

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.
Petitioner

v.

MOBILE DATA TECHNOLOGIES, INC.,
Patent Owner

Case IPR2024-00249
U.S. Patent No. 9,619,578 B2

PETITIONER'S PRELIMINARY REPLY

Petitioner respectfully submits this Preliminary Reply, as authorized by the Board, to address certain issues raised by Patent Owner (“PO”) under § 325(d).

Neibauer, Cheng and Squibbs: Under Part Two, “if ‘the record is not well developed or silent,’” the Petitioner “must simply ‘show [that] the Office [materially] erred by overlooking something.’” *LG Elecs. v. Pantech*, IPR2023-01273, Paper 26 at 15 (PTAB April 9, 2024) (quoting *Advanced Bionics*). The record on *Neibauer, Cheng and Squibbs* is entirely “silent” because the Examiner never addressed them. Petitioner cannot read the Examiner’s mind, so any assertions about what he may have thought about those references would be pure speculation.

As the Petition explained, the Examiner erred by overlooking these references and the compelling grounds of unpatentability they provided. (Petition, 4-5.) Petitioner has filed IPRs against several patents in this family, and this one of the few instances in which a prior art rejection was actually entered (based on *Brandrud*), which the applicants overcame with various amendments. (*Id.*, 5.) *Neibauer, Cheng, and Squibbs* were stronger prior art because they disclosed the limitations the Examiner thought were missing from *Brandrud*. (*Id.*) *Neibauer, Cheng, and Squibbs* disclosed and rendered obvious each limitation of the challenged claims including the “**integrating**” and “**inserting**” limitations highlighted by the Examiner in the Notice of Allowance. (*Id.*) As further evidence of error, the Examiner rejected the claims based on double-patenting grounds over U.S. Patent No. 8,135,801, an earlier

patent in the same family whose claims were invalidated in reexamination based on Neibauer and Cheng. (EX1022, 00252-00254.) The double patenting rejection was based on a finding that the '336 and '578 claims had "common subject matter." (EX1022, 00254.) The Examiner should have appreciated Neibauer and Cheng in light of their use to reject similar claims in the '801 patent.

PO attempts to distinguish the '578 and '801 claims through a two-column chart comparing claim 1 of both patents, but PO fails to consider the claims as a whole. (POPR, 12-13.) The left column highlights limitations in the '801 relating to "**accessibility rules**," but their absence in the challenged claims merely demonstrates that the invalidated claims in reexamination were arguably narrower. The right column highlights limitations of the '578 patent relating to an interface for sharing content with two or more users, which are encompassed by features recited (with additional limitations) in claims 1, 3, and 4 of the '801 patent. (EX1028, 18:31-43, 18:49-19:3.) The PTAB affirmed the obviousness of claims 1-9, 12-13, 15-19 and 21-28 based on Neibauer. (EX1024, 9-12.) The fact that the independent claims are not identical does not diminish the subject matter overlap between the claims of both patents, further demonstrating the existence of material error.

PO asserts that Petitioner did not adequately show the existence of material error under § 325(d), but does not explain else Petitioner could have said on this topic given the prosecution history. *Advanced Bionics* makes clear that if the record

with respect to a reference is “silent,” as it was here, the Petitioner “must simply ‘show [that] the Office [materially] erred by overlooking something.’” *LG Elecs.*, *supra*, at 15. The Petition did this, and more, by explaining the Examiner’s error in overlooking Neibauer, Cheng, and Squibbs, which disclosed the very limitations the Examiner relied upon in allowing the claims.

Ausems: Ausems is materially different from Rensin. Petitioner cited Ausems as “an example of a mobile communications device that, among other things, incorporated a digital camera for *recording, storing, and transmitting* digital images.” (Petition, 23 (*italics added*)). The disclosures of Rensin cited by PO merely identify a camera as a “PDA expansion slot” device, and do not describe the camera’s operation in any detail or state that captured images can be stored and transmitted. (POPR, 9.) Ausems was thus more relevant to the challenged claims and more applicable to a prior art reference (such as Neibauer) that disclosed the ability of the user to upload photos to a remote server.

Harvey: PO’s arguments about Harvey are puzzling considering that it insists the Board need not even consider Harvey. (POPR, 10.) PO also does not identify any other reference that is allegedly similar to Harvey. (*Id.*) In connection with ***other*** IPR petitions, PO argued that Harvey was cumulative of Sutherland (which Petitioner addressed), but PO does not renew those arguments here.

Petitioner's Preliminary Reply
IPR2024-00249

Dated: April 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONER'S PRELIMINARY REPLY** and related documents are being served via electronic mail on the 22nd day of April 2024 upon the Patent Owner's attorneys of record in this proceeding as follows:

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