

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC
Petitioner

v.

ENDRESS + HAUSER FLOWTEC AG
Patent Owner

Case No. PGR2018-00017
U.S. Patent No. 9,593,973

Before Thomas Green, *Trial Paralegal*

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop PATENT BOARD, PTAB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

	<u>Pages</u>
I. Introduction	1
II. Background.....	2
III. U.S. Patent No. 9,593,973 is Not Eligible for Post Grant Review	2
IV. Conclusion.....	8

TABLE OF AUTHORITIES

Cases

Inguran, LLC v. Premium Genetics (UK) LTD., 2015 WL 10860848 * 5,
PGR2015-00017, (PTAB 2015)..... 7

Statutes

35 U.S.C. 371(c)(2)..... 3

Rules

37 C.F.R. 1.75..... 4, 6

Other Authorities

MPEP 608.01(M)..... 4

MPEP 608.01(V) 3

PATENT OWNER'S EXHIBIT LIST

EXHIBIT	DESCRIPTION
2001	U.S. Patent 9,593,973
2002	WO 2014/102037 A1 (Publication of PCT/EP2013/074688)
2003	DE 10 2012 025 246
2004	Declaration of Michael Kirst

I. Introduction

Petitioner has challenged claims 1-56 of U.S. Patent No. 9,593,973 (hereafter “the ‘973 patent”) (Ex. 2001) (also referred to as Exhibit A). Petitioner does not dispute that the ‘973 patent properly claims priority to international patent application PCT/EP2013/074688 (Ex. 2002) (also referred to as Exhibit B), which claims priority to DE 10 2012 025 246 (Ex. 2003) (also referred to as Exhibit C) (filed December 30, 2012) and DE 10 2013 102 711 (filed March 18, 2013), where the earliest possible effective filing date of the ‘973 patent is December 30, 2012, which is before the March 16, 2013 effective date of Section 3(n)(1) of the America Invents Act. The Petitioner, however, asserts that the foreign priority date of March 18, 2013 is an admission that written description of claimed subject matter is only found after the March 16, 2013 effective date and the ‘973 patent is subject to post-grant review. The Petitioner also asserts that at least one claim of the patent application corresponding to the ‘973 patent was not disclosed in compliance with the written description and enablement requirements, and therefore (without citing any authority), the claims are subject to post-grant review.

The ‘973 patent, however, is not eligible for Post Grant Review because all of its claims have an effective filing date before March 16, 2013. Specifically, all claims of the ‘973 patent are entitled to an effective filing date of foreign priority document DE 10 2012 025 246, which has a priority date of December 30, 2012. Because the ‘973 patent is entitled to the priority date before March 16, 2013, it is not eligible for Post Grant Review and the petition must be denied.

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.