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			ART UNIT 3992	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Rodney C. LeRoy
Law Office of Rodney LeRoy
335 Walk Circle
Santa Cruz CA 95060

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,500 .

PATENT UNDER REEXAMINATION 8738103 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,500	Patent Under Reexamination 8738103	
	Examiner Colin LaRose	Art Unit 3992	AIA (FITF) Status Yes
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address-- The request for <i>ex parte</i> reexamination filed <u>04/30/2024</u> has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached. Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____ 1. ☒ The request for <i>ex parte</i> reexamination is GRANTED. RESPONSE TIMES ARE SET AS FOLLOWS: For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c). For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). NO EXTENSION OF THIS TIME PERIOD IS PERMITTED. If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.			
/COLIN M LAROSE/ Primary Examiner, Art Unit 3992			
cc:Requester (if third party requester)			

U.S. Patent and Trademark Office
PTOL-471G(Rev. 01-13)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20240604

JCI Ex. 1004-0003

ORDER GRANTING REEXAMINATION OF U.S. PATENT 8,738,103

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I. ACKNOWLEDGEMENT OF REQUEST FOR REEXAMINATION

An *ex parte* request for reexamination (hereinafter “Request”) of claims 12 and 15 of U.S. Patent 8,738,103 (hereinafter “’103 Patent”) was received on April 30, 2024, based on the following prior art patents and/or publications:

- U.S. Patent Application Publication 2007/0238483 (“Boireau”);
- U.S. Patent Application Publication 2003/0189522 (“Zeilinger”);
- U.S. Patent 6,239,765 (“Johnson”); and
- U.K. Patent Application Publication No. GB 2416625A (“Langley”).

II. PROSECUTION HISTORY OF THE '103 PATENT

The Request's summary of the prosecution history of the '103 patent appears to be accurate (see Request, pp. 15-18). Notably, during prosecution of the '103 patent, the examiner rejected claim 18 (now patent claim 12) under 35 U.S.C. § 103(a) as being unpatentable over the combination of Lehtola (U.S. 6,476,769), Ramer (U.S. 7,548,915), and Dominquez (U.S. 2002/0175211).¹

In response to this rejection, Applicant amended claim 18 as follows:²

18. (Currently Amended) A handheld multifunction wireless device having at least one of multimedia functionality and smartphone functionality, the handheld multifunction wireless device comprising:

~~a receiver of at least one of analog and digital sound signals;~~
~~an image recording system comprising at least one of an at least two-Megapixel image sensor, a flashlight, an optical zoom, and a digital zoom;~~
~~data storage means having a capacity of at least 1 GB;~~
~~a touch screen;~~
~~a processing module;~~
~~a memory module;~~
~~a communication module;~~
~~a power management module;~~
~~an antenna system within the handheld multifunction wireless device and comprising:~~
~~a ground plane layer;~~
~~a first antenna element having a conducting plate, the first antenna element configured to simultaneously supporting radiation modes for first, second, and third at least three frequency bands, the first frequency band being contained within a first frequency region of an electromagnetic spectrum, the second frequency band being contained within a second frequency region of the electromagnetic spectrum that is higher in frequency than the first frequency region, the third frequency band of operation being used by a 4G communication standard, so that the antenna system is capable of simultaneously transmitting and receiving electromagnetic signals across the frequencies of said at least three frequency bands; wherein said at least three frequency bands are used by at least a GSM communication standard and a WCDMA communication standard; wherein the antenna system a perimeter of the first antenna element defines a first an antenna contour comprising at least two disjointed subsets of segments, each of~~

¹ See non-provisional application no. 11/614,429, Non-Final Office Action dated 3/19/2013, at pp. 18-19.

² See id., Applicant's Amendment and Response to Notice of Non-Compliant Amendment dated 11/13/2012, at pp. 5-7.

~~said at least two subsets of segments comprising at least six~~ thirty-five segments, the first antenna element defining an antenna box, an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defining an antenna rectangle, wherein a length of the first antenna contour is greater than four times a diagonal of the antenna rectangle; and

a second antenna element configured to operate in at least one frequency band used by a 4G communication standard, wherein a perimeter of the second antenna element defines a second antenna contour comprising at least twenty segments

~~wherein one of said at least two disjointed subsets of segments is defined by the perimeter of said conductive plate; and~~

~~wherein the antenna contour has a level of complexity defined by complexity factor Fa, having a value of at least 1.05 and not greater than 1.40 and by complexity factor F32 having a value of at least 1.20 and not greater than 1.70.~~

In response to the above amendment to claim 18, the examiner allowed claim 18 because, “the prior art of record does not anticipate or render obvious ... the features of: ‘wherein a perimeter of the first antenna element defines a first antenna contour comprising at least thirty-five segments, the first antenna element defining an antenna box, an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defining an antenna rectangle, wherein a length of the first antenna contour is greater than four times a diagonal of the antenna rectangle; and a second antenna element configured to operate in at least one frequency band used by a 4G communication standard, wherein a perimeter of the second antenna element defines a second antenna contour comprising at least twenty segments.’”³

³ See *id.*, Notice of Allowability dated 1/8/2014, at p. 2.

III. SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The Request alleges the following substantial new questions of patentability (SNQs) based on the above-identified prior art:

SNQ 1—Boireau and Zeilinger for claims 12 and 15 (see Request at pp. 31-77);

SNQ 2—Boireau, Zeilinger, and Langley for claims 12 and 15 (see Request at pp. 78-129); and

SNQ 3—Johnson and Boireau for claims 12 and 15 (see Request at pp. 129-187).

SNQ 1—Boireau and Zeilinger for claims 12 and 15

Boireau, which is directed to antenna sharing techniques, and Zeilinger, which is directed to a tri-band antenna, are identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art during the initial examination. Specifically, the Request alleges that these prior art references teach a handheld wireless device that includes a first antenna element having a perimeter that defines a first antenna contour comprising at least thirty-five segments, the first antenna element defining an antenna box, an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defining an antenna rectangle, wherein a length of the first antenna contour is greater than four times a diagonal of the antenna rectangle, and a second antenna element configured to operate in at least one frequency band used by a 4G communication standard, wherein a perimeter of the second antenna element defines a second antenna contour comprising at least twenty segments, *inter alia*, as claimed.

Notably, Zeilinger is cited by the Requester as providing teachings that correspond to the claimed configuration of the first antenna element – see pp. 61-68 of the Request, which

identifies FIG. 2 of Zeilinger as illustrating an antenna element that allegedly (1) has a perimeter that defines a first antenna contour comprising at least thirty-five segments, (2) defines an antenna box in which an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defines an antenna rectangle, and (3) has a length of the first antenna contour greater than four times a diagonal of the antenna rectangle. Zeilinger is also cited as providing teachings that correspond to the claimed configuration of the second antenna element – see pp. 69-70 of the Request, which identifies FIG. 2 of Zeilinger as illustrating a second antenna element that allegedly (1) is configured to operate in at least one frequency band used by a 4G communication standard, and (2) has a perimeter that defines a second antenna contour comprising at least twenty segments. In addition, teachings in both Zeilinger and Boireau are identified that suggest the incorporation of multiple antennas into a handheld wireless device, as claimed – see pp. 71-73 of the Request.

Neither of these prior art references were cited or considered during the initial examination. The Request establishes that they would have been considered important in determining the patentability of claims 12 and 15—that is, Boireau and Zeilinger provide teachings coinciding with, or at least related to, the limitations that previously rendered the claims patentable.

Since these prior art references appear to provide new technological teachings that were missing in the prior art during the initial examination of the ‘103 patent and were not previously considered during the initial examination, they do raise a substantial new question of patentability.

SNQ 2—Boireau, Zeilinger, and Langley for claims 12 and 15

As indicated above, the teachings of Boireau and Zeilinger raise a bona fide substantial new question of patentability for claims 12 and 15. For SNQ 2, the Request identifies the teachings of Boireau, Zeilinger, and Langley as raising a substantial new question of patentability for claims 12 and 15. Since Boireau and Zeilinger alone raise an SNQ for claims 12 and 15, it is agreed that the teachings in Boireau and Zeilinger, in combination with the teachings of Langley, which is directed to a multi-band antenna, also raises a bona fide SNQ of claims 12 and 15 for substantially the same reasons as identified in SNQ 1.

SNQ 3—Johnson and Boireau for claims 12 and 15

Johnson, which is directed to an asymmetric dipole antenna assembly, and Boireau, which is directed to antenna sharing techniques, are identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art during the initial examination. Specifically, the Request alleges that these prior art references teach a handheld wireless device that includes a first antenna element having a perimeter that defines a first antenna contour comprising at least thirty-five segments, the first antenna element defining an antenna box, an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defining an antenna rectangle, wherein a length of the first antenna contour is greater than four times a diagonal of the antenna rectangle, and a second antenna element configured to operate in at least one frequency band used by a 4G communication standard, wherein a perimeter of the second antenna element defines a second antenna contour comprising at least twenty segments, *inter alia*, as claimed.

Notably, Johnson is cited by the Requester as providing teachings that correspond to the claimed configuration of the first antenna element – see pp. 165-173 of the Request, which identifies FIG. 9 of Johnson as illustrating an antenna element that allegedly (1) has a perimeter that defines a first antenna contour comprising at least thirty-five segments, (2) defines an antenna box in which an orthogonal projection of the antenna box along a normal to a face with a largest area of the antenna box defines an antenna rectangle, and (3) has a length of the first antenna contour greater than four times a diagonal of the antenna rectangle. Johnson is also cited as providing teachings that correspond to the claimed configuration of the second antenna element – see pp. 173-181 of the Request, which identifies FIG. 9 of Johnson as illustrating a second antenna element that allegedly (1) is configured to operate in at least one frequency band used by a 4G communication standard, and (2) has a perimeter that defines a second antenna contour comprising at least twenty segments.

Johnson was cited and considered during the initial examination of the ‘103 Patent, as evidenced by its citation on the face of the ‘103 Patent. Accordingly, SNQ 3 is based solely on a prior art patent already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

“The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., “old art,” does not necessarily

preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists an SNQ based solely on the teachings of Johnson. Although Johnson was cited during the initial examination of the '103 patent, it was never applied as a basis of rejection, nor was it ever discussed by the Patent Owner or the examiner with respect to the claims. The Request now effectively presents Johnson in a new light by identifying how the technological teachings therein coincide with, or are at least related to, the limitations that previously rendered the claims patentable. Accordingly, the teachings of Johnson, as discussed in the Request on pp. 165-181, raise a substantial new question of patentability that, by all accounts, has not been specifically considered or addressed during the initial examination of the '103 Patent.

The Request to reexamine claims 12 and 15 on the basis on SNQs 1-3 is **GRANTED**.

IV. ONLY CLAIMS 12 AND 15 ARE SUBJECT TO REEXAMINATION

Since Requester did not request reexamination of claims 1-11, 13, 14, and 16-20 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims, such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006). The District Court upheld the Office's discretion to not reexamine claims in an *inter partes*

reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

“To be sure, a party may seek, and the PTO may grant, *inter partes* review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which *inter partes* review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for *inter partes* review, 35 U.S.C. § 31 I(b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive.”

See also MPEP § 2240:

If the requester fails to apply the art to certain claims, then the requester is not statutorily entitled to reexamination of such claims. If a requester chooses not to request reexamination for a claim, and thus fails to set forth the pertinency and manner of applying the cited art to that claim as required by 37 CFR 1.510(b), that claim will generally not be reexamined. The decision to reexamine any claim for which reexamination has not been requested under 35 U.S.C. 302 lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested under 35 U.S.C. 302, it is permitted to do so.

V. 35 U.S.C. § 325(d)

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must

first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the post grant history of the ‘103 patent indicates that the patent was the subject of a single prior post grant challenge.

On October 24, 2023, Petitioner Vivint, Inc. filed a petition seeking *inter partes* review of claims 12 and 15 of the ‘103 patent (IPR2024-00087), which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP #	Claims Challenged	35 USC §	References
1	12, 15	103	Johnson, Boireau
2	12, 15	103	Zeilinger, Boireau

On February 20, 2024, the Patent Trial and Appeal Board (PTAB) issued a decision terminating the proceeding prior to institution in view of a joint motion by the parties to terminate the proceeding due to a settlement before institution.

A comparison between the prior art and arguments presented in the instant Request for ex parte reexamination of the ‘103 patent, indicates that the Request is based on the same prior art grounds that were previously presented to the Office in the prior terminated IPR petition:

SNQ #		Claims Challenged	Basis	References
1		12, 15	103	Boireau, Zeilinger
2		12, 15	103	Boireau, Zeilinger, Langley
3		12, 15	103	Johnson, Boireau

Thus, the threshold under 35 USC 325(d) for the director to exercise discretion in determining whether to Order reexamination has been met.

However, in view of the following facts, the Director declines to exercise such discretion to reject the reexamination request: 1) the fact that the prior denied IPR petition was terminated prior to institution based on a joint settlement agreement without the PTAB substantively reviewing the prior art presented in the petition, and 2) the fact that there has been no prior finding of abusive challenges to the '103 patent by third party requester.

Accordingly, *ex parte* reexamination is Ordered for the '103 patent, in view of the determination above that SNQ has been raised in the instant Request for Reexamination.

VI. PATENT OWNER STATEMENT (OPTIONAL)

In response to this Order for Reexamination, the Patent Owner is given a two (2) month period to file an optional Patent Owner Statement in accordance with 37 C.F.R. § 1.530(b) and (c). The Patent Owner Statement must clearly point out why the patent claims are believed to be patentable, considering the cited prior art patents or printed publications alone or in any reasonable combination. In addition, the Patent Owner may utilize the Patent Owner Statement to introduce amendments. A copy of the Patent Owner Statement must be served on the Third Party Requester. See MPEP § 2249.

If a Patent Owner Statement is timely filed and served on the Third Party Requester, the Third Party is given the opportunity to reply within two (2) months from the date of service in accordance with 37 C.F.R. § 1.535. The reply need not be limited to the issues raised in the Patent Owner Statement and may include additional prior art patents and printed publications as well as any issue appropriate for reexamination. A copy of the reply must be served on the Patent

Owner. If no Patent Owner Statement is filed, no reply is permitted from the Third Party

Requester. See MPEP § 2251.

VII. WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. § 1.530 to file a Patent Owner Statement for the purposes of expediting prosecution; see MPEP § 2249. The document should contain a statement that Patent Owner waives the right under 37 C.F.R. § 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. § 1.248, if the request for reexamination was made by a third party requester; see 37 C.F.R. § 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner hereby waives the right under 37 C.F.R. § 1.530 to file a Patent Owner Statement.

VIII. NOTICE OF OTHER PROCEEDINGS

The patent owner is reminded of the continuing responsibility under 37 C.F.R. § 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,738,103 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or

proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

IX. NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

37 C.F.R. § 1.33(c) states:

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination or supplemental examination proceeding will be directed to the correspondence address in the patent file.

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 C.F.R. § 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination

(571) 272-7703

Central Reexam Unit (CRU)

(571) 272-7705

X. CONCLUSION

Extensions of time under 37 C.F.R. § 1.136(a) will not be permitted in these proceedings because the provisions of 37 C.F.R. § 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 C.F.R. § 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 C.F.R. § 1.550(c). See MPEP § 2265.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Colin LaRose whose telephone number is (571) 272-7423.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hetul Patel can be reached at (571) 272-4184. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of this proceeding may be obtained from the USPTO's Patent Center. To file and manage patent submissions in Patent Center, visit:
<https://patentcenter.uspto.gov>.

Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (in USA or Canada) or 571-272-1000.

General inquiries may also be directed to the Central Reexamination Unit customer service line at (571) 272-7705.

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
 Attn: Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450

Information regarding the status of reexamination proceedings may be obtained from the USPTO's Patent Center. To file and manage patent submissions in Patent Center, visit:
<https://patentcenter.uspto.gov>.

Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

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