

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 RESPONSE 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

Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) have moved to dismiss, arguing that U.S. Reissue Patent No. 48,206 (“the ’206 Patent”) violates the rule against recapture under 35 U.S.C. § 251.

However, Samsung’s complaint was already raised *and addressed* during the prosecution of the ’206 Patent. Specifically, on September 30, 2019, the USPTO issued an Office Action rejecting the then-pending claims under § 251 for allegedly recapturing subject matter surrendered during the prosecution of U.S. Patent No. 8,022,870 (“the ’870 Patent”). In response, the patentee conversed with not one *but three* USPTO Examiners—including the primary examiner’s own supervisor—and together they all agreed on amended claim language to explicitly overcome the rejection under § 251. As later stated by the Primary Examiner: “The previous rejections based upon impermissible recapture under 35 U.S.C. 251 are withdrawn due to the corrected reissue declaration filed with the amendment of December 30, 2019.” *See* Ex. A at 9 (04-01-2020 Office Action in the ’206 Patent).<sup>1</sup>

Contrary to Samsung’s conclusory assertion that all three Examiners somehow erred in subsequently issuing the ’206 Patent, the amended claim language satisfies the legal test for avoiding recapture under § 251. In stark contrast, Samsung’s motion rests on a faulty application of this legal test and a fundamental misreading of the relevant claim language. Accordingly, Plaintiff Nariste Networks Pty. Ltd. (“Nariste”) respectfully requests that the Court deny Samsung’s motion.

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<sup>1</sup> *See also*, Dkt. 23-4 at 000973. Exs. A–D, F and G are excerpts from the file histories of the ’870 Patent and ’206 Patent. The file histories of these patents appear to be included in their entirety as Exs. A and C to Samsung’s brief (Dkt. 23). For convenience, Nariste has included parallel citations to Samsung’s exhibits.

## II. FACTUAL BACKGROUND

Dr. Robert Malaney is the Director of Plaintiff Nariste and the sole inventor of the '870 Patent, which the USPTO issued on September 20, 2011. On December 12, 2016, Dr. Malaney filed U.S. Reissue Application No. 15/376,627 (“the '627 Reissue Application”) as a reissue of the '870 Patent.

On September 30, 2019, as part of the ongoing prosecution of the '627 Reissue Application, the USPTO issued an Office Action explicitly rejecting the then-pending claims under 35 U.S.C. § 251 for allegedly recapturing claim scope that had been surrendered during the prosecution of the '870 Patent. *See* Ex. B at 9-12.<sup>2</sup> In particular, the language allegedly “surrendered” during the prosecution of the '870 Patent recited: “setting a current value of the period of the power-up phase of said GPS dependent on information on the radio position of the mobile device in the wireless network determined from the wireless network.” *Id.*; Ex. C at 7 (11-7-2010 Amendment in the '870 Patent)<sup>3</sup>; *see also* Dkt. 23 at 2.

On November 7, 2019, Dr. Malaney—acting *pro se*—conducted a telephonic interview with the USPTO to discuss the rejections contained in the September 30<sup>th</sup> Office Action. Ex. D at 2 (11-27-19 Applicant Initiated Interview Summary in the '206 Patent).<sup>4</sup> The USPTO's participants included three examiners: Primary Patent Examiner B. James Peikari, Supervisory Patent Examiner Alex Kosowski, and Patent Examiner Michelle Tarae. *Id.* With respect to the pending rejection under § 251, the call participants discussed amending the claim language to recite: “when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless

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<sup>2</sup> Dkt. 23-4 at 000910–13

<sup>3</sup> Dkt. 23-2 at 000286–91

<sup>4</sup> Dkt. 23-4 at 000940

communications network.” Ex. E at ¶ 10 (Declaration of Dr. Robert Malaney); *see also* Ex. F at 10–12 (12-30-2019 Amendment in the ’206 Patent). After considering the issue, the three examiners agreed that the proposed amendment would overcome the rule against recapture, and this language was subsequently incorporated into all pending independent claims. *See* Ex. F at 10–12<sup>5</sup>; Ex. A at 9 (withdrawing the recapture rejection in view of the amended claim language).

On September 15, 2020, the USPTO issued the ’627 Reissue Application as the ’206 Patent, which is currently asserted against Samsung in this lawsuit.

### III. LEGAL BACKGROUND

A patentee may seek a reissue of a patent under the reissue statute, 35 U.S.C. § 251. However, a reissue patent may not be granted to “recapture” subject matter that we surrendered during prosecution to obtain the claims of the original patent. *In re McDonald*, 43 F.4th 1340, 1345 (Fed. Cir. 2022). In other words, “[t]he recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broadier scope* than those claims that were canceled from the original application.” *Ball Corp. v. United States*, 729 F.2d 1429, 1436 (Fed. Cir. 1984) (emphasis in the original).

To determine whether the recapture rule applies to a claim of a reissue patent, the Court applies a three-step test: “(1) whether and in what aspect the reissue claims are broader than the patent claims; (2) if broader, whether those broader aspects of the reissue claim relate to the surrendered subject matter; and (3) if so, whether the surrendered subject matter has crept into the reissue claim.” *McDonald* at 1446. “Violation of the rule against recapture may be avoided under this final step of the analysis if the reissue claims ‘materially narrow’ the claims relative to the

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<sup>5</sup> Dkt. 23-4 at 000953

original claims such that full or substantial recapture of the subject matter surrendered during prosecution is avoided.” *In re Mostafazadeh*, 643 F.3d 1353, 1358 (Fed. Cir. 2011).

#### IV. ARGUMENT

##### A. Samsung’s Argument was Previously Addressed During Prosecution.

Samsung’s assertion that the Examiner erred in allowing the ’206 Patent omits key details. As detailed above in the factual background section, during the prosecution of the underlying reissue application, the USPTO rejected the then-pending claims as unpatentable due to the rule against recapture in 35 U.S.C. § 251. Ex. B at 9-12 (“Claim 49 lacks the following language which was added to claim 23 to overcome rejections based on the prior art during the prosecution of the ’707 application: “current radio position and error of said mobile device”).<sup>6</sup>

After receiving this rejection, the Applicant, Dr. Malaney, initiated an interview with the USPTO Examiners to review all of the rejections in the September 30<sup>th</sup> Office Action, including the rejection under § 251. Ex. D.<sup>7</sup> With respect to the rejection under § 251, the call participants discussed amending pending Claim 37 to recite “dependent on at least one of a current radio position and a position error.” *Id.* (“Every issue in the Office action was discussed”); Ex. E at ¶ 10; Ex. F<sup>8</sup> at 10-12 (amending claim language). Contrary to Samsung’s sparse characterization of this call, the proposed amendment was evaluated by not one but three separate examiners: Primary Patent Examiner B. James Peikari, Supervisory Patent Examiner Alex Kosowski, and Patent Examiner Michelle Tarae. Ex. D. These three examiners duly considered the amendment and agreed that that it would overcome the recapture rejection. *See* Ex. A at 9 (“The previous rejections

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<sup>6</sup> Dkt. 23-4 at 000910–13

<sup>7</sup> Dkt. 23-4 at 000940

<sup>8</sup> Dkt. 23-4 at 000953

based upon impermissible recapture under 35 U.S.C. 251 are *withdrawn* due to the corrected reissue declaration filed with the amendment of December 30, 2019”).<sup>9</sup>

As a result, Samsung’s baseless assumption that “[t]he Examiner may have [mis]interpreted” the amended claim language defies logic. *See* Dkt. 23 at 15 (suggesting that the examiners may have misread the amended language’s recitation of “at least one of” the listed options). The amended language was considered and agreed to by not just one Examiner but by *three* of them. And their decision to withdraw the recapture rejection was not made hastily on a phone call—rather, the Examiners formally withdrew that rejection three months after Dr. Malaney filed the amended claims, after having ample time to consider the amended language. In contrast to the plain facts, Samsung’s insinuation requires this Court to believe that all three Examiners—including the Primary Examiner’s supervisor—repeatedly misread the proposed language over this period. As explained below, given that the amended language overcomes any violation of the rule against recapture, the Court should reject Samsung’s baseless argument.

For the same reasons, the Court should also reject Samsung’s focus on a *different* reissue application, U.S. Reissue Application No. 15/364,195 (the ’195 Reissue Application). Although Section II.B of Samsung’s motion claims that Dr. Malaney “abandoned a related reissue application due to recapture,” this section of Samsung’s brief deliberately omits the fact that the recapture issue was raised by the USPTO for the ’206 Patent, the patent actually asserted in this lawsuit. *See* Dkt. 23 at 4. As a result, Samsung’s bold assertion that Dr. Malaney “never responded to the Examiner’s recapture rejection” is, at best, deliberately misleading. For the asserted patent, the recapture issue was not only raised, it was explicitly addressed and overcome by Dr. Malaney with the approval of an entire team of Patent Examiners. Samsung’s attempt to bury this salient

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<sup>9</sup> Dkt. 23-4 at 000973

fact over ten pages later in its motion only highlights its importance. *See* Dkt. 23 at 15. Additionally, Samsung does not cite any case law even suggesting that the abandonment of a related reissue application is relevant to the rule against recapture. The mere fact that Dr. Malaney elected to streamline prosecution by pursuing one reissue application and abandoning another does not negate the undeniable fact that Dr. Malaney addressed, head on, the USPTO's recapture rejection during the prosecution of the asserted patent.

**B. The '206 Reissue Patent Does Not Violate the Rule Against Recapture.**

As outlined in the legal background section above, courts evaluating the rule against recapture use a three-step test.

*First*, as a purely gatekeeping function, the courts determine whether the reissue claims have an aspect that is broader than the issued claims. If the reissue claims have no broader aspect are narrower, then the inquiry ends and there is no violation of the rule against recapture.

*Second*, if the reissue claims are broader than the issued claims, the courts determine whether those broader aspects of the reissued claims relate to the surrendered subject matter. Under the law, this analysis focuses on the original claim language (*i.e.*, the language surrendered) during prosecution. If the broader aspects of the reissued claims do not relate to the surrendered subject matter, then the inquiry ends and there is no violation of the rule against recapture.

*Third*, if the broader aspects in the reissued claims relate to the surrendered subject matter, the courts determine whether the reissue claims “materially narrow” the claims relative to the original claim language. If the reissue claims satisfy this third step, then there is no violation of the rule against recapture.

Under this three-step analysis, the reissued claims do not violate the rule against recapture.

### 1. First Step of the Recapture Analysis.

Nariste does not dispute that, under the first step of the test for recapture, the aspect of the reissue claims raised in Samsung’s brief is broader than the issued claims. To be clear, under the law, this is only a gatekeeping step and does not end the overall inquiry in Samsung’s favor.

### 2. Second Step of the Recapture Analysis.

Similarly, Nariste does not dispute that, under the second step of the test for recapture, the broader aspects of the reissued claims “relate” to the surrendered subject matter. The pending claims originally recited: “setting a current value of the period of the power-up phase of said GPS dependent on information on the radio position of the mobile device in the wireless network determined from the wireless network.” *See* Ex. C at 7.<sup>10</sup> Following a rejection of that element under the *Lau* prior art reference, the language was amended to read:

setting a current value of ~~[[the]]~~ a period of ~~[[the]]~~ a power-up phase of said GPS  
dependent on information on the radio position of the mobile device in the wireless network  
determined from the wireless network a current radio position and error and adaptive  
predictions of when said GPS should be powered on to meet specifications on positioning  
accuracy and GPS acquisition time; ~~said specifications being statistical bounds.~~

*Id.* Nariste does not dispute that the disputed language from the reissue patent—“when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network”—relates to this surrendered subject matter. *See* Ex. H at 16:12–13 (’206 Reissue Patent, Claim 37).

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<sup>10</sup> Dkt. 23-2 at 000286–91

### 3. Third Step of the Recapture Analysis.

Instead, as previously determined by the USPTO, the rule against recapture is not violated because the reissue claims materially narrow the claims relative to the original claim language. In other words, the Applicant, Dr. Malaney, did not seek to recapture the scope of the claim language surrendered during prosecution of the '870 Patent.

As an initial matter, Samsung's own analysis under this third step is fatally flawed because it 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. 23 at 12 (“Compared to the original '870 patent's **issued claims**, the '206 patent reissue claims are not narrower in any respect that avoids recapture of the surrendered subject matter”) (emphasis added). But Federal Circuit case law is clear that courts must consider the originally pending claims (*i.e.*, the claims that were narrowed), not the claims that eventually issued. *In re Youman*, 679 F.3d 1335, 1345–46 (Fed. Cir. 2012). As held by the Federal Circuit in *Youman*, “[t]he appellee argues that material narrowing should be determined relative to the patented claim, rather than the original claim. We disagree.” *Id.* In reaching this holding, the Federal Circuit noted that “[u]sing the original claim as a frame of reference for determining whether the reissue claim materially narrows is consistent both with case law and the purposes underlying the reissue statute.” *Id.*

Because Samsung improperly compares the disputed language to the issued claim language of the '870 Patent, Samsung fails to properly analyze whether the reissue claims materially narrow the claims **relative to the original claim language**, as required by the law. For this reason alone, the Court should deny Samsung's motion.

Additionally, Nariste notes that under the proper analysis, this third step should be resolved in Nariste's favor. Contrary to Samsung's characterization of the prior art, the *Lau* reference was not relied on by the examiner as disclosing “powering up a GPS module based only on the ‘radio

position’ of the device.” *See* Dkt. 23 at 2. Rather, the Examiner relied on *Lau* as allegedly using “information on the radio position” of the mobile device, as recited in the then-pending claim:

- Setting a current value of the period of the power-up phase of the GPS dependent on information on the radio position of the mobile device in the wireless network and adaptive prediction of when the GPS should be power on to meet specification on positioning accuracy and GPS time (see column 9, lines 12-65).

Ex. G at 5–6 (5-19-2010 Office Action in the ’870 Patent).<sup>11</sup> Accordingly, the amendment made during prosecution of the ’870 Patent can, at most, only be argued to have surrendered the broader “information on the radio position” element that was originally recited in the claims.

Under the correct analysis of the third step, the language of the reissue claims is narrower than the originally pending “information on radio position” language that was surrendered during the prosecution of the ’870 Patent. The ’206 Patent’s recitation of “at least one of a current radio position and a position error” is a narrower subset of the originally recited “information on the radio position” that was surrendered during prosecution of the ’870 Patent. “Information” on radio position would include any kind of related information determined from the wireless network, regardless of whether it is specifically the “current radio position,” such as past and future position information, the type or category of such positions, time duration at a position, a change or deviation in positions, a recorded pattern of positions, etc. For example, as discussed during the prosecution of the ’870 Patent, *Lau* recited “the use of a ‘dead reckoning device’ that attempts to determine the rate of change of location.” Ex. C at 18.<sup>12</sup>

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<sup>11</sup> Dkt. 23-2 at 000264–65

<sup>12</sup> Dkt. 23-2 at 000302

Additionally, the limitation-at-issue from the reissued patent is narrower in other related aspects. For example, as detailed above, the original claims of the '870 Patent recited “setting a current value of the period of the power-up phase of said GPS dependent on information on the radio position of the mobile device.” In other words, the '870 Patent method required determining the “period” at which the GPS should enter the “power-up phase” but did not require actually powering the GPS on, with that being dependent on the current radio position or error, as recited in the reissue patent. *See* Ex. H at 16:12–13 ('206 Reissue Patent, Claim 37).

As a result, the '206 Patent claims are materially narrowed relative to the original claims and, therefore, do not violate the rule against recapture under Step 3 of the recapture analysis. *See In re Mostafazadeh*, 643 F.3d at 1358. Given that multiple examiners from the USPTO reviewed this very issue, Nariste respectfully maintains that the Court should leave their conclusion undisturbed and deny Samsung's motion.

Finally, Nariste notes that Samsung's arguments relating to estoppel are fundamentally incorrect. Contrary to Samsung's assertion, the Applicant, Dr. Malaney, did not admit—either affirmatively or tacitly—that the *Lau* reference disclosed “current radio position” by amending the claims of the '870 Patent to require both “current radio position *and* error.”<sup>13</sup> As a basic analogy, simply stating that a refrigerator “does not include milk and eggs” is not an admission that it contains “milk.” This is also not a situation where an applicant overcame a rejection of A by requiring both A *and* B. Instead, as detailed above, the sub-term “current radio position” was not in the original claim language that was surrendered during prosecution of the '870 Patent. Samsung's argument is simply a repackaged attempt to improperly compare the disputed language to the issued claims of the '870 Patent, rather than to the subject matter that was surrendered.

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<sup>13</sup> As described above, *Lau* was distinguished on the basis that it recited “the use of a ‘dead reckoning device’ that attempts to determine the rate of change of location.” Ex. C at 18.

Indeed, in *Youman*, the Federal Circuit acknowledged that the reason to look to the original claims rather than the issued claims is that an applicant may surrender more than is necessary to overcome prior art. As explicitly stated by the Federal Circuit: “[b]y 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.” *In re Youman*, 679 F.3d at 1346; *see also In re Richman*, 409 F.2d 269, 274–75 (Cust. & Pat. 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.”). For this reason, the Court should reject Samsung’s improper application of the law and deny its motion to dismiss.

## V. CONCLUSION

As detailed above, the issue of recapture was front-and-center during the prosecution of the asserted patent. Together, the Applicant and three individual Patent Examiners considered the issue and the proposed amended language. After giving the issue due consideration, the USPTO agreed that the amended language overcame the rule against recapture and withdrew the rejection. As a result, Samsung’s motion, at its core, rests on the suggestion that those three examiners were all wrong. However, under the law and as agreed by the USPTO, the reissued claims do not violate the rule against recapture. As detailed above, the relevant language of the ’206 Patent materially narrows the subject matter that was surrendered, which is all that is required under the law. In contrast, Samsung’s attempts to shift the analysis to a comparison of the reissued claims to the issued claims of the ’870 Patent is legally erroneous and contrary to Federal Circuit law. As a result, this Court should deny Samsung’s motion to dismiss.

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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 2, 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  
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