

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH CORPORATION

Patent Owner.

Case IPR2023-01273

U.S. Patent No. 9,136,924

**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 Pursuant to §325(d)

The art and arguments raised in the Petition are not the same or substantially the same as those presented during prosecution. Even if some Petition art was cited to or by the Office, the Office materially erred by failing to apply the art.

Sayana: Although the Examiner cited Sayana in a Notice of References Cited, the Examiner considered neither the specific combinations of Sayana raised in the Petition nor the secondary references (Lee-689, TS36.213, TS36.211 and Koivisto) of those combinations. For these reasons alone, the first part of *Advanced Bionics* is not met. *Sony v. MZ Audio Scis., LLC*, IPR2022-01544, Pap. 12, *7 (§325(d) discretion improper where "Examiner did not consider the specific combination").

The POPR (pp.39, 43) argues that Sayana's disclosures are cumulative of Hammarwall (applied during prosecution), but does not show how each of the Petition's cited Sayana disclosures are substantially the same as Hammarwall. Pet. 23-53. The POPR acknowledges (p.15) the claims were allowed after an amendment added "wherein *a period of transmitting the information relating to ... the first precoder and a period of transmitting the information relating to ... the second precoder are different from each other*," but omits that this limitation came from

application claims 8, 23 and 30 that were allowed without rejection. Ex. 1002, 52, 56-58, 464, 484, 540, 557. The Examiner never applied Hammarwall to this alleged point of novelty about transmitting feedbacks at different **periods**. Moreover, PO argued Hammarwall discloses “**precoder** selection” instead of selecting a “**precoding matrix**.” Ex. 1002, 462-463. Whereas, Sayana expressly discloses selection and feedback of precoding “matri[ces]” “at **different ... periodicities**” and feedback “**slowly in time**” or “**more frequently in time**”—meeting this limitation even under PO's interpretation. Sayana, [0006], [0095], [0099]; Pet. 39-44.

While the POPR (pp.39-40) tries to equate these disclosures to Hammarwall's discussion ([0009], [0018]) of “wideband/long-term properties” and “frequency-selective/short term properties,” the Examiner never cited these disclosures and none of those portions of Hammarwall disclose the feedback period of those properties or how often those properties are fed back. Even if Hammarwall did disclose such periods of feedback, the Examiner would have “overlook[ed] specific teachings of the relevant prior art [that] impact patentability of the challenged claims” because the Examiner never cited to any such passage, or considered such argument during prosecution. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Pap. 6, *7-8, n.9. Also, as discussed below, Hammarwall (¶[0010]) criticizes bitmaps for codebook restriction, but Sayana does not.

Lee: The POPR (p.12) incorrectly argues that “the Examiner specifically

cited” Lee-689 “in the rejection,” when the Examiner cited to a **different** reference (U.S. 2011/0206024, Lee-024) that happened to share a common inventor (Wook Bong Lee), but not the same disclosures. The POPR (pp.41-42) further argues that Lee-689’s bitmap disclosures are the same as Hammarwall, but Hammarwall (¶[0010]) discusses a “disadvantage” of using bitmaps. And unlike Lee-689 (p.7, lines 1-3), Hammarwall does not disclose using a codebook subset restriction to reduce interference at a UE. Pet. 24-25 (relying on this teaching from Lee-689).

TS36.213 and TS36.211: The POPR (pp.41-42) asserts that TS36.213 and TS36.211’s teachings of bitmaps are substantially similar to Hammarwall because it references (¶[0010]) TS36.213. But TS36.213 and TS36.211 were never cited and thus the first part of *Advanced Bionics* is not met. Moreover, even though the Examiner cited that portion of Hammarwall, the Examiner did not consider that it emphasizes a “disadvantage” of bitmaps and thus teaches not to use a bitmap—unlike TS36.213 and TS36.211 teaching to use one—demonstrating material error.

Koivisto: Koivisto was never cited during prosecution. Even if Koivisto contained the same disclosures as Hammarwall and Jongren (as the POPR (p.43) asserts without support—they do not), it would have been error to not cite them. Notably, the Petition relies on Koivisto for claim limitations that were not rejected by the Examiner. Pet. 76-78; Ex. 1002, 55, 57, 433, 464, 540 (application claims 22 and 29 corresponding to Challenged Claims 21 and 27 allowable without rejection).

U.S. Patent No. 9,136,924
Petitioner's Preliminary Reply - IPR2023-01273

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 filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as providing a courtesy copy via e-mail to the following attorneys of record for the Patent Owner listed below:

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Dated: February 21, 2024

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