UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRANSCORE, LP,
Petitioner,

v.

HAND HELD PRODUCTS, INC.,
Patent Owner.

Case No. IPR2024-00443
Patent No. 8,919,654

Patent Owner's Sur-Reply
to Petitioner's Reply to Patent Owner's Preliminary Response

Petitioner's Reply (Paper 9) fails to establish a reasonable likelihood that Katz is a printed publication to support institution based on Grounds 2-3 for two main reasons. First, none of Petitioner's new arguments about Katz's alleged public availability were made *in the Petition* or are supported by *evidence submitted with the Petition*. Second, Petitioner still fails to present any meaningful evidence showing interested persons in the art could have accessed Katz exercising reasonable diligence at the relevant time, despite Petitioner having a second bite at the apple.

To begin, Petitioner correctly does not dispute that the only mention in the Petition concerning Katz's prior art status is an uncorroborated statement that it "published in September 2006." (Paper 2 ("Pet."), 2; Paper 8 ("POPR"), 4-7.) Yet, in responding to the Board's first request concerning the particularity requirements of § 312(a) (Ex. 3001), Petitioner attempts to bolster the record with new unsubstantiated arguments about what the alleged "indicia" in Katz conveys. (Reply 2-4.) However, there was no evidence or related argument submitted with the Petition that supports those assertions (Pet., 2-3, 9-11, 43-68), and Petitioner does not identify where in the Petition such evidence or arguments were made (Reply, 1-5). Instead, Petitioner relies on the premise that the footer in Katz (Ex. 1006, 1) alone conveys the information Petitioner newly contends in its Reply. (*See e.g.,* Reply 2-4.) But this premise is unsupported.

For example, Petitioner alleges (for the first time) that the URL in Katz "navigates the reader to the entire library of past and present Analogue Dialogue publications" (Reply, 1) and that the "website" link in Katz is "where the article can still be found." (Reply, 3). PO previously explained, based on the lack of any argument/evidence presented by Petitioner, that the URL identified in Katz (Ex. 1006, 1 ("http://www.analog.com/analogdialogue")) no longer exists as it redirects a user to a different 2023 (now 2024) URL. (POPR, 5-6.)[1] Showing that Katz may be available *today* (Reply, 3-4 (citing Exs. 1025-1026)) fails to demonstrate how the Petition identified with particularity the accessibility of Katz *at the relevant time*.

Likewise, Mr. Frank-White's declaration (Ex. 1028; Reply, 5) has limited evidentiary value given the URLs identified in the declaration exhibits A-B do not have the same URL as that identified in Katz. (*Compare* Ex. 1006, 1 ("http://www.analog.com/analogdialogue") *with* Ex. 1028, 4-5 (Ex. A ("[]http:/www.analog.com/library/analogDialogue/archives/40-09/rfid.html")), 11-12 ("[]http:/www.analog.com/library/analogdialogue/index.html"), 14 (Ex. B

[1] Petitioner's complaint against PO's reference to excerpts from the website in the POPR misses this point. (Reply, 3-4.) There is still no record evidence showing the URL in Katz provided, at the relevant time, the same library and search functionalities readers may access today at the redirected site.

("[]http:/www.analog.com/library/analogDialogue/archives/40-09/rfid.pdf").) (*See also* Ex. 1028, ¶5 (the "[Archived URL]" follows the date/time codes at the end of such "extended URLs").) Exhibits 1029-1030 are also of limited value. (Reply, 5.) Neither is authenticated, and no further evidence is provided explaining how Exhibit 1030 (bearing a May 2024 access date) relates to the same Exhibit 1029 or whether there were any access restrictions to the content shown in Exhibit 1029.

Petitioner also alleges Katz "bears its *publication* month and year and the volume in which it was *published*." (Reply, 4). But *the Petition* presents no such theory or evidence demonstrating what the "September 2006" date represents. (POPR, 5-7.) Blanket self-serving statements like that in the Petition (Pet., 2 (Katz "*published*" in September 2006)) does not show where "***the Petition*** included sufficient evidence" to satisfy the requirements of § 312(a). (Ex. 3001.)

The cases Petitioner relies upon do not alter this understanding. The Board's consideration of indicia in *Grunenthal* was not as expansive as Petitioner suggests. (Reply, 2-3 (citing PGR2018-00092, Paper 25)) The "hallmarks" in *Grunenthal* were specific to the NPL at-issue and included indicia such as copyright (©) labels and express indications that the article was "published," "available to the public," and where "interested" readers can make relevant inquiries. *Grunenthal* at 16-17. None of these indicia are present in Katz. And unlike in *Grunenthal*, there is no record testimony from someone who accessed Katz before the '654 critical date. *Id*.

at 16. Likewise, the issues in *Telefonaktiebolaget* (Reply, 2) focused on declarant testimony relating to the public accessibility of the NPL-at-issue—not on the "date on the face of the journal" as suggested by Petitioner. (*Id.*) *Telefonaktiebolaget*, 941 F.3d at 1341-48. Petitioner's reliance on *Nintendo* is similarly inapposite (Reply, 1) because there was no Board finding regarding the public availability of the Analog Dialogue document (Samuels) as its prior art status was not disputed. *Nintendo*, IPR2015-00105, Paper 35 at 2, 32-33, 41.

As to accessibility, Petitioner argues that public dissemination does not apply to Katz because it "is not a dissertation or a conference paper." (Reply, 1, 4.) But "public accessibility" is the touchstone in determining whether an NPL reference—not just a dissertation or conference paper—is a "printed publication" (*In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)) and it is Petitioner's burden to show public accessibility by showing, e.g., interested persons could locate the reference exercising reasonable diligence. (POPR, 3-5.) *See*, *e.g.*, *Argentum Pharmaceuticals LLC v. Research Corporation Tech., Inc*., IPR2016-00204 at 9-10 (May 23, 2016); *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350. *See also Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 4-5, 8-13 (discussing a *textbook*, which is neither a conference paper nor dissertation).

Despite PO flagging public accessibility as an issue (POPR, 4-5, 7), Petitioner still fails to provide any meaningful evidence demonstrating that interested persons

in the art could have located Katz at the relevant time. Petitioner argues that Katz is an article published in a "well-known and renowned industry trade journal." (Reply, 4 (citing Ex 1027).) But like its other new evidence, Exhibit 1027 is of little evidentiary value. The unauthenticated exhibit describes how frequently Analog Dialogue ("AD") submissions were provided—not their reach or popularity to interested persons in the art. That is insufficient to demonstrate how renowned AD was at the relevant time, or how interested artisans could have accessed Katz using reasonable diligence at that time. The other newly submitted exhibits fail for the same reason. (Exs. 1025-1030.)

Thus, even if considered, none of Petitioner's exhibits and belated arguments establish Katz as a printed publication under the law. Indeed, Petitioner did not present sufficient evidence for either (i) the wide public distribution of AD (in which Katz was allegedly provided) or (ii) that interested and ordinary skilled persons could have located Katz exercising reasonable diligence at the relevant time. This failure, along with the other deficiencies noted above and in the POPR,[2] supports PO's arguments that Grounds 2-3 do not support institution. (POPR, 3-9.)

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[2] Petitioner did not reconcile the contradiction the Petition introduces to its printed publication arguments in representing that Katz incorporates by reference Exhibit 1009, which is a **2017** document. (*See* POPR, 15-16; Pet., 2-3.)

Respectfully submitted,

Dated: May 15, 2024

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CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response by electronic means on May 15, 2024 to the following:

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