

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 IPR2023-01250
Patent 9,277,433

**PETITIONER'S PRE-INSTITUTION REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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Headwater's §325(d) argument primarily focuses on citation of a relative of Rao (WO 2006/012610A2 ("Rao-2")) and a relative of Cole (U.S. Pub. No. 2008/0080457 ("Cole-2")) in signed Information Disclosure Statements (IDSs) during prosecution. But this ignores that the '433 patent was allowed without the Office issuing *any* prior art rejection—a fact that several Board decisions confirm is insufficient to support discretionary denial under Section 325(d). *See, e.g., Navistar, Inc. v. Fatigue Fracture Tech., LLC*, IPR2018-00853, Pap. 13, 17 (PTAB Sept. 12, 2018) ("the fact that [references] were of record, but not applied in any rejection by the Examiner...provides little impetus for us to exercise our discretion to deny institution under § 325(d)."); *see also* IPR2017-00178, Pap. 6, 12-13 (PTAB 2017); IPR2016-01876, Pap. 8, 7-9 (PTAB 2017); IPR2015-00893, Pap. 14, 8 (PTAB 2015); IPR2017-01742, Pap. 9, 5-6 (PTAB 2018); IPR2017-02097, Pap. 11, 37-38 (PTAB 2018).

I. THE PETITION APPLIES PRIOR ART AND COMBINATIONS NOT PREVIOUSLY PRESENTED IN EXAMINATION

Headwater spends the bulk of its § 325(d) analysis arguing that Rao and Cole are cumulative to Rao-2 and Cole-2. *See* POPR, 30-35. This misses the point because, while Rao-2 and Cole-2 were cited in IDSs, no evidence exists on the record that the Office in fact considered them. Indeed, the Office issued no prior art rejections during prosecution of the '433 patent at all. SAMSUNG-1002, 227-250.

Moreover, all grounds advanced in the Petition include other references and combinations not presented to, or previously considered by, the Office. In particular, none of Freund, Singh, Montemurro, or Gandhi were previously presented to the Office. *See id.*, 838, 960-962.

II. THE PETITION ESTABLISHED THAT THE EXAMINER ERRED IN A WAY MATERIAL TO PATENTABILITY OF THE '433 PATENT

The Petition explained that the prosecution history of the '433 patent was limited—the Examiner issued no prior art rejections. Pet., 74-76; SAMSUNG-1002, 227-250. The lack of prior art rejections establishes that “the asserted art was not substantively evaluated during examination (apart from being initialed in an IDS) or a basis for rejection.” *Scientific Design Co. Inc. v. Shell Oil Co.*, IPR2022-00158, Pap. 7, 24-26 (PTAB Apr. 4, 2022) (declining to exercise discretion under § 325(d) based on “credit[ing] Petitioner’s argument that although the references ‘were cited in an IDS, together with 111 references, none of them was used in any rejections, or otherwise addressed by the examiner’”).

Prior Board decisions further establish that the second part of the *Advanced Bionics* framework is not satisfied when the prosecution history provides little insight into the examiner’s evaluation of prior art asserted by a petitioner and the petitioner demonstrates with a reasonable likelihood that the asserted prior art discloses the allegedly patentable features. In *Samsung Electronics Co. Ltd. v.*

Evolved Wireless LLC, the examiner’s evaluation was not “well developed” or was “silent,” so the petitioner’s showing was “sufficient to establish that the Examiner erred because Petitioner has shown that the Examiner overlooked the particular combination of the [prior art references], which were among the hundreds of references listed on the IDS.” IPR2021-00943, Pap. 9, 12 (PTAB Dec. 1, 2021). Indeed, where the Office issued no rejections, as was the case with the ’433 patent, “[t]he prosecution history provides little insight into the Examiner’s evaluation of the prior art.” *Carrier Fire & Security Americas Corp. v. SentiLock LLC*, IPR2021-00664, Pap. 12, 22 (PTAB. Sept. 16, 2021). Additionally, in *Tokyo Ohka Kogyo Co. Ltd. v. Fujifilm Elec. Materials USA Inc.*, the Board determined that, where the Examiner did not rely on asserted prior art presented in an IDS during prosecution and where Petitioner had shown it is more likely than not that at least one claim of the challenged patent is unpatentable over the asserted prior art, Petitioner had “demonstrate[d] that the Examiner erred in a manner material to the patentability of the challenged claims.” PGR2022-00010, Pap. 9, 8-9 (PTAB 2022). The same scenario applies here.

Moreover, a petitioner need not identify any specific teaching misapprehended or overlooked by the Examiner in order to sufficiently show material error. *See Satco Prods. Inc. v. The Regents of the Univ. of California*, IPR2021-00662, Pap. 13, 25 (PTAB Nov. 8, 2021) (declining to exercise

discretionary denial under § 325(d) even though “Petitioner does not identify any specific teaching in [the asserted references] that the Examiner misapprehended or overlooked”). Here, Petitioner showed that the Examiner erred by failing to consider “Rao’s or Cole’s disclosures and how those references in combination with other prior art references not previously before the Office (Freund, Singh, Montemurro, and Gandhi) render the Challenged Claims obvious.” Pet., 75.

Headwater’s cited authority for the second part of the *Advanced Bionics* framework is distinguishable. See POPR, 53-55. In *Eyenovia*, prosecution of the challenged patent included substantive prior art rejections and patent owner’s discussion of those references, and the Board found a “significant overlap between the arguments considered by the Examiner during prosecution and Petitioner’s grounds in this proceeding.” IPR2022-00963, Pap. 7, 13 (PTAB 2022). No such overlap exists here. Likewise, in *Gator Bio*, the asserted prior art references were “applied extensively during examination of the parent application,” including rejections based on those references. IPR2023-00215, Pap. 19, 12 (PTAB 2023). The same is not true here. Thus, Headwater is unable to identify any authority finding that the second part of the *Advanced Bionics* framework is satisfied where the prosecution history lacks any indication that the Examiner evaluated the asserted prior art references. For all of these reasons, discretionary denial is not warranted.

Respectfully submitted,

Date: January 22, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on January 22, 2024, a complete and entire copy of this Petitioner's Pre-Institution Reply to Patent Owner's Preliminary Response was provided by email to the Patent Owner by serving the correspondence address of record as follows:

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