

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2023-01253
Patent 9143,976

PATENT OWNER'S PRELIMINARY SUR-REPLY

I. The Petition applies the same or substantially the same art previously considered by the USPTO.

The Petition relies only on Rao and Oestvall for the sole independent claim.¹

Pet. 1-2. As to Oestvall, Petitioner does not dispute that each of Oestvall's disclosures that the Petition relies on are substantially the same as those from art that was before the Examiner. *See* POPR at 47-51. Petitioner's reply does not even address this issue, so Oestvall should be considered cumulative prior art.

As to Rao, Petitioner admits a family member was enumerated on "a signed [IDS]," and does not allege there are material (or any) differences between the family member and the Rao it relies on. Reply 1. Petitioner rather claims this is insufficient because the "patent was allowed without the Office issuing *any* prior art rejections." *Id.* But that argument has 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 the Examiner needs to rely on a reference in a rejection during prosecution in order for the reference to be 'considered' during prosecution.").

¹ That the Petition relies on other art for certain dependent claims is of no event because if the sole independent claim (claim 1) is valid then so are the dependents. POPR 51-52. Petitioner ignores this argument, yet still points to art it relies on only for dependent claims. Reply 1-2, 4. Petitioner also incorrectly claims none of that art was presented to the Office, but Montemurro's disclosure was. POPR 52-53.

Moreover, Board precedent is clear that “[p]reviously 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 40-42 (collecting cases). That art on an IDS is deemed considered by the Examiner, for purposes of Section 325(d), is consistent with the public interest underlying an applicant’s requirement to disclose information that may be material to patentability. 37 C.F.R § 1.56(a); MPEP § 2001. Indeed, recent Board decisions, issued after the POPR was filed, further confirm disclosure on an IDS is sufficient for that art to have been “previously presented to the Office” under the first part of *Advanced Bionics*. See, e.g., *Advanced Med. Designs, Inc. v. Corbin Clinical Resources, LLC*, PGR2023-00041, Paper 12, 24-25 (Jan. 23, 2024); *Padagis Israel Pharms. Ltd. v. Bausch Health Ireland Ltd.*, IPR2023-01114, Paper 18, 11-12 (Jan. 12, 2024).

Petitioner unsurprisingly cites no contrary authority. Indeed, the only cases Petitioner cites pre-date *Advanced Bionics*. Reply 1. Reliance on such decisions for the notion that citation on an IDS is insufficient 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).

In sum, Petitioner does not dispute that the art it presents was either listed on an IDS, or is cumulative to art listed on an IDS or that dubbed “closest prior art” by the Examiner; thus, “the same or substantially the same art [relied on by Petitioner] was previously presented” to the Office. *See, e.g., Advanced Med. Designs* at 24-25.

II. The Petition does not demonstrate Examiner material error.

As to the second part of the *Advanced Bionics* test, Petitioner contends “[t]he 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.’” Reply 2 (quoting *Scientific Design Co. v. Shell Oil. Co.*, IPR2021-01537, Paper 7, 24 (2022)). Of course, Petitioner lacks any knowledge of the Examiner’s reasoning and art review process, and if anything, the lack of prior art rejections over the disclosed art is circumstantial evidence of the patentability of the challenged claims over that art. Moreover, in *Scientific Design*, the Board found that petitioner’s art was presented to the Examiner during prosecution (the first part of *Advanced Bionics* was met) but declined to deny institution in that case because the petitioner’s “particularly strong showing in support of institution” sufficiently demonstrated that the Examiner erred. *Scientific Design*, 26. Here, by contrast, the merits of the Petition are weak and far from “particularly strong.” POPR 11-37, 54-55 (cited art fails to

teach several limitations of all challenged claims for three independent reasons).

The other cases cited by Petitioner are similarly distinguishable. Reply 2-4. For example, in *Samsung Elecs. Co. v. Evolved Wireless LLC*, the Board explained “if the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive under [*Becton, Dickinson*] factors (e) and (f).” IPR2021-00943, Paper 9, 11 (2021) (quoting *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 10 (2017) (informative)). The Board then found “[p]etitioner establishe[d] a reasonable likelihood of prevailing in demonstrating that the claims would have been obvious,” and that such “showing is sufficient to establish that the Examiner erred.” *Id.*, 12; *see also Carrier Fire & Security Ams. Corp. v. Sentrilock LLC*, IPR2021-00664, Paper 12, 23 (2021) (same reasoning); *Tokyo Ohka Kogyo Co. v. Fujifilm Elec. Materials USA, Inc.*, PGR2022-00010, Paper 9, 8-9 (2022) (same); *Satco Prods. v. Regents of Univ. Calif.*, IPR2021-00662, Paper 13, 25 (2021) (same). But as explained above and in the POPR, Petitioner has not established a reasonable likelihood of prevailing as to any challenged claim.

Finally, Petitioner claims Patent Owner “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.” Reply 4. Of course, Patent Owner pointed to the signed IDS

and the face of the patent, as evidence indicating the Examiner considered a Rao family member (POPR 40-41 (citing Ex. 1001, 9; Ex. 1002, 21) and demonstrated insubstantial differences between that family member and the reference relied upon (Ex. 2003). And, for example, in *Microsoft Corp. v. AlmondNet, Inc.*, the Board denied institution under Section 325(d) in similar circumstances, and rejected the argument that a reference listed on a signed IDS was “not substantively considered during the prosecution.” IPR2022-01319, Paper 9, 8 (2023), *POP request denied*, Paper 13 (2023), *reh’g denied*, Paper 14 (2023). The Board explained: “There is no argument or evidence before us that [the reference at issue] was concealed from the Examiner,” and “[t]he Examiner ultimately made a determination that the claims were patentable.” *Id.*, 11. The Board further noted that “[a]s cautioned by *Advanced Bionics*, ‘[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a material matter to patentability[;] ... this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.’” *Id.* (quoting *Advanced Bionics*, 9). The Board concluded that in view of “the record presented by Patent Owner and the absence of any substantive showing from Petitioner, we are not persuaded of material Examiner error.” *Id.* The facts are similar here as in *AlmondNet*—the art was disclosed on an IDS and the Petition makes no showing of material error. The Board should deny institution of review.

Date: February 1, 2024

Respectfully submitted,

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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 February 1, 2024, 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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