

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

SLYDE ANALYTICS, LLC
Patent Owner.

Case No. IPR2024-00002
U.S. Patent No. 9,651,922

**PRELIMINARY REPLY IN SUPPORT OF SAMSUNG'S
PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 9,651,922**

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UPDATED LIST OF EXHIBITS¹

Ex. No.	Description
Ex-1001	U.S. Patent No. 9,651,922 (“the ’922 Patent”)
Ex-1002	Declaration of Dr. Benjamin Bederson
Ex-1003	Curriculum Vitae of Dr. Benjamin Bederson
Ex-1004	Prosecution History of the ’922 Patent (Application No. 13/334,823)
Ex-1005	U.S. Patent Application Publication No. 2008/0168368 (“Louch”)
Ex-1006	U.S. Patent Application Publication No. 2006/0097991 (“Hotelling”)
Ex-1007	U.S. Patent No. 6,449,219 (“Hepp”)
Ex-1008	Linux Watch, https://researcher.watson.ibm.com/researcher/view_group_subpage.php?id=6102 (last visited Sept. 29, 2023).
Ex-1009	U.S. Patent No. 4,165,575 (“Neilsen”)
Ex-1010	U.S. Patent No. 8,296,684 (“Duarte”)
Ex-1011	U.S. Patent Application Publication No. 2008/0062207 (“Park”)
Ex-1012	U.S. Patent No. 6,714,486 (“Biggs”)
Ex-1013	Howard Anton, <i>Calculus</i> (2nd ed. 1984)
Ex-1014	U.S. Patent No. 8,344,998 (“Fitzgerald”)
Ex-1015	Haptic, https://www.merriam-webster.com/dictionary/haptic (last visited Sept. 27, 2023).

¹ Four-digit pin citations that begin with 0 are to the page stamps added by Samsung in the bottom right corner of the exhibits. All other pin citations are to original page, column, paragraph, and/or line numbers.

Ex. No.	Description
Ex-1016	Active-matrix liquid-crystal display, https://en.wikipedia.org/wiki/Active-matrix_liquid-crystal_display (last visited Sept. 27, 2023).
Ex-1017	Display device, https://en.wikipedia.org/wiki/Display_device (last visited Sept. 27, 2023).
Ex-1018	Palm (PDA), https://en.wikipedia.org/wiki/Palm_(PDA) (last visited Sept. 27, 2023).
Ex-1019	U.S. Patent Application Publication No. 2009/0199241 (“Unger”)
Ex-1020	Claim Mapping Table
Ex-1021	Chandra Narayanaswami et al., IBM’s Linux Watch: The Challenge of Miniaturization 33-41 (2002).
Ex-1022	U.S. Patent Application Publication No. 2009/0199130 (“Tsern”)
Ex-1023	Benjamin B. Bederson & James D. Hollan, Pad++: A Zooming Graphical Interface for Exploring Alternate Interface Physics 17-26 (1994).
Ex-1024	David Rogers, Feimo Hou, Chandelle Vuolo & Benjamin B. Bederson, Tossing Objects in a Desktop Environment (1996).
Ex-1025	Benjamin B. Bederson, Fisheye Menus 217-225 (2000)
Ex-1026	Leslie E Chipman, Benjamin B. Bederson & Jennifer A. Golbeck, SlideBar: Analysis of a linear input device 1-9 (2004).
Ex-1027	Hilary Browne et al., Designing a Collaborative Finger Painting Application for Children (2000).
Ex-1028	Pekka Parhi, Amy K. Karlson & Benjamin B. Bederson, Target Size Study for One-Handed Thumb Use on Small Touchscreen Devices 203-210 (2006).
Ex-1029	Amy K. Karlson, Benjamin B. Bederson & José Contreras-Vidal, Understanding One-Handed Use of Mobile Devices 1-22 (2007).

Ex. No.	Description
Ex-1030	Test of Time Awards, https://ieevis.org/year/2021/info/awards/test-of-time-awards (last visited Oct. 3, 2023).
Ex-1031	Test of Time Awards, https://ieevis.org/year/2022/info/awards/test-of-time-awards (last visited Oct. 3, 2023).
Ex-1032	Takeo Igarashi & Ken Hinckley, Speed-dependent Automatic Zooming for Browsing Large Documents 139-148 (2000).
Ex-1033	U.S. Patent Application Publication No. 2008/0316183 (“Westerman”)
Ex-1034	Stipulation Regarding Invalidity Challenges, <i>Slyde Analytics LLC v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00083-RWS-RSP (E.D. Tex. Jan. 31, 2024), ECF No. 51
Ex-1035	Transcript of PTAB Conference Call on February 20, 2024

I. INTRODUCTION

This paper was authorized by the Board's February 20, 2024 order (Paper 9) to address: (1) PO's unforeseen and unsupportable §325(d) argument and (2) PO's unsupportable *Fintiv* argument in view of Petitioner's *Sotera* stipulation.

II. THE BOARD SHOULD NOT DENY INSTITUTION UNDER §325(d)

A. Patent Owner's Argument Has No Basis In Law

PO erroneously argues published patent application 2006/0097991 ("Hotelling-991"), Ex-1006, which Petitioner relies on as a secondary reference, was considered during prosecution and should preclude institution. POPR, 25-28. PO argues the Examiner considered a *different* Hotelling published patent application 2006/0026535 ("Hotelling-535") that incorporates Hotelling-991's application 10/840,862 by reference. *Id.* Because the Examiner considered Hotelling-535, PO argues the Examiner also must have looked up and considered application 10/840,862. PO's conclusion has no basis in law.

The Manual of Patent Examining Procedure ("MPEP") establishes procedures for citation of considered art. *See* MPEP §707.05. A first, uncited reference does not become "considered" art merely through incorporation by reference in a second, cited reference. *See* MPEP §609.05(a) ("The listing of references in the specification is not a proper information disclosure statement.... [U]nless the references have been cited by the examiner on form PTO-892, *they*

have not been considered.”). Hotelling-991 was not cited in the ’922 patent’s record, so it was not considered. Board precedent confirms this principle. In *Qualcomm v. Daedalus Prime*, IPR2023-00567, Paper 13 at 18-19 (PTAB Oct. 11, 2023), the Board was not “willing to presume” that a prior art reference (Sutardja ’785) was considered by the examiner “simply because it was incorporated by reference” in a different Sutardja reference (Sutardja ’748) that was cited during prosecution. *See also TRW Auto. LLC v. Magna Elecs Inc.*, IPR2015-01013, Paper 9 at 17 (PTAB Oct. 13, 2015) (rejecting §325(d) challenge to grounds based on art incorporated by reference in the challenged patent). Petitioner can find no contrary precedent.²

Even if Hotelling-991 were deemed considered, PO still fails part 1 of the *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“AB”) framework. Specifically, there is no basis to conclude that substantially the same art or arguments were previously before the Office because of “(d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art.” *AB* at 9-10 n. 10 (noting factor (d) of *Becton*,

² Nor does PO’s argument make practical sense. An Examiner cannot reasonably be presumed to have considered every piece of prior art in the record **and** every additional application, patent, and publication incorporated by reference.

Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to §III.C.5, ¶1) pertains to whether the “same or substantially the same” art was presented to the Office). Indeed, none of the alleged novel features PO enumerates with reference to the Notice of Allowance (POPR, 27-28) are features for which Petitioner relies on Hotelling-991, nor is Hotelling-991 alleged to be cumulative of Hotelling-535 (it is not). *See AB* at 9-10 n. 10 (noting factor (b) “the cumulative nature of the asserted art and the prior art evaluated during examination”). Petitioner relied on Hotelling-991 for its teaching that multi-touch matrix displays and touchscreens with a cover made from glass were well known in the art at the time of the alleged invention, an unremarkable fact that PO does not even dispute on the merits. For these additional reasons, §325(d) does not apply.

B. Petitioner Could Not Have Reasonably Foreseen PO’s Argument

Petitioner could not have reasonably foreseen PO’s §325(d) argument. Petitioners cannot reasonably be required to search the record not only for cited art, but to also examine every cited reference for any additional references cited therein, when such incorporated art has “not been considered” as a matter of examination practice set forth in the MPEP. Because PO’s §325(d) argument has no basis in established law, Petitioner could not reasonably have foreseen it.

III. PATENT OWNER'S §314(a) ARGUMENT IS MOOT

On January 31, 2024, Petitioner stipulated in the parallel EDTX litigation that if this IPR is instituted, “Samsung will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in” district court. Ex-1034, 2 (filed February 7, 2024). PO admitted that under “the current guidance we understand that it’s very unlikely that discretionary denial would be, would be granted.” Ex-1035, 5:3-14. PO thus has no basis to impose further costs on Petitioner and the Board to respond to a meritless argument. Director Vidal’s Memo³ is dispositive, stating “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Petitioner’s stipulation makes precisely that representation, and “[u]nder the mandatory *Fintiv* guidance discussed above, this stipulation is dispositive.” *BMW v. Northstar*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023). The only exception is for a stipulation made *after* denial of institution. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (PTAB Sept. 7, 2022) (precedential). Otherwise, Board precedent holds that *Sotera* and the Director’s Memo are not to be questioned, and PO’s discussion of the *Fintiv*

³ Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, 2 (June 21, 2022)

factors is moot. *Meta Platforms, Inc. v. Eight Khz, LLC*, IPR2023-01005, Paper 9 at 12 (PTAB Jan. 9, 2024) (“Patent Owner’s argument essentially attacks the reasoning of *Sotera* itself and the Director’s Memo, which we are bound to follow. Accordingly, Patent Owner’s argument is unavailing.”).

PO’s allegation that Petitioner’s *Sotera* stipulation is untimely is unsupported by any precedent or allegation of undue prejudice. POPR 29-30. Petitioner stipulated within 2 weeks of the POPR in this case. Under similar circumstances, the Board has rejected PO’s argument, stating: “It is within our discretion to permit Petitioner to file a stipulation prior to institution.” *Meta*, IPR2023-01005, Paper 9 at 12 (distinguishing *NXP*, IPR2021-01556, Paper 13 at 4); *BMW*, IPR2023-01017, Paper 12 at 9 (declining to deny institution under §314(a) where Petitioner made a *Sotera* stipulation several days after the POPR). In fact, Petitioner has found no instance in which the Board did not give effect to a *Sotera* stipulation filed in circumstances such as these.

Petitioner filed its *Sotera* stipulation in this case well before the deadline for institution and according to established PTAB practice. Such a stipulation is dispositive under the Director’s Memo. Thus, this petition should not be discretionarily denied.

Respectfully Submitted,

/s/ William M. Fink

William M. Fink (Reg. No. 72,332)

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on February 27, 2024, a true and correct copy of **PRELIMINARY REPLY IN SUPPORT OF SAMSUNG’S PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,651,922** was served in its entirety by filing this document through the PTAB P-TACTS System, as well as by email, on the counsel of record for the Patent Owner.

Lead Counsel	Back-up Counsel
Peter Lambrianakos (Reg. No. 58,279) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 PTAB@fabricantllp.com plambrianakos@fabricantllp.com	Vincent J. Rubino, III (Reg. No. 68,594) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 vrubino@fabricantllp.com
	Alfred R. Fabricant (subject to motion to appear <i>pro hac vice</i>) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 ffabricant@fabricantllp.com

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	Enrique W. Iturralde (Reg. No. 72,883) FABRICANT LLP 411 Theodore Fremd Avenue, Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 eiturralde@fabricantllp.com
	Richard Cowell (Reg. No. 79,143) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 rcowell@fabricantllp.com
	Jacob Ostling (Reg. No. 77,624) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 jostling@fabricantllp.com

Dated: February 27, 2024

Respectfully submitted,

/s/ William M. Fink

William M. Fink (Reg. No. 72,332)
O'Melveny & Myers LLP
1625 Eye Street, NW
Washington, DC 20006
Telephone: (202) 383-5300
Fax: (202) 383-5414
E-Mail: tfink@omm.com
Attorney for Petitioner