

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

PATENT OWNER'S SURREPLY

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner's Reply does not establish any doubt that each reference Petitioner relies upon meets Step One of *Advanced Bionics*. "Where *either* the prior art references advanced *or* the arguments raised in a petition previously were presented to the Office, the inquiry shifts to whether the petitioner establishes a material error" at Step Two. *Nespresso USA, Inc. v. K-FEE System GmbH*, IPR2021-01221, Paper 9, 12 (PTAB Jan. 18, 2020). **First**, Petitioner does not dispute that Liu and Kuchibhotla were disclosed in an IDS, satisfying Step One. *Advanced Bionics*, Paper 6, 7–8. **Second**, Petitioner is incorrect that the Examiner's consideration of Khan did not involve substantially the same arguments that Petitioner now makes with respect to Liu and Das.¹ *Eyenovia, Inc. v. Sydnexis*, No. IPR2022-00963, Paper 7, 19 (PTAB Nov. 8, 2022) ("Although there was no rejection issued over the particular references cited in the Petition, those references were either before the Examiner [] or are cumulative of references [] before the Examiner.").

Regarding Lucent, Petitioner does not present any alleged differences between Lucent and Khan in the context of the '247 Patent's claim language, as required. *Nokia*, IPR2023-00681, Paper 10, 25 (error not shown where invalidity disputes "do not turn on" alleged differences in art). The only limitation even alluded to, "determin[ing] whether to retransmit the data block based on the received uplink

¹ Petitioner's Reply makes no mention of Rathonyi.

scheduling information” (claim elements [1.e] and [11.c]), was previously considered by the Examiner in the context of Khan. Petitioner identifies no reason why Khan’s disclosure of “cod[ing] [feedback information] along with the other forward control channel information” (EX2003, [0002], [0003], [0020]-[0022]) meaningfully differs from Lucent’s disclosure of the use of a “New Data Indicator (NDI) bit” (EX1005, §3.1.3) in the context of this claim language. Both of these teachings provide for the use of feedback information to improve ACK/NACK reliability along with an ACK/NACK channel. That Lucent calls its NDI bit “implicit signalling of H-ARQ ACK/NACKs” (*id.*) does not change that Lucent discloses the mere use of feedback information or distinguish Lucent’s teachings from those of Khan; ***the argument previously presented is the same.***

Regarding Das, the limitation at issue is “wherein the scheduling information indicates a modulation and coding scheme.” See Claim 8, Pet., 34-36. Whether the prior art taught modulation and coding schemes was considered by the Examiner in the context of Khan (EX2003, [0001]), Kuchibhotla (EX1006, [0017]-[0020]) and Liu (EX1007, [0035]). Whether Das presents a “different modulation/coding scheme” from Khan, as Petitioner contends, is irrelevant in the context of the claim language in dispute. *Nokia*, IPR2023-00681, Paper 10, 25.

Under Step Two, Petitioner fails to show material error; rather, it appears that Petitioner simply disagrees with the Examiner’s conclusions. “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.” *Advanced Bionics*, Paper 6, 9. Petitioner presents only two arguments for why error allegedly occurred (no error is identified for Das), and neither is supported by the record.

First, the Examiner did consider Khan in the context of the “determining” limitation of claim elements [1.e] and [11.c]—the Examiner clearly stated that the “primary reason” for allowance was that Khan did not teach this limitation, either alone or in combination with other prior art of record. EX1002, 175. Petitioner may disagree, but there is no clear error in the Examiner’s reasoning, and as shown above, Khan’s teachings with respect to this limitation are not substantively different from those of Lucent, which are deficient. *See* POPR, 33-35.

Second, there is no evidence that the Examiner “fail[ed] to recognize and apply Kuchibhotla’s and Liu’s collective disclosure of the substantive ‘receiving’ and ‘determining’ elements,” and Petitioner presents no evidence of such failure aside from its own arguments. Petitioner bears a significant burden of persuasion to show error. *Advanced Bionics*, Paper 6, 8. And indeed, Petitioner is incorrect, as neither Kuchibhotla nor Liu satisfy this claim limitation. POPR, 37-40 (explaining the failures of Kuchibhotla and Liu with respect to the “determining” limitation).

Accordingly, Petitioner has not shown any material error during prosecution.

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Dated: February 28, 2024

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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