UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEINEKEN N.V.,
Petitioner
v.

ANHEUSER-BUSCH INBEV S.A.
Patent Owner.

IPR2018-01669
U.S. Patent No. 9,517,876

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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Pursuant to the Board's authorization, Petitioner submits this Reply to Patent Owner's Preliminary Response (Paper 6).

I. ARGUMENT

A. Section 325(d) Does Not Provide A Reason To Deny Institution

Patent Owner argues that institution should be denied under 35 U.S.C. § 325(d) because some of the prior art in the petition had been before the Examiner and other prior art is purportedly cumulative of art before the examiner. Patent Owner cites cases where the Board denied institution of a petition involving art that had been considered during prosecution. Paper 6 at 14-15 (citing cases). But other than arguing that the prior art is the same or cumulative, Patent Owner fails to address the factors articulated in *Becton, Dickinson & Co. v. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (Dec. 15, 2017) (informative). Those factors do not support denying institution under § 325(d).[1]

[1] None of the other cited cases supports denying the petition, because those cases involved the same arguments as before the Examiner. *Neil Ziegman, N.P.Z., Inc. v. Stephens*, IPR2015-01860, Paper 11 at 13 (Feb. 24, 2016) ("The same primary reference asserted by the Petitioner was previously presented to, and considered by, the Office in the same substantive manner as advocated for by Petitioner."); *Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10 at 12 (Dec. 14, 2016) ("[T]he Petition relies on the same or substantially the same prior art and arguments presented previously to the Office."); *Nu Mark LLC v. Fontem Holdings 1, B.V.*, IPR2016-01309, Paper 11 at 12 (Dec. 15, 2016) (finding "the instant Petition raises the same or substantially the same prior art and arguments as those previously presented to the Office"); *Merial, Inc. v. Intervet Int'l B.V.*, IPR2018-00919, Paper 13 at 17 (Oct. 22, 2018) ("We see no substantive difference between the Examiner's findings during prosecution and Petitioner's arguments here.").

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First, the fact that the Butterworth prior art reference was considered by the Examiner is a reason to grant this petition, not deny it. In the prosecution of the '876 patent's parent application, the examiner *repeatedly* rejected the pending claims based on Butterworth and *repeatedly* found Patent Owner's arguments insufficient to overcome those rejections. Ex.1004 (232-34, 313-19, 363-71). Patent Owner was only able to overcome the Examiner's rejections based on Butterworth by submitting a declaration from Daniel Peirsman, a named inventor, in which he represented that the relevant disclosure of Butterworth was not enabled and therefore could not be relied on as prior art. Ex.1004 (470-96). Based on that declaration, and Patent Owner's accompanying arguments, the Examiner withdrew the rejection. Patent Owner continued to rely on the Peirsman declaration in the prosecution of the '876 patent. Ex.1003 (232).

But the Peirsman declaration was misleading, contained materially false statements, and failed to provide the Examiner with contrary evidence which shows that Butterworth was enabled and that Mr. Peirsman's representations lacked support. Without this contrary evidence (now before the Board), and because of the *ex parte* nature of prosecution, the Examiner had no way to know of (or evaluate) the falsities of these statements. This petition provides that additional information the Examiner lacked. Accompanying the petition is a declaration from Dr. Maureen Reitman, who explains in detail why the declaration's statements are factually

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