UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

IRON OAK TECHNOLOGIES, LLC.
Patent Owner

Case: IPR2018-01553
U.S. Patent No. 5,699,275

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

Regulations

I. INTRODUCTION

Petitioner submits this Reply to Patent Owner's ("PO") Response (Paper 18, "Resp.") concerning claim 1 of the '275 patent.

PO makes similar arguments against each of the two grounds, 1) *Hapka* and *Parrillo* and 2) *Hapka*, *Parrillo*, and *Wortham*. PO's arguments fail because they are based on an incorrect interpretation of the "wherein" clause[1] recited in claim 1. Moreover, even under PO's interpretation, the prior art in the instituted grounds discloses or suggests the system recited in claim 1. Thus, none of PO's positions warrant disruption of the Board's initial findings and analysis as to why claim 1 is unpatentable in view of the prior art asserted in each of the instituted grounds. Accordingly, for the reasons set forth in the Petition (Paper 1, "Pet.") and further explained below, claim 1 should be found unpatentable and cancelled.

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[1] Petitioner refers to claim element 1(e) as the "wherein" clause, which recites "wherein the manager host is further operable to address the at least one discrete patch message such that the at least one discrete patch message is transmitted to the first mobile unit but not to the second mobile unit." (Ex. 1001, 13:50-53.)

II. PO'S ARGUMENTS IN ITS PRELIMINARY RESPONSE NOT RAISED IN ITS RESPONSE ARE WAIVED

As a preliminary matter, PO's attempt to incorporate by reference all of its arguments from its Preliminary Response is improper. (Resp., 1 ("Patent Owner incorporates herein for all purposes those arguments presented in its Preliminary Response.").) By rule, "[a]rguments must not be incorporated by reference from one document into another document." 37 C.F.R. § 42.6(a)(3); *see also RPX Corp. v. Collision Avoidance Techs. Inc.*, IPR2017-01337, Paper 35 at 20 (Nov. 13, 2018) ("Incorporation by reference is a direct violation of our rules, which prohibit incorporation by reference from other documents."). Additionally, "[a]rguments that are not developed and presented in the Patent Owner Response, itself, are not entitled to consideration." *Id.* at 20-21 (citations and internal quotation marks omitted). In fact, the Board's scheduling order explicitly cautions PO "that any arguments for patentability not raised in the response may be deemed waived." (Paper 10, 5.) Therefore, PO's arguments raised in its Preliminary Response but not raised in its Response are waived and not addressed herein. *See Trane U.S. Inc. v. SEMCO, LLC*, IPR2018-00514, Paper 36 at 4-6 (April 17, 2019) (finding "waiver of any argument" in patent owner's "post-institution response due to improper incorporation by reference" of arguments "from [patent owner's] "pre-institution response"); *Canfield Scientific, Inc. v. Melanoscan, LLC*, IPR2017-02125, Paper 62

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