

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 IPR2024-00251
U.S. Patent No. 10,839,427 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 and Cheng: 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 and Cheng 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.) Neibauer and Cheng were stronger prior art because they disclosed the limitations the Examiner thought were missing from Chow, including the “uploading,” “**reformatting**,” and “**automatically generating**” limitations that he highlighted in the Notice of Allowance. (*Id.*) Petitioner further observed that U.S. Patent No. 8,135,801, an earlier patent in the same family, had its claims invalidated in reexamination based on Neibauer and Cheng. (*Id.*, 5.)

PO attempts to distinguish the ’427 and ’801 claims, but misses the point. The fact that the independent claims are not identical does not diminish the fact that Neibauer and Cheng were expressly used by the PTO and the Federal Circuit to

reject claims in an earlier patent supported by the same written description. This should have provided an additional red flag to the Examiner to pay extra attention to Neibauer and Cheng and their applicability to the '427 patent.

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, which not only contained no mention (let alone discussion) of Neibauer or Cheng, but did not even enter any Office Action rejections based on prior art. *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 that, and more, by explaining the Examiner's error in overlooking these references that disclosed the limitations of the claims, including the limitations the Examiner thought were missing from Chow.

Balabine and Yates: PO's contentions about these references are puzzling. PO does not dispute that these references were not cited during prosecution. (POPR, 10-11.) PO briefly mentions these references in its § 325(d) arguments, but does identify any other reference that is allegedly “substantially similar” to Balabine and Yates. (POPR, 10-11.) Balabine and Yates were thus indisputably not considered under Step One of *Advanced Bionics*.

Petitioner's Preliminary Reply
IPR2024-00251

Dated: April 22, 2024

Respectfully submitted,

COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Avenue NW
Suite 700
Washington, DC 20004
Tel: (650) 843-5001
Fax: (650) 849-7400

By: / Heidi L. Keefe /
Heidi L. Keefe
Reg. No. 40,673
Counsel for Petitioner

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:

Kevin Tuttle
ktuttle@spencerfane.com

Brian G. Strand
bstrand@spencerfane.com

Erick S. Robinson
erobinson@spencerfane.com

Patrick M. Dunn
pdunn@spencerfane.com;

Kyle L. Elliott
kelliott@spencerfane.com

Homayoon Rafatijo
hrafatijo@spencerfane.com

mdt@spencerfane.com

DATED: April 22, 2024

/ Heidi L. Keefe /
Heidi L. Keefe
Reg. No. 40,673
COOLEY LLP
1299 Pennsylvania Ave. NW,
Suite 700
Washington, D.C. 20004
Tel: (650) 843-5001