

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS
Petitioner

v.

GENERAL ACCESS SOLUTIONS, LTD.
Patent Owner

IPR2023-00978
U.S. Patent No. 7,230,931

**PATENT OWNER'S SUR-REPLY TO PATENT
OWNER PRELIMINARY RESPONSE¹**

¹ Authorized by the Board's email dated October 23, 2023.

ARGUMENT

Verizon's Reply fails to address the merits of General Access's 35 U.S.C. § 325(d) argument. Verizon's Petition relies on the same primary reference—Vornefeld—that the Board and the Federal Circuit already found did not anticipate the Challenged Claims (28 and 29) or render them obvious. As explained in the Preliminary Response, the additional references Verizon relies upon add nothing pertinent to the validity of Claims 28 and 29 to the prior art that was previously before the Board in the Sprint IPR. POPR at 24-46.

Instead of grappling with the substance of General Access's arguments, Verizon sets up a strawman – wrongly arguing that General Access seeks to undo its prior surrender of Claims 1 and 19 in the Sprint IPR. Reply at 2. But this argument is nothing more than a diversion. General Access acknowledged in the Preliminary Response that it “surrendered” Claims 1 and 19 in the Sprint IPR. POPR at 15. Verizon's suggestion in its Reply that a discretionary denial under § 325(d) is not possible because Verizon was “successful” on Claims 1 and 19, and thus General Access is “precluded from taking action inconsistent with the adverse judgment,” is off the mark. Reply at 3.

This IPR involves Claims 28 and 29, not Claims 1 and 19, as Verizon knows. In its effort to confuse the issues, Verizon never addresses Claims 28 and 29.

As it did in its Petition, Verizon once again fails to identify any error in the Board's—and the Federal Circuit's—prior decisions that Vornefeld does not anticipate or render obvious Claims 28 and 29. Instead, Verizon acts as if Vornefeld was never considered as a reference in the Sprint IPR directly against Claims 28 and 29. But it was. The Board expressly determined that Claims 28 and 29 were not anticipated by, or rendered obvious over, Vornefeld. In making that determination, the Board held:

The block [from Figure 3 of Vornefeld] that Petitioner relies on for second downlink data traffic is depicted as a different (spatially separated) TDD frame that is simultaneously transmitted with the other frames. We agree with Patent Owner that Petitioner does not establish Vornefeld discloses using different beams in the same TDD frame (i.e., second downlink data traffic, transmitted in “said downlink portion of said TDD frame”) to transmit to devices within a different sector.

Ex. 1009, Sprint IPR Final Written Decision at 23 (emphasis added) (citations omitted).

The bottom line is that Verizon's Petition merely seeks a re-do of Vornefeld. Indeed, a simple word search reveals that “Vornefeld” appears 155 times in the Petition. None of the other references—Goldburg, Atsuta, or Tangemann—are cited anywhere near as frequently. More importantly, as General Access explained in detail in the POPR, those other references add nothing over Vornefeld, and the claimed disclosures of Verizon's newly-cited prior art are duplicative of prior art

cited in and incorporated by reference into the specification of the '931 Patent. POPR at 38-39. Verizon does not even respond to this.

Verizon quibbles over whether Goldberg was a formal exhibit before the Board in the prior Sprint IPR. Reply at 3. Regardless of whether Goldberg was a formal exhibit or just cited by Sprint's expert as evidence of the state of the art, the fact remains that Verizon has failed to identify any art that substantively adds anything beyond Vornefeld.

Verizon repeats like a mantra that it now cites "new references," as if that requires institution. Reply at 3. But as General Access explained in the POPR, Verizon cannot simply rest on its argument of "new references." POPR at 46-53. *Sony Interactive Entertainment LLC v. Terminal Reality, Inc.*, IPR2020-00710, at 11-12 (PTAB Oct. 13, 2020) (Paper 15), is directly on point. Like the Petition rejected in *Sony*, Verizon's Petition relies primarily on a previously considered reference (Vornefeld) and cites purported "new references" that do not add anything new.

To the extent Verizon argues in its Reply that General Access did not address Atsuta and Goldberg substantively on the merits, that representation is incorrect. General Access devoted pages 24-42 of its POPR to doing just that. Verizon had another opportunity in its Reply to respond to *Sony* and identify with specificity what

its “new references” add to what was previously before the Board in the Sprint IPR, but Verizon fails to even attempt to do so.

For all the reasons discussed in the POPR, the *Becton* factors, and specifically factor 6 that touches on the new references (“the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments”), *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586 (PTAB Dec. 15, 2017) (Paper 8) (precedential in relevant part), weigh heavily in favor of denying institution.

Verizon completely ignores General Access’s arguments on the application of the *Becton* factors to Claims 28 and 29. Verizon’s failure should be fatal.

Verizon has now failed twice (the Petition and the Reply) to point out any error in the Board’s prior holding and the Federal Circuit affirmance on Claims 28 and 29. General Access walked through each of the *Becton* factors, and given two opportunities to respond, Verizon is silent. Verizon consciously decided to avoid the merits of General Access’s arguments for discretionary denial on Claims 28 and 29, and such conduct should not be rewarded by wasting the Board’s and everyone else’s time, resources, and effort for the next year. *See Neil Ziegman, N.P.Z., Inc. v. Stephens*, IPR 2015-01860, at 12-13 (PTAB Feb. 24, 2016) (Paper 11) (“[T]he Board weighs petitioners’ desires to be heard against the interests of patent owners, who seek to avoid harassment and enjoy quiet title to their rights.”) (citing H.R. Rep. No.

112-98, pt. 1, at 48 (2011)); *Fox Factory, Inc. v. Spram, LLC*, IPR 2016-01876, at 7 (PTAB Apr. 3, 2017) (Paper 8) (noting the Board’s “interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.”). Given the Board’s and the Federal Circuit’s prior consideration of the same or substantially the same prior art and arguments in the Sprint IPR, and Verizon’s failure to show any prior error, the Board should exercise its discretion to deny the petition.

In conclusion, General Access’s arguments and application of the *Becton* factors to Claims 28 and 29, which stand unrefuted, demonstrate the Board should exercise its discretion and deny institution. 35 U.S.C. § 325(d). General Access stands on its arguments in the POPR regarding the Board’s discretion to deny the Petition under *Fintiv* and *General Plastics*. POPR at 51-58.

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CERTIFICATE OF SERVICE

The undersigned certifies, that on this 10th day of November, 2023, the foregoing document is being served by e-mail on counsel of record for Petitioner as follows:

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