

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH WIRELESS, LLC

Patent Owner.

Case IPR2023-01267

U.S. Patent No. 9,313,809

**PETITIONER’S PRELIMINARY REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE**

I. Offered *Sotera* Stipulation in Response to the POPR's §314(a) Arguments

Pursuant to the Board's authorization, Petitioner submits a *Sotera* stipulation as Exhibit 1300 in response to Patent Owner's ("PO") §314(a) arguments.

II. The Board Should Not Exercise Discretion Pursuant to §325(d)

The art and arguments raised in the Petition are not the same or substantially the same as those previously considered. To the extent some Petition art was cited, the Board should not exercise its §325(d) discretion because the Office materially erred by failing to recognize Wager as prior art and properly apply the cited art. The IPR should be instituted.

Wager: As explained in the Petition, Wager satisfies *Drinkware* and qualifies as prior art. Pet. 19-20. PO argues Wager was not found to be prior art during prosecution of the related '104 Patent, but at no point did the Examiner apply the proper *Drinkware* test. Rather, the Examiner accepted PO's flawed argument that Wager's provisional "does not support ***all*** of the subject matter disclosed in" Wager. Ex. 1027 at 754, 759-68 (allowing '104's claims) (emphasis added). *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, does not require this showing. 800 F.3d 1375, 1378, 1381-82 (Fed. Cir. 2015). Nor did the Examiner apply *Drinkware* during prosecution of the '809. Indeed, *Drinkware* was decided Sep. 4, 2015 (*id.*)—nearly three months after '809's first notice of allowance (Ex. 1002 at 194-201)—and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017) (extending *Drinkware* to

published applications like Wager) was decided years later. Failing to apply the proper legal test during prosecution and reject the '809 claims in view of Wager was error. Moreover, Wager satisfies *Drinkware* because Wager-Prov provides support for at least one claim of Wager, and describes the subject matter relied on in the grounds. Pet. 19-20, 25-36. The POPR fails to apply *Drinkware*, and wrongly asserts that subject matter relied-upon in the Petition is absent from Wager-Prov because Wager-Prov does not anticipate elements [1.c]-[1.d] of the '809's claims. POPR 40-41. The Petition identifies where all the material relied upon is found in Wager-Prov, and elements [1.c]-[1.d] being rendered obvious by Wager in view of TS25.321—rather than Wager alone—does not impact Wager's prior art status. See Pet. 25-36.

PO incorrectly argues that the challenged '809 claims are entitled to a filing date that predates Wager-Prov, nor has the Office ever made such a determination. Indeed, the '104's issued claims were never found to be entitled to the benefit of its provisional filings. See Ex. 1027 at 703-711, 728-734 (reintroducing rejections based on Wager after claims amended to recite a “[HARQ] data transmission”). As explained in the Petition, the '809 fares no better and adds unsupported limitations (e.g., “releasing the E-DCH resource when...the HARQ buffer is empty”) not found in the '104's claims. Pet. 13-14. The passages identified in the POPR merely confirm that the '985-Prov's sole discussion of “HARQ buffers” (Ex. 1029, ¶37) does not disclose triggering release when the HARQ buffer is empty. Rather, the HARQ

buffer is disclosed as being flushed after the release has begun.

Lee, Nokia, TS25.321, and Chun: Despite being cited in an IDS, the Examiner erred by not discussing these references or applying them to the '809 claims, thereby “misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Advanced Bionics v. MED-EL Elektromedizinische Geräte*, IPR2019-01469, Pap. 6, *8 n.9. Indeed, failing to address the art during prosecution weights against §325(d). *See, e.g., Nintendo Co., Ltd. v. Gamevice, Inc.*, IPR2023-00643, Pap. 11, *19 (declining to exercise §325(d) despite all the petition art being cited in an IDS). In the reasons for allowance, the Examiner simply stated the “art of record fails to disclose the features for determining if a hybrid automatic repeat request (HARQ) buffer is empty; and on a condition that the transmission of scheduling information with the TEBS equal to zero has been made and the HARQ buffer is empty, releasing an E-DCH resource.” Ex. 1002 at 200. That was error. As demonstrated by the grounds presented in the Petition, those features are rendered obvious by at least the combination of Lee in view of Nokia and TS25.321. Pet. 44-59; *see also id.* 25-36.

Sarkkinen and TS25.331 are not cumulative: PO does not argue Sarkkinen's radio link failure teachings are cumulative (Pet. 67-70), and unlike Lin (POPR 32-33), Sarkkinen discloses the timer limitations (Pet. 65-67). And unlike Fisher (POPR 33-34), TS25.331 discloses the claimed triggers to complete transmission (Pet. 74).

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Petitioner's Preliminary Reply - IPR2023-01267

Date: February 21, 2024

Respectfully submitted

By: /James L. Davis Jr./
James L. Davis, Jr.
Reg. No. 57,325
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE was served in its entirety by filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as providing a courtesy copy via e-mail to the following attorneys of record for the Patent Owner listed below:

<u>Lead Counsel</u> Amanda S. Bonner Registration No. 65,224 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 Facsimile: 312-706-8157 asbonner@mayerbrown.com Pantech-LGE-IPR-Service@mayerbrown.com	<u>Back-Up Counsel</u> James A. Fussell, III Registration No. 54,885 Clark S. Bakewell Registration No. 71,615 Baldine B. Paul Registration No. 54,369 Seth W. Bruneel Registration No. 78,973 Mayer Brown LLP 1999 K Street NW Washington, D.C. 20006 Telephone: 202-263-3000 Facsimile: 202-263-3300 jfussell@mayerbrown.com cbakewell@mayerbrown.com bpaul@mayerbrown.com sbruneel@mayerbrown.com
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By: /Jonathan Bradford/
Name: Jonathan Bradford
ROPES & GRAY LLP