

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.

Case No. IPR2024-01217

U.S. Patent No. 10,104,658

PATENT OWNER PRELIMINARY RESPONSE

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I. INTRODUCTION

By statute, *inter partes* review can only be based on “prior art consisting of patents or printed publications.” 35 U.S.C. §311(b). However, both Grounds in the present Petition are based on other types of alleged prior art. Therefore, institution should be denied.

II. INSTITUTION SHOULD BE DENIED BECAUSE BOTH GROUNDS ARE IMPROPERLY BASED ON REFERENCES NOT SHOWN TO BE PRIOR ART PATENTS OR PRIOR ART PRINTED PUBLICATIONS UNDER 35 U.S.C. §311(B)

Institution should be denied because both grounds rely on references that have not been shown to qualify under 35 U.S.C. §311(b) as a basis for *inter partes* review. For example, Ground 1 is improperly based on Tooher and alleged AAPA, and Ground 2 is improperly based on the 3GPP-36.300 reference and the R1-112517 reference.

A. Ground 1 is Improperly Based on alleged Applicant-Admitted Prior Art and the Tooher Reference

1. Ground 1 is Improperly Based on Alleged AAPA

Ground 1 is improperly based on alleged applicant-admitted prior art (AAPA). This is not permitted because an IPR cannot be based on AAPA. *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1372-76 (Fed. Cir. 2022) (“§ 311(b) does not permit AAPA ... to be the basis of a ground in an *inter partes* review”).

For example, Ground 1 relies on alleged AAPA for the entire claimed radio frame/subframe/symbol structure. Pet., 31 (“As for the uplink and downlink

transmission structure, the **AAPA** admits that the claimed radio frame/subframe/symbol structure was conventional in LTE.”) (emphasis added).

The Petition cites *Qualcomm* for the proposition that AAPA can be used to assess whether claims would have been obvious, Pet., 24, fn.12. However, *Qualcomm* draws the line at basing an IPR on AAPA. *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1372-76 (Fed. Cir. 2022) (“§ 311(b) does not permit AAPA ... to be the basis of a ground in an inter partes review”). In the present case, relying on alleged AAPA for the entire claimed radio frame/subframe/symbol structure is not just using AAPA to assess obviousness from other references; it is using AAPA as a basis for the Petition.

This reason alone is sufficient to deny institution as to Ground 1. However, Ground 1 is also based on another reference, Tooher, that likewise fails to qualify as a proper basis for IPR.

2. Ground 1 is Improperly Based on Tooher

The Tooher reference was not a prior art printed publication upon which an IPR could be based under 35 U.S.C. §311(b) because Tooher was not publicly accessible (*i.e.*, not a printed publication) as of the ‘658 filing date. Tooher was not published until October 5, 2017, more than one year after the ‘658 actual filing date (June 7, 2016).

While the Petition contends Tooher is “prior art” due to the Tooher-Prov provisional filed in 2014 (Pet., 21), the Petition never contends Tooher qualified as “prior art consisting of patents or printed publications” as required for IPR under 35 U.S.C. §311(b). Thus, the Petition waived any argument that IPR could be based on Tooher. That should be the end of the matter.

Even if the Board were to consider that waived argument, it should find Tooher has not been shown to qualify as a basis for IPR. Section 311(b) limits available prior art, as a matter of law, to only references that are themselves “a prior art patent or prior art printed publication.” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375 (Fed. Cir. 2022). Tooher has not been shown to be either.

First, Tooher is not a patent. Petition, 21 (“Tooher is U.S. Patent App. Pub. No. 2017/0290008”).

Second, regardless of whether Tooher qualifies as prior art generally, Tooher is not a “prior art printed publication” because it was not asserted to be publicly accessible as of the ‘658 filing date.

The Federal Circuit has consistently held “[t]he statutory phrase ‘printed publication’ ... mean[s] that **before the critical date** [of the challenged patent] the reference must have been sufficiently accessible to the public interested in the art.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (emphasis added); *accord, e.g., Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772-74 (Fed. Cir.

2018) (affirming finding in IPR that reference was not a “printed publication” because it “was not publicly accessible before the critical date”); *In re Lister*, 583 F.3d 1307, 1314, 1311-17 (Fed. Cir. 2009) (manuscript was not a “printed publication” because it was not “publicly accessible” before critical date); *B/E Aerospace, Inc. v. C & D Zodiac, Inc.*, 709 F. App’x 687, 697-98 (Fed. Cir. 2017) (affirming finding in IPR that document was not a “prior art printed publication” because petitioner “did not establish public accessibility ... before the priority date”); *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012) (“a prior art ‘printed publication’” must be “‘sufficiently accessible to the public interested in the art’ before the critical date.”). The pending appeal before the Federal Circuit in *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.* (App. No. 23-2346 from IPR2022-00149) is expected to address whether abandoned applications for patent published after the priority date are permissible “printed publications” in IPRs.

The burden is on the petitioner to show a reference is a prior art patent or printed publication. *Acceleration Bay*, 908 F.3d at 772 (“petitioner ... ha[s] the burden to prove [a reference] is a printed publication.”). To do so, the petitioner must show that the reference was, before the critical date, “made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Id.*

Petitioner did not even allege Tooher was a prior art patent or printed publication, much less prove Tooher was publicly accessible before the critical date. Thus, Petitioner did not satisfy its burden and its Petition cannot properly be based on Tooher.

Ground 1 is based on Tooher. Pet., 25 (“Ground 1 relies on Lindh and Tooher”). For example, Ground 1 relies on Tooher for the following three teachings: “Tooher discloses that data resources may (a) be allocated in a single symbol or may be as long as an entire subframe, (b) start in different symbols, and (c) be specified by legacy PDCCH or enhanced EPDCCH control signals.” Pet., 28. Ground 1 also relies on Tooher to teach varying transmission time interval durations based on factors including the amount and type of data to be transmitted. Pet., 29 (“Tooher facilitates improvement in transmission efficiency, latency, channel capacity, and scheduling flexibility by varying transmission time interval (‘TTI’) durations based on factors including the amount and type of data to be transmitted [citations omitted]. A POSITA would have found such improvements beneficial to Lindh.”) Further, Ground 1 relies on Tooher to teach varying the starting location and symbol duration of a given data resource in a subframe: “Tooher’s ability to vary the starting location and symbol duration of a given data resource in a subframe would allow the network to more fully utilize available resources in a way that would improve Lindh in the ways described by Tooher.” Pet., 29. See also Pet., 45-50

(detailed reliance on teachings of Tooher for element 11.5 and claim 12) and 59 (reliance on Tooher for element 18.5).

Thus, Ground 1 is based on (1) alleged AAPA and (2) a reference (Tooher) not shown to be “a prior art patent or prior art printed publication” under *Qualcomm*. Basing IPR on those references would violate 35 U.S.C. §311(b).

B. Ground 2 is improperly based on the 3GPP-36.300 reference and the R1-112517 reference

Ground 2 of the Petition is based on the 3GPP-36.300 reference (Ex. 1009) and the R1-112517 reference, but the Petition does not satisfy its burden to show they qualify as printed publications as required under 35 U.S.C. §311(b). Having failed to carry Petitioner’s burden, the Petition should be denied institution. *See Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (“Petitioner bears the burden of establishing that a particular document is a printed publication.”).

1. The Petition Fails To Show the 3GPP-36.300 Reference (Ex. 1009) Was a Printed Publication

The 3GPP-36.300 reference (Ex. 1009) has not been shown to be a printed publication as required for use in an IPR under 35 U.S.C. §311(b). The petition merely alleges (a) Ex. 1009 was publicly accessible according to the Bishop declaration; (b) Ex. 1009 is applicant-admitted prior art (AAPA); and (c) Petitioner filed earlier versions as exhibits. Pet., 22. Those allegations do not satisfy Petitioner’s burden under *Medtronic*.

a. Bare Incorporation By Reference of the Bishop Declaration Does Not Satisfy Petitioner’s Burden to Show Public Accessibility

Petitioner has failed its burden to establish the 3GPP-36.300 reference (Ex. 1009) was a publicly accessible printed publication. The Petition’s only effort to demonstrate public accessibility is an improper incorporation by reference of the Bishop declaration:

3GPP-36.300 is prior art; as Mr. Bishop confirms, v12.5.0

was published and publicly accessible by March 24, 2015.

(Ex-1012-Bishop at ¶¶47-52, 58-59.)

Pet., 22. The Petition states no basis for its bare conclusion that 3GPP-36.300 v12.5.0 (Ex. 1009) was publicly accessible.

The Petition itself must “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. §312(a)(3). It is impermissible to incorporate by reference from another document. 37 C.F.R. §42.6(a)(3) (“[a]rguments must not be incorporated by reference from one document into another document.”).

Federal Circuit caselaw supports that Rule. For example, in *3M Co. v. Evergreen Adhesives, Inc.*, the Federal Circuit rejected 3M’s arguments not made in the petition because its reference to expert testimony was “an attempt to introduce

argument by citation.” 860 Fed.Appx. 724, 725-727 (Fed. Cir. 2021) (the Board is not to be forced to “play archeologist with the record” for arguments made outside the parties’ briefing). *See also, e.g., Medtronic, Inc. v. Teleflex Life Sciences Ltd.*, 86 F.4th 902, 906-7 (Fed. Cir. 2023) (rejecting incorporation by reference); *Monsanto Co. v. Scruggs*, 459 F.3d 1328, 1335 (Fed. Cir. 2006) (finding arguments incorporated by reference waived).

As the Board explained in *Vivint, Inc. v. SB IP Holdings LLC*: “What a petitioner may not do is to simply state conclusions in the petition, and rely on the expert declaration to provide all of the reasoning, explanation, and analysis.” IPR2022-00814, Paper 15 at 14-15, 2023 WL 6878619 at *5 (PTAB Oct. 16, 2023). That is precisely what the present Petition attempts to do: simply assert the conclusion that Ex. 1009 was publicly accessible by March 24, 2015, and rely on an expert declaration to provide all the reasoning, explanation, and analysis. Pet., 22 (“as Mr. Bishop confirms, v12.5.0 was published and publicly accessible by March 24, 2015. (Ex-1012-Bishop at ¶¶47-52, 58-59.)”).

The statutory requirement that the Petition itself must identify the evidence supporting the grounds—and not just incorporate an expert declaration by reference—applies to the requirement to establish a reference as a printed publication. *Microsoft Corp. v. Throughputer, Inc.*, IPR2023-00852, Decision

Denying Institution (Paper 18) at 17-18 (PTAB Nov. 9, 2023). That is part of Petitioner's burden. *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018).

The Petition presents only a single sentence to allege public accessibility, and block-cites without explanation to four pages of the Bishop declaration, which themselves incorporate two more pages of appendices. Pet., 22. (“as Mr. Bishop confirms, v12.5.0 was published and publicly accessible by March 24, 2015. (Ex-1012-Bishop at ¶¶47-52, 58-59.)”). Bishop Paragraph 48 itself incorporates “Appendix 19 at annex E, p.116,” buried somewhere in five hundred thirty pages of Appendices with no index. Bishop Paragraph 49 incorporates “Appendix 20 at 3,” also buried somewhere within five hundred thirty pages of Appendixes with no index. This improperly forces the Board to “play archeologist with the record” to search for arguments made outside of the briefs. *3M Co. v. Evergreen Adhesives, Inc.*, 860 F. App'x 724, 725 (Fed. Cir. 2021). The Petition itself does not state any reason why the reference was publicly accessible.

Neither Patent Owner nor the Board should be forced to “play archeologist” with the record and dig through those six pages of the Bishop declaration in an attempt to discern what reasoning, explanation, and analysis might support the Petition's one-sentence conclusion of public accessibility. Incorporation of six pages of the Bishop declaration does not substitute for the reasoning, explanation, and

analysis that was required to appear in the Petition itself to establish Ex. 1009 as a publicly accessible printed publication.

Such incorporation by reference is especially impermissible where, as here, the incorporated material would cause the Petition to exceed the word limit: "in no event is such incorporation permitted if it would result in exceeding the applicable word count." *Promptu Systems Corp. v. Comcast Cable Communications, LLC*, No. 2022-1093 (Fed. Cir. Feb. 16, 2024); See also *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014) ("[i]t would be fundamentally unfair to allow a party to use incorporation to exceed word count."). As best understood, the Petition's incorporation of four pages of the Bishop declaration and their further incorporation of two more pages from Bishop's 530-page compendium of unindexed appendices includes 1,617 words. Adding 1,617 to the Petition's stated word count of 13,612 (Pet., 2) totals 15,229 words, well beyond the 14,000 word limit stated in 37 C.F.R. §42.24(a)(1)(i).

Under 37 C.F.R. §42.6(a)(3), the incorporated material from Mr. Bishop should not be considered and should be considered waived. Without it, the Petition provides no basis to treat 3GPP-36.300 v12.5.0 (Ex. 1009) as a printed publication because there is no cognizable evidence of public accessibility before the critical date.

b. Alleging a Reference Was Applicant-Admitted Prior Art Does Not Satisfy Petitioner’s Burden to Show Public Accessibility

The Petition alleges certain portions of 3GPP-36.300 v12.5.0 (Ex. 1009) were applicant-admitted prior art. Pet., 22 and 24-25. But even if Ex. 1009 were AAPA in its entirety, being prior art would not be sufficient to make the reference a “printed publication” as required by 35 U.S.C. §311(b) for use in IPR. In any event, an IPR cannot be based on AAPA. *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1372-76 (Fed. Cir. 2022) (“§ 311(b) does not permit AAPA ... to be the basis of a ground in an inter partes review”). Petitioner identifies no statement in the patent admitting that Ex. 1009 was publicly accessible prior to the critical date.

c. Submitting Alleged “Earlier Versions” Does Not Show Public Accessibility of Ex. 1009

The Petition alleges “[e]arlier versions from Release 8 (v8.11.0) and Release 10 (v10.2.0) are also filed herewith.” Pet., 22. However, the Petition does not explain how Petitioner’s alleged filing of “earlier versions” demonstrates public accessibility of version 12.5.0 (*i.e.*, the cited reference titled 3GPP-36.300 v12.5.0 and filed as Ex. 1009), even if some material was similar between versions.

Because Ground 2 is based on a reference that was not publicly accessible, the ground cannot form a basis for institution.

2. The Petition Fails To Show the R1-112517 Reference (Ex. 1010) Was a Printed Publication

Ground 2 is based on the R1-112517 reference (Ex. 1010). That reference has not been shown to be a printed publication as required for use in an IPR under 35 U.S.C. §311(b). The petition merely alleges it was “submitted by Samsung for discussion” at a meeting and publicly accessible according to unspecified reasons in the Bishop declaration:

It was submitted by Samsung for discussion at the 3GPP TSG-Ran #66 meeting held in Athens, Greece, in August 2011. R1-112517 is prior art, having been published and publicly accessible by August 16, 2011. (Ex-1012-Bishop at ¶¶53-59.)

Pet., 23. Those allegations are insufficient to demonstrate R1-112517 (Ex. 1010) was publicly accessible before the critical date. Thus, the Petition has not carried its burden of demonstrating the reference was a printed publication. Ground 2 cannot support institution for this additional reason.

a. The Attempted Bare Incorporation By Reference of the Bishop Declaration Does Not Satisfy Petitioner’s Burden to Show Public Accessibility

The Petition itself must state the basis for considering a reference to be publicly accessible. Incorporating a declaration by reference is insufficient. In the present case, with respect to R1-112517 (Ex. 1010), the Petition block-cites without

explanation to more than three pages of the declaration, which themselves incorporate seven more pages of appendices, for a total of ten incorporated pages. This violates 37 C.F.R. §42.6(a)(3) and improperly forces the Board to “play archeologist with the record” to search for arguments made outside of the briefs. *3M Co. v. Evergreen Adhesives, Inc.*, 860 F. App’x 724, 725 (Fed. Cir. 2021).

As best understood, incorporating the additional ten pages concerning Ex. 1010 adds 2,167 words. Adding 2167 to the Petition’s stated word count of 13,612 (Pet., 2) totals 15,779 words, well beyond the 14,000 word limit stated in 37 C.F.R. §42.24(a)(1)(i). As best understood, after incorporating both the additional material concerning Ex. 1009 and the additional material concerning Ex. 1010, the total word count would be approximately 17,396—clearly an unfair violation of the rules.

Both Ex. 1009 and Ex. 1010 are necessary for Ground 2. Consideration of those references should not benefit from the Petition’s purported incorporation by reference to Mr. Bishop’s declaration and materials. Without such benefit, neither reference can support *inter partes* review based on Ground 2.

b. Submitting a Reference for Discussion at a Meeting Does Not Satisfy Petitioner’s Burden to Show Public Accessibility

According to the Petition, Ex. 1010 “was submitted by Samsung for discussion at the 3GPP TSG-Ran #66 meeting held in Athens, Greece, in August 2011.” Pet., 23. This skeletal allegation does not demonstrate Ex. 1010 was actually

discussed by anyone, much less that it was actually disseminated to the relevant interested people or in any way publicly accessible.

As discussed above, under 37 C.F.R. §42.6(a)(3), nothing else should be incorporated by reference from Mr. Bishop's declaration and materials at least because nothing else was discussed in the Petition itself. *Microsoft Corp. v. Throughputer, Inc.*, IPR2023-00852, Decision Denying Institution (Paper 18) at 17-18 (PTAB Nov. 9, 2023); *Vivint, Inc. v. SB IP Holdings LLC*: IPR2022-00814, Paper 15 at 14-15, 2023 WL 6878619 at *5 (PTAB Oct. 16, 2023) ("What a petitioner may not do is to simply state conclusions in the petition, and rely on the expert declaration to provide all of the reasoning, explanation, and analysis.").

Even if the Petition had stated some reason to believe Exhibit 1010 was publicly accessible before the critical date, which it did not, that would not have cured Petitioner's failure to do the same for Exhibit 1009. Both are necessary bases for Ground 2.

III. FURTHER PRELIMINARY BRIEFING IS NOT WARRANTED

To the extent Petitioner realizes from this Preliminary Response that its Petition was deficient and seeks further preliminary briefing, it should be denied.

Further briefing may only be authorized upon a showing of good cause. *See* 37 C.F.R. §42.108(c). Petitioners know their "initial petition" must identify "with particularity" the evidence that supports each ground. "It is of the utmost importance

that petitioners in the IPR proceedings adhere to the requirement that **the initial petition** identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intel. Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (emphasis added).

It should come as no surprise to Petitioner that its Petition was deficient. Demonstrating that a reference qualifies as a printed publication is a “fundamental element of Petitioner’s contentions” in its Petition. *Microsoft Corp. v. Corel Software, LLC*, IPR2016-01083, Decision Denying Institution (Paper 14) at 13, fn.5 (PTAB Dec. 1, 2016). That a Petitioner reading a Patent Owner Preliminary Response realizes its Petition failed to state a threshold showing of a reference being a printed publication “does not support a finding of good cause” for additional briefing. *Id.* at 13, fn.5. The same applies here. As in *Microsoft Corp. v. Corel Software*, the present Petitioner should be denied any further preliminary briefing.

IV. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Dated: December 27, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 3,339 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Response complies with the type-volume limitation of 14,000 words as set forth in 37 C.F.R. §42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: December 27, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on December 27, 2024, a copy of the foregoing documents **PATENT OWNER PRELIMINARY RESPONSE** was served by electronic mail, as consented to by Petitioner, upon the following:

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