

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH CORPORATION,

Patent Owner.

Case IPR2023-01269

U.S. Patent No. 9,854,545

**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 Under §325(d)

Qualcomm: In both the '545 and child '954 prosecutions, the Office never considered the Qualcomm-based combinations presented in the Petition; namely, Qualcomm in view of TS36.331, and in further view of TS36.300 and/or Fan (and with none of these secondary references having been before the Office). *Sony v. MZ Audio Scis., LLC*, IPR2022-01544, Pap. 12, *7 (§325(d) discretion improper where "Examiner did not consider the specific combination of references asserted").

The Examiner also materially erred by not fully considering Qualcomm. Where the "Examiner did not expressly consider [the reference] on the record," it is difficult, if not impossible, to explain "why the Examiner allowed the claims" or "how the Examiner might have considered the arguments presented in the Petition." *Bowtech v. MCP*, IPR2019-00379, Pap. 14, *20. At minimum, the Examiner failed to recognize that Qualcomm discloses the following claim elements PO successfully argued were absent in the prior art: (1) "the RRC including a 'UL timing group information set' comprising 'one or more UL timing groups,' the one or more UL timing groups each comprising one or more UL CCs;" (2) "each TA value is configured to be applied to CCs in the respective UL timing group;" and (3)

“wherein each TA value is calculated by the eNB for the respective UL timing group based on the received RAP associated with a delegate CC of the respective UL timing group.” Ex. 1002, 474-476. Notably, the POPR does not argue that Qualcomm lacks these specific elements. POPR, 47. And indeed, the Petition demonstrates that Qualcomm discloses these same elements. Pet., 47-67 (see [2.a], [2.b], [2.d], [2.e]; citing Ex. 1007). The Examiner erred at least by not rejecting the '545 claims over Qualcomm in combination with other references, such as TS36.331, for the reasons set forth in the Petition.

Tenny: Tenny was *never* considered by the Office and PO's arguments that Tenny is cumulative of the combination of Yoo-Marinier-Narasimha are belied by the fact that Tenny is not a combination of three references. PO does not—because it cannot—demonstrate that Yoo, Marinier, or Narasimha individually have the same disclosures as Tenny. Nor is Tenny cumulative to the three references in combination. PO successfully argued in prosecution that Narasimha (and thus the Yoo-Marinier-Narasimha combination) “fails to disclose a TA value calculated for the respective ‘UL timing group’ or a ‘delegate CC of the respective UL timing group’” and thus fails to teach the limitation “‘wherein each TA value is calculated...based on the received RAP associated with a delegate CC of the respective UL timing group.’” Ex. 1002, 475. The POPR, however, does not demonstrate that Tenny is similar to Narasimha. See POPR, 35-37. Indeed, it is not.

Unlike Narasimha, Tenny discloses, as explained, a “timing offset [i.e., advance]” determined “in response to a random access procedure” for “one [chosen] carrier [i.e., delegate CC] of each timing group.” Pet. 32, 35-38 (citing Ex. 1006, AppxA). Tenny is thus not cumulative to Narasimha (or Yoo-Marinier-Narasimha). But, even if it were, the Examiner erred by not applying Tenny's disclosures to the '545 claims, as set forth in the Petition. Pet., 17-47.

Additionally, to whatever extent Tenny is cumulative to Marinier (and it is not, *see, e.g.*, Pet. 13-14; Ex. 1003 ¶45), the Examiner erred by not applying the Marinier disclosures purportedly similar to Tenny. For example, for the claimed “UL timing group information set,” PO argues that Tenny's “‘group identifier’ in RRC signaling” operating as “‘an index into the set of timing groups...’” is not materially different from Marinier's “‘group index’ of the UL CC set in an RRC message.” POPR, 35-36. But in prosecution, the Examiner did not recognize and apply Marinier's “group index.” *See* Ex. 1002, 419-424. Nor did PO draw the Examiner's attention to Marinier's RRC “group index” in its responsive remarks. *Id.*, 474-475. And notably, PO does not now dispute that Tenny's disclosures meet the “UL timing group information set” limitation. Accordingly, to the extent that Tenny's disclosures as presented in the Petition, or the arguments thereto, are cumulative to those of Marinier (or Yoo or Narasimha), the Examiner materially erred in reviewing the references and failing to fully apply them to the '545 Challenged Claims.

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Petitioner's Preliminary Reply - IPR2023-01269

Date: February 21, 2024

Respectfully submitted

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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 causing the aforementioned document to be electronically mailed, pursuant to the parties' agreement to the following attorneys of record for the Patent Owner listed below:

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Dated: February 21, 2024

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