

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

PATENT OWNER'S SURREPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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The Board should deny the Petition under § 325(d) in view of the Office's intention to "defer to previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics*, IPR2019-01469, Paper 6, 9.

At Step One, Petitioner concedes Qualcomm was considered by the Examiner in the context of the '545 and related '954 Patents. EX1002, 428; EX2005, 188. This is because disclosure in an IDS on its own satisfies the Step One inquiry. *Advanced Bionics*, Paper 6-8. But Step One is also met over any argument that the Examiner did not consider Qualcomm in view of TS 36.300, TS 36.331, and Fan, as such conclusion is implausible. Qualcomm is a 3GPP Working Group document from the same Group that adopts changes to 3GPP TS 36.311 and TS 36.300. EX1007; EX1009, 211. And the alleged teachings of those secondary references are duplicative of references the Examiner did consider. *See* POPR, 37-38. Further, Petitioner now relies on Qualcomm for substantially the same teachings found in Yoo, Marinier, and Narasimha ("YMN"). (*See* POPR at 8-9):

Claim Element	Qualcomm teachings (Pet.)	YMN teachings
"UL timing group information set"	"RRC signaling" sent by the network to the UE to "indicate" whether a UL carrier "belong[s] to a new timing group." (Pet., 55)	The UE receives an "RRC message" to "obtain the group index of the UL CC set to which an UL carrier belongs." (POPR, 7)
"one or more UL timing groups"	Groups of "more than one CC" that "share the same timing" (Pet., 55)	Groups of uplink carriers ("UL CC sets") that may operate with the same timing advance. (POPR, 7)

“wherein each TA value is”	The reception of a “timing advance” in response to a “RACH preamble.” Pet., 59-60. Petitioner asserts that a POSITA would understand that the timing advance is received in a RAR. <i>Id.</i>	The UE may receive a timing advance using a Random Access procedure in which the TA value is provided to the UE using a Random Access Response. (POPR, 7-8)
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Petitioner makes no attempt to rebut the fact that the alleged teachings of these references are entirely duplicative of references that the Examiner ***did*** consider. This too satisfies the Step One inquiry. *Nespresso USA, Inc. v. K-FEE System GmbH*, IPR2021-01221, Paper 9, 19 (PTAB Jan. 18, 2020) (“Petitioner, in the Reply, makes no meaningful attempt ‘to show that these arguments do not overlap.’”).

Turning to Step Two, Petitioner alleges without evidence that the Examiner “overlooked” certain teachings of Qualcomm. Petitioner bears a significant burden of persuasion to show such error. *Advanced Bionics*, Paper 6, 8. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at 9. Again, Qualcomm’s disclosures match those of the YMN combination with respect to the limitations that Petitioner alleges were overlooked; and Petitioner has not attempted to carry its significant burden to show otherwise. The Examiner considered the YMN combination with its substantively similar teachings and there is no evidence that these teachings were not considered with Qualcomm. *See Nespresso*, Paper 9, 21 (“the Examiner did not apply [] the same combination of prior art []. That does not

end the inquiry, however, where the Petition includes other significant arguments that, at minimum, ‘overlap’ with those previously presented to the Office”).

For Tenny, Petitioner identifies a single alleged difference between the teachings of Tenny and YMN. Namely, Petitioner contends that YMN does not teach Tenny’s alleged “timing offset,” but fails to link its allegations to any specific limitation of the ’545 Patent. *Nokia*, IPR2023-00681, Paper 10, 25 (error not shown where invalidity disputes “do not turn on” alleged differences in art). Furthermore, Petitioner relies on its own **characterizations** of Tenny (such as “chosen” and “delegate”), not Tenny itself; such characterizations cannot make up differences that are meaningful in view of the claim language. *See* POPR, 6-13. Petitioner then argues that the Examiner erred by not citing Marinier’s “group index” for the “UL timing group information set” limitation. But the Examiner relied on YMN, and Marinier specifically, for this limitation (EX1002, 419), and Petitioner has not shown the Examiner overlooked relevant teachings of Marinier. *Nespresso*, Paper 9, 21; *Eyenovia, Inc. v. Sydnexis*, No. IPR2022-00963, Paper 7, *19 (PTAB Nov. 8, 2022) (“Although there was no rejection [] over the particular references cited . . . [t]here is no evidence that suggests the Examiner overlooked the [] teachings in the art presented during prosecution.”). Accordingly, no material error has been shown.

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Respectfully submitted,

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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:

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Date: February 28, 2024

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