

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

SLYDE ANALYTICS, LLC,

Patent Owner.

Patent No. 9,651,922
Filing Date: December 22, 2011
Issue Date: May 16, 2017

Inventors: Jörg Hysek and Pascal Pozzo Di Borgo
Title: WRISTWATCH WITH A TOUCH SCREEN AND
METHOD FOR DISPLAYING ON A TOUCH-SCREEN WATCH

PATENT OWNER'S PRELIMINARY SUR-REPLY

Case No. IPR2024-00002

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Second Amended Docket Control Order, Dkt. 33, <i>Slyde Analytics LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00083-RWS-RSP (E.D. Tex., October 5, 2023)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Slyde Analytics LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00083-RWS-RSP, served November 14, 2023

I. THE PETITION SHOULD BE DENIED UNDER § 325(d)

Petitioners do not deny that patent application 2006/0026535 (“Hotelling-535”) was considered during prosecution of the ’922 Patent and that patent application 2006/0097991 (“Hotelling-991”), Ex. 1006, is incorporated by reference in Hotelling-535’s Paragraph 0069. Paper No. 11 (“Reply”), at 1; Hotelling-535, [0069]. Petitioners also cannot deny that the Examiner specifically cites to “Hotelling [US-2006/0026535 A1], paragraphs 0068-0069.” Ex. 1004, 0290, 0402 (“see also *Hotelling, paragraphs 0068-0069* [describing and defining single vs. multi touch interfaces, in which multipoint sensing a capable of distinguishing multiple simultaneous touches, which serves as an advantage over single touch input devices]”) (emphasis added); *see also* Ex. 1004, 0403 (“see also Hotelling, paragraphs 0068-0069”). Therefore, the Examiner considered and cited *the same paragraph* that incorporates Hotelling-991 by reference. Neither MPEP §609.05(a) nor the cited case law considers the situation where the exact paragraph that includes the incorporation by reference was cited to by the Examiner.

Petitioners fail to address whether “*substantially the same prior art or arguments* previously were presented to the Office” as required by § 325(d) (emphasis added). Examiner’s Reasons for Allowance stated the claim limitations that were distinguished over Hotelling-535, and therefore, were also distinguished over Hotelling-991 for substantially the same reasons. *See* Paper No. 7 (“Prelim.

Resp.”), 26-28. Petitioners’ Reply also does not address Patent Owner’s § 325(d) argument regarding Louch. *Id.* at 28-29.

Petitioners’ argument that it could not reasonably foresee Patent Owner’s argument is not credible. Hotelling-535 and Hotelling-991 have the same named inventor. It is reasonable to expect a Petitioner to search the prosecution history of the ’922 Patent by the name of the reference being asserted, identify Examiner’s citations to references with the same name, and investigate any relationship between cited references with the same named inventor. Any of these commonplace practices would have allowed Petitioners to foresee Patent Owner’s argument.

Therefore, the Board should deny all Grounds involving Louch and Hotelling.

II. THE BOARD SHOULD DISREGARD PETITIONERS’ LATE SOTERA STIPULATION

A Sotera stipulation is not a carte blanche to sidestep the Board’s discretion to deny institution. This Board may still exercise its discretion to deny institution where Patent Owner shows that it had been prejudiced by the timing of the stipulation. *Accord BMW of N. Am., LLC v. NorthStar Sys. LLC*, IPR2023-01017, Paper No. 12, at 10 (“Patent Owner [does not] allege that it has been prejudiced by the timing of the stipulation. Therefore, we are not persuaded that we should disregard Petitioner’s *Sotera* stipulation because of its timing.”) (footnote omitted).

Patent Owner has been prejudiced by Petitioners’ late Sotera stipulation.

Petitioners filed their Petition on October 9, 2023. Petitioners filed invalidity contentions in the related district court litigation on November 14, 2023, which included the same prior art and combinations relied upon in this proceeding. *See generally* Ex. 2002, at 51-85 (describing various combinations of Louch, Hepp, Duarte, Biggs, Park, and Hotelling). Petitioners' invalidity contentions specifically include a footnote that "Defendants further incorporate its IPR Petition IPR2024-00002 and accompanying exhibits." *Id.*, 51, n.3. Therefore, despite knowing its alleged bases of invalidity, Petitioners filed a Petition with the same bases without a Sotera stipulation. Petitioners only filed a Sotera stipulation on January 31, 2024. The parties are scheduled to exchange proposed claim terms and preliminary constructions on March 22, 2024, and April 19, 2024, respectively. Ex. 2001, at 5.

Petitioners' late filing of a Sotera stipulation forces Patent Owner to litigate validity on the same prior art and combinations in both the PTAB and the district court under different standards (preponderance of the evidence and clear and convincing evidence, respectively), and craft claim constructions based on these standards *prior to* the statutory deadline for institution, April 17, 2024. *Id.*; *see* 35 U.S.C. § 314(b)(1) ("three months after receiving a preliminary response to the petition under section 313"). In view of the prejudice to Patent Owner due to the timing of Petitioner's late Sotera stipulation, Patent Owner's *Fintiv* arguments should be considered, and the Petition should be discretionarily denied.

Respectfully submitted,

Dated: March 1, 2024

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CERTIFICATE OF SERVICE

A copy of PATENT OWNER'S PRELIMINARY SUR-REPLY has been
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