

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

ASUS TECHNOLOGY LICENSING INC.,
Patent Owner

IPR2024-01036
Patent No. 11,291,052

**PATENT OWNER RESPONSE
TO PETITIONER PRELIMINARY REPLY**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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Pursuant to the Board's authorization on November 18, 2024, Patent Owner submits this Response to Petitioner's Preliminary Reply.

Petitioner confuses the file history. Lohr enters the file history on January 13, 2020, when the examiner issued a rejection on the basis that "Lohr discloses (Figs. 7-15) perform a single (TB) transport block of Msg transmission to the network according to the TTI information of the Msg", relying on Lohr [0120], [0183], [0187]. EX1002 [FH], 164. On April 13, 2020, the applicant traversed the rejection, arguing that Lohr does not disclose the limitation. *Id.*, 200-201. On May 1, 2020, the examiner issued a final rejection maintaining its rejection based on Lohr. *Id.*, 214.

On July 9, 2020, the applicant held an interview with the examiner. *Id.*, 243. According to the examiner, during the interview, "[a]pplicant ***furthermore descriptively explained how the current claimed invention differs from the cited prior art(s).***" [e.g., Lohr]. *Id.* At this point during prosecution, the examiner dropped all remaining prior art bases for rejection, including Lohr. *Id.* The examiner did not limit their statement to agreeing with applicant's positions regarding certain prior art; instead the statement included all prior art. One of the arguments advanced by applicant was that Lohr does not disclose the "single transport block" limitation. *Id.*, 200-201.

While the examiner issued two further rejections, both of those rejections dealt entirely with 112 issues. *Id.* at 483-485 and 491-492, respectfully. Thus, as of July 9, 2020, the examiner abandoned its previous incorrect view that Lohr taught “a UE performing a single (TB) transport block of Msg3 transmission to a network according to TTI information of a Msg3.” *Id.*, 201. The examiner did not further reject any claims based on Lohr or any other prior art before issuing a notice of allowance.

Given that the examiner clearly dropped their rejection based on Lohr, there is little if any weight to be accorded to the statement from the examiner in the Notice of Allowance.

Dated: November 22, 2024

/ Stephen McBride /
Stephen McBride (Reg. No. 78,396)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9247
stevemcbride@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on November 22, 2024, a copy of the foregoing document **PATENT OWNER RESPONSE TO PETITIONER PRELIMINARY REPLY** was served by electronic mail, as consented to by Petitioner, upon the following:

Greenberg Traurig, LLP

Heath J. Briggs (Reg. No. 54,919)
BriggsH@gtlaw.com

Trenton Ward (Reg. No. 59,157)
Trenton.Ward@gtlaw.com

Andrew Sommer (Reg. No. 53,932)
SommerA@gtlaw.com

Vimal M. Kapadia (Reg. No. 73,310)
KapadiaV@gtlaw.com

Stephen M. Ullmer
UllmerS@gtlaw.com

Jared K. Lee (Reg. No. 72,786)
Jared.lee@gtlaw.com

Samsung-ASUS-IPRs@gtlaw.com

By: /s/Stephen McBride