

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,**
Petitioner

v.

TVNGO LTD.,
Patent Owner

IPR2026-00214
U.S. Patent No. RE50,399

**PATENT OWNER TVNGO LTD.'S
REPLY TO PETITIONER'S OPPOSITION TO THE
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	THE <i>CARBYNE</i> REISSUE PATENT HAD NEW CLAIMS.	1
II.	TVNGO DID NOT WITHHOLD MATERIAL PRIOR ART.	1
A.	No “Substantially Similar” EP Claims Were Rejected Over Marler.....	2
B.	The Marler-Inequitable Conduct Issue Was Before The Examiner.....	3

TABLE OF AUTHORITIES

Agency Decisions

<i>Carbyne, Inc. v. Tritech Software Sys.,</i> IPR2025-00959, Paper 11 (Director Oct. 3, 2025)	1
<i>Magnolia Medical Tech., Inc. v. Kurin, Inc.,</i> IPR2026-00097, Paper 17 (Director May 14, 2026) (precedential)	1
<i>Microsoft Corp. v. Sandpiper CDN, LLC,</i> IPR2026-00180, Paper 15 (Director May 6, 2026).....	1
<i>Nvidia Corp. v. Neural AI,</i> IPR2025-00608, Paper 16 (Director July 31, 2025)	1

EXHIBIT LIST	
2001	Memorandum re: Interim Processes for PTAB Workload Management (Mar. 26, 2025)
2002	Memorandum re: Enforcement And Non-Waiver Of 37 C.F.R. § 42.104(b)(4) And Permissible Uses Of General Knowledge In Inter Partes Reviews (July 31, 2025)
2003	Complaint, <i>TVnGO Ltd., v. Samsung Elecs., Co., Ltd. et al.</i> , Case No. 7:25-cv-00549 (W.D. Tex. Nov. 26, 2025)
2004	Samsung's Motion for Extension of Time, <i>TVnGO Ltd., v. Samsung Elecs., Co., Ltd. et al.</i> , Case No. 7:25-cv-00549 (W.D. Tex. Feb. 26, 2026)
2005	<i>Markets in Brief</i> , Haaretz (Aug. 5, 2008) available at https://www.haaretz.com/2008-08-05/ty-article/markets-in-brief/0000017f-e984-dc91-a17f-fd8d18b90000 .
2006	Shelah, Shmulik, <i>TVnGo wins contract with Chinese TV co BTTV</i> , Globes (Oct. 5, 2006). available at https://en.globes.co.il/en/article-1000139146
2007	<i>TVnGo Introduces: TV Broadcasting Overlaid by Internet Contents on TV Screen, Navigated by User Remote Control at CES, Las Vegas</i> , Business Wire (January 7, 2007). available at https://web.archive.org/web/20111118005006/HTTP://WWW.BUSINESSWIRE.COM/NEWS/HOME/20070107005003/EN/TVNGO-INTRODUCES-TV-BROADCASTING-OVERLAID-INTERNET-CONTENTS#.VB3F1RTVIKO
2008	U.S. Patent No. RE49,461
2009	U.S. Patent Application No. 12/118,041 File History

Pursuant to the Office’s email authorization on June 2, 2026, Patent Owner TVnGO Ltd. files this Reply to Petitioner’s Opposition (“Opp.”) to the Request for Discretionary Denial (“RDD”). Ex. 3102.

I. THE *CARBYNE* REISSUE PATENT HAD NEW CLAIMS.

Petitioner cites *Carbyne* as deciding whether settled expectations of a reissue patent with the same claims should be measured from the date of the original patent. Opp. at 4-5. But the *Carbyne* patent reissued with eleven new dependent claims, four of which were at issue in the IPR. Ex. 1036 at 17:11-18:29; Ex. 1035 at 5. Opp. at 3. Petitioner does not dispute that “the ’399 patent issued with substantially the same claims as the original patent.” Opp. at 2; RDD at 6-9. Thus, *Carbyne*, like *Nvidia Corp. v. Neural AI*, is “inapposite” to the current situation where the ’399 Patent reissued with no newly added claims whatsoever. Opp. at 4-5.

II. TVNGO DID NOT WITHHOLD MATERIAL PRIOR ART.

Petitioner cites the recent Director decisions—*Microsoft v. Sandpiper* and *Magnolia Med. v. Kurin*—and two Federal Circuit cases for the proposition that intentionally withholding material prior art from the Patent Office during prosecution weighs against discretionary denial. Opp. at 6-11. But these cases do not apply here as TVnGO did not intentionally withhold material prior art or an adverse examiner decision on substantially similar claims from the Patent Office.

Petitioner's contrary arguments rest on false and misleading statements regarding TVnGO's prosecution histories, as discussed below.

A. No “Substantially Similar” EP Claims Were Rejected Over Marler.

Petitioner's argument is based on the false premise that a claim “in substantially the same form as claim 1 of the '399 patent” was rejected over Marler and Blackketter at the EPO. Opp. at 8. Petitioner contends that in response to a rejection over Marler and Blackketter in the “Corresponding EP Application,” TVnGO amended claim 1 in that application “to make it substantially similar to claim 1 of the '399 Patent,” and then “[t]he claims were *again* rejected,” requiring a further amendment to overcome Marler. *Id.* at 7-8 (citing Exs. 1039-1041).

But this is not true. After TVnGO amended the EP claims to allegedly make them “substantially similar” to the '399 Patent, they were *not* rejected over Marler, Blackketter, or any other prior art. Instead, the next Examination Report raised clarity and support objections and suggested edits to fix those concerns—including revising claim 1 to require “overlay activation criteria including at least a channel information and a time information” Ex. 1040 at 4-7. TVnGO accepted those edits to obviate the Examination Division's concerns of clarity and support, *not* to get around Marler, as Petitioner alleges. Ex. 1041 at 4-5; Opp. at 7-8. Indeed, TVnGO expressly noted that its prior “detailed arguments for novelty and inventive step ... in view of the cited prior art” were never refuted. *Id.* at 5.

B. The Marler-Inequitable Conduct Issue Was Before The Examiner.

Petitioner incorrectly suggests that LG's inequitable conduct allegations based on Marler and Blackketter were hidden from the Office during the reissue prosecution that led to the '399 Patent. Opp. at 9-10. Indeed, TVnGO's inequitable conduct briefing, which lists Marler ("US2001/003212") and Blackketter ("US2002/056129"), and a district court order addressing those allegations were identified in a reissue litigation search in a co-pending reissue application that led to the related '328 Patent. Ex. 1031 at 169-176, 124-128. These related reissue applications were pending before the same examiner at the same time. Ex. 1001 at 1; Ex. 1002 at 1. Thus, there is no merit to the contention that the Examiner lacked notice of LG's allegations based on Marler and Blackketter. Ex. 1031 at 238, 293; Ex. 1005 at 233 (Examiner "Reviewed Related" '328 Patent file history).

Additionally, Marler and Blackketter had already been submitted to the Office by TVnGO on January 26, 2017—eight years before the '399 Patent issued—in an IDS during the prosecution of the application leading to U.S. Patent No. 9,794,621 (the "'621 patent"), which was a continuation of the '220 Patent that eventually reissued as the '399 Patent at issue in this IPR. Ex. 1031 at 171-172; *id.* at 125 (District Court noting "LG does not allege that there was any problem with this particular IDS filed ... in this particular prosecution."); Ex. 1005 at 59, 233 (Reissue Examiner: "Reviewed Prior Application(s) History/Cited Prior Art").

Date: June 5, 2026

Respectfully submitted,

/s/ David L. Hecht

David L. Hecht (Lead Counsel)

(Reg. No. 61,618)

dhecht@hechtpartners.com

HECHT PARTNERS LLP

125 Park Avenue, 25th Floor

New York, NY 10017

P: (212) 851-6821

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the following documents were served
by electronic service on the date signed below:

**PATENT OWNER TVNGO LTD.'S
REPLY TO PETITIONER'S OPPOSITION TO THE
REQUEST FOR DISCRETIONARY DENIAL**

The names and addresses of the parties being served are as follows:

James M. Heintz
Michael Saulnier
Peter D. VandeVort
Sangwon Sung

jim.heintz@us.dlapiper.com
michael.saulnier@us.dlapiper.com
peter.vandevort@us.dlapiper.com
sangwon.sung@us.dlapiper.com
DLA-SamsungIPR-TVnGO@us.dlapiper.com

Date: June 5, 2026

/s/ David L. Hecht
David L. Hecht (Lead Counsel)
(Reg. No. 61,618)
dhecht@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (212) 851-6821