

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2023-01157
Patent 11,405,224

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

EXHIBITS

- SAMSUNG-1001 U.S. Patent No. 11,405,224 to Raleigh, et al. (“the ’224 Patent”)
- SAMSUNG-1002 Excerpts from the Prosecution History of the ’224 Patent (“the Prosecution History”)
- SAMSUNG-1003 Declaration and Curriculum Vitae of Dr. Patrick Traynor
- SAMSUNG-1004 Complaint, *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al.*, 2:22-cv-00422, E.D. Tex., October 26, 2022
- SAMSUNG-1005 U.S. Patent Publication No. 2008/0080458 A1 (“Cole”)
- SAMSUNG-1006 U.S. Patent Publication No. 2009/0119773 A1 (“D’Amore”)
- SAMSUNG-1007 U.S. Patent Publication No. 2006/0039354 A1 (“Rao”)
- SAMSUNG-1008 U.S. Patent No. 5,987,611 (“Freund”)
- SAMSUNG-1009 U.S. Patent Publication No. 2005/0037740 A1 (“Smith”)
- SAMSUNG-1010 European Patent Publication No. 1 484 871 A1 (“Kelz”)
- SAMSUNG-1011 U.S. Patent No. US 2008/0057894 A1 (“Aleksic”)
- SAMSUNG-1012 U.S. Patent No. 7,924,730 B1 (“McAllister”)
- SAMSUNG-1013 Excerpts from the Prosecution History of U.S. Patent No. 9,277,445 to Raleigh, et al. (“the Prosecution History of the ’445 Patent”)
- SAMSUNG-1014 U.S. Patent No. 6,947,723 B1 (“Gurnani”)
- SAMSUNG-1015 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)
- SAMSUNG-1016 Samsung Stipulation letter regarding IPR grounds in District court litigation

SAMSUNG-1017 First Amended Complaint, *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al.*, 2:22-cv-00422, E.D. Tex., November 30, 2022

SAMSUNG-1018 Amended Docket Control Order, *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al.*, 2:22-cv-00422, E.D. Tex., April 21, 2023

SAMSUNG-1019 Email from Board dated November 22, 2023 authorizing Petitioner's Reply to Patent Owner's Preliminary Response

As explained in more detail below, the Board should not deny institution of the Petition under 35 U.S.C. §325(d) in these proceedings at least because: (1) the Examiner did not consider the asserted references, among the more than 1,800 references cited in IDSs during prosecution; (2) the asserted references are not cumulative to any reference applied during prosecution; and (3) none of the *Advanced Bionics* factors favor discretionary denial.

I. AN INITIALED IDS DOES NOT DEMONSTRATE SUBSTANTIVE CONSIDERATION BY THE OFFICE ON ITS OWN

The Petition presents invalidity grounds that are based on prior art references (Cole, Rao, D’Amore) that are materially different from and not cumulative of the prior art substantively considered during prosecution of the application corresponding to the ’224 Patent.

As an initial matter, it is undisputed that Cole, Rao, and D’Amore were never made available to the Office during examination, as evidenced by their absence from the ’224 Patent’s list of cited references. Petition, 5-6, 81-83; SAMSUNG-1001. Patent Owner (“Headwater”) argues that because U.S. 2008/0080457 (“’457 Pub.”) and WO 2006/012610A2 (“’610 Pub.”) are respectively in the same family as Cole and Rao, have overlapping subject matter, and were cited in an IDS, Cole and Rao should be deemed as substantively considered. Patent Owner Preliminary Response (“POPR”), 26-30. Headwater’s argument is categorically incorrect and contrary to PTAB precedent.

For example, there is abundant case law in which the Board has refused to exercise discretionary denial under §325(d) when the asserted art was merely listed in a signed IDS. *Scientific Design Co. v. Shell Oil Co.*, IPR2021-01537, Paper 7 at 24-26 (PTAB 2022) and IPR2022-00158, Paper 7 at 24-26 (PTAB 2022) (granting institution and finding that the Examiner initialing the asserted art on an IDS does not indicate substantive evaluation); *Digital Check Corp. d/b/a ST Imaging v. E-ImageData Corp.*, IPR2017-00178, Paper 6 at 12-13 (PTAB 2017) (acknowledging that a reference was cited in an IDS, but granting institution because there was no indication that the Examiner substantively discussed it during prosecution); *Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 8 at 7-9 (PTAB 2017) (refusing to deny institution based on a prior art reference that was simply cited in an IDS and not considered at any length); *Praxair Distribution, Inc. v. INO Therapeutics, LLC d/b/a Ikaria, Inc.*, IPR2015-00893, Paper 14 at 8 (PTAB 2015); *Analytics For Life, Inc. et al v. 8825319 Canada Ltd.*, IPR2017-01742, Paper 9 at 5-6 (PTAB 2018); *ABS Global, Inc. et al v. Cytonome/ST, LLC*, IPR2017-02097, Paper 11 at 37-38 (PTAB 2018).

In the present case and as noted in the Petition, the Examiner did not rely upon the '457 Pub. or '610 Pub. to formulate a prior art rejection, and there is no evidence that the Examiner ever substantively considered these references.

Petition, 81-83. Indeed, Headwater cannot produce any evidence of substantial

consideration by the Examiner because none of Cole, '457 Pub., Rao, or '610 Pub. formed part of any rejection or evaluation in the entire prosecution history. POPR, 26-30. And because no evaluation or rejection during prosecution involved Cole, '457 Pub., Rao, or '610 Pub., none of the *Advanced Bionics* factors (a)-(f) favor discretionary denial. Consequently, a petition should not be denied simply because a reference (or a family member of an asserted reference) was cited in an IDS.

To the extent consideration is given to Headwater's argument that similar subject matter as the asserted references was considered, the Examiner committed clear error by failing to issue any rejection involving the '457 Pub. and '610 Pub. (to the extent their disclosure may be considered to be similar to Cole and Rao, respectively—which Petitioner does not concede). Here, in particular, the Examiner's failure to properly consider Cole, '457 Pub., Rao, or '610 Pub. is not surprising given that *over 1,800 references* were presented to the Office via IDSs during prosecution. SAMSUNG-1002, 314-317, 329-383, 395-533.

II. D'AMORE WAS NEVER PRESENTED TO THE OFFICE AND IS NOT CUMULATIVE TO COLE

The Office did not consider D'Amore during prosecution. Petition, 5-6, 81-83; SAMSUNG-1001, Cover. As discussed in the Petition, the teachings of D'Amore would have provided a POSITA with motivations to improve the techniques of Cole and Rao. Petition, 11-17. These motivations and the resulting combination could not have been considered by the Office without D'Amore.

Indeed, Headwater fails to address how the ***combination*** of references in the petition is similar to any combination considered during prosecution. Instead, Headwater relies on the flawed assertion that Cole, Rao, D’Amore combination is not obvious (which Petitioner disagrees with). POPR, 31-43.

Headwater alleges that D’Amore is “cumulative of and substantially similar” to Cole because the Petition relied upon both D’Amore and Cole as teaching certain claim features recited in claim features [1.3] and [1.4]. POPR, 31-39. However, D’Amore supplements Cole’s disclosure at least in its description of a “service provider” for setting initial application priority levels. Petition, 11-17. Moreover, Headwater’s flawed argument fails to recognize that two references with different disclosures can both disclose a claimed feature due to the breadth of the claim language, and that such disclosure does not render two references “cumulative.” Indeed, Headwater’s flawed argument is evidenced by its reliance on select disclosure of extremely generic and well-known concepts such as webpages and VoIP, to allege that D’Amore and Cole are “substantially similar” and “cumulative.” POPR, 31-34. The reliance on such well-known concepts to establish a “cumulative” relationship between references is simply not appropriate and should be rejected. *Id.* Headwater’s analogous arguments for other limitations should similarly be rejected. POPR, 31-39.

III. D'AMORE IS NOT CUMULATIVE TO LIM

Headwater alleges that “cited disclosures from D’Amore are substantially the same as ... disclosures from the Lim reference that the Examiner discussed in the Notice of Allowance.” POPR, 31. Headwater relies upon Lim’s disclosure that the policy engine 603 can effectuate a consequence of a policy. POPR, 35, citing Ex. 2005 ¶[0262]. However, Headwater neglects to mention that Lim’s policies are used for “controlling of access to documents and usage of application data and functions,” as opposed to D’Amore’s policies for “approv[ing] or den[ying] access to a system resource ... based at least on the priority level or the privilege code.” POPR, 35; SAMSUNG-1006, ¶[0008]; Ex. 2005, ¶[0077]. Indeed, Lim’s disclosure is generally directed to “access and usage control and management of information stored in a computer environment” – a concept that is orthogonal to D’Amore’s “[m]anagement and arbitration of dedicated mobile communication resources for mobile applications.” Ex. 2005, ¶[0002]; SAMSUNG-1006, ¶[0006]. Although both references use the word “policy,” the purpose of these policies is vastly different. Ex. 2005, ¶¶[0002]-[0010], [0073], [0077], [0262]; SAMSUNG-1006, ¶¶[0006]-[0008]. Accordingly, D’Amore and Lim are not “cumulative” or “substantially similar.”

Respectfully submitted,

Dated December 6, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on December 6, 2023, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response and accompanying exhibit were provided by email to the Patent Owner by serving the correspondence address of record as follows:

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