

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: IPR2025-00135

U.S. Patent No. 10,219,020

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO THE
PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO. 10,219,020**

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TABLE OF CONTENTS

	Page
I. PETITIONER'S GROUNDS INVOLVE THE SAME OR SUBSTANTIALLY THE SAME ART AND/OR ARGUMENTS	1
II. NO MATERIAL ERROR	3
III. PETITIONER'S CLAIM CONSTRUCTION ARGUMENTS FAIL.....	4
IV. CONCLUSION.....	5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	1, 2
<i>Biocon Pharma Ltd. v. Novartis Pharmaceuticals Corp.,</i> IPR2020-01263, Paper 12 (P.T.A.B. Feb. 16, 2021).....	1
<i>Praxair Distribution, Inc. v. Ino Therapeutics, LLC,</i> IPR2015-00893, Paper 14 (P.T.A.B. Sept. 22, 2015).....	1
<i>Vital Connect, Inc. v. Bardy Diagnostics, Inc.,</i> IPR2023-00381, Paper 7, 20 (P.T.A.B. July 11, 2023).....	3

I. PETITIONER'S GROUNDS INVOLVE THE SAME OR SUBSTANTIALLY THE SAME ART AND/OR ARGUMENTS

Petitioner's arguments that Bennett was not "discussed" by the Examiner lacks merit. Reply 1-2. It is well established that "[p]reviously presented art includes art made of record . . . such as on an Information Disclosure Statement." *Biocon Pharma Ltd. v. Novartis Pharmaceuticals Corp.*, IPR2020-01263, Paper 12, at 9 (P.T.A.B. Feb. 16, 2021) (quoting *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 7-8 (P.T.A.B. Feb. 13, 2020) (precedential)). Petitioner's arguments rely on outdated cases and institution decisions that precede the precedential *Advanced Bionics* decision. Reply 1-2.¹ Also, Petitioner's Reply fails to rebut or even address that the same (or substantially the same) figures and descriptions relied upon in the Petition were previously presented in multiple other references made of record. *See, e.g.*, POPR 15-24. The fact that a plurality of previously presented art incorporated the same disclosures relied on in the Petition further demonstrates the extent that the same art and/or arguments were previously considered by the Office. *See id.*

¹ Petitioner wrongly dates the *Praxair Distribution, Inc. v. Ino Therapeutics, LLC* decision as 2025, instead of 2015. *See* Reply 2; *Praxair Distribution, Inc. v. Ino Therapeutics, LLC*, IPR2015-00893, Paper 14 at 8 (P.T.A.B. Sept. 22, 2015).

Petitioner also dismisses the comparison of Bennett and Nashida with Slotznick with an argument that “Petitioner’s reliance on Bennett and Nashida, both of which are materially better references than Slotznick, does not duplicate the examination record but corrects its shortcomings.” Reply 2. Further, Petitioner’s alleged distinctions of Slotznick from Bennett and Nashida are inconsequential, because the Petition did not rely on these alleged distinctions as a basis for either of its grounds. For example, Petitioner describes the “drag-and-drop style interface” of Nashida as a distinguishing feature, but fails to rely on this feature anywhere in the Petition. *See, e.g.*, Pet. at 66-83 (failing to mention the “drag-and-drop style interface” as a basis for any of the claim elements). While Petitioner dismisses Patent Owner’s arguments as “very high level descriptions,” these “high level descriptions” are precisely what Petitioner relies upon in its Petition. *See, e.g.*, POPR 40-46. Patent Owner has merely taken these “high level descriptions” directly from the Petition and mapped them to previously presented art and/or arguments. *See, e.g.*, POPR 40-46.

As such, Bennett was previously presented, and the combination of Bennett and Nashida is cumulative to previously presented art and/or arguments. The first part of *Advanced Bionics* is met.

II. NO MATERIAL ERROR

Petitioner failed to assert any material error by the Office in the Petition over previously presented art, including Bennett. *See* Pet. 10. Now, in its Reply, Petitioner attempts to manufacture material error by pointing to the grounds of the Petition. This approach cannot establish material error *per se* and should be rejected. *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.”).

Petitioner argues with respect to “operation instructions” that “Bennett discloses a ‘media swapping’ feature where control signals from the phone direct the display of new media while the current content is still playing.” Reply at 3. In the very next paragraph Petitioner states that “[n]one of this analysis or evidence was before the Examiner.” *Id.* at 4. This is incorrect. Bennett was previously presented to the Office and Bennett’s discussion of “operation instructions” was already considered. Further, as detailed in the POPR, there was no material error because Bennett’s “operation instructions” fail to disclose or render obvious the challenged claims. *See* POPR 58-65.

Petitioner's arguments distinguishing Nashida from Slotznick carry no weight, because they confirm what Patent Owner has already stated above—Petitioner's Reply arguments concern features not relied upon in the Petition. *See* Reply 3. For example, Petitioner fails to provide any citation to Nashida on the allegedly distinguishing feature of “drag-and-drop content transfer with visual feedback,” and merely cites to Nashida itself instead of the Petition. Reply 3.

III. PETITIONER'S CLAIM CONSTRUCTION ARGUMENTS FAIL

Petitioner presents new claim construction arguments that are unsupported by the Petition and cited references, and ultimately fail to support the District Court's claim construction.

The District Court construed “operation instructions” as “commands and instructions used to operate second video content.” *See* EX2002 at 30. Petitioner argues that the Petition's theory is consistent with the Court's construction, yet fails to provide any citations to the Petition explaining this consistency. Petitioner instead cites to, and mischaracterizes, Dr. Wolfe's declaration. *See* Reply 5. While Petitioner alleges that Dr. Wolfe articulated a theory that operation instructions were used to operate second video content that is being displayed, Dr. Wolfe's testimony only generically refers to “media swapping.” EX1003 ¶¶89-90. Petitioner's arguments that the operation instructions were directed to “stop[ping] displaying the current (second) video content” were never articulated in the Petition or declaration. *See id.*

In any case, the operation instructions of “display[ing] different multimedia content” fails to relate to the second content being displayed. Bennett explicitly states that “media swapping” is directed to the delivery of new content and not the content currently being displayed. *See* EX1003 ¶ [0051] (“The phone 403 sends a control signal to the multimedia source 409 that directs the multimedia source 409 to deliver a second multimedia element.”). Additionally, or alternatively, executing operation instructions to cause delivery of new content ceases any alleged second video content being displayed and therefore cannot occur “while the second video content is being displayed,” as recited in the claim.

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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