

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH WIRELESS, LLC,

Patent Owner.

Case IPR2023-01270

U.S. Patent No. 10,869,247

**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)

Lucent: Lucent was *never* considered by the Office, and PO fails to show that each of the teachings relied on for Lucent is substantially the same as Kahn. Moreover, the references themselves belie PO's argument. With respect to '247 [1.e] and [11.c], PO argues incorrectly that Lucent's "system of encoding ACK/NACK by using New Data Indicator (NDI) bits" is substantively the same as Khan's "ACK/NACK channel...with encoded feedback information to improve ACK/NACK reliability." POPR, 30. Specifically, Khan teaches that the "HARQ feedback field" of the "forward control channel" provides the "ACK/NACK message for a packet transmitted over a particular HARQ channel by the mobile station." Ex. 1010, ¶¶[0020]-[0022]. Lucent, in contrast, does not teach an ACK/NACK channel or an "ACK/NACK message," but instead discloses using a "New Data Indicator (NDI) bit" in the uplink "schedule grant message." Ex. 1005, §3.1.3. Although Lucent states that the NDI bit provides "*implicit* signalling of HARQ ACK/NACKs" (*id.*), it is not an ACK/NACK message or sent on an ACK/NACK channel.

Moreover, even if Lucent were cumulative to Khan, the Examiner would have

erred by failing to reject the Challenged Claims over either Lucent or Khan. During prosecution, the '242 was allowed without any office action—the Examiner merely recited the “processor,” “transceiver,” “receive” and “determining” limitations of claim 1 and stated that Khan, alone or in combination with other art “fails to teach” all those limitations together. Ex. 1002, 175. The Examiner’s failure to substantively evaluate Khan makes it “difficult, if not impossible, to discern...how the Examiner might have considered the arguments presented in the Petition” with respect to Lucent. *Bowtech v. MCP*, IPR2019-00379, Pap. 14, *20. Regardless, as set forth in the Petition, these limitations are met by Lucent. *E.g.*, Pet., 16-33. PO does not argue otherwise except for the “determining” [1.e] limitation, where PO incorrectly argues that Lucent’s NDI bits are “different than using scheduling information to determine the transmission, as required by the claim element [1.e].” POPR, 33-35. But Lucent’s NDI bits are included in the scheduling information and are used to determine the transmission. Pet., 25-27. Lucent’s NDI bit is not an ACK/NACK message—instead it “implicitly indicates to the UE [whether] the first packet was received correctly” depending on whether the NDI has changed compared to the value in the previous received transmission. Ex. 1005, §3.1.3. Thus, if Kahn contains the same disclosures as Lucent (it does not), the Examiner would have materially erred by not applying either reference to the Challenged Claims in the manner set forth in the Petition.

Liu and Kuchibhotla: Although cited (together with over 200 references),

neither Liu or Kuchibhotla were addressed during '247's prosecution, weighing against §325(d). *See, e.g., Nintendo Co., Ltd. v. Gamevice, Inc.*, IPR2023-00643, Pap. 11, *19 (declining to exercise §325(d) when all prior art asserted in petition had been cited in patent). Also weighing against §325(d) is the fact that “the challenge here is not based solely on [Liu and Kuchibhotla].” *Samsung Elec. Co. v. G+ Comm's, LLC*, IPR2023-00441, Pap. 10, *15. Moreover, the Examiner erred at least by failing to recognize and apply Kuchibhotla's and Liu's collective disclosure of the substantive “receiving” and “determining” elements, as set forth in the Petition. *See* Ex. 1002, 175; Pet., 37-67. Indeed, PO argues only that [1.e] is missing from Kuchibhotla, and there is no motivation to combine with Liu. POPR, 37-40. But Kuchibhotla discloses that when a “New Data Expected” (NDE) indicator in a scheduling message conflicts with an ACK/NACK message, the mobile unit will—as [1.e] requires—**ignore** the misread ACK/NACK message and instead determine whether to retransmit based on the NDE. Ex. 1006, ¶¶71-73; Pet. 53-57. And a POSITA would have been motivated to apply Liu's H-ARQ process ID teachings to Kuchibhotla for the reasons explained in the Petition. Pet. 41. The Examiner thus materially erred by not applying Kuchibhotla and Liu to the claims.

Das: POPR (pp.30-31) misstates Petitioner's reliance on Das, which discloses using a **different** modulation/coding scheme between transmitted and retransmitted data blocks. Pet. 34-36. Khan has no such disclosure; thus, Das is not cumulative.

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Petitioner's Preliminary Reply - IPR2023-01270

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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