

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

G+ COMMUNICATIONS, LLC,
Patent Owner.

Case IPR2023-00441
Patent 10,448,430

**PATENT OWNER'S SUR REPLY IN SUPPORT OF
PRELIMINARY RESPONSE TO PETITION**

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Patent Owner G+ Communications submits this sur-reply in support of its preliminary response as authorized by the Board in an email dated June 2, 2023.

I. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(D)

Petitioner's reply seeks an improper second bite at the apple in an attempt to fix its failure to provide sufficient explanation and citations of specific teachings of Li that were alleged to be overlooked, as noted in G+'s POPR at pages 18-20. Samsung's failure remains, as both the Petition and Reply fail to make a showing of material error, which was Samsung's burden under the circumstances of this case.

Samsung's Reply leads with the issue of Li's alleged teaching of sending a message 3 according to the UL grant allocated to the UE, but never addresses G+'s arguments as to this limitation, for example, that the Office cannot have materially erred as to the claim at issue if it did not err with respect to the "pre-set UE number" limitation, and that the Examiner's non-final rejection relied on another reference for the "UL grant" limitation so the Office cannot be shown to have materially erred by not relying on teachings in Li alleged by Samsung. *See* POPR 20-21.

As to the alleged material error on the "pre-set UE number" limitation, Samsung attempts to distract from its failures by asserting that G+ dodges the issue. Samsung ignores that it is its burden both on the substantive merits of the Petition, and on the issue of material error (given that the Examiner considered Li, as admitted by Samsung), both of which are related to the requirement under 37 C.F.R.

§ 42.104(b)(3) to identify how the challenged claim is to be construed. G+ has responded to the issues as presented in the Petition, noting Samsung's failures.

Samsung's litigation positions explain, but do not excuse, its failure to address the construction of "pre-set UE number" anywhere in its Petition, including in its 325(d) argument, which would be required to show material error. As noted in the POPR, Petitioner argued to the district court, for example, that the "pre-set UE number" limitation is indefinite, that "[a] POSITA would not understand the scope of this term with reasonable certainty," Ex. 2006 at 17, and that the "intrinsic record suggests that the term at issue *is not* an identifier," *id.* at 19, fn7. *See* POPR 36-41. These contradictions, which Samsung failed to bring to the attention of the Board at any point, evidence Samsung's deliberate avoidance of the issue in the Petition, and thus its failure to meet its burdens. In its reply, Petitioner merely emphasizes the single word "unique," without any further explanation or acknowledgement of its contradictory arguments to the district court.

Under the only interpretation of the term "pre-set UE number" that Samsung has bothered to explain, i.e., its contention to the district court that the term *is not* an identifier, Samsung's allegation of material error fails, as it relies on its argument that Li's message 3 includes "the terminal ID of MTC UE1." *See* POPR 19.

Samsung also argues in conclusory fashion that "Li and Kim have differing disclosures," Reply 2, but fails to address G+'s demonstration that Kim is

substantially the same as Li, and that any differences show it is actually less pertinent than Li, the reference considered by the Examiner. *See* POPR 21-23.

For these reasons, and those presented in G+'s POPR, the Board should deny institution under § 325(d).

II. A SINGLE *FINTIV* FACTOR SHOULD NOT BE DISPOSITIVE

In the face of G+'s strong arguments in favor of discretionary denial under § 314(a), Samsung attempts to avoid the issue by offering a belated stipulation under *Sotera* that it will not pursue an invalidity defense in the parallel district court action based on the same grounds as in this petition or any grounds that could have reasonably been raised before the PTAB, which *Sotera* noted includes “any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (precedential as to II.A) (quoting Ex. 1038). G+ contends it is improper for a single *Fintiv* “factor” such as overlap of issues to be dispositive on discretionary denial, particularly a factor entirely within control of Petitioner that may be used in bad faith by, *e.g.*, intentionally not providing the well-known stipulation until after Patent Owner has fully briefed the issue. Patent Owner urges the Board to evaluate all factors in exercising its *discretion* to deny.

IPR2023-00441 to U.S. Patent No. 10,448,430

Dated: June 16, 2023

Respectfully submitted,

/Brad Liddle/

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CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of June, 2023, a true and correct copy of the foregoing PATENT OWNER'S SUR REPLY IN SUPPORT OF PRELIMINARY RESPONSE, along with any accompanying exhibits, was served by electronic mail upon the following counsel of record for Petitioners:

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