

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

FENDGO, LLC,

Patent Owner

Case IPR2024-00114

U.S. Patent No. 11,265,404

PETITIONERS' REPLY TO PATENT OWNER'S RESPONSE

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<i>Purdue Pharma L.P. v. Faulding Inc.</i> , 230 F.3d 1320 (Fed. Cir. 2000)	5, 6

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,265,404 (“’404Pat.”)
1002	Declaration of William R. Michalson, Ph.D. (“ <i>Michalson</i> ”)
1003	Curriculum Vitae of William R. Michalson, Ph.D.
1004	File History of U.S. Patent 11,265,404
1005	U.S. Provisional Application 60/643,865
1006	U.S. Application 13/897,353
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1025	U.S. Publication 2004/0121756A1 (“ <i>Griffin</i> ”)
1026	U.S. Publication 2004/0137938A1 (“ <i>Deubler</i> ”)
1027	U.S. Patent 7515900B2 (“ <i>Van Camp</i> ”)
1028	U.S. Publication 2006/0201964 (“ <i>DiPerna964</i> ”)
1029	U.S. Patent 10,460,590 (“ <i>Strack</i> ”)
1030	U.S. Patent 10,089,842 (“ <i>Fadell</i> ”)
1031	U.S. Patent 8,032,108 (“ <i>Kuz</i> ”)
1032	Summary of all applications in the ’404 patent’s family
1033	Infringement Contentions served in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (July 13, 2023)
1034	Complaint in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (May 19, 2023)
1035	Order Granting Proposed Docket Control Order in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (August 8, 2023)
1036	Letter from Jin-Suk Park to Jay Nuttall dated November 1, 2023
1037	Transcript of Deposition of George Edwards, Ph.D., dated October 30, 2024

I. INTRODUCTION

Petitioners submit this Reply to Patent Owner's (PO) Response (POR) concerning claims 1-8 ("Challenged Claims") of U.S. Patent No. 11,265,404 ("the '404 patent"). PO's arguments should be rejected and the claims found unpatentable and cancelled for at least the reasons set forth in the Petition and accompanying exhibits, the Board's decision to institute *inter partes* review ("Decision"), the cross-examination testimony of PO's expert Dr. George Edwards, and the other reasons below.

II. PO HAS FAILED TO MEET ITS BURDEN OF DEMONSTRATING THAT *DIPERNA964* AND *STRACK* ARE NOT PRIOR ART

Petitioners met their initial burden to show that *DiPerna964* and *Strack* are prior art to claims 1-8 of the '404 patent. Specifically, the claims are not entitled to priority before January 30, 2019 because the "ready itself" limitation of 1[d] lacks written description support in the '353 application (the '404 patent's parent). Petition at 8-9. At best, the '353 application describes an embodiment in which the mobile device includes a "separate 'safety' switch which, upon being moved into position, readies the panic button to contact 911 upon being pressed." Petition at 9. A POSITA would not have understood the '353 application to disclose activating the panic button merely readies the panic button to perform certain functions (as opposed to,

for example, just performing the functions). *Id.* (citing *Michalson* ¶53). Thus, the burden of production shifts to PO to show that the references are not prior art, such as by **proving** entitlement to an earlier priority date. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). PO failed to carry its burden in its POR.

A. PO’s first argument that the ’404 patent discloses “readying a panic button” is a straw man.

PO first argues that “Petitioners incorrectly argue that the ’353 application does not disclose readying a panic button.” POR at 6. According to PO, “the ’353 application discloses that ‘[t]here can be a separate ‘safety’ switch which, upon being moved into position, readies the panic button to contact 911 upon being pressed.’” POR at 6 (citing Ex. 1006 at 23) (emphasis in original removed). This is a near verbatim rehashing of the same argument PO raised in its Patent Owner Preliminary Response (“POPR”). *Compare* POR at 5-7 *with* POPR at 4-7.

As an initial matter, this argument misrepresents Petitioners’ actual position. Petitioners are not arguing that the ’353 application does not disclose “readying a panic button”; rather, Petitioners argue that there is no written description support prior to January 30, 2019 for the full scope of limitation 1[d], which requires:

[1d] a panic button, adapted to, when activated, **ready itself** to perform the following panic button functions: (1) dialing a public or

private network for an emergency purpose and (2) activating the transmitting unit;¹

Setting aside that PO attacks a straw man, the Board considered this exact argument in its Institution Decision and found that “[o]n this record, Petitioner[s] ha[ve] the better position concerning the ’404 patent’s priority date” because the very passages to which PO cites teach “the ‘safety’ switch to be ‘separate’ from the panic button, not a part of it.” Decision at 17. As the Board correctly recognized, “moving the safety switch into position readies the panic button, which is not the same as the panic button reading itself to perform [the] functions in claims 1-8 of the ’404 patent.” *Id.* The Board faulted PO for failing to “sufficiently address this issue in its assertion.” *Id.* As already noted, the POR merely repeats the same argument nearly verbatim in the POPR and fails to provide any new evidence or argument that would justify the Board reaching a different conclusion now.

B. PO’s second argument about “starting the speech recognition process” also fails.

PO also asserts that the ’353 application discloses an embodiment where ‘the button can start the speech recognition process ... to trigger the device.’” POR at 7 (citing Ex. 1006 at 25). PO argues that this disclosure “means that the panic button

¹ All emphases added unless noted otherwise.

performs the function of ‘start[ing] the speech recognition process,’ without immediately dialing 911 or activating the transmitter.” POR at 7 (citing *Edwards* ¶64). Thus, according to PO, “[i]n this case, the button readies the device to dial 911 by initiating the speech recognition process which would then further trigger the dialing of 911 upon recognition of the correct voice prompt.” POR at 7-8.

But PO has not met its burden of proving that claims 1-8 are entitled to a priority date earlier than January 30, 2019 because PO fails to show that this disclosure supports the full scope of limitation 1[d]. This limitation requires “a panic button, adapted to, when [1] **activated**, [2] **ready itself** to perform” [3] **two** functions: “dialing a public or private network for an emergency purpose” and “**activating the transmitting unit**.” ’404pat., 8:49-52. PO’s argument that the specification discloses an embodiment in which “the button readies the device to dial 911 by initiating the speech recognition process” ignores these three aspects of limitation 1[d].

First, the sentence identified by PO **does not** disclose that “activating” the panic button causes the panic button to “ready itself” to do anything. Nor does it say that “activating” the button starts the speech recognition process. When this sentence is read in context, it merely discloses that, in one embodiment, the button can start the speech recognition process, which allows the panic button to subsequently be **activated** by utterance of “911” or a “code word.” See ’404pat., 3:59-64 (“[a] voice

activation unit may be provided which activates the panic button using a codeword.”). Thus, even if “starting the speech recognition process” allows the panic button to be subsequently activated, the specification does not disclose that “activating” the panic button is what “start[s] the speech recognition process.” Written description support for only part of the limitation is not written description support for the entire limitation. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (to satisfy the written description requirement, “one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims.”); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification.”).

Second, PO’s argument fails to acknowledge that limitation 1[d] requires that the panic button “ready *itself*” to perform the claimed functions. PO asserts that “[i]n this case, the button readies *the device*” to perform a function (POR at 7-8), but PO provides no evidence or argument as to why a POSITA would have considered that equivalent to the claim, which requires the button to “*ready itself*.” *Lockwood*, 107 F.3d at 1572 (although “the exact terms need not be used *in haec verba*, ... the specification must contain an equivalent description of the claimed subject matter.”).

Finally, PO fails to acknowledge that limitation 1[d] requires performance of *two* functions. At best, PO addresses the first function, i.e., “dialing a public or private network,” by noting that “the button readies the device *to dial 911* by initiating the speech recognition process which would then further *trigger the dialing of 911* upon recognition of the correct voice prompt.” POR at 7-8. But this is not sufficient because it ignores that the claim also requires that the panic button “ready itself” to “activat[e] the transmitting unit.” *See Purdue Pharma*, 230 F.3d at 1323; *Lockwood*, 107 F.3d at 1572. The POR is silent as to this requirement of the claim.

Thus, PO has failed to prove that the ’353 application discloses an embodiment in which activation of the panic button readies the panic button *itself* to perform *all* the recited functions.

III. PO DOES NOT OTHERWISE DISPUTE THAT THE CLAIMS ARE UNPATENTABLE

In its Institution Decision, the Board found that “Petitioner[s] ha[ve] shown sufficiently that a POSITA would have combined DiPerna964 and Strack with a reasonable expectation of success” (DI at 22), and that they had “show[n] sufficiently” that the combination of *DiPerna 964* and *Strack* discloses or suggests every limitation of claims 1-8 (*id.* 23-31). As with the POPR, the POR fails to come forward with anything to contest the evidence and arguments in the Petition.

Thus, PO's sole basis for disputing the merits of the Petition is its argument that *DiPerna964* and *Strack* do not qualify as prior art. As explained in Section II, PO has failed to prove that claims 1-8 are entitled to a priority date earlier than January 30, 2019 (i.e., the filing date of the application that issued as the '404 patent). Accordingly, Petitioners submit that they have carried their burden with respect to the unpatentability of the challenged claims.

IV. CONCLUSION

The Board should find the challenged claims unpatentable and cancel them.

Date: November 18, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing Petitioners' Reply to Patent Owner's Response contains 1,483 words, excluding those portions identified in 37 C.F.R. § 42.24(c), as measured by the word-processing system used to prepare this paper.

/Ali R. Sharifahmadian/

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Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on November 18, 2024, I caused a true and correct copy of the foregoing Petitioners' Reply to Patent Owner's Response to be served on the Patent Owner via electronic mail to Patent Owner's counsel of record below:

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