

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C.,
Petitioner,

v.

ENTROPIC COMMUNICATIONS, LLC,
Patent Owner.

CASE: IPR2024-00373

U.S. PATENT NO. 7,594,249

PATENT OWNER'S PRELIMINARY SUR-REPLY

Exhibits

Exhibit Number	Description
Ex. 2001	Unsubmitted Excerpts of Ex. 1006, Dennis J. Rauschmayer, <i>ADSL/VDSL Principles</i> , 1999 (“ADSL/VDSL”)
Ex. 2002	’249 Patent Reexamination File Wrapper of Application No. 90/019,247
Ex. 2003	U.S. Patent No. 6,795,450 to Mills
Ex. 2004	U.S. Patent Publication No. 2002/0069417 to Kliger
Ex. 2005	U.S. Patent No. 6,005,861 to Humpleman
Ex. 2006	Notice of Intent to Issue Ex Parte Reexamination Certification, Control No. 90/019,247 (May 31, 2024)

Petitioner's attempts to address the discretionary denial analysis that it should have done in the Petition fail to move the needle. The Petition represents a repurposing of the same arguments that have now been twice before the patent office and twice rejected. The Petition represents a third attempt to present the same type of challenge, in a manner that is approaching harassment of the '249 Patent. Even more egregious, Petitioner fails to address the fact that the entire IPR record of this proceeding—Petition, prior art, and declaration—was submitted in the reexamination, and the claims were allowed over not only the *Amit*-based rejections, but also over the *Amit*-based challenges that make up the Petition. Ex. 2002, 798.

A. *Amit* is Cumulative of the Art Presented During Prosecution

The patent office recently found the '249 Patent's claimed subject matter patentable over Petitioner's primary reference, *Amit*. Ex. 2006 (Notice of Intent to Issue *Ex Parte* Reexamination Certification (NIIRC), Control No. 90/019,247). Not only is *Amit* cumulative of the art considered during the original prosecution (Paper 6 at 57-60), but in fact *Amit* is identical to the art the patent office just considered with respect to the '249 Patent. In the recently completed reexamination proceeding, *Amit* was used in substantially the same way as the Petition, and the examiner was presented with the IPR challenge and allowed the claims over these challenges. Accordingly, the Petition's arguments are similarly deficient for those same reasons since Petitioner identifies no error in the reexamination's decision. *Infra* Section C.

In the NIIRC, the patent office found a POSITA would not have modified *Amit*'s reflected signal environment in view of a reference that teaches generic signal processing without any regard for the considerations of the reflected signal environment. Ex. 2006. Accordingly, not only is *Amit* cumulative for the reasons set forth in the POPR, but the reexamination represents an actual finding of patentability over *Amit*, one in which Petitioner fails to identify any material error.

Petitioner relies on a pre-AIA case for assessing the scope of “cumulative” art, ignoring the established practice of the PTAB to look to the teachings of the art that are actually applied to the claims, rather than “additional explanation” that may be found in the cumulative reference. *See e.g., Sandoz Inc. v. Acerta Pharma B.V.*, IPR2023-00478, paper 17 at 15-16 (P.T.A.B. Aug. 7, 2023). Where the Petitioner relies on a teaching of a prior art reference for the same disclosure as was already applied to the claims, the Petitioner's use of that art is cumulative of the art already considered by the Patent Office. *Id.* Petitioner does nothing to distinguish Patent Owner's cited opinions on cumulateness, *Gardner Denver* or *Roku* (Paper 6 at 58).

Contrary to Petitioner's argument, whether *Amit* addresses different problems than those addressed by *Kliger* and *Humpleman* is irrelevant. Paper 7 at 2. Instead, the test is: Are the teachings applied to the claims in the Petition the same teachings previously considered? In this case, they are. Similarly, Petitioner's argument that “*Amit* is not cumulative because it includes relevant disclosures that are not in *Kliger*

or Humpleman” is not persuasive. Paper 7 at 3. While the passage of *Amit* identified by Petitioner (*Amit* at 14:1-5) is in Petitioner’s challenge (Petition at 9, 23), the Petitioner only uses the citation to allege the presence of “reflected signals.” *Humpleman* and *Kliger* (references from the specification and original prosecution) similarly explain the use of reflected signals.

Petitioner’s over-generalization of the notice of allowance does not alter the fact that the Examiner admitted that “Kliger...teaches a home network system in which a module in one room can communicate with modules in other rooms *through a signal reflector unit.*” Ex. 1002, 5. Instead the claims were allowed because “the prior art of record fails to reasonably show or suggest a filter located at the point of entry of a building tuned to reject network signals originating in the building such that the network signals originating in the building do not pass through the filter, but rather are reflected back into the building.” *Id.* Petitioner’s application of *Amit* to the claims is cumulative of the art already considered during original prosecution, the reexamination occurred, and the art presented in the specification. Petitioner’s challenge is nothing more than re-hashing of the same twice-rejected arguments.

B. The Office Already Made Findings Pertinent To This Proceeding

The Patent Office’s recent allowance of Claim 10 out of reexamination over *Amit*, and the entire IPR record, underscores the cumulative nature of the Petition’s challenge. Ex. 2006; Ex. 2002, 798. The Patent Office has considered, and rejected,

a challenge combining a first reference that relates to an in-home cable network and a second reference that describes signal-processing in a different environment.

In the reexamination, the same *Amit* reference (along with an additional primary reference in a second ground, *Afshary*) and another signal processing reference from a non-on-premises reflected signal environment (*Mills*, Ex. 2003) were before the patent office. The patent office properly found that the non-reflected signal environment of the secondary reference (*Mills*) failed to suggest to a POSITA a basis to modify the reflected signal environment reference (*Amit* and *Afshary*) to arrive at the challenged claims. The Petition is similarly deficient.

Like the reexamination challenge, Petitioner's grounds are nothing more than a primary reference that describes a reflected signal environment (*Amit*), and a secondary reference(s) that themselves have no bearing on the environment of the primary reference (*Jacobsen*, ADSL/VDSL, and the DSL-Book).

Petitioner's preliminary reply fails to address the substantive findings of the patent office that *Amit* would **not** have been combined with a non-reflected signal reference (*Mills*). Unlike Petitioner's non-binding precedent, *Pfizer v. Hoffman-La Roche* and *Arthrex v. Vite Tech.* (Paper 7 at 4), the reexamination of the '249 Patent has concluded, and the patent office has made a finding of non-combinability that has significant bearing on this proceeding. Similarly, *Fox Factory, Inc. v. SRAM, LLC*, IPR2017-01439, Paper 7 (P.T.A.B. Dec. 8, 2017) is equally no longer

pertinent, as there is no longer a pending reexamination proceeding.

The reexamination finding is instead more instructive as it confirms Patent Owner's *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH* argument that substantially the same evidence has been presented over and over, and the claims of the '249 Patent continue to be distinguished for the same reasons. IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).

C. *Advanced Bionics Factor 2*

Petitioner does not identify any material error beyond simply alleging that one exists. Paper 7 at 5. Factor 2 is “if either condition of first part of the framework is satisfied, ***whether the petitioner has demonstrated that the Office erred*** in a manner material to the patentability of challenged claims.” *Advanced Bionics*, 8. Petitioner has not demonstrated anything in its 1/3-page treatment of factor 2, let alone identified any error material to patentability. Contrary to Petitioner's allegation, the reexamination did actually review the combination proposed in the Petition (Ex. 2002, 798) and nevertheless allowed the claims over the Petition and its art. Petitioner fails to identify any material error. The Petition should be denied.

The Petition represents nothing more than a third attempt to reargue the same challenge. To preserve the repeated findings of the patent office, and to protect the resources of Patent Owner and the patent office, the Petition should not be instituted.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 7, 2024, a true and correct copy of the foregoing was caused to be served on the following counsel of record for Petitioner by electronic mail at the following address:

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