

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 IPR2023-01226
Patent 10,237,773

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	Excerpts from IEEE 100: The Authoritative Dictionary of IEEE Standards Terms (7th ed. 2000)

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 7-15, 26-27.

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 18-21.

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 18-19, 26-27.

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, but without providing any specificity on what such error was. Reply 3. And the weakness of the Petition’s obviousness theory further supports

that *Advanced Bionics* Step Two is satisfied here. *See id.*, 18-19, 26-27.

II. The D’Amore Disclosures On Which The Petition Relies For Elements [1.6] and [1.7] Are Cumulative Of Those It Relies On From Cole.

Petitioner criticizes Patent Owner for allegedly “fail[ing] to meaningfully address petitioner’s combination analysis in the petition, choosing to instead to declare D’Amore ‘cumulative’ based on a select few citations.” *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 21-23. 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 cumulateness 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). This is as would 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 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. POPR 17-21.

Petitioner also alleges “D’Amore’s teachings supplement Cole to improve Cole’s device in various ways,” and “D’Amore’s teachings would have enabled, for example, ‘privilege codes’ to control user permissions, a ‘service provider’ to set priority levels, and application conflict-resolution in Cole’s system.” Reply 4. Even if so, it is unclear to which claim limitation(s) these notions are relevant. If Petitioner is alleging these are reasons a POSITA would have combined Cole and D’Amore, that is irrelevant to the cumulativeness analysis, as discussed above.

III. The Board Should Exercise Discretion To Deny Institution.

Petitioner claims “D’Amore was never presented to the office, and accordingly, any analysis under *Advanced Bionics* ... does not favor discretionary denial.” Reply 4. Petitioner thus argues *exactly the same* art must have been presented, which is plainly incorrect; the proper inquiry is “whether the *same or substantially the same art* previously was presented to the Office.” *Advanced Bionics*, 8-9 (citing 35 U.S.C. § 325(d), which presents the same standard).

Petitioner then argues “the failure to issue even a single prior art rejection

when relevant prior art references were submitted for consideration is material error, and thus factor (e) also weighs against exercising discretion.” Reply 5. Petitioner presents no authority for this position, which is *also* plainly incorrect; an Examiner’s decision to not issue any prior art rejections over disclosed relevant art is evidence the Examiner viewed the claims as novel over that art, and is **not** evidence of material error. And if Petitioner is referring specifically to Cole/D’Amore, the Petition’s weak merits show the Examiner did not err by not issuing a rejection over Cole, of which D’Amore is cumulative in context of the Petition’s allegations.

Finally, Petitioner contends “the petition presents ***new arguments*** that could not have been considered at the time of examination, for example, the Cole-D’Amore combination and the testimony of [its expert].” Reply 5. *Advanced Bionics* makes clear the proper inquiry is “whether the same or substantially similar ***art*** previously was presented to the Office **or** whether the same or substantially the same ***arguments*** previously were presented to the Office.” *Advanced Bionics*, 8-9; *see also id.* 20. There are thus two independent conditions, and either alone is sufficient. This concept is again rooted § 325(d): The Board “may take into account whether ... the same or substantially the same prior ***art or arguments*** previously were presented to the Office.” If Petitioner is arguing its allegedly new arguments result in factor (f) weighing in favor of institution, that is incorrect, as indicated by the lack of showing of material error and the weak merits of the Petition’s theories. POPR 18-19, 26-27.

Date: December 21, 2023

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

The undersigned hereby certifies that the above document was served on December 21, 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:

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