UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

SONY INTERACTIVE ENTERTAINMENT LLC

Petitioner

v.

BOT M8, LLC
Patent Owner

_____

Case No. IPR2020-01288
U.S. Patent No. 7,664,988

_____

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE ADDRESSING ISSUES RELATED TO 35 U.S.C. § 325 (d)**

Table of Contents

I.   REPLY REGARDING 35 U.S.C. § 325(d)

The Board should not exercise its discretion to deny institution under § 325(d). Neither part of the two-part framework established in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) is satisfied.

A.   The Art and Arguments Are Not the Same or Substantially the Same as Those Previously Presented to the Office.

The Petition asserts Grounds 2, 4, 6, and 8 for every Challenged Claim based on *Morrow* and *Morrow '771*. These Grounds are entirely unrelated to the § 325(d) arguments based on *Sugiyama* presented by PO, and are reason alone for the Board to not exercise its discretion to deny institution under § 325(d).

Sugiyama (Ex. 1005) was cited on an IDS and submitted with <u>only</u> an English abstract and <u>without</u> an English-language translation of the Japanese reference itself. Ex. 1002 at 62, 73-80. *Sugiyama* was never discussed or used as a basis for rejection of the '988 Patent or the '670 Child Patent. MPEP § 609.04(a) indicates that the Examiner will consider a Japanese reference only "insofar as it is understood on its face." Only the abstract of *Sugiyama* was submitted in English, and it therefore is the only portion of *Sugiyama* that was understood on its face.[1]

---

[1] Although certain numerals and acronyms in the Japanese drawing of Figs. 2-4 are understandable (e.g., CPU 20, HDD 24, ROM 22), each of these drawings also

PO alleges that Ex. 2007, a European Search Report mentioning *Sugiyama*, was purportedly missing from Ex. 1002. POPR at 20-21.[2] Ex. 1002 is a complete and accurate copy of the file history that was downloaded from the USPTO's Public PAIR system. NPLs, which Ex. 2007 purports to be, are <u>not</u> available from Public Pair. *See, e.g.,* https://www.uspto.gov/ebc/pair/pair_faq_pt_general.html. Moreover, Ex. 2007 was not: 1) itself listed on any IDS; 2) initialed by the Examiner as having been considered; 3) listed as a reference having been considered by the Examiner; or 4) discussed in any office action, response, or interview. Ex. 1002. And it is not listed on the face of the '988 Patent. There is nothing in the file history to suggest the Examiner considered or evaluated Ex. 2007.

Regardless, Ex. 2007 does not support an exercise of discretion to deny institution under § 325(d). Ex. 2007 identifies ***only the abstract*** of *Sugiyama* as

_____

contains Japanese characters that are not. The Japanese drawing of Fig. 5 is predominantly Japanese characters that are not understandable on its face. Ex. 1002 at 79-80.

[2] Notably, PO did not itself provide a "complete" copy of the '988 File History. Instead, PO submitted a Non-Patent Literature ("NPL") document as Ex. 2007. PO does not state from where, how, or when it obtained the "recent[ly] discover[ed]" Ex. 2007. POPR at 21.

being particularly relevant to the claims of the foreign counterpart application. Ex.

2007 at 4. As to its relevance, the European Patent Office states only:

> The subjet[sic]-matter of claim 1 also lacks an inventive step with respect to [*Sugiyama*] for similar reasons (see [*Sugiyama*], HDD 24 containing an application program, ROM 22 containing fault processing program run by the CPU (20), it is obvious to the skilled person to have the ROM containing the system boot program and the CPU and the ROM on a mother board).

Ex. 2007 at 3. This description is coextensive with what can be understood from the

English-language abstract itself. Ex. 1002 at 72. Thus, even if the Examiner

considered Ex. 2007 (of which there is no evidence), it, like the English-language

abstract of *Sugiyama*, does not provide or suggest the important disclosures from

the translated portions of *Sugiyama* relied on in the Petition.

Specifically, the Petition overwhelmingly relies on the detailed disclosures in

Sugiyama that was provided to the Examiner only in Japanese, and therefore was not

understood on its face by the Examiner during prosecution. Taking Claim 1 of the

'988 Patent as exemplary, the Petition relies on the following portions of *Sugiyama*:

Claim Element	Portions of *Sugiyama* Cited in Petition
[1(preamble)]	[0002], [0005], [0010], [0013], Fig. 3
[1a]	[0011], [0032], [0012]-[0013], [0022]-[0028], Figs. 3, 5
[1b]	[0010], [0005]-[0006], [0011], Figs. 2, 3, Claim 1
[1c]	[0002], [0010], [0012], Figs. 2, 4
[1d]	[0023], [0001], [0013], [0030], [0022]-[0028], [0011], [0029], Abstract, Fig. 5
[1(e)]	[0023], [0030], [0022], [0013], [0025], Fig. 5

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.