

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC.,

Petitioner,

v.

INTELLECTUAL VENTURES I, LLC,

Patent Owner.

Case No. IPR2024-01224

U.S. Patent No. 7,623,439

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

TABLE OF CONTENTS

I.	The Request Is Based On New Arguments And “Evidence” Not Presented In The Petition	1
II.	The Board Correctly Applied The Burden Set Forth in <i>Hulu</i>	2
III.	The Board Properly Rejected Petitioner’s Request For Leave To Submit New Evidence.....	4

Petitioner's Request ("Request") for Director Review should be denied.

I. The Request Is Based On New Arguments And "Evidence" Not Presented In The Petition

The Petition (at 22-23) devoted less than a page to arguing that Dammann qualified as prior art, based solely on Exs. 1014-1016, discussed below. The Request is replete with new arguments and "evidence" absent from the Petition.

Ex. 1014 is a page from the website "docenti.ing.unipi.it." The Petition failed to explain how "docenti.ing.unipi.it" was connected (if at all) to the European Wireless 2002 conference, and presented no evidence of any such connection. The Request now proffers a new argument that Ex. 1014 includes "a clickable hyperlink (in purple underlined text) that opens a page giving access to the conference schedule and electronic copies of the presented papers." Request, 3. *The original Petition made no such argument*, which is not surprising since the pdf file submitted as Ex. 1014 *lacks a working hyperlink*.

Ex. 1015 purports to be another page archived from "docenti.ing.unipi.it." This exhibit *does not mention the Dammann paper*. The Request makes a new argument that Ex. 1015 includes "a clickable hyperlink that accesses a contact page for buying hard copies of and accessing electronic versions of the proceedings." Request, 3-4. *The original Petition made no such argument*, which is again not surprising since the pdf file submitted as Ex. 1015 *lacks a working hyperlink*.

Ex. 1016 is another page archived from "docenti.ing.unipi.it" on Nov. 23,

2004 -- which is after the priority date of the '439 Patent. Again, the Request makes a new argument that Ex. 1016 “[a] clickable hyperlink ... is included on the webpage that directly opens an electronic copy of the paper.” Request, 4. Again, the original Petition made no such argument, and the pdf file submitted as Ex. 1016 lacks a working hyperlink.

Other examples of arguments and “evidence” absent from the Petition and made for the first time in the Request include:

- Dammann “was also separately published in proceedings that were made available to conference attendees as well as on the conference website.” Request, 12. There is no copy of these “published” proceedings anywhere in the record.
- “[T]he content of Exs. 1014-1016 ... show a connection between the European Wireless 2002 conference and School of Engineering at the University of Pisa (using URL addresses ‘ing.unipi.it’), which hosted and provided ongoing support for the conference.” Request, 13. There is no evidence in the record that ‘ing.unipi.it corresponded to the School of Engineering at the University of Pisa or that the School of Engineering at the University of Pisa “hosted and provided ongoing support for the conference,” nor does the Petition say so.

It is wholly inappropriate for the Request to repeatedly allege that the Board “ignored” or “overlooked” arguments and “evidence” that was never previously presented. Request, 1, 7, and 8. Moreover, whether Dammann was “publicly presented” at a conference in Italy does not equate to whether the document qualifies as a “printed publication” (which requires dissemination as opposed to mere presentation), nor would presentation in Italy meet the Pre-AIA requirement of 35 U.S.C. §102(a) that the information was “known or used by others in this country.”

II. The Board Correctly Applied The Burden Set Forth in *Hulu*

As noted in the Institution Decision, “the first page of the Dammann reference itself, as well as the remaining four pages, are devoid of any publication date, associated conference, or conference date. See Ex. 1005, 1 et seq. Thus, Petitioner relies solely on Exhibits 1014 through 1016 to assert Dammann is prior art.” Institution Decision (Paper #11), 25. Since there was “no evidence of record that Dammann was actually physically disseminated to the public, such as at the conference site,” the Board “focused on whether an interested skilled artisan, using reasonable diligence, would have found Dammann on the “docenti.ing.unipi.it” website.” *Id.*, 26. However, as the Board found, the record was devoid of evidence that a person interested in wireless diversity would have been aware of the “docenti.ing.unipi.it” website as a place to search for such subject matter. *Id.*, 27.

The facts of the present case bear no resemblance to *Hulu, LLC v. Sound View Innovations, LLC*. IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019). In *Hulu*, there was substantial evidence presented in the Petition that the reference was a printed publication including: (i) a date stamp on the reference from a library with a date predating the priority date, (ii) an affidavit from the supervisor in charge of cataloging at the library attesting to the indexing and publicly availability before the priority date, and (iii) the reference bore a copyright date before the priority date, stated that it was the fourth printing of the book and listed four earlier printing dates under the heading “Printing History.”

The present case contains no such facts. In contrast to *Hulu*, the Dammann reference presented with the present Petition bore no date stamp or copyright date, the present Petition included no testimonial evidence that Dammann was indexed or publicly available before the priority date, and the present Petition lacked any evidence that Dammann had a “Printing History.”

The Board, in this case, correctly found “that, even for purposes of institution, Petitioner has failed to meet its threshold burden under *Hulu* to show a reasonable likelihood that the Dammann reference was publicly accessible before the critical date.” Institution Decision, 27-28.

III. The Board Properly Rejected Petitioner’s Request For Leave To Submit New Evidence

Petitioner made the strategic choice to file the present petition as a “me too” or “copycat” of IPR2024-00883 (the “Zebra IPR”). On Aug. 22, 2024, Patent Owner (“PO”) filed its Preliminary Response in the Zebra IPR. Therefore, Petitioner had been aware (or should have been aware) of the PO’s argument that Dammann has not been adequately shown to be a printed publication at that time. Rather than promptly raising the issue of submission of supplemental evidence with the Board, Petitioner made the strategic choice to remain silent. Subsequently, on Nov. 18, 2024, PO filed its Preliminary Response in this IPR, and on Nov. 20, 2024, the Board denied the institution in the Zebra IPR finding that the Petition in that IPR failed to demonstrate that Dammann was prior art. It was not until after the Board denied the

institution in the Zebra IPR based on the failure to demonstrate Dammann's prior art status that the Petitioner here requested leave to submit additional evidence. The Board correctly found that Petitioner failed to show "good cause":

As a potential understudy in the Zebra IPR, Petitioner was certainly on notice at that early date that the Dammann reference's status as a printed publication was in question, ... In short, Petitioner could have requested earlier consideration of this issue prior to Patent Owner filing a POPR in this IPR, and waived its intended understudy status if the risk of denial of petition on the basis of Dammann not being adequately shown as prior art was too great. Instead, Petitioner waited and now seeks to benefit from using the Board's decision denying institution in the Zebra IPR as a roadmap to attempt to correct the petitioner's deficiencies therein in demonstrating that Dammann is a printed publication. The Board's rejection of the petitioner's showing in the Zebra IPR does not provide good cause for Petitioner here to try to remedy that showing here. Petitioner cannot have it both ways, be an understudy or not be an understudy, depending on the institution decision in the '883 IPR.

Having considered the respective positions of the parties, and on the particular facts here, Petitioner reasonably should have foreseen that Patent Owner would challenge Petitioner's reliance on Exhibits 1014 through 1016 as support for the alleged status of Dammann as a printed publication. Because Petitioner has not demonstrated good cause to file a pre-institution reply to address Patent Owner's arguments as to the status of Dammann, we deny Petitioner's request. Order - Conduct of the Proceeding, Paper #10, at 7-8 (emphasis added).

Under these circumstances, the Board was well within its discretion to deny Petitioner's request to submit additional evidence.

For the above reasons, the Request for Director Review should be denied.

Dated: March 12, 2025

Respectfully submitted,
By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST** was served via email (as consented to by counsel) on March 12, 2025 to lead and backup counsel of record for Petitioners as follows:

Dinesh Melwani (Reg. No. 60,670)
2000 Pennsylvania Ave, NW,
Suite 4001
Washington, DC 20006
dmelwani@bomcip.com

Jameson Ma (Reg. No. 68,343)
2000 Pennsylvania Ave, NW,
Suite 4001
Washington, DC 20006
jma@bomcip.com

docketing@bomcip.com

Dated: March 12, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701
Counsel for Patent Owner
Intellectual Ventures I LLC