

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 B2

PATENT OWNER'S PRELIMINARY SUR-REPLY

PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	U.S. Patent Application Publication No. 2008/0080457 to Cole (“Cole-2”)
Ex. 2002	Redline of the text of Cole (Ex. 1005) and Cole-2 (Ex. 2001)
Ex. 2003	International Publication No. WO 2006/012610 to Rao et al. (“Rao-2”)
Ex. 2004	Redline of the text of Rao (Ex. 1007) and Rao-2 (Ex. 2003)
Ex. 2005	U.S. Patent Application Publication No. 2007/0157203 to Lim (“Lim”)

I. Citation On An IDS Is Sufficient To Support Section 325(d) Denial.

Petitioner alleges “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.” Reply 2. If Petitioner is arguing citation on an IDS is insufficient for Step One of *Advanced Bionics* to be met, that is contrary to Board precedent: “***Previously presented art includes art*** made of record by the examiner, and art provided to the Office by the applicant, such as ***on an Information Disclosure Statement (IDS)***, in the prosecution history of the challenged patent.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6, 8 (2020) (precedential); see POPR 28-30 (collecting cases).

Petitioner cites no authority that supports such a position. Rather, the only post-*Advanced Bionics* case cited (Reply 2) confirms citation on an IDS is sufficient. *Scientific Design Co. v. Shell Oil. Co.*, IPR2021-01537, Paper 7, 24 (2022) (“Under the first part of the *Advanced Bionics* framework, ... the art relied upon in[] the Petition was presented to the Office in an IDS during examination”). The Board declined to deny institution in that case under the second part of the *Advanced Bionics* framework, holding “the strength of Petitioner’s challenges ... sufficiently demonstrate[d] that the Examiner erred.” *Id.*, 25. Here, the merits of the Petition are weak and there is no evidence the Examiner erred. POPR 12-24, 41-43.

The only other cases Petitioner cites all pre-date *Advanced Bionics*. Reply 2.

Reliance on pre-*Advanced Bionics* decisions for the notion that citation on an IDS is insufficient under Section 325(d) has been expressly rejected by the Board. *See, e.g., Nespresso USA, Inc. v. K-Fee Sys. GmbH*, IPR2021-01223, Paper 9, 12 (2022) (criticizing reliance on “non-precedential Board decisions, which predate *Advanced Bionics*, to argue that mere submission of a reference in an IDS is insufficient for purposes of exercising discretion to deny review under Section 325(d),” and noting “*Advanced Bionics* unambiguously instructs” to the contrary); *see* POPR 28-30.

If Petitioner is arguing Patent Owner must demonstrate “substantive consideration” by the Examiner (for either *Advanced Bionics* step), Petitioner neither explains what “substantive consideration” means, nor cites any authority in support of such a requirement. And if Petitioner is arguing the art must have been part of a rejection during prosecution (Reply 3), that argument has also been expressly rejected by the Board. *See, e.g., Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01530, Paper 14, 17 (2023) (“[T]here is no requirement that Examiner needs to rely on a reference in a rejection during prosecution in order for the reference to be ‘considered’ during prosecution.”); *see* POPR at 28-29, 42.

Finally, in relation to the second step of the *Advanced Bionics* framework, Petitioner contends “the Examiner committed clear error by failing to issue any rejection involving” Cole-2 or Rao-2, without providing any specificity on what such error was. Reply 3. The Examiner found the prior art did not teach or suggest claim

elements [1.5] and [1.6], and Petitioner still fails to identify any specific alleged mistakes the Examiner made in coming to that finding. *See* Ex. 1002 at 31; POPR, 6-7, 41-42. In fact, Petitioner ***concedes*** that no individual reference discloses these limitations. POPR, 12. And the weakness of the Petition’s obviousness theory further supports that *Advanced Bionics* Step Two is satisfied here. *See id.*, 12-24, 42-43.

II. The D’Amore Disclosures On Which The Petition Relies For Elements [1.3], [1.4], And [1.6] Are Cumulative Of Those It Relies on From Cole.

Petitioner criticizes Patent Owner for alleged “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.’” *See* Reply 4. But Patent Owner relies upon the precise D’Amore disclosures on which the Petition relies, and compares those with specific Cole disclosures on which the Petition also relies. POPR 31-36. Indeed, the Board routinely relies on a comparison of relied-upon disclosures in evaluating whether a reference is “cumulative” under Section 325(d), confirming that this approach is proper. *See, e.g., Advanced Bionics* at 15-19 (performing limitation-by-limitation cumulativeness analysis, evaluating whether the cited disclosures from references not before the Office “disclos[e] substantially the ***same information*** already considered by the Office”); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7, 10-12 (2022) (same approach). Indeed, this is to be expected, as what matters is whether the Examiner had *cumulative information* as compared with what the Petition claims to be the *relevant portions* of the cited art.

Petitioner also argues the Office did not consider its alleged motivations to combine D’Amore with Cole/Rao since D’Amore was not before the Office, and faults Patent Owner for “fail[ing] to address how the ***combination*** of references in the petition is similar to any combination considered during prosecution.” Reply 3-4. Petitioner cites no authority to support either proposition. Moreover, logic dictates that if D’Amore and Cole are substantively cumulative in relevant part, as Patent Owner showed, the Examiner would have considered the “combination” of the substance of those disclosures since he considered Cole.¹ POPR 26-30.

III. The D’Amore Disclosures On Which The Petition Relies For Elements [1.5] And [1.6] Are Cumulative of Disclosures From Lim.

The Petition alleges D’Amore’s “policy management module can ***control access to ‘device resources.’***” Pet. 48 (citing Ex. 1006 ¶¶32-33); POPR 34-36. On reply, Petitioner argues Lim’s “policy engine” is not cumulative of D’Amore’s “policy management module” because “Lim’s policies are used for ‘***controlling access to documents and usage of application data and functions,***’ as opposed to

¹ Petitioner also claims “D’Amore supplements Cole’s disclosure at least in its description of a ‘service provider’ for setting initial application priority levels.” Reply 4. Even if so, it is unclear to which claim limitation(s) this notion is relevant. If Petitioner is alleging this is a reason a POSITA would have combined Cole and D’Amore, that is irrelevant to the cumulativeness analysis, as discussed above.

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.’” Reply 5 (quoting Ex. 2005 ¶77; Ex. 1006 ¶8). Even relying on Petitioner’s selective quotations, it is apparent both references disclose applying policies to manage access to device and network resources. Both references also teach managing application authorization to access those resources. *Compare* Ex. 1006 ¶51 (D’Amore’s “policy management module” uses “privilege code[s]” that “indicate whether the application is authorized to access the resource”) *with* Ex. 2005 ¶¶79, 88, 262 (Lim’s “policy engine” uses “policy rules supplied by the policy server to ... ALLOW, DENY” access to resources “*anywhere on the network*,” such as those to “send[] an email message”); *see also id.* ¶83 (discussing “[c]ontrolling application usage” including sending of files and emails).

Petitioner also states: “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,’” and as such alleges “the purposes of [these references] policies is vastly different.” Reply 5 (quoting Ex. 2005 ¶2; Ex. 1006 ¶6). It is unclear what Petitioner contends is “orthogonal,” but if it is alleging Lim’s disclosures are not applicable to mobile communication devices, that is incorrect. *See, e.g.,* Ex. 2005 ¶264 (describing implementation of the “policy engine” and “policy enforcer” on a “*smart phone*”).

Date: December 20, 2023

Respectfully submitted,

/Amy E. Hayden/

Reza Mirzaie, Reg. No. 69,138

Marc A. Fenster, *pro hac vice* forthcoming

Dale Chang, Reg. No. 61,476

Amy E. Hayden, Reg. No. 64,817

Neil A. Rubin, Reg. No. 67,030

Philip X. Wang, Reg. No. 74,621

James A. Milkey, Reg. No. 79,503

RUSS, AUGUST & KABAT

12424 Wilshire Blvd., 12th Floor

Los Angeles, CA 90025

Counsel for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on December 20, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

W. Karl Renner (Reg. No. 41,265)
Jeremy J. Monaldo (Reg. No. 58,680)
Usman A. Khan (Reg. No. 70,439)
FISH & RICHARDSON P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
IPR39843-0163IP1@fr.com
axf-ptab@fr.com
jjm@fr.com
khan@fr.com

Date: December 20, 2023

/Amy E. Hayden/
Reza Mirzaie, Reg. No. 69,138
Marc A. Fenster, *pro hac vice* forthcoming
Dale Chang, Reg. No. 61,476
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Philip X. Wang, Reg. No. 74,621
James A. Milkey, Reg. No. 79,503
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025

Counsel for Patent Owner