

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC AND GOOGLE, LLC,
Petitioners,

v.

MULTIFOLD INT'L INC. PTE. LTD.,
Patent Owner.

Case IPR2025-00040

Patent No. 9,134,756

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

Patent Owner contends that this proceeding should not be instituted because two of Petitioner's four references were cited among over 300 other references during prosecution. POPR at 10-12. But the record shows no evidence that the examiner substantively considered any of the references—certainly not after the applicant broadened the claims by amendment after receiving a notice of allowance—and the Petition describes how each reference anticipates the Challenged Claims. Discretionary denial is unwarranted in these circumstances following the Board's precedent under 35 U.S.C. § 325(d) and *Advanced Bionics*.

A. The Prior Art References

The Petition relies on four prior art references, each anticipating the Challenged Claims: Yook, Lee, Aguilar, and Purcell. None of the Petition's references was substantively addressed during prosecution, much less mentioned in any office action. Purcell and Lee were not cited during prosecution in any way. Yook and Aguilar were cited in an IDS filed during prosecution. The applicants cited at least 300 other materials in an IDS. Yook and Aguilar were never cited to nor discussed by the examiner.

B. Denial Under Section 325(d) Would Be Improper.

The issue before the Board is whether the same or substantially the same art or arguments previously were presented to the Office and, if so, whether the Office materially erred in its prior analysis. The Board considers the six *Becton Dickinson*

factors under the two-prong approach in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020).

The first prong of *Advanced Bionics* is not met at least for Purcell and Lee; on this basis alone, Patent Owner's discretionary denial arguments must be rejected. As noted above, neither Purcell nor Lee was cited to the Office nor addressed by the examiner. Patent Owner merely alleges that Lee is related to a European patent cited in an IDS. POPR at 10. But Lee does not claim priority to EP1775925, nor does EP1775925 claim priority to Lee. See Ex. 1005. Even if it did, that would not be enough. *Samsung Elec's Co., Ltd. et al v. Mfg. Resources Int'l, Inc.*, IPR2023-00255, Paper 11, at 12. And Purcell – a primary anticipation reference – is not cumulative and discloses what Patent Owner alleged to be missing from the prior art, which is maximizing an application across two displays (Ex. 1002, p. 105-07) and across two screens of a single device (Ex. 1002, p. 178). That Purcell discloses the Challenged Claims along with the other Petition references shows the strength of the Petition, not that Purcell is cumulative of art during prosecution.

Even if the Board reaches *Advanced Bionics* prong two, Patent Owner's arguments fail because the references were not addressed in any way by the examiner, and the Petition notes how each reference anticipates the claims and discloses elements the examiner found missing from the prior art. As part of the second prong in *Advanced Bionics*, the Board considers “the record developed by

the Office in previously reviewing the art or arguments” (*Becton* factor (c)) which informs “the petitioner’s showing under factors (e) and (f).” *Sony Corp. v. OIT, LLC*, IPR2024—1-46, Paper 11, at 9 (Jan. 17, 2025) (citing *Advanced Bionics*, at 10). Factor (e) considers whether the petitioner has sufficiently shown how the Office erred in its prior consideration of the prior art and factor (f) considers the extent to which the facts and evidence in the Petition warrant reconsideration of the prior art. Here, the Office did not address any of the references, and even if the Office did, it failed to appreciate and consider the teachings of each reference.

Whether the references were considered substantively during prosecution is an important factor under the analysis. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17–18 (Dec. 15, 2017) (contrasting merely listing a reference in an IDS to being discussed or utilized by an examiner). Here, the Petition described how none of the four references was considered substantively, which is why there exists *no record* of any review by the examiner or the Office during prosecution. Pet., at 9-11. The Board routinely addresses the merits of a petition in such circumstances. See, e.g., *Amazon.com, Inc. et al v. Nokia Techs Oy*, IPR2024-01140, Paper 9, at 16 (Feb. 12, 2025) (noting “the Examiner did not use the [references] in any rejection” and concluding “[u]nder *Becton, Dickinson* factor (c), this does not weigh in favor of denying the Petition under § 325(d)”).

For Yook and Aguilar, Patent Owner relies only on the fact that the references

were cited in an IDS. However, when a reference is buried among hundreds of other references in an IDS, that becomes a factor that shows error by the Examiner under step two of the *Advanced Bionics* framework and is a basis to avoid denial under § 325(d). *Chemtronics USA, Inc. v Flatfrong Labs. AB*, IPR2024-00014, Paper 11, at 23–26. For example, in *Chemtronics*, four petition references were included among hundreds cited on the face of the patent. *Id.* at 23–24. Petitioners argued that “[t]he Examiner’s boilerplate ‘all references considered’ stamp of this IDS does not establish substantive consideration of these references” and that “the absence of any mentions in Office Actions ‘is further telling that the Examiner failed to adequately consider those references.’” *Id.* at 24. The Board agreed, noting that “it is difficult to characterize error in a silent record. ***In this light, we find that Petitioner’s assertion that the Examiner failed to adequately consider the references, which should have resulted in an Office Action because the references clearly disclose the ’335 patent claimed subject matter, serves as sufficient identification of error under factor (e).***” *Id.*, at 24-26. Here, there is no dispute that the examiner did not use the references, and the Petition shows that if the examiner had applied them, an Office Action and rejection would have resulted.

Denial under §325(d) is also improper because none of the prior art references was compared to the issued claims. Multiple rejections occurred during prosecution and Patent Owner argued that the cited prior art failed to include a single device with

two physical screens (a “multi-screen device”). Pet. at 11. After the examiner allowed the claims, Patent Owner amended the claims to *remove* “multi-screen device” and replace it with “multi-display device.” *Id.* Although Patent Owner told the Patent Office and examiner that the amendment did not change the scope of the claims, that was false. The Petition notes how the patent defines these terms differently because a “screen” is a hardware element while a display can be a logical portion of *a single* screen. Indeed, Patent Owner agreed with this distinction during claim construction in District Court. *Multifold Int’l, Inc. v. Motorola Mobility, LLC*, Case 1:23-cv-01173-JLH, D.I. 83 (Jan. 27, 2025 D. Del.) Accordingly, the examiner did not consider the Petition’s prior art to the issued claims. *Palo Alto Net’s, Inc. v. Centripetal Net’s, LLC*, IPR2022-00182, Paper 11, at 36 (May 25, 2022) (not exercising discretionary denial because prior art was not applied to amended claims).

Finally, the Petition noted that its references disclose the ability to maximize an application across both displays. Pet. at 30-31, 50-51, 64-65, 78. This limitation was argued to overcome rejections during prosecution, so this is yet another factor that weighs against discretionary denial. *Sarepta Therapeutics, Inc. v. Nippon Shinyaku Co., Ltd.*, IPR2021-01134, Paper 20, at 20, 22 (Jan. 20, 2022) (“the Office appears to have materially erred during prosecution insofar as there is no indication that the Examiner fully considered [the reference’s] teachings regarding [a specific limitation]” that was material to patentability.”)

Respectfully submitted,

Dated: April 7, 2025

By: /Christopher J. Higgins
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CERTIFICATE OF SERVICE

The undersigned certifies that on April 7, 2025, a copy of the following was served in its entirety via electronic mail, upon the following attorneys of record for the Patent Owner:

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