

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

PATENT OWNER'S SURREPLY

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Patent Trial and Appeal Board
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P.O. Box 1450
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The bulk of Petitioner's Reply is devoted to arguing that the Examiner incorrectly determined that, as a factual matter, Wager was not prior art to the '809 Patent. This determination was correctly decided.

First, Petitioner argues that the Examiner did not apply the proper legal test for priority because *Drinkware* had not yet issued. But *Drinkware* is simply a particular case highlighted by Petitioner, and it did not represent any change in the law. *See Drinkware*, 800 F.3d at 1381-82. **Second**, there is simply no evidence that the Examiner ever applied an incorrect legal standard. Petitioner may not agree with the Examiner's decision on the evidence, but that is not evidence that the Examiner applied an incorrect legal standard. In these circumstances, denial under § 325(d) is appropriate, because it "reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics*, IPR2019-01469, Paper 6, 9. Regardless, it is beyond reasonable that Wager was considered by the Examiner during prosecution, satisfying Step One of *Advanced Bionics*.

Furthermore, there was no material error in the Examiner's consideration of Wager, satisfying Step Two. **First**, the Examiner's decision about the priority date of Wager was correct. *See* POPR, 40-41. **Second**, Wager would have at most been entitled to an earlier priority date **for only some** of its disclosures. *Forescout Technologies, Inc. v. Fortinet, Inc.*, IPR2021-01328, Paper 12, 9 (PTAB Jan. 27,

2022) (“the subject matter disclosed in Thomas is only available as prior art to the ’421 patent to the extent it also is described in the earlier-filed Thomas Provisional.”). The ’316-Wager Provisional makes no reference to HARQ buffers, and Wager therefore does not gain priority for this teaching. *See generally* Ex. 1006. This is crucial—challenged claim elements [1.c] and [1.d] of the ’809 Patent require “determining if a [HARQ] buffer is empty” and “releasing the E-DCH resource when ... the HARQ buffer is empty.” They cannot be met by the ’316-Wager Provisional. Despite the POPR pointing out this deficiency in the ’316-Wager Provisional, Petitioner fails to meaningfully address it. *See* POPR, 40-41. On this basis too, Petitioner’s argument should be rejected, as no mistake has been shown at *Advanced Bionics* Step Two.¹

Regarding Lee, Nokia, TS 25.321, and Chun, Petitioner acknowledges that they were disclosed and considered in an IDS, thereby satisfying Step One of *Advanced Bionics*. *Advanced Bionics*, Paper 6, 7–8. At Step Two, Petitioner points to no specific teachings of these references that were overlooked. This is insufficient to carry Petitioner’s burden to show error. *Id.* at 8; *Nespresso USA, Inc. v. K-FEE*

¹ Petitioner’s Reply also challenges the priority date of the ’809 Patent, arguably exceeding the leave granted for a Reply to address § 325(d). Regardless, Patent Owner’s position has already been set forth. POPR, 36-39.

System GmbH, IPR2021-01221, Paper 9, 25 (PTAB Jan. 18, 2020) (“To the extent Petitioner argues that the relative strength of the grounds stated in the Petition, standing alone, supports a finding of material Examiner error, that argument is not developed adequately and, therefore, is unpersuasive on this record.”).

Finally, regarding Sarkkinen and TS 25.331, Petitioner offers the bare argument that these references do not overlap with Lin and Fisher with respect to certain claim elements, but fails to provide any explanation. This is insufficient to avoid discretionary denial. *Nespresso*, Paper 9, 19 (“Petitioner, in the Reply, makes no meaningful attempt ‘to show that these arguments do not overlap.’”).

Furthermore, Petitioner is incorrect that TS 25.331 differs from Fisher—Fisher provides a similar teaching (especially in the context of the '809 Patent claim limitation) for TS 25.331's alleged “trigger.” It does so with its disclosure of using a determination to indicate failure, as a determination can be a trigger in certain circumstances. EX1027, 731. Petitioner has not explained any differences. It also does not matter whether “Sarkkinen's radio link failure teachings” or the “timer limitation” are cumulative or not, first because Sarkkinen is only used by Petitioner for dependent claims (and is therefore irrelevant for determining the validity of the independent claims), and second because Petitioner fails to link its arguments to disputed claim limitations. Petitioner also does not identify any material error at *Advanced Bionics* Step Two for these references.

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Dated: February 28, 2024

Respectfully submitted,

/Amanda S Bonner Reg No 65224 /
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

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

Attorneys for Pantech Wireless LLC

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CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of February, 2024, a copy of the attached **PATENT OWNER'S SURREPLY** was served by electronic mail to the attorneys of record, at the following addresses:

James L. Davis, Jr.
James.l.davis@ropesgray.com
Daniel W. Richards
Daniel.richards@ropesgray.com
Abed R. Balbaky
Abed.balbaky@ropesgray.com
LGE-Pantech-Ropes-IPR-Service@ropesgray.com

Respectfully submitted,

Date: February 28, 2024

By: /Amanda S Bonner Reg No 65224/
Amanda S. Bonner (Reg. No. 65,224)

MAYER BROWN LLP