

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

EDEN PARK ILLUMINATION, INC.,  
LARSON ELECTRONICS LLC, FAR UV TECHNOLOGIES  
and USHIO AMERICA, INC.,  
Petitioners,

v.

S. EDWARD NEISTER,  
Patent Owner.

---

Case IPR2022-00381  
Patent 9,700,642

---

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

The Board should not exercise its discretion to deny institution under 35 U.S.C. § 325(d) because the two-part framework set forth in *Advanced Bionics, LLC v. MED-El Elektromedizinische Geräte GmbH* is not satisfied. IPR2019-01469, Paper 6 (Feb. 13, 2020). As an initial matter, all four prior art references in this Petition were not disclosed to the Patent Office during prosecution of the '642 Patent. And Brown-Skrobot, the primary reference of Ground 2 of the Petition, was never considered during prosecution of the '951 Patent. For these reasons alone the Board should not exercise its discretion to deny the Petition under § 325(d).

If the Board nevertheless considers the second prong of *Advanced Bionics*, the Examiner made at least two material errors that weigh against discretionary denial: (1) crediting Neister's Rule 1.131 declaration without performing a priority analysis, and (2) overlooking key disclosures in Eckhardt that render the claims of the '951 Patent (and to greater extent, the claims of the '642 Patent) unpatentable.

**I. The Examiner Erred in Allowing Claims Lacking Written Description Support in the Alleged Priority Documents.**

The Examiner only allowed the claims of the child '951 Patent after the applicant submitted a § 1.131 declaration to antedate the Ressler prior art patent under 35 U.S.C. § 102(e). EX1038 at 13. In the Petition, however, the Grounds are presented with references published more than one year prior to the effective filing date of the '642 Patent, which cannot be sworn behind. Eckhardt, for example, is a published U.S. patent application that is undisputed § 102(b) art and cannot be

antedated. *See* Pet. at 11. The Examiner of the child '951 Patent erred because she considered only U.S. Patent 6,730,113 and overlooked the earlier Eckhardt publication that is prior art under § 102(b). EX1038 at 294, 334.

The other references in the Petition were also published more than one year prior to the effective filing date and cannot be antedated. The challenged claims are not supported by the written description of the earlier provisional application (Ground 1) or the original non-provisional application (Ground 2). *See* Pet. at 3-9. “[W]hen one files an affidavit under 37 C.F.R. § 1.131 to antedate a reference,” “such a showing of possession alone does not cure the lack of a written description in the specification, as required by statute.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). The same is true of the claims of the '951 Patent that Patent Owner seeks to rely on for its § 325(d) argument. The Examiner who allowed the claims of the '951 Patent did not demonstrate that she conducted a claim-by-claim priority analysis. Because the reason for allowance over Ressler was the § 1.131 declaration, the effective filing date was not questioned and then resolved by such an analysis. Neither applicant nor Examiner ever supported the priority claim in the prosecution of the '951 Patent with citations to support in the written description of the earliest priority claims. Therefore, all the art in the Petition qualifies as § 102(b) art that cannot be antedated with a § 1.131 declaration. *See* 37 C.F.R. § 1.131(a)(2); *Application of Foster*, 343 F.2d 980, 988 (C.C.P.A. 1965).

## II. The Rule 1.131 Declaration Cannot Establish Prior Invention of the Challenged Claims.

Even if a Rule 1.131 declaration could establish priority, Neister's declaration does not support either conception or reduction to practice of the challenged claims with respect to, at minimum, using "282 nm" light (dropped to overcome a rejection during prosecution of the '951 Patent) or disinfecting human skin (Ground 1), or combining wavelengths (Ground 2). A showing of actual reduction to practice requires (1) construction of an embodiment or performance of a process that meets all the limitations of the claims at issue; (2) a determination that the invention would work for its intended purpose; and (3) sufficient evidence to corroborate inventor testimony regarding these events. *See, e.g., Medichem, S.A. v. Rolabo, S. L.*, 437 F.3d 1157, 1169 (Fed. Cir. 2006). Inventor-generated documents are not independent information and cannot corroborate inventor testimony. *Kolcraft Enters., Inc. v. Graco Children's Prods., Inc.*, 927 F.3d 1320, 1324 (Fed. Cir. 2019).

Here, the declaration consists solely of "inventor-generated documents": an undated report that Neister wrote, (EX1038 at 69-71), a single page from his lab notebook with redacted dates, (*id.* at 73), and undated photos untethered to the claims, (*id.* at 74-76). None of this corroborates that Neister conceived or practiced by any date a "process for destroying a DNA or RNA of a microorganism on a substance or on a surface ... wherein the substance or surface to be disinfected is

human or animal tissue,”<sup>1</sup> (*id.* at 51; *see also* EX1001 at claim 1), or of using 282 nm light to do so, as is required by the ’642 Patent claims. Further, Neister’s declaration provides no evidence whatsoever of disinfecting animal tissue or skin. *See Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1322, 1332-33 (Fed. Cir. 2008); *see also* Pet. at 5. Because no determination was made that the invention would actually work for its intended purpose, reduction to practice was neither shown nor corroborated, and the Examiner materially erred in allowing the claims.<sup>2</sup>

### **III. The Examiner Erred in Ignoring Key Teachings in Eckhardt.**

The ’642 Patent claims encompass limitations that were withdrawn or never claimed during prosecution of the ’951 Patent. *See* POPR at 22. Even if Petitioner’s arguments regarding Eckhardt are considered to be “substantially the same argument” before the PTO, the Examiner made a second material error in

---

<sup>1</sup> Neister only “tested lamp on back of hand” with 222 nm light and determined “no erythema marker next two days,” (EX1038 at 73), meaning he was not sunburnt, (EX1003 at ¶ 91). This is just a safety test. It did not suggest anywhere that Neister successfully disinfected skin with 222 nm (or 282 nm) light.

<sup>2</sup> Additionally, Patent Owner has made no showing that Neister exercised the necessary diligence between conception and reduction to practice. *See, e.g., ATI Techs. ULC v. Iancu*, 920 F.3d 1362, 1370 (Fed. Cir. 2019).

overlooking key teachings in Eckhardt.

Eckhardt was cited in a § 103 rejection only as a secondary reference that disclosed dependent claims for “provid[ing]/position[ing] a wand in a process for destroying a DNA or RNA of a microorganism” and disinfecting a “wound.” *See* EX1038 at 294-295, 300-301. The Examiner relied on primary reference Coogan to disclose “at least one of 282nm and 308nm” light. *Id.* at 293. The applicant then dropped all wavelengths besides 222 nm and dropped claims relating to disinfecting a wound. *Id.* at 255-265. The Examiner thus materially erred by overlooking Eckhardt’s teachings of using particular UV light sources and ranges to disinfect skin. *See* Pet. at 20, 22–23, 26-27 (citing EX1004, ¶¶ 31, 43, 69–70).

The Examiner did initially cite Eckhardt for “directing photons to a ... surface to be disinfected being human or animal tissue ... in the form of a wound,” (EX1038, 295). But months later she allowed claims on what she had found in Eckhardt, (*see id.*, 158-160, 182), contending that the new primary reference, Sizer, “does not specifically teach or suggest that the substance or surface to be disinfected is human or animal tissue,” (*id.*, 159-160). The Examiner’s findings are internally inconsistent. It is apparent from the record that Eckhardt disclosed a key limitation the Examiner relied on to find the claims patentable over Sizer. Thus, the Examiner materially erred another time. *See Advanced Bionics*, Paper 6, 8.

For at least these reasons, discretionary denial under § 325(d) is not warranted.

Respectfully submitted,

Date: June 10, 2022

/David Conrad/

David Conrad, Reg. No. 60,788  
Fish & Richardson P.C.  
3200 RBC Plaza, 60 South Sixth Street  
Minneapolis, MN 55402  
T: 202-783-5070  
F: 877-769-7945

*Attorney for Petitioner*

## CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on June 10, 2022, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

Brent P. Ray (Reg. No. 54,390)  
KING & SPALDING LLP  
110 N. Wacker Drive Suite 3800  
Chicago, IL 60606  
(312) 995-6333  
[bray@kslaw.com](mailto:bray@kslaw.com)

Abby Parsons (Reg. No. 61,473)  
KING & SPALDING LLP  
1100 Louisiana Street Suite 4100  
Houston, TX 77002  
(713) 751-3200  
[aparsons@kslaw.com](mailto:aparsons@kslaw.com)

/Crena Pacheco/  
Crena Pacheco  
Fish & Richardson P.C.  
3200 RBC Plaza, 60 South Sixth Street  
Minneapolis, MN 55402  
(617) 956-5938