

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

**PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO PRELIMINARY RESPONSE**

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The Board should deny institution of *inter partes* review because Patent Owner has satisfied the two-part framework established in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020), in its Preliminary Response. Paper 6.

Applicant Universal Entertainment Corporation (“Applicant”) complied with its duty to the Office and disclosed references cited in the “extended European Search Report” (Ex. 2007, “ESR”) for the then-pending European Patent counterpart EP 1630659. 37 C.F.R. § 1.97(e); Ex. 1002 at 61, 119–20. Patent Owner has no role or responsibility for the omission of the ESR from Petitioner’s submission of U.S. Patent No. 7,664,988’s filing history (Ex. 1002, “’988 File History”).

The submission of this ESR and the *Sugiyama* reference magnify Petitioner’s lack of diligence in developing the theories in its Petition. Courts have long considered “statements made before a foreign patent office when construing claims” as long as “they are relevant and not related to unique aspects of foreign patent [counterpart].” *E.g., Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1312 (Fed. Cir. 2014) (overruled on other grounds). Accordingly, Petitioner should have considered Patent Owner’s Response to the ESR when evaluating “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(3). This is a foreseeable issue and Petitioner did not meet this burden and fundamental requirement.

I. Petitioner Misstates and Misapplies the First Part of the *Advanced Bionics* Framework

A. The *Advanced Bionics* Framework Inquires Whether the Same Art Were “Previously Presented to the Office,” Not Whether the Office Discussed It

The first part of the two-part *Advanced Bionics* framework and the statutory language of section 325(d) both inquire whether the same prior art or arguments were “previously presented” to the Office. 35 U.S.C. § 325(d); *Advanced Bionics*, Paper 6 at 7–8. One example of “previously presented art” includes “art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS).” *Advanced Bionics*, Paper 6 at 7–8. In contrast to Petitioner’s assertions (Paper 8 at 2), the framework does not require the Office to have discussed the art. *See Husky Injection Molding Sys., Ltd. v. Plastipak Packaging, Inc.*, IPR2020-00438, Paper 23 at 12 (P.T.A.B. July 29, 2020) (finding the submission of an asserted reference and accompanying European Search Report satisfies the “same or substantially the same art” condition that was “previously presented” to the Office). The same result applies here.

As evidenced by the Electronic Acknowledgement Receipt dated January 25, 2008 (“Receipt”), Applicant submitted *Sugiyama* along with the ESR to the Office. Ex. 1002 at 61 (IDS transmittal), 62 (IDS), 73–80 (*Sugiyama*), 119–20 (Receipt). In fact, the IDS submitted to the Office expressly references the “attached Extended European Search Report.” *Id.* at 61. The Examiner then

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