UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOX Factory, Inc.,
Petitioner,

v.

SRAM, LLC,
Patent Owner.

Case IPR2017-00118
U.S. Patent No. 9,182,027

PETITIONER'S RESPONSE TO PATENT OWNER'S OPENING BRIEF ON REMAND

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I. Introduction

The Federal Circuit's remand is clear: SRAM's asserted secondary considerations evidence for its X-Sync chainring is not relevant to the Board's obviousness determination unless SRAM can meet its burden to prove the evidence is the "'*direct result* of the unique characteristics of the claimed invention,'" the combination of inboard-offset, narrow-wide teeth. *FOX Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373-74, 1378 (Fed. Cir. 2019) (emphasis added). SRAM has not and cannot meet this burden. SRAM has presented no evidence focusing on the effect, impact, or desirability of the inboard-offset, narrow-wide teeth feature of the X-Sync chainring. Nor has SRAM performed any testing to demonstrate the relative utility, significance, or specific contribution of that feature to the X-Sync's performance, as opposed to the many other chain-retention features of the X-Sync.

Instead, SRAM's evidence addresses the chain-retention abilities or "technology" of the X-Sync as a whole. But the Federal Circuit rejected that approach because the X-Sync includes many chain-retention features not claimed in the '027 patent. *FOX*, 944 F.3d at 1374-76. Accordingly, the Federal Circuit specifically required SRAM to prove "that the evidence of secondary considerations is attributable to the claimed *combination* of wide and narrow teeth with inboard . . . offset teeth, as opposed to, for example, prior art features in isolation or unclaimed features." *Id*. at 1378. SRAM has failed to meet that burden.

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