

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. IPR2024-01273

U.S. Patent No. 10,785,759

CORRECTED

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, all three Grounds in the Petition are based on other types of alleged prior art. Therefore, institution should be denied.

II. INSTITUTION SHOULD BE DENIED BECAUSE THE PETITION DOES NOT ESTABLISH THE REFERENCES AS PRIOR ART PATENTS OR PRINTED PUBLICATIONS AS REQUIRED BY 35 U.S.C. § 311(B)

Institution should be denied because all three grounds are based 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, all three grounds rely heavily on alleged Applicant-Admitted Prior Art, which cannot form a basis for IPR. Likewise, the primary reference for each ground cannot form a basis for IPR because it has not been shown to be “prior art consisting of patents or printed publications” as required by Section 311(b).

A. The Petition is Improperly Based On Alleged Applicant-Admitted Prior Art

All three grounds heavily rely 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) (holding that applicant-admitted prior art appearing in a patent document cannot be a basis for IPR under § 311(b)).

For example, Ground 1 relies on alleged AAPA to argue for obviousness of the claimed “first numerology.” Ground 1 states:

In fact, the ’759 patent quotes 3GPP TR 36.211 V13.1.0 (AAPA) for following: “[a] downlink physical channel corresponds to a set of resource elements carrying information originating from higher layers” and “[t]he following downlink physical channels are defined: Physical Downlink Shared Channel PDSCH . . . Physical Downlink Control Channel PDCCH.” Ex-1001, 8:9:18. Accordingly, a POSITA would have understood that Noh’s disclosure of a “service-specific numerolog[y]” for eMBB (claimed “first numerology”) would have been associated with a PDSCH on which downlink data for the eMBB service is received by the UE.

Pet., 16-17 (emphasis altered).

Grounds 2 and 3¹ rely even more heavily on alleged AAPA, in an attempt to show obviousness of the claimed “first numerology for a physical downlink shared channel (PDSCH) or a physical uplink shared channel (PUSCH).” Regarding those grounds, the Petition states:

[T]he ’759 patent quotes 3GPP TR 36.211 V13.1.0 (AAPA) for the following: “[a] downlink physical channel corresponds to a set of resource elements carrying information originating from higher layers” and “[t]he

¹ Ground 3 purports to incorporate Ground 2 by reference. Pet., 78, 82, 85, 88.

following downlink physical channels are defined: Physical Downlink Shared Channel PDSCH ... Physical Downlink Control Channel PDCCH.” Ex-1001, 8:9:18. The ’759 patent also quotes 3GPP TS 36.213 V13.1.1 (AAPA) for the following: “7.1 UE Procedure for Receiving the Physical Downlink Shared Channel ... [A] UE shall upon detection of a PDCCH of the serving cell ... decode the corresponding PDSCH in the same subframe ...” Ex-1001, 23:1-15. A POSITA would have understood Islam’s disclosure of assigning a numerology to a sub-band teaches the claimed “the first numerology for a physical downlink shared channel (PDSCH) or a physical uplink shared channel (PUSCH).”

Pet., 59-60 (emphasis altered).

In neither case did Petitioner establish that it was proper to base its Petition on alleged AAPA, when doing so is explicitly barred by *Qualcomm. Qualcomm*, 24 F.4th at 1375 (“[§ 311\(b\)](#) does not permit AAPA ... to be the basis of a ground in an *inter partes* review”).

B. Noh has not been shown to be an eligible basis for IPR under 35 U.S.C. § 311(b)

The Petition also fails to show Noh, the primary reference in Ground 1, qualifies as a basis for Inter Partes Review under 35 U.S.C. § 311(b).

While the Petition contends “Noh is presumptively prior art” (Pet., 6) based on a foreign priority document, the Petition never contends Noh qualified as “prior

art consisting of patents or printed publications” as required for IPR under § 311(b). Thus, the Petition waived any argument that IPR could be based on Noh. That should be the end of the matter.

Even if the Board were to consider that waived argument, it should find Noh does not 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*, 24 F.4th at 1375. Noh has not been shown to be either.

First, Noh is not a patent. Pet., 6 (“Noh, U.S. Patent Publication No. 2019/0090218”).

Second, Noh is not a “prior art printed publication” under § 311(b) because it was not publicly accessible as of the ‘759 filing date. The Petition concedes Noh was not published until March 21, 2019, well after the ‘759 actual filing date of August 10, 2017. Pet., 6 (“Noh...was published on March 21, 2019.”). Therefore, it does not qualify as a prior art “printed publication” under Section 311(b).

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 “printed publication” because it was not “publicly accessible” before the 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 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 Noh was a prior art patent or printed publication, much less prove Noh was publicly accessible before the critical date. Thus, Petitioner did not satisfy its burden and institution should be denied.

C. Islam is not an eligible basis for IPR under 35 U.S.C. § 311(b)

The Petition fails to show Islam, the primary reference in Grounds 2 and 3, qualifies as a basis for Inter Partes Review under 35 U.S.C. § 311(b).

While the Petition contends “Islam is prior art” (Pet., 53), the Petition never contends Islam qualified as “prior art consisting of patents or printed publications” as required by § 311(b). Thus, the Petition waived the argument that IPR could be based on Islam under § 311(b). That should be the end of the matter.

Even if the Board were to consider that waived argument, it should find Islam 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*, 24 F.4th at 1375. Islam has not been shown to be either.

First, Islam is not a patent. Pet., 53 (“Islam, U.S. Patent Publication No. 2017/0215170”).

Second, Islam is not a “prior art printed publication” because it was not publicly accessible as of the ‘759 filing date. The Petition concedes Islam was not

published until July 27, 2017, well after the ‘759 provisional filing date of August 12, 2016. Pet., 53 (“Islam...published on July 27, 2017.”).

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 *Lynt 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 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 here made no attempt to show the ‘759 critical date was anything other than the provisional filing date of August 12, 2016.

Petitioner did not allege Islam was a prior art patent or printed publication, much less prove that Islam was publicly accessible before the critical date. Thus, Petitioner did not satisfy its burden and institution should be denied.

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). “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 the 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

All three Grounds are based on references not shown to be eligible for *inter partes* review under 35 U.S.C. § 311(b). Therefore, institution should be denied.

Dated: December 27, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 1,984 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).

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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 **CORRECTED PATENT OWNER PRELIMINARY RESPONSE** was served by electronic mail, as consented to by Petitioner, upon the following:

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