**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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TRANSCORE, LP

Petitioner,

v.

HAND HELD PRODUCTS, INC.,

Patent Owner.

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Case No: IPR2024-00443
Patent: 8,929,654

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# REPLY TO PATENT OWNER PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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Unable to successfully challenge the Petitions on the merits, PO resorts to attempting to attack the public availability of one of the most well-known and widely distributed industry magazines in the electronics industry. Analog Dialogue has been in continuous publication since 1967 and has been cited by thousands of papers and journals. Indeed, the PTAB has accepted Analog Dialogue articles as prior art in other proceedings, without the need for further corroboration. *See, e.g.*, *Nintendo v. iLife Techs*, IPR2015-00105 Paper No. 35 at 2, 32-33 (P.T.A.B. April 28, 2016).

As published in Analog Dialogue, Katz (Ex. 1006) bears the hallmarks of public availability. Despite PO's feigned ignorance (POPR, IPR2024-00443, Paper No. 8 at 3-9), Katz includes the month and year of publication, the volume number, the publication name, and a link that navigates the reader to the entire library of past and present Analogue Dialogue publications. In short, Katz is not a dissertation or a conference paper, for which dissemination to the public is a genuine question.

Notably, PO does not dispute that Katz was publicly available in 2006, because it cannot. Instead, PO only argues that Petitioner should have submitted more corroborating evidence. While unnecessary for the reasons discussed below, Petitioner does just that with this reply. It would be unjust to allow invalid patent claims to remain in force based on a meritless challenge to a reference that no reasonable party would dispute was publicly available.

### 1. The indicia on Katz's face establishes it as a printed publication.

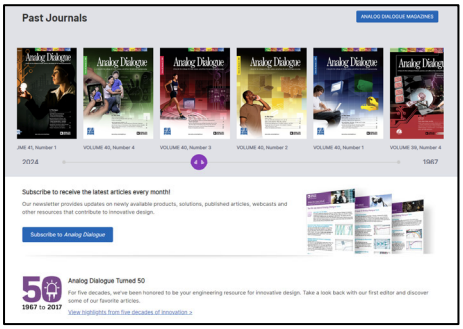
The Board first asks "whether the Petition included sufficient evidence of Katz as a printed publication to satisfy the particularity and evidentiary requirements of 35 U.S.C. § 312(a)." The Petition met this standard.

The Katz article itself—including the indicia on the face of the article—contains sufficient evidence of its 2006 public availability, particularly at institution. The "indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the evidence." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039 Paper No. 29 at 16-18 (P.T.A.B. Dec. 20, 2019). While "no particular indicia per se is sufficient at the institution stage," *id.* at 17, the Board considers indicia such as the name of the journal, the regular distribution of the journal, citation information reflecting the date, the volume number, and a link to the website of the journal as each "hallmarks" of a journal article's public availability. *Grunenthal GMBG v. Antecip Bioventures II LLC*, PGR2018-00092, Paper No. 25 at 16-17; *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1344 & 1347 (Fed. Cir. 2019) (finding "the date on the face of the journal" part of the evidence supporting PTAB's finding that an article was prior art).

Like the Journal of Rheumatology article at issue in *Grunenthal*—found to be publicly available in a final written decision—the indicia on the face of Katz

confirms it was a printed publication. PGR2018-00092, Paper No. 25 at 17. Katz bears the name of a regularly published industry publication, "Analog Dialogue;" the volume number, 40; the month and year of the publication, September 2006; and a link to the Analog Dialogue website, where the article can still be found. *See* Ex. 1006 at 1; Petition, IPR2024-00443 Paper No. 1 at v, 2. That is sufficient evidence at the institution stage.

PO offers no rebuttal evidence contesting that Katz was a printed publication as indicated on its face. *See Grunenthal*, PGR2018-00092, Paper No. 25 at 17 (considering "the lack of evidence supporting PO's position that [the reference] is not a printed publication"). Instead, PO mischaracterizes the evidence. PO navigates the Board to the URL on the face of Katz, and selectively includes only the top-half of the webpage (POPR, IPR2024-00443 Paper No. 8 at 6)—completely omitting the bottom-half displaying the collection of past issues, navigable by the sliding arrow between 1967 and 2024. Not surprisingly, Katz can be found in the September 2006 (Volume 40) journal, as shown in Exhibits 1025 and 1026 submitted herewith.



Ex. 1025 (bottom-half POPR cited webpage (left); Ex. 1026 (Katz article retrievable by clicking Volume 40, Number 3 on same webpage (right)).

PO also misstates the issues in *In-Depth Geophysical* and *Topcon Medical Systems*, neither of which are relevant here. PO incorrectly suggests that *Topcon* stands for the proposition that evidence from the reference, itself, and the Internet Archives are not enough to establish public availability. POPR, IPR2024-00443 Paper No. 8 at 7. *Topcon* concerned the public availability of an ***image*** included in an article, where the article bore its ***submission*** date and where the Internet Archive's (Wayback Machine's) capture reflected the image as a broken link. *Topcon Medical Sys., Inc. v. Carl Zeiss Meditec, Inc.*, IPR2021-00452, Paper No. 14 at 13-14 (P.T.A.B. July 21, 2021). Katz does not bear its submission date; it bears its publication month and year and the volume in which it was published. And the link to the article is not a broken link on the Wayback Machine.

Furthermore, unlike the article at issue in *In-Depth Geophysical*, Katz is not a conference paper for which public distribution is a genuine question. *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper No. 14 at 10 (P.T.A.B. Sept. 6, 2019). Katz is an article published in a well-known and renowned industry trade journal. (Ex. 1027.) Notably, PO cites no cases requiring further evidence of public availability of articles from similar journals.

### 2. Additional evidence corroborates Katz's public availability.

As Katz was published in a well-known industry magazine, Analog Dialogue, the information on the face of Katz shows it was publicly available as a printed publication as of September 2006. However, Petitioner submits the following evidence further corroborating Katz as a printed publication.

First, Petitioner submits a declaration from Mr. Frank-White, showing that the Wayback Machine captured the Katz article (Ex. 1006) by October 26, 2006, corroborating the September 2006 publication date on the article. *See,* Ex. 1028. The PTAB has accepted submissions from the Wayback Machine in other matters. *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374-75 (Fed. Cir. 2021).

Second, Katz was cited by an IEEE article (Ex. 1029 at 628), which was available on IEEE Xplore by September 11, 2009. Ex. 1030 (showing submission to IEEE Xplore). A citation in an article by other authors and published by the IEEE corroborates that Katz was in fact publicly available.

Third, Petitioner submits the complete Analog Dialogue webpage, showing that the URL in the article links to the Analog Dialogue webpage, and that Katz is available in Volume 40—as stated on its face. (Exs. 1026, 1028). Petitioner also submits information confirming Analog Dialogue has been "[p]ublished monthly since 1967" and is "[w]ritten by [e]ngineers for [e]ngineers." (Ex. 1027.)

Respectfully submitted,

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## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on May 8, 2024, a complete and entire copy of this Reply to Patent Owner Preliminary Response and Exhibits were provided via electronic mail to:

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