

Filed on behalf of Patent Owner by:

Paper No. ____

Richard F. Giunta, Reg. No. 36,149
Gerald B. Hrycyszyn, Reg. No. 50,474
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210
(617) 646-8000 Phone
(617) 646-8646 Fax

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC., and ASUS GLOBAL PTE. LTD., DELL
TECHNOLOGIES INC., DELL INC., AND HP INC.

Petitioners,

v.

LITL LLC,
Patent Owner.

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

PATENT OWNER'S PRELIMINARY SUR-REPLY

The Patent Owner Preliminary Response (“POPR”) demonstrated that “Petitioners did not even attempt [to] mak[e] the ‘required’ showing of material error.” POPR, 31-35. The only proper reply would have been to identify where the *Petition* made that required showing. Instead the Reply seeks to excuse Petitioners’ failure by incorrectly suggesting “the challenged claims here were absent from the [Lenovo reexam] by **default**, rather than an Office decision to exclude them.” Reply, 3.¹ That is a mischaracterization of MPEP § 2258.IV.B (which does not create such a “default” rule). This “default rule” argument requires the Board to believe the Office did not know that rejecting the claims challenged here was an option, so it “defaulted” to no rejection. Nothing supports that the Office did not know of the option under MPEP § 2258.IV.B to reject those claims. Thus, the Office **decided** to **not** use its discretion to reject those claims.

There is no dispute that the Petition relied on the same art Lenovo relied on in a prior reexam of the same patent (satisfying *Advanced Bionics*’ first prong), and there is no dispute that the Petition failed to even allege why the Office erred in the reexam (meaning Petitioners failed to make their required showing under *Advanced Bionics*’ second prong). Discretionary denial under § 325(d) is thus appropriate. POPR, 29-35.

Petitioners do not dispute that, under *Advanced Bionics* first prong: this is a

¹ Emphasis added unless otherwise noted.

serially filed challenge to the ‘688 Patent (*id.*, 29-31); the same prior art Petitioners rely on was used in rejection of other claims in the Lenovo reexam, but the claims challenged here were never rejected (*id.*); Petitioners cite no authority supporting their assertion that the concerns of duplicative efforts and due deference to prior evaluations by the Office underlying Section 325(d) are inapplicable here (POPR, 30); and under MPEP § 2258.IV.B “[o]nce the reexamination was ordered, the Office had the authority to reexamine every claim in the ‘688 Patent” (POPR, 30).

Petitioners do not dispute that under *Advanced Bionics* second prong: the Board generally denies institution when petitioner fails to show material error (*id.*, 31); and Petitioners “did not even purport to comply with the second prong of *Advanced Bionics* by making the ‘required’ showing of material error” (*id.*).

Petitioners also do not dispute that the claims challenged here are of different scope than those rejected in the Lenovo reexam, so there is no reason to assume the unexamined claims would have been rejected in the Lenovo reexam. *Id.*, 32-34.

Petitioners only allege that “*Advanced Bionics* does not apply here” because: Lenovo had not requested reexam of claims challenged here; and that “the challenged claims here were absent from the EPR by *default*, rather than an Office decision to exclude them.” Reply, 1, 3.

First, the Reply mischaracterizes MPEP § 2258.IV.B by arguing it creates a “default” rule that reexam is limited to claims for which reexam is requested. That

is wrong. The MPEP is clear that the “***decision to reexamine any claim for which reexamination has not been requested*** ... lies within the ***sole discretion of the Office***, to be exercised ***based on the individual facts and situation of each individual case***.” MPEP § 2258.IV.B; *see also* POPR 32-35). The portion of the MPEP that the Reply relies on merely states that “reexamination will ***generally*** be limited solely to a review of the “live” claims ... for which reexamination has been requested.” MPEP § 2258.IV.B. There is no “default” rule excluding claims from reexam, which means the Office decided to not reject the claims challenged here and Petitioners needed to show error in that decision.

Second, because it is just as likely the Office did not find the claims challenged here to be unpatentable and ***decided*** to not reexamine them (MPEP § 2258.IV.B—the “***decision*** to reexamine any claim for which reexamination has not been requested ... lies within the sole discretion of the Office”), material error cannot be presumed. *Advanced Bionics*, 8-9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”); *see also* POPR at 32-35.

Petitioners ask the Board to devote its limited resources to addressing this serially filed challenge to the ‘688 Patent based on evidence the Office has already considered, in the hopes that the Board might reach a different conclusion. Institution should be denied.

Respectfully submitted,
LiTL LLC

Date: April 19, 2024

/Gerald B. Hrycyszyn/

Gerald B. Hrycyszyn, Reg. No. 50,474
WOLF, GREENFIELD & SACKS, P.C

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on April 19, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

James Heintz	Jim.Heintz@us.dlapiper.com
Jackob Ben-Ezra	Jackob.Ben-Ezra@us.dlapiper.com
James L. Day	jday@fbm.com
Daniel Callaway	dcallaway@fbm.com
Raymond K. Chan	Raymond.Chan@procopio.com
	Calendar@fbm.com

Date: April 19, 2024

/MacAulay Rush /
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.