

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC and GOOGLE LLC,
Petitioners,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner.

Case IPR2025-00040

U.S. Patent 9,134,756

PATENT OWNER'S PRELIMINARY SUR-REPLY

The Petition unambiguously argued that 325(d) denial is inappropriate because it “relies upon prior art references that were not of record during prosecution of the ’756 patent.” Pet., 9. Petitioners now concede that this representation is false. Reply, 1. Because Petitioners make no attempt to explain or defend their Petition argument that the references were not of record during prosecution and instead abandon that argument to argue that the examiner did not sufficiently consider the references during prosecution, the Reply makes a new argument that was not presented in the Petition. This new argument should not be considered. *See* 37 CFR §42.104(b) (all arguments should be made in the Petition), §42.108(c) (good cause required to reply to the POPR).

Even if the Board were to entertain Petitioners’ new argument, discretionary denial is still warranted because the Reply misrepresents the statuses of the references, and the examiner sufficiently considered the references for the Director to exercise her discretion and deny institution under Section 325(d).

A. The same or substantially similar references were previously presented

The Petition relies on four references: Yook, Lee, Aguilar, and Purcell. Petitioners admit Yook and Aguilar were previously presented to the Office. Reply, 1 (“Yook and Aguilar were cited in an IDS filed during prosecution.”).

Petitioners base their argument against Lee on a hypertechnicality: Lee itself was not cited to the PTO – rather, Lee’s European counterpart was. Ex.2001; Reply, 2. But the issue is not whether the exact publication number of Lee was presented as Petitioners frame it. The issue is that Lee and its European counterpart *share the same word-for-word disclosure* – thus, Lee’s disclosures were previously presented in the form of Lee’s identical European counterpart. *Compare* Ex.1005 with Ex.1002, 236-258.

While Purcell was not of record during prosecution, the Petition represented that Purcell was cumulative with Yook because they “accomplish the same solutions to the same problem” and, to the extent a limitation is absent from Purcell, it would have been found in Yook. POPR, 11 (*citing* Pet., 84-85). The Reply generically argues that Purcell “is not cumulative” with the other references but fails to “identify any teaching in Purcell that distinguishes it” from the other references. Reply, 2; POPR, 11. Petitioners cannot meet their burden on this issue with a generic allegation after their own Petition admission and the POPR’s calling out their failure of proof. Without identifying a specific distinguishing teaching, there is nothing even for Patent Owner to refute or explain why it is not distinguishing. The Board should presume that Purcell is cumulative based on Petitioners’ inability to meet their burden to identify anything distinguishing.

B. The Director should exercise her discretion and deny institution under Section 325(d)

The first prong of *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB 2020) is met because Petitioners' references were either previously presented to the Office (Yook, Lee, Aguilar) or substantially similar to references previously presented (Purcell).

Under the second prong, Petitioners argue that “the Office did not address any of the references.” Reply, 3. But Section 325(d) permits the Director to deny institution under these circumstances. Section 325(d) on its face states that “the Director may[] reject the petition[] because, the same or substantially the same prior art or arguments previously were *presented* to the Office.” And they were. This is consistent with the first prong of *Advanced Bionics*. All Section 325(d) and *Advanced Bionics*'s first prong require is that the teachings be *presented* – there is no additional requirement that they be addressed. Respectfully, a reference that is presented but not addressed is not an error under the second prong.

The fact that an examiner did not address a reference in writing is not evidence that the examiner did not substantively consider it. The MPEP requires examiners consider all information submitted in an IDS. MPEP 609 (“Once the minimum requirements of 37 CFR 1.97, 37 CFR 1.98, and 37 CFR 1.33(b) are met, *the examiner has an obligation to consider the information.*”). If an

examiner following the MPEP did not address an IDS reference, that means the examiner concluded that the reference could not support a rejection in an Office action, not that the examiner did not consider the reference at all. *Id.* It would be an inefficient use of PTO resources to require examiners to explain individually in writing why claims are allowable over every single considered reference. But Petitioners' proposal that the examiner must do exactly that or the considered references would be subject to reexamination and review by default would lead to that result. To the extent *Chemtronics USA, Inc. v Flatfrong Labs. AB*, IPR2024-00014, Paper 11 (PTAB 2024) is cited to suggest that absence of mentions of references in Office Actions is an error, *Chemtronics* is distinguishable. There, Patent Owner only argued discretionary denial (*Chemtronics*, Paper 6) and did not contest Petitioners' showing that the references suggested the claims. The prior art disclosing the claims, not the absence of mentions, is the second prong error. Here, the POPR at 13-17 identifies reasons why an examiner could have found that the references do not suggest the claims; thus, there is no error. *Chemtronics* requires the references to "clearly disclose" the claimed subject matter – the POPR at 13-17 shows that there is no clear disclosure here.

The Reply at 1 and 5 also argues that the examiner did not consider the claims as amended after allowance. This is disproven by the prosecution history.

The applicant requested reconsideration of the after allowance amendment (Ex.1002, 62)—there was no representation that the amendment did not change the claim scope. In response, the examiner performed a new search (Ex.1002, 41) specifically for the amended keyword “display” and further made an examiner’s amendment (Ex.1002, 37) before allowing the amended claims again. The record shows that the examiner did substantively consider the amended claims, and allowed the claims over the presented references nonetheless. And as the POPR at 12 pointed out, Petitioners do not allege that Purcell teaches “multi-display” as opposed to “multi-screen,” so this alleged error does not even implicate the sole reference that was not explicitly presented to the Office.

The Reply focuses on the references’ disclosing the ability to maximize an application across two displays (rather than screens). Reply, 5. This is not alleged to be taught by Lee or Purcell and so cannot be an error with respect to these references. POPR, 12. And the Reply has not sufficiently pointed out how the examiner erred with respect to Yook and Aguilar given that the POPR shows Yook and Aguilar do not clearly disclose the claimed subject matter. In short, Petitioners have at most argued that *Becton, Dickinson* factor 4 and possibly factor 3 do not weigh in favor of denying institution, while factors 1, 2, 5, and 6 still favor denial. As most factors favor denial, discretionary denial is still appropriate.

Date: April 14, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Sur-Reply consists of 1,147 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 words as mandated 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).

Respectfully submitted,

/Minghui Yang/

Date: April 14, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** have been served electronically via email on counsel of record for

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