

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WILLIAM HILL U.S. HOLDCO, INC. AND
BRANDYWINE BOOKMAKING LLC
Petitioners

v.

CG TECHNOLOGY DEVELOPMENT, LLC,
Patent Owner

Case No. IPR2019-00319
Patent No. 9,240,098

Patent Owner's Surreply in Support of Its Preliminary Response

I. Introduction

Petitioner failed to address in its Petition that Bradford '333—the continuation child of the cited Bradford '928 reference—was substantively analyzed in a PCT opinion considered by the Examiner, in the same prior art combination that it applies here. Realizing its omission is potentially fatal, Petitioner sought to file a Reply to Patent Owner's Preliminary Response. It now argues that Patent Owner's argument under 35 U.S.C. § 325(d) should fail because the disclosures of the two Bradford references are different. That contention, which forms the basis for its analysis of the *Becton Dickinson* factors, is plainly wrong.

One need not look any further than Petitioner's own Reply exhibit to see that the parent-child disclosures are identical. Indeed, it is patent-law-101 that “a continuation application is based solely on the disclosure of a parent application” and, by definition, “adds no new matter.” *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1579 (Fed. Cir. 1996) (Mayer, J., concurring). Petitioner's belated arguments are unsupported and cannot change the fact that its Petition relied on “the same prior art or arguments” previously “presented to the Office.” 35 U.S.C. § 325(d).

II. The Disclosures of Bradford '928 and Bradford '333 Are Identical

Petitioner argues that Bradford '928 is “materially different and non-cumulative of Bradford '333.” Reply, 2. But Petitioner cannot explain why, and that

is because basic patent law holds that “continuations are based on the same disclosure” as their parent and “continuations can claim no new invention not already supported in the earlier issued patents.” *Gen. Protecht Grp., Inc. v. Leviton Mfg. Co.*, 651 F.3d 1355, 1361 (Fed. Cir. 2011); *see also Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 555 (Fed. Cir. 1994) (same). The cited Bradford ’928 reference does not contain any disclosure that was not already disclosed to and considered by the Patent Office in Bradford ’333 because they definitionally disclose the same information.

Petitioner does not dispute that the written specification and figures, i.e., the disclosures, in the two Bradford references are identical. Indeed, Petitioner’s exhibit does not show different disclosures, but instead demonstrates their sameness, with three-dozen pages of verbatim specification shared between them. Ex. 1005 at 13-49. This common specification teaches precisely the same invention using the same words. *See Lizardtech, Inc. v. Earth Res. Mapping, Inc.*, 433 F.3d 1373, 1378 (Fed. Cir. 2006) (“every specification describes and defines the same thing, a single invention”). If it did not, Bradford ’333 would not qualify as a continuation.

That the *claims* of Bradford ’928 vary from Bradford ’333 is irrelevant for purposes of analyzing prior art disclosure: “a ‘continuation’ application *claims the same invention claimed in an earlier application*, although there may be some variation in the scope of the subject matter claimed.” *Transco*, 38 F.3d at 555

(emphasis added). Stated differently, a continuation “is akin to an amendment of a pending application” and presents claims to the same single invention disclosed in the earlier-filed parent application. *Applied Materials*, 98 F.3d at 1579.

Further, “[t]he specification must teach and enable all the claims.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1325 (Fed. Cir. 2005) (en banc). That is, the claims that Petitioner argues “renders Bradford ’928 materially different” from Bradford ’333, Reply, 2, must have been fully enabled and described by the same specification already reviewed during examination. *See Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999) (“The scope of the claims must be less than or equal to the scope of the enablement. The scope of enablement, in turn, is that which is disclosed in the specification”). At most, the claims of Bradford ’928 “teach no more than what a reasonable examiner would consider to be taught by the [specification] already before the PTO,” which is cumulative art. *Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997).

Accordingly, Petitioner is wrong that the complete disclosure of Bradford ’928 was not already considered by the Patent Office. The PCT written opinion asserting lack of inventive step based on the same combination of Bradford and Parrott that Petitioner applies here shows that “the same prior art or arguments . . . were presented to the Office” in the same combination. 35 U.S.C. § 325(d). Petitioner’s application of the *Becton Dickinson* factors is thus premised

on arguments lacking legal or factual support. As in *Exocad GmbH v. 3Shape A/S*, which involved a petition reciting a prior art combination already considered by an examiner via a PCT opinion, Petitioner “provides no explanation as to how the obviousness ground based on [Bradford] and [Parrott] now presented . . . somehow differs from the combination . . . previously considered by the Patent Office.” IPR2018-00785, Paper 8 at 15 (P.T.A.B. Oct. 3, 2018).

III. Petitioner Speculates that the Examiner Erred

As a back-up position, Petitioner presents a wholly unsupported theory that the “Examiner more likely than not erred” in reviewing Bradford’s disclosure. Reply, 5. This speculative argument does not pass the red-face test. Petitioner fails to provide any explanation for why this Board should expend resources on reevaluating the same rejection set forth in a PCT opinion, which the same Examiner identified *multiple times* as being considered during prosecution. Petitioner does not cite any reason—because there is none—to assume that an experienced Examiner failed to do his job when he signed his name as fully considering the arguments in the PCT opinion and had every incentive to do so. *See* POPR, pp. 6, 12-14. And, contrary to Petitioner’s assertion, Reply, 3 n.2, there is every indication that the Examiner evaluated both Bradford ’333 and Parrott *after* the pre-appeal brief conference decision. *E.g.*, Ex. 2001, pp. 39-41, S44-50 (showing the Examiner specifically searched for Bradford ’333 and Parrott after the decision).

Here, “the Examiner was aware of the contents of [Bradford and Parrott]” and the Board has been “shown no reason sufficient to reevaluate [Bradford and Parrott] with respect to any of the challenged claims.” *Juniper Networks, Inc. v. Mobile Telecomm. Techs., Inc.*, IPR2017-00642, Paper 24 at 13 (P.T.A.B. July 27, 2017); *see also Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10 at 12 (P.T.A.B. Dec. 14, 2016). Petitioner “does not direct [the Board] to differences between the content of the reference cited in the foreign search report” or provide any compelling rationale to speculate that the same Examiner misapprehended a PCT written opinion applying the same combination of prior art that Petitioner relies on here. *Exocad*, IPR2018-00785, Paper 8 at 14.

Petitioner’s new, but unsupported, argument could have been raised in the Petition, but was not, and was only raised for the first time in its Reply. *See* Trial Practice Guide, p. 14. To institute review based upon such an argument would subvert the purpose of 35 U.S.C § 325(d), which is to “prevent parties from mounting attacks on patents that raise issues that are substantially the same as issues that were *already before the Office* with respect to the patent.” 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (emphasis added). The Board should consider the “interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.” *Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 8 at 7, (P.T.A.B. Apr. 3, 2017).

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Respectfully submitted,

Dated: April 3, 2019

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Surreply in Support of Its Preliminary Response was served on April 3, 2019, via e-mail directed to counsel of record for the Petitioners at the following:

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