

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

PTAB Case No. IPR2024-01322

Patent No. 9,022,294

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S PETITION
AND EXPERT DECLARATION
UNDER 35 U.S.C. § 42.107**

Petitioner Google LLC (“Google” or “Petitioner”) filed its Petition for *Inter Partes* Review (IPR) of U.S. Patent No. 9,022,294 (the 294 Patent”) on September 11, 2024. (IPR2024-01322, Paper No. 1 (“Petition”)). The Board instituted the IPR on March 24, 2025. Patent Owner now objects to evidence submitted during the preliminary phase of this IPR under 35 U.S.C. § 42.64(b)(1).

First, the Patent Owner objects to the Petition for failing to meet the particularity requirement of 35 U.S.C. § 312(a)(3). String cites have been used through the Petition and conjunctive and alternate presentation of the references in the Grounds. This lack of particularity adversely affects the ability of the Patent Owner to respond to the issues raised by the Petitioner fully. Further, the Petitioner has failed to meet the requirement of the PTAB’s Trial Practice Guide, which advises petitioners to “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012).

Second, Patent Owner objects, under Fed. Rule Evid. 401 and 403, to Petitioner putting forward an improper claim construction. Petitioner asserts their claim construction is “to the extent ‘data conveyance switching element’ is subject to construction under 35 U.S.C. § 112, sixth paragraph (pre-AIA)” Pet. 6, and “control device,” Pet. 7, “data exchange device, and “external data exchange device”

Pet. 7. However, 35 U.S.C. § 282(b) requires “construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Petitioner has the burden of establishing either the claim needs to be construed under 35 U.S.C. § 112, sixth paragraph (pre-AIA) or plain meaning. The Petitioner only asserts generally “to the extent” that the claims should be interpreted under 35 U.S.C. § 112, sixth paragraph (pre-AIA), and makes no legal arguments as to why or what the extent is.

Third, Patent Owner objects to the Petitioner’s Expert Declaration of Stuart Lipoff (Exhibit 1003) under Fed. Rule Evid. 401. The Declaration paragraphs 1-52, 58-61, 63, 65, 69-71, 76, 79-80, 89, 113, 127, and 194, are not cited in the Petition, have no relevance, and would be considered new matter if cited after the Petition was filed.

Fourth, Patent Owner objects to Exhibit 1003 under Fed. Rule Evid. 403, as the Expert states in a paragraph 26:

All of the opinions contained in this declaration are based on the documents I reviewed and my knowledge and professional judgement. My opinions have also been guided by my understanding of how a POSITA would

have understood the claims of the '294 Patent at the time
of the earliest claimed priority date.

Exh. 1003, ¶26. Mr. Lipoff's opinions are based on his knowledge and professional judgment with only being guided by the understanding of a POSITA. The opinions in Exh. 1003 need to be what a POSITA at the time of the invention knows at the time of the invention, not just guided by the understanding of a POSITA. Therefore, all of Mr. Lipoff's opinions are tainted as "based upon his personal knowledge" and not the knowledge of a POSITA.

Dated: April 3, 2025

Respectfully Submitted

By: /s/ Robert Hart/

Robert Hart (Reg. No. 35,185)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies Patent Owner DH International Ltd. served this **PATENT OWNER'S OBJECTIONS TO PETITIONER'S PETITION AND EXPERT DECLARATION** on the counsel of record for Petitioner Google LLC by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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Date: April 3, 2025

By: /s/ *Robert Hart*
Robert Hart