

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL ELECTRONICS HOLDINGS LTD.
(f/k/a TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.)

Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00120

U.S. Patent No. 10,375,341

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO THE
PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO. 10,375,341**

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I. PETITIONER'S SINGLE GROUND INVOLVES THE SAME OR SUBSTANTIALLY THE SAME ART AND/OR ARGUMENTS

Acharya is cumulative and substantially the same as Robbins. POPR at 18. Petitioner's arguments that Robbins was not "discussed, cited, or substantively applied by the Examiner during prosecution of the '341 patent" (Reply 1) are irrelevant in establishing Robbins as previously presented art, because Robbins's inclusion on an Information Disclosure Statement establishes Robbins as such. *See* POPR 18-20; *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 7-8 (P.T.A.B. Feb. 13, 2020) (precedential).

Further, Robbins was the primary reference asserted by the Examiner during prosecution of the parent application. EX2001 at 347; *see* POPR 18. As stated in the POPR, "the prosecution history of the '895 Application is to be considered 'with equal force' as the prosecution history of the '341 Patent itself." *See* POPR 19-20.

In any case, Petitioner's arguments that "Patent Owner makes no effort to compare the claims of the '341 patent to the parent" are ineffectual. Petitioner has already provided evidence that the Examiner considered the claims of the '341 patent to be substantially similar to the parent patent through its acknowledgement that the '341 Patent application was subject to a nonstatutory obviousness-type double

patenting rejection.¹ Pet. 12. In relation to this rejection, the Examiner noted that “all the claimed limitations recited in the present application are transparently found in the [parent patent] with obvious wording variations” and provided a comparison of the claims of the '341 Patent and the parent patent. EX1002 at 254-70.

Petitioner attempts to distinguish its asserted reference, Acharya, from Robbins based on a single allegedly missing element related to communication that bypasses a router.² See Reply 2-3. For example, Petitioner states that “Robbins fails to disclose the second communication path that bypasses the router, as required by claim 1, whereas Acharya explicitly teaches multiple user-selectable wireless paths.” Reply 2-3. While the Reply asserts that Acharya “explicitly teaches” this limitation, the Petition tells a different story. In the Petition, Petitioner concedes this feature is missing in Acharya and instead relies on the knowledge of a POSITA in relation to this feature. See, *e.g.*, Pet. 46-47. Further, Petitioner's cited portions of Acharya fail

¹ The claims subject to the obviousness-type double patenting rejection were allowed after filing a terminal disclaimer and are substantially the same as the challenged claims. See, *e.g.*, EX2001 at 254-70 (showing listing of claims subject to obviousness-type double patenting rejection).

² Other distinctions Petitioner makes, such as the statement that Robbins allegedly discusses communication systems “distributed to ‘commercial and/or residential buildings’” are irrelevant to how the Examiner relied on Robbins or how Petitioner relies on Acharya. See, *e.g.*, POPR 18-21.

to support Petitioner's contention that the user can select specific wireless paths and instead only provides examples of wireless links and discussion of "roundtable multiple-user mode." See EX1004 Fig. 5; ¶¶ [0036], [0058]-[0062]. Further, as provided in the POPR, Acharya, with or without the knowledge of a POSITA, fails to disclose or render obvious this limitation. See, e.g., POPR 24-30.

Petitioner's Reply arguments therefore fail. Acharya is cumulative to art presented to the Office during prosecution of the '341 Patent, such as Robbins, and the first part of *Advanced Bionics* is met.

II. NO MATERIAL ERROR

While the Reply asserts that the "Petition explains in detail why the '341 patent should not have issued over the prior art in view of the knowledge of the PHOSITA," the Reply only cites to its Grounds. Reply 3. But the alleged grounds of unpatentability cannot establish material error *per se*. See *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (P.T.A.B. July 11, 2023) ("[W]hile there are no 'magic words' necessary to address material error, Petitioner's alleged grounds of unpatentability cannot establish material error *per se* under our binding precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework ('material error') would collapse into one."). Rather, under Part 2 Petitioner needed to, but failed to, address why allowance of the claims over Robbins—which is cumulative to

Acharya—was material error. Petitioner therefore fails to demonstrate material error. *See also* POPR 21-23.

III. PETITIONER'S CLAIM CONSTRUCTION ARGUMENTS FAIL

Petitioner's Reply asserts that the Petition accounts for the District Court construction but fails to address any component in Acharya as the "wireless transceiver that can communicate with wireless control devices either directly or indirectly," and "executes two-types of bi-directional wireless communication" and only cites different wireless protocols. Reply 5. Petitioner's generic recitation of wireless protocols fails to address the claim construction, which requires a component that executes two-types of bi-directional wireless communication. As explained in the POPR, the Petition fails to establish a component in Acharya that executes two types of bi-directional wireless communication. *See, e.g.*, POPR 24-31. For example, the Petition fails to establish that Acharya teaches "sending of a first information for informing termination," as recited in the claims and therefore fails to establish communication in at least one direction. *See, e.g., id.*

Additionally, while Petitioner alleges that Acharya "discloses both communications with a first wireless control device without going through a router and a second communication via a router with a second control device that is different from the first" (Reply 5) Acharya fails to disclose this limitation. *See* POPR 24-31. The Petition even tacitly admits that Acharya fails to disclose this limitation

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and relies on the knowledge of a POSITA in relation to this limitation. Pet. at 33-35. Petitioner's claim construction arguments therefore fail to find support in either the Petition or the reference itself and should be rejected.

IV. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: April 22, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of April, 2025, a copy of the attached **PATENT OWNER'S SUR-REPLY** was served by electronic mail to the attorneys of record, at the following addresses:

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