

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTeK COMPUTER INC.; ASUS GLOBAL PTE. LTD.;
DELL TECHNOLOGIES INC.; DELL INC.; AND HP INC.
Petitioners

v.

LITL LLC,
Patent Owner

Case IPR2024-00532
U.S. Patent No. 8,289,688

**PETITIONERS' PRELIMINARY REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Pursuant to the April 8, 2024 e-mail from the Board, Petitioners respectfully submit this Preliminary Reply to Patent Owner’s Preliminary Response (“POPR”) to address Patent Owner’s arguments regarding co-pending *Ex Parte* Reexamination No. 90/015,035 (“EPR”) and quotation of MPEP § 2258.IV.B in Patent Owner’s argument for discretionary denial under § 325(d).

This Petition challenges Claims 1-10 and 23 of the ’688 Patent. In the EPR, the Office has rejected all other claims of this patent (except Claim 29, which Patent Owner had previously disclaimed) in a final office action citing prior art that includes the prior art of record in this Petition. (Exh. 1011 at 2.) In the Petition, Petitioners argue that the two-part framework in *Advanced Bionics* does not apply here because (1) the same art was previously presented to the Office against only the other claims of this patent, alleviating the concerns of duplicative efforts and due deference to prior evaluations by the Office underlying Section 325(d), and (2) the material error requirement applies only if the challenged claims have survived a prior challenge citing the same art, as was the case in *Becton, Dickinson*. (Paper 1 at 57-58.)

Despite admitting “that Lenovo did not request that the Office reexamine the claims of the ’688 Patent challenged here,” Patent Owner contends that “the Office made a ‘decision’ and chose to not reexamine and reject the claims challenged here,” merely because MPEP § 2258.IV.B grants the Office “the sole discretion” in “[t]he decision to reexamine any claim for which reexamination has not been requested.”

(Paper 9 at 30; *see also id.* at 32.) Patent Owner further contends that Petitioners do not even allege that the Office made a material error in this “decision.” (*Id.* at 31-34.) Patent Owner apparently reasoned (incorrectly) that because the Office had the discretion to include claims for which reexamination was not requested, the fact that the challenged claims here were not reexamined in the EPR must mean that the Office had somehow decided to exclude them from the EPR.

However, this logical fallacy is soundly refuted by the preceding paragraph of § 2258.IV.B, which tellingly is not referenced in the POPR. That paragraph states, in relevant part:

The Office’s determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the “live” claims ... for which reexamination has been requested. If the requester was interested in having all of the claims reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexamination was not requested under 35 U.S.C. 302 will generally not be reexamined by the Office.

MPEP § 2258.IV.B (emphasis in original). Thus, the MPEP makes clear that the challenged claims here were absent from the EPR by default, rather than an Office decision to exclude them, as Patent Owner incorrectly contends.

Moreover, the Order Granting the Request for Reexamination confirms that the Office did not consider or make a decision to exclude the challenged claims here from the EPR. (Exh. 1009 at 2 & 13-45 (discussing only the other claims of the '688 Patent).)

For the foregoing reasons, Petitioners submit that discretionary denial under Section 325(d) is not warranted here.

Respectfully submitted,

/s/ Raymond K. Chan
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CERTIFICATE OF COMPLIANCE

I, the undersigned, hereby certify that the above Petitioners' Preliminary Reply to Patent Owner's Preliminary Response complies with the type-volume limitations of 37 C.F.R. § 42.24(a)(1)(i). Exclusive of the portions exempted by 37 C.F.R. § 42.24(a)(1), this Petition, including footnotes, contains 561 words as counted by the word count function of Microsoft Word.

Dated: April 12, 2024

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CERTIFICATE OF SERVICE

I, the undersigned, hereby certify that a copy of the above Petitioners' Preliminary Reply to Patent Owner's Preliminary Response of U.S. Patent No. 8,289,688 was served on April 12, 2024 via electronic means, as agreed by the Patent Owner, at the following email addresses:

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