

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2023-01336
Patent 9,137,701

PATENT OWNER'S PRELIMINARY SUR-REPLY

I. The Petition applies the same and substantially the same art previously considered by the USPTO.

The Petition's sole ground challenging the sole independent claim is based on Rao and Oestvall.¹ Pet. 1; POPR 30-31. Rao's disclosure was considered during prosecution (POPR 31-34), and the Oestvall disclosures on which the Petition relies are substantially the same as disclosures considered during prosecution (*id.* 34-42).

Rao. Petitioner admits Rao-2 (a Rao family member) was "cited in [an] IDS[]," and does not allege there are material (or any) differences between Rao-2 and Rao. Reply 1. Petitioner rather claims such disclosure is insufficient for denial of institution because the "patent was allowed without the Office issuing *any* prior art rejections." *Id.* But the Board has expressly rejected that argument. *See, e.g., Ivantis v. Sight Sciences*, IPR2022-01530, Paper 14, 17 (2023) ("[T]here is no requirement that the Examiner needs to rely on a reference in a rejection during prosecution in order for the reference to be 'considered' during prosecution.").

Moreover, Board precedent is clear that "[p]reviously presented art includes art made of record by the examiner, and *art provided to the Office by the applicant, such as on an Information Disclosure Statement (IDS)*, in the prosecution history

¹ That the Petition relies on other art (i.e., Araujo) for dependent claims is of no event because if the independent claim is valid then so are dependents. POPR 42-43. Petitioner reliance on Araujo (Reply 1) is thus of no consequence here.

of the challenged patent.” *Advanced Bionics v. Med-El Elektromedizinische Gerate*, IPR2019-01469, Paper 6, 8 (2020); *see* POPR 31-34. That art on an IDS is deemed considered by the Office, for § 325(d), is consistent with the public interest underlying an applicant’s requirement to disclose information that may be material to patentability. 37 C.F.R § 1.56(a); MPEP § 2001. Recent Board decisions further confirm IDS disclosure is sufficient for art to have been “previously presented to the Office” under *Advanced Bionics* part one. *See, e.g., Advanced Med. Designs v. Corbin Clinical Resources*, PGR2023-00041, Paper 12, 24-25 (2024); *Padagis Israel Pharms. v. Bausch Health Ireland*, IPR2023-01114, Paper 18, 11-12 (2024).

Petitioner cites no contrary authority. Reply 1. IPR2023-01157 is irrelevant—the Board did not discuss the impact of IDS disclosure on *Advanced Bionics* part one. Paper 9, 6-7 (2024) (“-01157 ID”). The only other cited cases pre-date *Advanced Bionics*. The Board expressly rejected reliance on such decisions for the notion that IDS citation is insufficient. *See Nespresso USA v. K-Fee Sys.*, IPR2021-01223, Paper 9, 12 (2022) (rejecting reliance on “non-precedential Board decisions, which predate *Advanced Bionics*, to argue that mere submission of a reference in an IDS is insufficient for purposes of exercising discretion to deny review under Section 325(d);” noting “*Advanced Bionics* unambiguously instructs” to the contrary).

Oestvall. Petitioner criticizes Patent Owner for purported “reliance on only select disclosure of generic and well-known concepts” to allege that Oestvall’s

disclosures are substantially the same as those before the Examiner. *See* Reply 2. But Patent Owner relies upon the precise Oestvall disclosures on which the Petition relies, and compares those with specific disclosures from Rao and references discussed in the Notice of Allowance.² POPR 34-42. Indeed, the Board routinely analyzes a comparison of relied-upon disclosures in evaluating whether a reference is “cumulative” under Section 325(d), confirming this approach is proper. *See, e.g., Advanced Bionics*, 15-19 (performing limitation-by-limitation analysis, evaluating whether cited disclosures from references not before the Office “disclos[e] substantially the ***same information*** already considered by the Office”). This is to be expected, as what matters is whether the Office had *cumulative information* as compared with what the Petition claims to be the *relevant portions* of the cited art.

Petitioner also argues the Office did not consider its alleged motivations to

² Petitioner claims Patent Owner “fail[s] to address how Judge or Nicholas teach” treating applications differently “depending on whether the application runs in the background or foreground.” Reply 3. But Patent Owner relies on Rao (not Judge or Nicholas) as being cumulative with this aspect of Oestvall. POPR 35-36. Petitioner also claims Patent Owner “fails to address how Nicholas provides a teaching cumulative of Oestvall’s ... battery conservation.” Reply 3. But Patent Owner relies on Judge (not Nicholas) as being cumulative with that teaching. POPR 38-40.

combine Oestvall with Rao, and faults Patent Owner for “fail[ing] to address how the *combination* of references in the Petition is similar to any combination considered during prosecution.” Reply 2. Petitioner cites no authority to support either proposition. Moreover, logic dictates if Oestvall is substantively cumulative to art before the Examiner in relevant part, as Patent Owner showed, the Examiner would have considered the “combination” of the substance of those disclosures.

II. The Petition does not demonstrate Examiner material error.

For *Advanced Bionics* part two, Petitioner leans heavily on the fact “the Examiner issued no prior art rejections at all.” *Id.*, 4. Petitioner further claims Patent Owner “is unable to identify any authority finding that the second part of the *Advanced Bionics* framework is satisfied where the prosecution history lacks any indication that the Examiner evaluated the asserted prior art references.” *Id.*, 5. Patent Owner pointed to the IDS and the patent’s face as evidencing the Office considered Rao-2 (POPR 31-32) and demonstrated insubstantial differences between Rao and Rao-2 (Ex. 2002). In *Microsoft v. AlmondNet*, the Board denied institution in similar circumstances, rejecting the idea that a reference on a signed IDS was “not substantively considered during the prosecution.” IPR2022-01319, Paper 9, 8 (2023), *POP req. denied*, Paper 13 (2023), *reh’g denied*, Paper 14 (2023). The Board explained: “There is no argument or evidence before us that [the reference at issue] was concealed from the Examiner,” and “[t]he Examiner ultimately made

a determination that the claims were patentable.” *Id.*, 11. The Board further noted: “As cautioned by *Advanced Bionics*, ‘[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a material matter to patentability[;] ... this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.’” *Id.* (quoting *Advanced Bionics*, 9). The Board concluded that in view of “the record presented by Patent Owner and the absence of any substantive showing from Petitioner, we are not persuaded of material Examiner error.” *Id.* The facts are similar here—cited art was disclosed on an IDS and the Petition makes no showing of material error. The Board should deny institution as it did in *AlmondNet*.

The -01157 ID does not counsel a different result. There, the Board declined to deny institution because, based on specific arguments about specific art applied to specific claim limitations of a different patent, in its view, “Petitioner’s showing on the merits is enough to demonstrate that the Examiner erred.” -01157 ID, 7-8. Those same merits issues are not at issue here. POPR 6-28. The -01157 ID thus cannot control the outcome here; rather, the Board must consider the facts specific to this proceeding. Here, the Petition’s merits are weak because it fails to establish its proposed combination blocks access to a WWAN modem based on a differential traffic control policy, and based on a determination that the application is running in a background state, as required by all challenged claims. *Id.* 6-28, 46.

Date: February 20, 2024

Respectfully submitted,

/Amy E. Hayden/

Reza Mirzaie, Reg. No. 69,138

Marc A. Fenster, *pro hac vice* forthcoming

Dale Chang, Reg. No. 61,476

Amy E. Hayden, Reg. No. 64,817

Neil A. Rubin, Reg. No. 67,030

Philip X. Wang, Reg. No. 74,621

James A. Milkey, Reg. No. 79,503

RUSS, AUGUST & KABAT

12424 Wilshire Blvd., 12th Floor

Los Angeles, CA 90025

Counsel for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on February 20, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

W. Karl Renner (Reg. No. 41,265)
Jeremy J. Monaldo (Reg. No. 58,680)
Jennifer J. Huang (Reg. No. 64,297)
Sangki Park (Reg. No. 77,261)
FISH & RICHARDSON P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
IPR39843-0155IP1@fr.com
PTABInbound@fr.com
axf-ptab@fr.com
jjm@fr.com
jjh@fr.com
spark@fr.com

Date: February 20, 2024

/Amy E. Hayden/
Reza Mirzaie, Reg. No. 69,138
Marc A. Fenster, *pro hac vice* forthcoming
Dale Chang, Reg. No. 61,476
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Philip X. Wang, Reg. No. 74,621
James A. Milkey, Reg. No. 79,503
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025

Counsel for Patent Owner