

(description of Ex. 1004). Dr. Pokharna does not attest to any personal knowledge of the dissemination or public availability of Nakamura, and therefore does nothing to evidence the alleged year of publication. *See Coalition for Affordable Drugs*, No. IPR2015-01076, Paper 33 at 7.

In sum, Nakamura is not prior art. It does not include an abstract, does not identify any classification, has no indexing, and does not identify any date prior to May 12, 1999 on which Nakamura was available to and locatable by the public. *See Ex. 1004*. And as with the documents discussed in *Coalition for Affordable Drugs* and *Sandoz*, Petitioner fails to present any evidence that might otherwise suggest that Nakamura was publicly accessible. Since all of the grounds for challenging claims 1-3 of the '680 patent are based on Nakamura, the Board should deny the Petition.

III. CONCLUSION

The Board should deny the Petition and decline to institute IPR of the '680 patent because Petitioner has failed to establish a reasonable likelihood that it will prevail with respect to any of the challenged claims. Nakamura is not prior art, and Petitioner has failed to present any evidence to the contrary.

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE
UNDER 37 C.F.R. § 42.24(d)**

The undersigned hereby certifies under 37 C.F.R. § 42.24(d) that the foregoing document complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(1)(i). The Response contains 3,514 words, as calculated by Microsoft Word, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a copy of the foregoing document was served by electronic mail upon the following:

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