UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner.

IPR2024-00247
Patent 8,825,801

PATENT OWNER'S PRELIMINARY SUR-REPLY

MDT's POPR cited specific portions of the Petition where Meta 1) emphasized that Neibauer and Cheng disclose most if not all of the claim limitations and 2) relied on the additional references only for straightforward ancillary features. POPR, 6-7. Meta's Reply does not deny this, yet tries to walk back its prior position by identifying supposedly important differences in parallel art before the Examiner. Regardless, as MDT noted (and Meta did not deny), step 1 of *Advanced Bionics* can be satisfied by only key references. POPR, 8.

For step 2, Meta's Reply appears to refine its arguments in the Petition regarding what exactly was the Examiner's alleged material error regarding Neibauer and Cheng. Meta's Petition straddled the fence on whether the material error was not relying on Neibauer and Cheng for all limitations or only for limitations the Examiner did not find in the art of record, but as MDT pointed out in its POPR, the latter would require combining Meta's art with the Examiner's, which Meta neither argued nor explained. POPR, 14-15. Meta's Reply appears to jettison that theory, simply arguing that the Examiner should have applied Meta's art wholesale. Reply, 1 ("the Examiner erred by overlooking [the petitioned references] and the compelling grounds of unpatentability they provided"). But that makes Meta's problem worse, as its superficial analysis now fully mirrors the rejected approach in *Vital Connect v. Bardy* (which MDT raised and Meta declined to address) where the petitioner simply argued the petition "presents grounds of

unpatentability not previously considered and/or applied by the Examiner." IPR2023-00381, Paper 7 at 19-20.

And if Meta has not indeed abandoned its prior apparent theory that material error could be shown merely by arguing that the petitioned art supplied specific limitations the Examiner found missing from the art of record, that approach is tautological and says nothing more of substance than reiterating the petitioned grounds as a whole as evidence of material error. A set of issued claims will always have limitations the Examiner found not satisfied by the art of record. A petition should apply art to all limitations of the challenged claims. Meta's approach thus seeks to convert the material error requirement of *Advanced Bionics* from an actual showing by analysis to a simple recitation of words that somehow undercuts the Examiner's discretion and analysis, effectively eviscerating step 2.

Meta further seeks to justify its bare-bones allegations of material error because there was minimal prosecution activity. But that too is circular: as MDT pointed out in its POPR, the fact that the Examiner allowed the claims over the art of record, including Neibauer and Cheng, presumably means that Examiner did not share Meta's opinions on the strength of their disclosures against the challenged claims. MDT further noted that the same Examiner was assigned to all family members, including the six under review here where Niebauer and Cheng were submitted via an IDS, as well as the predecessor '801 Patent reexam involving

Neibauer and Cheng, and thus should be presumed to have been well familiar with Neibauer and Cheng. Meta's Reply actually agrees that the Examiner must have had knowledge of the reexam and its use of Neibauer and Cheng. Reply, 1. The Board should thus decline Meta's invitation to second-guess the Examiner's judgment not to apply Neibauer and Cheng to the claims at issue, particularly since as demonstrated in the POPR, "reasonable minds can disagree regarding the purported treatment of the art or arguments." *Advanced Bionics* at 9.

As MDT noted, Meta very cursorily referenced the '801 Patent reexam in its Petition, without any specific details of why that should have mattered to the challenged claims. Meta's Reply faults MDT's chart showing the vast differences between representative independent claims of the reexam and challenged claims, advancing a supposed obligation to "consider the claims as a whole" (Reply, 2). But Meta then itself simply crop-quotes or paraphrases words in various claims to argue the claim sets were substantially similar after all. *Id.* This handwaving cannot change the fact that the independent claims of the reexam and challenged patents contain completely different limitations. That some of the reexam limitations may also be added in dependent claims is irrelevant to that overall difference in claim scope. Finally, Meta's double patenting argument is undeveloped, was not advanced in the Petition, and does not purport to be in response to MDT's POPR arguments, and thus should be disregarded.

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR 42.6, the undersigned hereby certifies that the above-captioned Patent Owner's Preliminary Sur-reply was served via electronic mail on April 29, 2024, to the following e-mail correspondence of record:

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