

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DIALECT, LLC,
Patent Owner.

Case IPR2024-00752
Patent 8,849,652

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE ’652 PATENT DISCLOSES AND CLAIMS PROCESSING NATURAL LANGUAGE UTTERANCES, AND SYNCHRONIZING A FIRST CONTEXT STACK IN ONE DEVICE WITH A SECOND CONTEXT STACK IN ANOTHER DEVICE AS PART OF THE PROCESSING	3
III.	THE BOARD NEED NOT REACH ANY CLAIM CONSTRUCTION ISSUES TO DENY THE PETITION.....	11
IV.	PETITIONER’S CHALLENGES FAIL ON THE MERITS	14
A.	Overview of Coffman.....	15
B.	Coffman Does Not Synchronize Context Stacks or Context Sets	18
C.	Petitioner’s Ground 1 Fails to Satisfy Synchronizing a First Context Stack (or Context Set) with a Second Context Stack (or Context Set)	20
V.	The Board Should Deny the Petition Based on 35 U.S.C. § 325(d)	23
VI.	CONCLUSION.....	28

TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. MED-EL Electromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (Feb. 13, 2020)	25
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)	24, 26
<i>Google LLC v. Valtrus Innov. Ltd.,</i> IPR2022-01197, Paper 18 (PTAB June 13, 2023)	26, 27

Statutes

35 U.S.C. § 325(d)	3, 23, 24
--------------------------	-----------

Other Authorities

<i>Consolidated Trial Practice Guide</i> (Nov. 2019)	23
--	----

Rules

37 C.F.R. § 42.65(a)	23
37 C.F.R. § 42.107	1
37 C.F.R. § 42.120(a)	1

PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	Patent Owner’s Power of Attorney
2002	U.S. Patent 7,693,720 (“the ’720 Patent”)
2003	U.S. Patent 8,015,006 (“the ’006 Patent”)
2004	U.S. Patent 8,195,468 (“the ’468 Patent”)
2005	U.S. Patent 9,263,039 (“the ’039 Patent”)
2006	U.S. Patent 9,495,957 (“the ’957 Patent”)
2007	Order (Construing Claim Terms), Dialect, LLC v. Amazon.com Inc., Civ. No. 1:23cv581, Dkt. 213 (E.D. Va. Apr. 29, 2024)
2008	U.S. Patent Application Publication No. 2007/0043574 (“Coffman Counterpart”)
2009	Cross-reference between Petitioner’s Citations to Coffman and Coffman Counterpart

Pursuant to 37 C.F.R. § 42.107, Patent Owner Dialect, LLC (“Dialect” or “Patent Owner”) files this preliminary response to the Petition, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-27 of U.S. Patent No. 8,849,652 (the “’652 Patent”), as requested by Google LLC (“Petitioner”), should be denied.¹

I. INTRODUCTION

The ’652 Patent is directed to enabling natural language human-machine interactions with speech inputs. The invention uses context stacks and context stack entries in the course of performing its interpretation of the speech inputs. Central to the invention claimed in the ’652 Patent, when context stacks (or sets of contexts) are present in different devices, the ’652 Patent synchronizes a first context stack or context set in a first device with a second context stack or context set in a second device.

The Petition relies upon a single reference—Coffman—to disclose the claimed “synchronizing.” But Petitioner fails to establish that Coffman synchronizes a “context stack” (or “context set”) in one device with another “context stack” (or “context set”) in another device. Petitioner’s citations to Coffman do not mention “synchronizing” and, instead, just indicate that a master

¹ By submitting this Preliminary Response, no waiver of any argument is intended by Patent Owner. Patent Owner will have a right to file a complete response to the Petition, should the Board institute *inter partes* review. 37 C.F.R. § 42.120(a).

dialog manager in Coffman may instruct a slave dialog manager *to add or update* context in a context stack. Petitioner provides no evidence or reasoning that would establish the stacks or sets themselves in different devices would be synchronized at a particular point in time as required by the claims of the ’652 Patent, which happens to be the precise reason for the Examiner’s allowance of the claims. Ex. 1012, 447 (“the limitation ... is also more narrow in that not only is the context synchronized, but context stacks/sets of distinct devices are synchronized.”) (emphasis in original). In fact, such a result—synchronized context stacks in different devices—is inconsistent with Coffman, which states that “different devices, CVMs or different applications *will have their own ... context stack 217, 217a.*” Coffman, 27:1-2 (emphasis added).

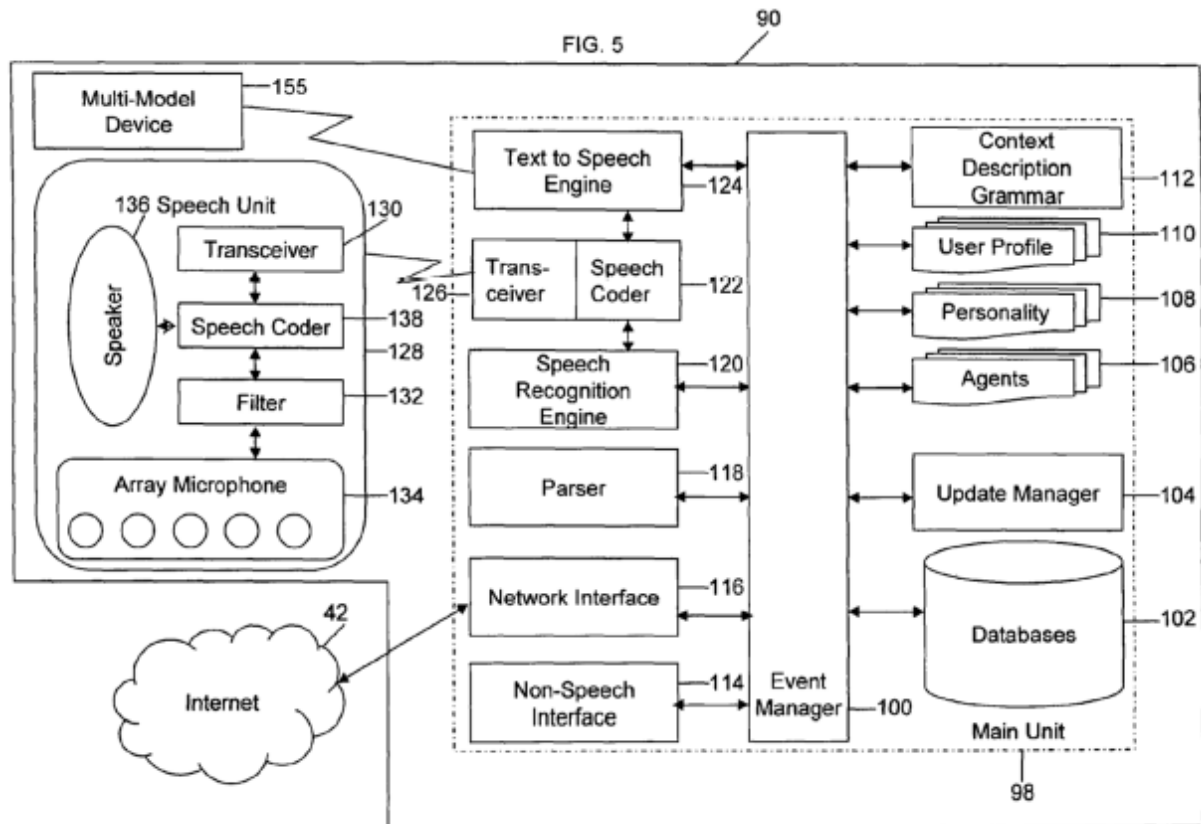
For these reasons, Petitioner’s challenges fail.

The Petition’s substantive failing is not the sole basis to deny the Petition. Petitioner acknowledges that a counterpart to Coffman was cited by the Examiner during prosecution when indicating allowable subject matter relating to the synchronization of context stacks. Pet., 14; Ex. 1012, 171 & 175. Rather than addressing the distinction the Examiner found when allowing the claims—the difference between synchronizing context and synchronizing context stacks or context sets—Petitioner contends that the Examiner’s actions were “unclear” or that the Examiner did not appreciate Coffman’s significance. Pet., 15. To the

contrary, the Examiner could not have been clearer—the prior art considered by the Examiner disclosed synchronizing context but lacked synchronizing context stacks or context sets. Coffman is no different. It may add or update context but nothing in Coffman discloses synchronizing context stacks or context sets. While Petitioner’s challenge plainly fails, the Petition also presents no reason why the Board should discard the Examiner’s reasoned analysis of Coffman’s disclosed subject matter. Thus, the Petition should be denied under 35 U.S.C. § 325(d).

II. THE ’652 PATENT DISCLOSES AND CLAIMS PROCESSING NATURAL LANGUAGE UTTERANCES, AND SYNCHRONIZING A FIRST CONTEXT STACK IN ONE DEVICE WITH A SECOND CONTEXT STACK IN ANOTHER DEVICE AS PART OF THE PROCESSING

The ’652 Patent is entitled, “Mobile Systems and Methods of Supporting Natural Language Human-Machine Interactions.” FIG. 5 of the ’652 Patent, reproduced below, is an overall diagrammatic view of an embodiment of the ’652 Patent:



'652 Patent, FIG. 5, *see also id.*, 15:38-40. The system includes, among other things, a main unit 98, speech unit 128, speech recognition engine 120, context description grammar module 112, parser 118, agents 106, multi-modal device 155 and non-speech interface 114. '652 Patent, 23:38-39, 25:60-65.

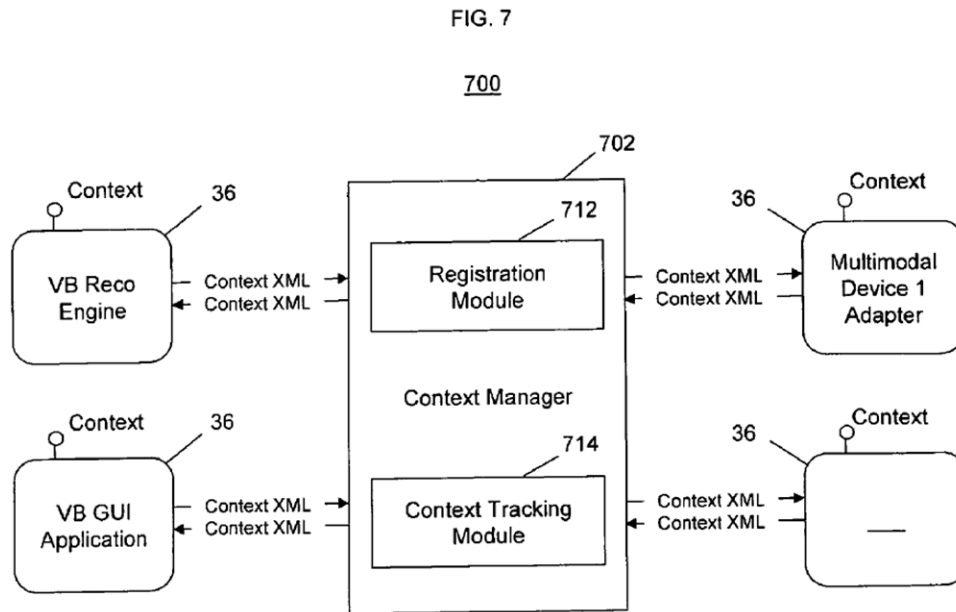
Speech unit 128 includes a microphone to receive a spoken utterance from a user. '652 Patent, 25:50-52. After initial processing, the speech is passed to speech recognition engine 120 for processing. '652 Patent, 26:18-20. Then, “[a]ny recognized information may be processed by the parser 118, which transforms information into complete algorithms and questions using data supplied by knowledge agents.” '652 Patent, 26:20-23.

More particularly, after speech recognition, parser 118 “may determine a context for an utterance by applying prior probabilities or fuzzy possibilities to keyword matching, user profile 110, dialog history, and context stack contents.” ’652 Patent, 34:2-5. “For example, a question with the keywords ‘temperature’ implies a context value of weather for the question.” ’652 Patent, 34:7-8. “Once the context for the question or command has been determined, the parser 118 can invoke the correct agent 156, 150.” ’652 Patent, 34:34-36.

To determine the context, the ’652 Patent discloses the use of a context stack. The context stack “includes an ordered list of command contexts, to enable follow-up requests.” ’652 Patent, 20:10-12; *see also* ’652 Patent, 36:13-14 (“Part of the dialog history is maintained in a context stack.”).).

The system of the ’652 Patent may be incorporated in a plurality of devices. Data and agents may be stored and synchronized in mobile structures 10, mobile devices 36 and/or fixed systems 44 having one or more main speech-processing units 98. ’652 Patent, 17:15-32.

FIG. 7 of the '652 Patent depicts a number of mobile devices 36:



Each mobile device 36 may track context. '652 Patent, 19:32-33. A context manager 702 may be centrally maintained to allow input to and output from multiple mobile devices 36. '652 Patent, 19:34-36.

Generally, the synchronization between different systems in the '652 Patent can occur on the wide area wireless network 38, the data network 42, through the handheld interface 20, or other local data connections. '652 Patent, 17:18-21. The synchronization process attempts to determine which version of a data element or an agent are the newest or most up-to-date and propagates that element. '652 Patent, 17:25-28. Thus, synchronization can be an incremental change process. *Id.*, 17:28-29. In some cases, a complete replacement of a database, a portion of the database or of one or more agents may be performed rather than performing a

series of incremental updates. *Id.*, 17:29-32. The synchronization may be performed automatically when any two or more of the computers are connected to these networks. *Id.*, 17:21-23. Alternatively, the synchronization may be performed on demand under user control. *Id.*, 17:24-25.

In FIG. 7, and with regard to context stack synchronization, each mobile device 36 may communicate with the context manager 702 to register via registration module 712, wherein registration may indicate events that the mobile devices 36 may subscribe to. ’652 Patent, 19:33-39. The context manager 702 may receive input in Context XML form, for example. ’652 Patent, 19:39-41.

Other registered mobile devices 36 may be informed of context changes through context tracking module 714, thereby synchronizing the context across the registered mobile devices 36. ’652 Patent, 19:41-48; *see also* ’652 Patent, 4:27-32.

“The knowledge agents may then process the commands or questions.” ’652 Patent, 26:27-31. Non-speech interface 114 and multi-modal devices 155 may be used as a substitute or complement to the speech interface. ’652 Patent, 26:51-53.

Consistent with the ’652 Patent’s disclosure, independent claims 1 and 14 of the ’652 Patent require synchronization of a context stack, and claim 20 requires synchronization of the context set. Claim 1 recites:

1. A system for processing natural language utterances where recognized words of the natural language utterances alone are

insufficient to completely determine one or more commands or requests, the system comprising:
one or more physical processors programmed with one or more computer program instructions which, when executed, cause the one or more physical processors to:
generate a first context stack associated with a first device, the first context stack comprising context information that corresponds to a plurality of prior utterances;
synchronize the first context stack with a second context stack associated with a second device such that the context information of the first context stack is updated based on related context information of the second context stack;
receive a natural language utterance associated with a command or request;
determine one or more words of the natural language utterance by performing speech recognition on the natural language utterance; and
determine the command or request based on the one or more words and the updated context information.

'652 Patent, Claim 1 (emphasis added).

Claim 14 recites:

14. A computer-implemented method of processing natural language utterances where recognized words of the natural language utterances alone are insufficient to completely determine one or more commands or requests, the method being implemented by a computer system that includes one or more physical

processors executing one or more computer program instructions which, when executed, perform the method, the method comprising:

generating, by the one or more physical processors, a first context stack associated with a first device, the first context stack comprising context information that corresponds to a plurality of prior utterances;

synchronizing the first context stack with a second context stack

associated with a second device such that the context information of the first context stack is updated based on related context information of the second context stack;

receiving, at the one or more physical processors, a natural language utterance associated with a command or request;

determining, by the one or more physical processors, one or more words of the natural language utterance by performing speech recognition on the natural language utterance; and

determining, by the one or more physical processors, the command or request based on the one or more words and the updated context information.

'652 Patent, Claim 14 (emphasis added).

Claim 20 recites:

20. A computer-implemented method of processing natural language utterances where recognized words of the natural language utterances alone are insufficient to completely determine one or more commands or requests, the method being implemented by a computer system that includes one or more physical

processors executing one or more computer program instructions which, when executed, perform the method, the method comprising:

generating, by the one or more physical processors, a first context set associated with a first device, the first context set comprising context information that corresponds to a plurality of prior utterances;

synchronizing the first context set with a second context set

associated with a second device such that the context information of the first context set is updated based on related context information of the second context set;

receiving, at the one or more physical processors, a natural

language utterance associated with a command or request;

determining, by the one or more physical processors, one or more words of the natural language utterance by performing speech recognition on the natural language utterance; and

determining, by the one or more physical processors, the command or request based on the one or more words and the updated context information.

'652 Patent, Claim 20 (emphasis added).

The recitations directed to synchronizing context stacks or context sets in different devices were first presented in dependent application claim 63. Ex. 1012, 127. During examination, the Examiner issued an Office Action finding that the synchronizing requirements presented allowable subject matter, reasoning “the limitation ... is also more narrow in that not only is the context synchronized, but

context stacks of distinct devices are synchronized.” Ex. 1012, 170-71 (emphasis in original). In response to the Examiner’s Office Action, Patent Owner presented the requirements for synchronization of context stacks or sets in the independent claims (Ex. 1012, 186 (claim 50), 191 (claim 64), 194 (claim 70) & 198), and the Examiner passed the application to allowance (Ex. 1012, 446), again reasoning that “the limitation ... is also more narrow in that not only is the context synchronized, but context stacks/sets of distinct devices are synchronized.” *Id.*, 447 (emphasis in original). As acknowledged in the Petition, the Examiner identified Coffman’s U.S. patent counterpart as a cited reference and considered it and Kennewick prior to allowing the ’652 Patent. Pet., 14-15; *see also* Ex. 1012, 175, 216, 224.

III. THE BOARD NEED NOT REACH ANY CLAIM CONSTRUCTION ISSUES TO DENY THE PETITION

The Petitioner identifies no terms as requiring constructions. The United States District Court for the Eastern District of Virginia has issued constructions for the following terms in other patents assigned to Patent Owner (Ex. 2007):

Term	Patent(s)	Claim(s)	Construction
context	'720 Patent	1, 31	"the subject matter area to which a particular user input is directed and which is used to determine the meaning of the user input"
	'006 Patent	1, 2, 4, 5, 10	
	'468 Patent	19, 28	
	'039 Patent	17, 18	
context stack	'006 Patent	2	"a data structure that stores or references contexts in a manner that can be ordered"
	'468 Patent	19, 28	
	'039 Patent	17	
	'957 Patent	1, 3, 4, 7	
entries in a context stack	'468 Patent	19	"elements of a context stack that store or reference contexts"
context entries	'957 Patent	1, 3, 4, 5, 7	"elements of a context stack that store or reference contexts"
grammar	'720 Patent	1, 31	"a set of rules governing how inputs and requests to a domain agent should be structured"
	'006 Patent	1, 5, 10	

IPR2024-00752 Patent Owner's Preliminary Response

context description grammar	'039 Patent	13	"a data structure containing entries constituting or referencing sets of rules, wherein each of those sets describes the structure of natural language in a particular context"
domain agent	'720 Patent	1, 31	"executables associated with a specific domain that receive, process and respond to user questions, queries and commands"
	'006 Patent	1, 2, 5, 10	
	'468 Patent	19, 30, 32	"software with domain-specific behavior and information"
	'039 Patent	13, 14	
procedures sensitive to the determined context	'006 Patent	5	"procedures that differ based on which context has been determined"
Parser	'720 Patent	1, 35	"software that analyzes a string of words"
	'006 Patent	1, 5, 10	

In the table above, the '652 Patent is the parent of U.S. Patent 9,495,957 ("the '957 Patent") (Ex. 2006), and U.S. Patent 8,195,468 ("the '468 Patent") (Ex. 2004) is related to the '652 Patent through a continuation. Ex. 2006, 1-2; '607 Patent, 1. U.S. Patent 7,693,720 ("the '720 Patent") (Ex. 2002), U.S. Patent 8,015,006 ("the '006 Patent") (Ex. 2003), and U.S. Patent 9,263,039 ("the '039 Patent") (Ex. 2005) are each assigned to Patent Owner and share at least one inventor in common with the '652 Patent.

Without waiving its right to submit constructions in a Patent Owner Response, Patent Owner submits that the Board need not engage in any pre-

institution claim construction. For the substantive reasons presented in Section IV below, Petitioner’s grounds include fundamental flaws and fail to establish the disclosure of every claimed element in each independent claim. These findings do not require the Board to conduct any construction of the above-identified terms.

IV. PETITIONER’S CHALLENGES FAIL ON THE MERITS

Petitioner asserts three Grounds in its Petition. Ground 1 is asserted against each independent claim, and contends that claims 1-9, 14-18, and 20-26 are obvious in view of Coffman alone.² Grounds 2 and 3 are not used to shore up the deficiencies of Ground 1 and, instead, are asserted against certain dependent claims. Ground 2 contends claims 10-13, 19, and 27 are obvious in view of Coffman and Kennewick³. Ground 3 contends that dependent claims 13 and 19 are obvious in view of Coffman, Kennewick, and Lee⁴.

As noted above, Coffman’s disclosures were known to the Examiner through Coffman’s U.S. patent publications, and they were specifically identified by the Examiner. *See* Ex. 1012, 175, 216, 224; *see also* Pet., 14-15. The Petition tries to create some mystery with the Examiner’s allowance by alleging that “neither of Coffman’s related U.S. patent publications ... were discussed during prosecution.”

² Ex. 1003, International Patent Application Publication No. WO 00/20962 (“Coffman”).

³ Ex. 1004, U.S. Patent App. Pub. No. 2004/0044516 (“Kennewick”).

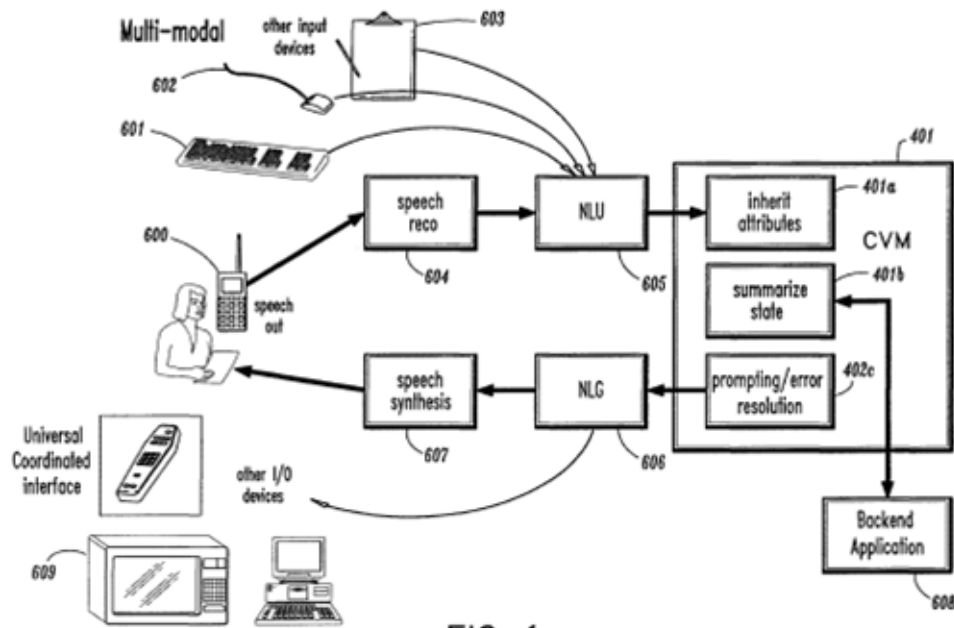
⁴ Ex. 1006, U.S. Patent App. Pub. No. 2002/0087315 (“Lee”).

Pet., 14. But there is no intrigue; the Examiner correctly allowed the claims over Coffman’s counterparts. In fact, the distinction expressly emphasized in the Examiner’s reason for allowance—that synchronizing context does not show synchronization of context stacks or synchronization of context sets—defeats Petitioner’s challenges based on Coffman. As discussed below, Coffman may add context to a context stack or update context in a context stack, but that does not establish that Coffman discloses synchronization of a context stack or context set. Accordingly, Coffman fails to satisfy the synchronization requirements recited in the independent claims.

Thus, Ground 1 is facially deficient in establishing the unpatentability of any challenged independent claim, and Grounds 2 and 3 do not remedy the deficiencies of Ground 1. For the reasons discussed below, the Petition should be denied without institution.

A. Overview of Coffman

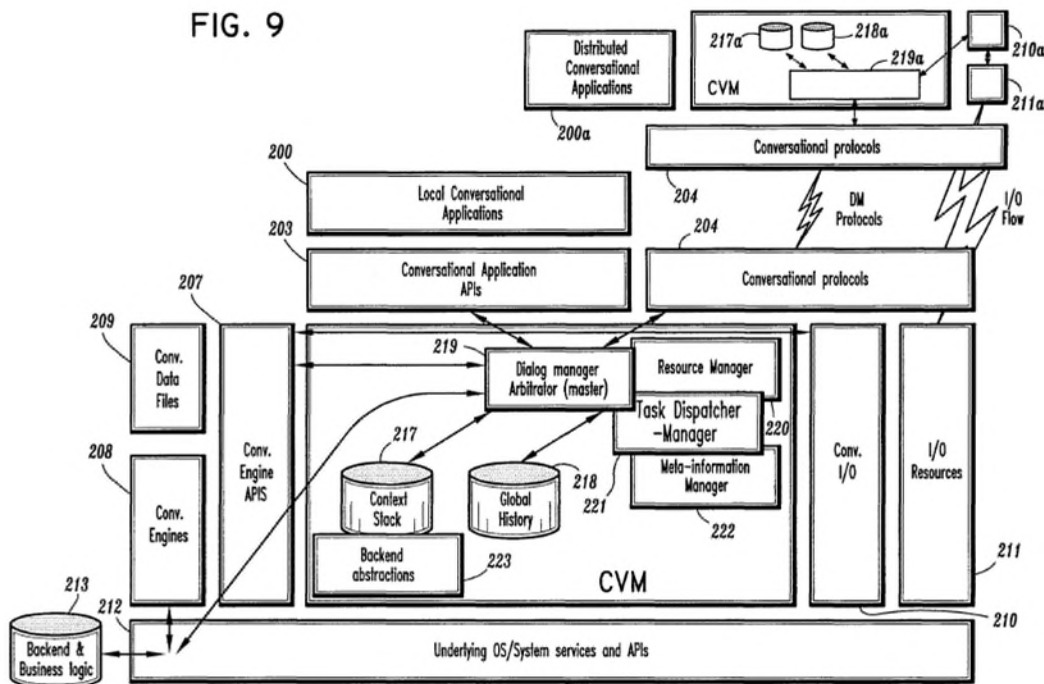
In FIG. 6, reproduced below, Coffman discloses a conversational input/output interface (Coffman, FIG. 6 & 37:14-29):



The conversational input interface according to Coffman can process multi-modal inputs, such as files/streams/resources, speech via a phone 600, keyboard 601, pointing devices 602, and handwriting devices 603. The modalities are caught and transferred to a dialog manager that causes the inputs to be stored in the context stack. Spoken input from a speech client is subject to a speech recognition process 604 and other input are subject to NLU processing 605.

As illustrated in FIG. 9, reproduced below, the conversational protocols of Coffman include protocols for information exchange between dialog managers (DMs) of networked devices (Coffman, 26:28-30):

FIG. 9



When applications are networked (distributed applications 200a), dialog management protocols are used for exchanging information to determine which dialog manager (219 or 219a) will execute a given function. Coffman, 26:30-27:1. As Coffman explains, typically, “different devices, CVMs or different applications *will have their own* dialog manager, *context stack 217, 217a* and global history 218, 218a.” Coffman, 27:1-2 (emphasis added).

Through the dialog manager DM protocols, the different dialog managers will negotiate a topology. Coffman, 27:2-5. An active master dialog manager (illustrated as dialog manger 219 in FIG. 9) will be responsible for managing the

flow of I/O to the different managers to decide the active dialog and appropriately execute a query and update the context and history. Coffman, 27:5-7.

B. Coffman Does Not Synchronize Context Stacks or Context Sets

Although Coffman provides a system with context stacks and allows for additions and updates to those context stacks, Petitioner’s theories do not identify synchronization of a context stack or context set in a first device with a context stack or context set in a second device in Coffman. In this regard Coffman is unlike the ’652 Patent, which seeks to determine “which version of a data element ... or an agent are the newest or most up-to-date and propagates that element” (’652 Patent, 17:26-27), and which can entail “complete replacement,” rather than a series of incremental updates (*id.*, 17:29-32), and, in particular, synchronizes a context stack across different devices (*id.*, 4:29-32 & 19:41-44).

More particularly, Petitioner cites portions of Coffman dealing with a device instructing another device to add context entries (*see, e.g.*, Pet. 30-31 & Ex. 1002, ¶70 (each citing Coffman, 25:10-14)) and to update context, but Petitioner fails to explain how those activities in Coffman would result in synchronization of context stacks or context sets in the devices.

Coffman’s failure to disclose synchronization of context stacks or context sets stands in contrast to its other detailed disclosures regarding what information can be exchanged between the different dialog managers and why that information

is exchanged. When describing the protocols for the operation of the different dialog managers in Coffman’s system, Coffman lists at least fifteen (15) items of information that *can be—not must be*—exchanged between the different dialog managers in Coffman’s system. Coffman, 27:7-22. None of this information is required to be exchanged, and Coffman also fails to disclose any “synchronization” protocol to synchronize any of these fifteen items among different context stacks in different devices.

Not only does Coffman provide for the non-mandatory exchange of information, Coffman even allows the individual dialog managers the choice to act *or not act* on received information when managing their own context stack, since “different devices, CVMs or different applications ***will have their own ... context stack 217, 217a.***” Coffman, 27:1-2 (emphasis added). For example, Coffman states that the dialog managers provide “notification of I/O events such as ... addition to contexts” (Coffman, 27:12-13 (item 5)), which allows the recipient to act on the notification *without requiring any synchronization* of the entire context stack. Similarly, Coffman allows for “transfer of ... ***proposed*** context changes” (Coffman, 27:16-18 (item 11) (emphasis added)) and data associated with the proposed context changes (Coffman, 27:19-20 (item 15) (“data files, context and state updates due to action”). Coffman’s use of the term “proposed” rather than “required” illustrates that Coffman does not require any synchronization of

individual context items, much less synchronization of the context stack. Items 12 and 14 provide context update and context change notifications but, again, do not require any synchronization of the context stack. *See* Coffman, 27:16-18 (item 12: “decision notification, context update, action update, state update, etc.” & item 14: “notification of context changes”).

C. Petitioner’s Ground 1 Fails to Satisfy Synchronizing a First Context Stack (or Context Set) with a Second Context Stack (or Context Set)

These technical details of Coffman confirm that Coffman fails to disclose every claim requirement of the challenged ’652 Patent claims. In particular, claims 1 and 14 of the ’652 Patent recite a “first context stack associated with a first device” and requires *synchronizing “the first context stack with a second context stack* associated with a second device.” Similarly, claim 20 recites a “first context set associated with a first device” and “*synchronizing the first context set with a second context set* associated with a second device.”

Petitioner relies on Coffman to assert that Coffman “makes clear” these limitations are satisfied, arguing (Pet. 30-31) (emphasis in original):

Coffman further makes clear that a master device’s context stack ... is ‘**synchronized**’ with a slave device’s context stack ..., explaining:

With a master/slave network configuration, the master dialog manager can compile all the lists and match the functions and needs with conversational capabilities. In

addition, context information may be transmitted by indicating passing or pointing to the context stack/history of the device or application that the controller can access and add to its context stack.

(Coffman, 25:10-14; Schmandt, ¶70.) Coffman further explains that, using dialog manager protocols, devices can exchange various kinds of information, including notification of “addition to contexts,” “context update” and “notification of context changes.” (Coffman, 27:7-20.)

But as introduced above in Section IV.B, none of these passages address synchronizing a “context stack” or “context set” in one device with another “context stack” (or “context set”) in another device. They certainly do not “make clear” that any synchronization is occurring and do not even mention “synchronizing.”

Instead, the actions cited in Coffman indicate that the master dialog manager may instruct a slave dialog manager *to add* or *update* an entry to its context stack, but Coffman does not disclose or suggest that the stacks themselves would be synchronized as required by the claims of the ’652 Patent. Petitioner has not shown, or even attempted to explain, that the activities of “addition” to a context stack or updating existing information for a context entry in context stack would necessarily or inherently produce two context stacks that are synchronized, *e.g.*, at a particular point in time.

Even viewed in the best light for Petitioner, Petitioner’s theory cannot overcome the very *distinction* the Examiner emphasized between the cited art (which included Coffman) and the allowed claims in the ’652 Patent—that a showing of even an individual context synchronization does not show that “context stacks/sets of distinct devices are synchronized.” Ex. 1012, 447 (emphasis in original).

Moreover, not only do Coffman’s passages at 25:10-14 and 27:7-20 fail to “make clear” that Coffman possesses synchronous context stacks in different devices, but Coffman itself contradicts Petitioner’s theory when stating that “different devices, CVMs or different applications *will have their own ... context stack 217, 217a.*” Coffman, 27:1-2. As noted above, the protocols for information exchange between different dialog managers propose, rather than require, context changes (Coffman, 27:16-18 (item 11)), making Petitioner’s unsupported leap—from Coffman’s instruction to add or update a context entry, to the synchronization of a context stack or context set—untenable.

Also, Petitioner does not present any argument or expert testimony concerning the desirability of synchronized context stacks in Coffman. In providing testimony regarding the “synchronize” requirement of the challenged claims, Petitioner’s expert merely parrots the language of the Petition (*compare* Pet. 30-31 *with* Ex. 1012, ¶70) without providing any basis for the opinion

presented. Petitioner’s expert and does not state any benefit, use, or improvement that would be achieved to Coffman if synchronized context stacks were present in Coffman (which they are not), or any additional reasoning why Coffman’s disclosure would lead a POSITA to understand that Coffman discloses or suggests the required synchronizing of context stacks or context sets. In the face of such unsupported and conclusory testimony, Petitioner’s argument and its expert’s testimony should not be relied upon. *Consolidated Trial Practice Guide* at 36 (Nov. 2019) (“expert testimony cannot take the place of disclosure from patents or printed publications”); 37 C.F.R. § 42.65(a).

Thus, the Petition fails with regard to Ground 1 and independent claims 1, 14, and 20, along with corresponding dependent claims 2-13, 15-19, and 21-27. Grounds 2 and 3, which are dependent on the success of Ground 1’s challenges to the independent claims, also necessarily fail, particularly as Petitioner does not contend Kennewick or Lee remedies the deficiencies of Coffman with regard to the claimed synchronization.

V. The Board Should Deny the Petition Based on 35 U.S.C. § 325(d)

Section 325(d) allows the Board to elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. The statute states, in pertinent part, “[i]n determining whether to institute ..., the Director may take into account whether, and reject the petition ... because, the

same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The question of whether a petition presents art or arguments that are “the same or substantially the same” as art or arguments previously presented to the Office is a factual inquiry, which may be resolved by reference to the factors set forth in *Becton, Dickinson. Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”).

The precedential section of that decision sets forth the following non-exclusive factors for consideration:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, 17–18.

Advanced Bionics, LLC v. MED-EL Electromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8, 10, 17-18 (Feb. 13, 2020) (precedential), sets out a two-part framework for analyzing these factors. In the first part, factors (a), (b), and (d) are considered to determine whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, 8-10. “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office,” then the second part of the analysis determines “whether the petitioner has demonstrated a material error by the Office” in view of factors (c), (e), and (f). *Id.* *Advanced Bionics* instructs that “[i]f 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.” *Id.* at 9.

With regard to the first part of the *Advanced Bionics* framework, Petitioner admits that the Examiner cited a counterpart to Coffman (Ex. 2008) in the Office Action that found application claim 63 to contain allowable subject matter. Pet., 14 (citing Ex. 1012, 175). Each citation to Coffman found in the Petition is found in the Coffman Counterpart (Ex. 2008), such that no substantive difference exists between the reference the Examiner cited and the reference Petitioner relies upon in its Ground 1 challenge. *See* Ex. 2009 (demonstrating where each of Petitioner's citations of Coffman are found in the Coffman Counterpart (Ex. 2008)). Thus,

even though Coffman’s counterpart was not itself part of a rejection formulated by the Examiner, the first part of the *Advanced Bionics* framework is satisfied. *See Google LLC v. Valtrus Innov. Ltd.*, IPR2022-01197, Paper 18 at 17-18 (PTAB June 13, 2023) (“*Valtrus*”).

Additionally, the Examiner stated that the claims were allowable because “the limitation ... is also more narrow in that not only is the context synchronized, but context stacks/sets of distinct devices are synchronized.” Ex. 1012, 447 (emphasis in original). Now, Petitioner comes forward with Coffman, which in the best light for Petitioner’s theory, presents that same question that the Examiner resolved in favor of allowance—that even a showing of individual context synchronization fails to demonstrate synchronization of context stacks or context sets.

For these reasons, step 1 of the *Advanced Bionics* framework is satisfied, and the analysis proceeds to step 2.

Becton, Dickinson factor (c) weighs in favor of discretionary denial because Petitioner acknowledges that Coffman’s disclosure was cited during examination by the Examiner prior to allowing the claims of the ’652 Patent. Pet., 14; *Valtrus*, at 18-19.

Becton, Dickinson factor (e) strongly weighs in favor of denial. Petitioner’s citations of support in Coffman do not address the feature found absent from the

prior art by the Examiner—synchronization of context stacks or context sets.

Instead, Petitioner cites to features in Coffman that go no further than the features in the Mumick reference discussed by the Examiner for synchronization of context but not context stacks or context sets. In particular, Petitioner only cites to Coffman’s ability to “add to its context stack” (Pet. at 15) in its deficient analysis of Coffman explained above.

Petitioner simply has not shown “synchronization” of “context stacks” or “context sets” in Coffman, or material error by the Examiner in finding such to be absent from Coffman. Rather than there being anything “unclear” about what the Examiner did or whether the Examiner “materially erred” (Pet., 15), the Examiner stated reasons for allowance that apply equally to Coffman as they do to Mumick—the claims require synchronization of context stacks or context stacks. A showing of context synchronization does not demonstrate that context stacks or context stacks are synchronized. There is simply no showing of material error in the Examiner’s work in this regard. “[B]ecause Petitioner in this case has failed to ‘point[] out sufficiently how the examiner erred in its evaluation of the asserted prior art,’ this factor weighs heavily in favor of us exercising discretion to deny institution.” *Valtrus*, at 19-24.

The Board should exercise its discretion under 35 U.S.C. § 325(d) and decline Petitioner’s request to reexamine whether Coffman’s additions and updates

to a context stack would satisfy the claimed requirements of synchronizing a context stack or set. There is no reason here to disturb the Examiner's reasoned decision to allow the '652 Patent against a similarly deficient reference.

VI. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

Dated: July 25, 2024

/Wayne M. Helge/

Wayne M. Helge (Reg. No. 56,905)

James T. Wilson (Reg. No. 41,439)

NOSSAMAN, LLP

1401 New York Ave, NW

Suite 800

Washington, DC 20005

Telephone: (202) 887-1400

Email: whelge@nossaman.com

Email: jwilson@nossaman.com

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 5,334 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

By: /Wayne M. Helge/
Wayne M. Helge (Reg. No. 56,905)
Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on July 25, 2024, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email addresses of record as follows:

Heidi L. Keefe
hkeefe@cooley.com

Andrew C. Mace
amace@cooley.com

Mark R. Weinstein
mweinstein@cooley.com

Reuben Chen
rchen@cooley.com

COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Ave. NW, Suite 700
Washington D.C. 20004
Tel: (650) 842-7800

/Wayne M. Helge/
Wayne M. Helge (Reg. No. 56,905)
Attorney for Patent Owner