

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NARISTE NETWORKS PTY. LTD.

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.
and SAMSUNG ELECTRONICS
AMERICA, INC.

Defendants.

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Civil Action No. 2:23-cv-00031

JURY TRIAL DEMANDED

**PLAINTIFF NARISTE NETWORKS PTY. LTD.'S SUR-REPLY IN OPPOSITION TO
DEFENDANTS' RULE 12(b)(6) MOTION TO DISMISS UNDER 35 U.S.C. § 251 AND
THE RULE AGAINST RECAPTURE**

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I. INTRODUCTION

As it did in its Motion to Dismiss (Dkt. 23, “Motion”), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Defendants” or “Samsung”) Reply Brief (Dkt. 43, “Reply”) erroneously focuses on the issued claims of the ’870 Patent and mischaracterizes the content of the *Lau* reference. Because the claims of the ’206 Patent are materially narrower than the surrendered subject matter, the Court should deny Samsung’s motion.

II. ARGUMENT

Samsung continues to conflate the issued claims of the ’870 Patent with the original claims of the patent application that were amended prior to issuance. As a result, Samsung’s analysis and conclusions are fundamentally flawed. The correct analysis of the subject matter surrendered from the ’870 Patent requires review of the original claims prior to amendment. Instead, Samsung focuses on what Nariste allegedly conceded was disclosed by the prior art, but in doing so misrepresents what Nariste argued in prosecution while failing to perform any substantive analysis of the prior art itself. Samsung additionally argues that this Court need not defer to the Patent Examiners. Nariste does not dispute that this Court owes no deference to the USPTO. However, Samsung’s opening brief goes one step further, wrongly asking this court to find that the Examiner had blatantly misinterpreted the claim amendment to the ’206 Patent, despite providing no evidence to that effect. Nariste’s analysis under the three-step recapture test is correct and is likely similar to that used by the Examiners in allowing the ’206 Patent in the first place.

A. The ’206 Patents Claims were Materially Narrowed with Respect to the Surrendered Subject Matter of the Original Claims.

Samsung’s argument in its Reply yet again focuses on the issued claim language of the ’870 Patent instead of the originally pending claim language, as required under the law. *See, e.g.,*

Dkt. 43 at 1. Under the correct analysis, the surrendered subject matter is “information on the radio position.” *See* Dkt. 32 at 7-9. Samsung follows this by incorrectly arguing that analysis of the original claim language of the ’870 Patent, prior to amendment, and the issued ’870 claim language would lead to the same result, on the basis that the *Lau* reference allegedly discloses a “position.” Dkt. 43 at 6. For the first time, in its reply, Samsung argues that *Lau*’s disclosure of “dead reckoning¹” is a “position” as recited by the ’206 Patent because “Nariste clearly stated that *Lau* disclosed ‘dead reckoning’ as ‘a means to estimate current location,’ and that *Lau* ‘does not disclose using . . . position error.’” Dkt. 43 at 6 (*citing* Dkt. 23-2 at 000302). This mischaracterizes Nariste’s argument and is incorrect.

First, what Nariste argued is that “dead reckoning is a means to estimate current location from previous last known positions by estimating a straight-line movement” and that the “dead reckoning device is embedded in the mobile device itself **and uses no other external inputs.**” Dkt. 32-5 at 18 (emphasis added). In contrast, the claims of the ’206 Patent (and the claims of the ’870 Patent before it) recite: “a current radio position . . . determined **from the wireless communications network.**”² Dkt. 32-10 at 16:15-20 (emphasis added). The “wireless communications network” recited in the claims of the ’206 Patent and the ’870 Patent **is** “an external input.” In other words, while *Lau* disclosed only an estimation based on *no external inputs* (e.g., a wireless communication network), the ’206 Patent claims using position or position error determined *from an external input* (i.e., a wireless communications network). Accordingly, *Lau* does not disclose a “position” as required by the claims of the ’870 Patent and the ’206 Patent. It

¹ Samsung did not discuss the disclosure of *Lau* itself at all in its opening brief nor include *Lau* as an exhibit. *See* Dkt. 23. Samsung only now references “dead reckoning” in response to it being distinguished by Defendant. Dkt. 32 at 9-10.

² References throughout Nariste’s briefing to “position” are made for economy and readability but should not be taken to read out the rest of the claim language.

is therefore no surprise that the examiner did not rely on *Lau* for disclosing the claimed “a position” limitation during prosecution of the ’870 Patent, and Nariste did not admit *Lau* disclosed “a position” during prosecution of the ’870 Patent.

Notably, Samsung did not discuss *Lau* directly or make any reference to the portion of *Lau* that allegedly discloses “a position . . . determined from the wireless communications network” in its opening brief. *See, e.g.*, Dkt 23-1 (*Lau* is not an exhibit). Samsung only relies on statements made by the examiner and by the applicant, neither of which contends or admits that *Lau* discloses “a position . . .” *See* Dkt. 32 at 8-9. Samsung’s failure to analyze *Lau* and specifically identify the portion of *Lau* that allegedly discloses “a current radio position . . . determined from the wireless communications network” is because it is unable to do so.

Instead, Samsung argues that Nariste distinguished *Lau* because “there was only one specific type of information missing in *Lau*: ‘position error’” Dkt. 43 at 6. This is incorrect for two reasons. First, Samsung misconstrues what Nariste argued during prosecution. Nariste did not admit that there was “only one specific type of information missing in *Lau*.” *Id.* Consistent with the disclosure of *Lau*, Nariste argued that *Lau* “does not disclose using position information, or more particularly, position error, as determined by the wireless network as one of the inputs to control the GPS power supply.” Dkt. 32-5 at 18 (emphasis added). In other words, “position error” was an example of something that *Lau* did not disclose, but not the only thing, as Samsung argues. Second, the argument that something is not present is not an admission that something else is, and Samsung provides no cases supporting that premise.

The issued claims of the ’870 Patent were narrower than they needed to be to overcome the *Lau* reference. This is of no consequence to the ’206 Patent. Indeed, the Federal Circuit has explicitly contemplated this situation, acknowledging that applicants may introduce claim

elements that are narrower than needed to overcome prior art, which is why the focus of Step 3 of the Recapture test is on the original claims and **not** the issued claims. *In re Youman*, 679 F.3d 1335 at 1346 (Fed. Cir. 2012) (“By measuring material narrowing relative to the original claim, which was deliberately surrendered during the original prosecution, we are ensuring that the patentee is unable to recapture what it surrendered deliberately, but allowing room for error, as required by the reissue statute.”); *see also In re Richman*, 56 CCPA 1083, 409 F.2d 269, 274–75 (1969) (“We ... find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under [§ 251], by reissue if the limitation turns out to be more restrictive than the prior art required.”). This is exactly the situation in the case of the ’206 Patent, the applicant surrendered the broad “information on radio position” but obtained narrower claims than necessary to overcome *Lau* during prosecution of the ’870 Patent. As such, the claims of the ’206 Patent are materially narrowed compared to the material surrendered from prosecution of the ’870 Patent. And, while at first glance, the disjunctive requirement of either “position” or “position error” in the ’206 Patent appears broader than the conjunctive requirement of “position” and “position error” in the issued claims of the ’870 Patent, either of these elements would have sufficed to overcome *Lau* and therefore there is no violation of the rule against recapture.

B. The Examination of the ’206 Patent and Dr. Malaney’s Declaration are both Relevant to Rebutting Samsung’s Unsupported Arguments

In its opening brief, Samsung contended that “[t]he Examiner may have interpreted the ‘at least one of . . .’ clause as conjunctive, requiring *both* ‘current radio position’ and ‘position error’ and thus avoiding the recapture of ‘position’ alone” based on pure speculation without providing any evidence that this misinterpretation took place. Dkt. 23 at 15 (emphasis in the original). What

Samsung failed to disclose was that more than one examiner was involved in considering the amendments made to the '206 Patent. While the Court need not defer to the decision of the Examiners regarding whether the rule against recapture applies to the claims of the '206 Patent, the posture of the Examination does make Samsung's speculative contentions of misinterpretation even more unlikely. It is highly unlikely that every examiner misinterpreted the claim language as Samsung suggests without any support.

Likewise, Dr. Malaney's declaration is relevant to both Samsung's "misinterpretation" argument as well as Samsung's argument that Nariste intentionally abandoned the '195 Reissue Application due to recapture. Dkt. 23 at 4. Samsung's opening brief explicitly argued that the inventor's reasons for abandoning the '195 Reissue Application were relevant to this Court's analysis of the '206 Patent under the three-step recapture test. *Id.* at 11, 13. And certainly the inventor's mindset with respect to that abandonment is a factual matter outside of the pleadings.³ However, having received a declaration that sheds light on the inventor's mindset and contradicts Samsung's assumptions, Samsung now argues that "an inventor's intentions have no place in the three-step recapture test." Dkt. 43 at 10. If that is case, then Samsung appears to concede that the abandonment of the '195 Reissue Application and Samsung's arguments regarding the inventor's reasons for doing so are irrelevant to the three-step recapture test as well. Dr. Malaney's declaration was provided to rebut arguments Samsung made regarding the inventor's mindset, and to the extent that Samsung now concedes that its original arguments regarding abandonment of the '195 Patent are irrelevant, then this Court has no reason to consider Dr. Malaney's declaration.

³ The cases Samsung cites in support of its request to strike Dr. Malaney's declaration are distinguishable as none of them involved declarations that were submitted to rebut unsupported factual allegations made by the opposing party.

III. CONCLUSION

Because the '206 Patent does not violate the rule against recapture and is materially narrower than the subject matter abandoned during prosecution of the '870 Patent, Nariste respectfully requests that the Court deny Defendant's Motion.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5, I hereby certify that, on June 30, 2023 a copy of the foregoing was served electronically through the U.S. District Court, Eastern District of Texas ECF system to all counsel of record whom are Filing Users of the Court's Electronic Filing System.

/s/ Amir Alavi

Amir Alavi