

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

PATENT OWNER'S SURREPLY

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Patent Trial and Appeal Board
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Advanced Bionics “reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, IPR2019-01469, Paper 6, 9. Petitioner attempts to sidestep this, concluding examiner error exists though none is shown and simply urging that its arguments are better than those originally considered. The Petition should be denied under §325(d).

Petitioner relies on Sayana as its primary reference for all grounds, but Sayana was considered by the Examiner in an IDS.¹ Petitioner's contrary argument for Step One is that, despite Sayana being considered in an IDS (and cumulative of Hammarwall, as detailed in POPR), it was not considered in combination with Petitioner's specific secondary references. Reply, 1-2. This argument is legally and factually flawed. **First**, disclosure in an IDS alone satisfies Step One. *Advanced Bionics*, Paper 6, 7–8. **Second**, Petitioner relies on Sayana's disclosures for most claim elements, relying on secondary references only for their alleged disclosures of a “bitmap” use. Pet., 23, 36, 39, 45, 47. But the now-asserted teaching of bitmap use were discussed by the Examiner in multiple rejections, including in the context of Hammarwall. That Petitioner now relies on different secondary references (Lee-689,

¹ Petitioner incorrectly asserts that the POPR argues that the Examiner specifically cited Lee-689. POPR states that Lee was cited in an IDS, but focuses on how the disclosures of Lee-689 of bitmap are duplicative of Hammarwall. POPR, 35, 41-42.

TS 36.213, and TS 36.211²) rather than Hammarwall is of no consequence.

TS 36.213 and its teachings of “certain bitmap-based signaling to indicate the particular precoders within a codebook that the UE is restricted to using” are explicitly cited in Hammarwall. EX2017, [0010]. And contrary to Petitioner's arguments, the Examiner did cite this paragraph. EX1002, 423, 425, 426, 473, 477, 528, 534. Furthermore, beyond making the irrelevant observation that Hammarwall teaches that this approach had “disadvantages” (irrelevant because this approach was before the Examiner), Petitioner makes no argument that TS 36.213 and TS 36.211 are outside the scope of disclosures of Hammarwall. Petitioner only argues that Lee-689 differs from Hammarwall because it supposedly teaches “using a codebook subset restriction to reduce interference at a UE.” Reply, 3. But this is inaccurate (EX2017, [0008] (teaching how the UE selecting a certain precoder matrix means “interference is reduced”)) and also irrelevant because this nuance is not required in the '924 claims. Because Sayana was considered by the Examiner and the relied-upon teachings of Lee-689, TS 36.213, and TS 36.211 are duplicative of Hammarwall, the inquiry passes to step two.

At step two, Petitioner fails to identify error in the Examiner's consideration of Sayana (or the teachings of Hammarwall pertinent to the secondary references).

² Koivisto has been relied upon by Petitioner only for dependent claims.

Instead, Petitioner merely emphasizes what it contends are differences between Sayana and Hammarwall, entirely missing the point of showing error because it fails to link these differences to patentability. *Nokia*, IPR2023-00681, Paper 10, 25 (error not shown where invalidity disputes “do not turn on” alleged differences in art).

Critically, Petitioner identifies no teachings in Sayana that the examiner did not address with Hammarwall. Petitioner makes no argument that Sayana's alleged disclosures of using precoding matrices at “at different ... periodicities” and feedback “slowly in time” or “more frequently in time” (Reply, 2) are different than Hammarwall's disclosure of using wideband versus subband precoding feedback, which the Examiner did cite in multiple rejections. EX1002, 423-25 (citing EX2017, [0058]-[0062], [0091]). Thus, it is wrong to conclude that the Examiner overlooked these teachings. And while Petitioner alleges that the claim amendments were not truly considered, they were the subject of an examiner interview. EX1002, 557-59.

Furthermore, to the extent that there are any omissions in the Examiner's consideration of Hammarwall, Petitioner does not explain what claim element they would meaningfully affect. Faced with the Examiner's consideration of very similar teachings of Hammarwall, the Examiner's consideration of Sayana, and no clear teachings of Sayana that would overcome the Examiner's determination of allowability in view of Hammarwall and Sayana, Petitioner is left with an attempt to substitute its reasoning for the Examiner's. This attempt should be denied.

Patent No. 9,136,924
Patent Owner's Sur-Reply

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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