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Sent: Wednesday, December 27, 2023 2:42 PM
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Subject: IPR2023-01135 to 1140, -1143 to -1146: Authorization to Reply to Patent Owner's Preliminary Response

GROUP A:

IPR2023-01135: U.S. Patent 9,973,361
9,584,262
IPR2023-01136: U.S. Patent 10,079,707
IPR2023-01137: U.S. Patent 10,291,449
IPR2023-01138: U.S. Patent 10,554,459
IPR2023-01139: U.S. Patent 10,917,272
IPR2023-01140: U.S. Patent 10,917,272

GROUP B:

IPR2023-01143: U.S. Patent
IPR2023-01144: U.S. Patent 9,145,566

GROUP C:

IPR2023-01145: U.S. Patent 11,212,146
IPR2023-01146: U.S. Patent 11,212,146

Your Honors –

The parties jointly submit this email regarding Petitioner’s request for authorization to reply to Patent Owner’s Preliminary Response filed on November 17 in IPR2023-01135 to -1140 and -01143 and December 11 for IPR2023-01144 to -1146. Because of the significant overlap in issues among the 10 IPR matters pending between the parties, for ease of the Board, Petitioner is presenting a consolidated request. Petitioner further notes that the *Sotera* stipulations in these cases, necessitated by Patent Owner’s selection of litigation forum, are being offered by the real parties-in-interest of Petitioner in two separate litigations for 8 asserted patents and required sufficient time

for consideration. However, to alleviate issues regarding any timing raised by Patent Owner, Petitioner agrees to a 5 business day due date for each of its filings while affording Patent Owner 7 business days in response.

Petitioner and Patent Owner are available for a call on Friday December 29, from 9am-2pm and 3pm to 5pm, and January 3-5 during normal business hours should the Board deem a call necessary.

Summary:

Petitioner seeks to reply on the following issues which overlap across multiple cases. Good cause exists to grant Petitioner's request for each issue as set forth below.

Patent Owner objects to Petitioner's email that impermissibly briefs the merits without Board authorization, and asks the Board to strike Petitioner's impermissibly argumentative email from the administrative record without further consideration.

Patent Owner further opposes Replies on **Topics #2-5**, as Petitioner lacks the good cause necessary to justify further briefing on these mine-run disputes over the merits. "[T]he Board does not expect that such a reply will be granted in many cases due to the short time period the Board has to reach a decision on institution." Consolidated Trial Practice Guide at 51-52. On that point, Petitioner's lack of good cause is further evidenced by its excessive delay in reaching out to Patent Owner to request these Replies, and that delay's prejudice to Patent Owner. Patent Owner filed the vast majority of its POPRs (all of Group A and one of Group B) on November 17, 2023, well over a month before Petitioner first reached out to Patent Owner just before the holidays on Friday, December 22. Granting Petitioner's untimely request will give Petitioner six to seven weeks to gather new evidence (e.g., Topic 2 supplemental declaration) and formulate new arguments that could have and should have been included in its Petitions and before the one-year bar expired.

Should the Board grant Petitioner's request for Replies on the merits (Topics #2-5), Patent Owner requests a Sur-reply of the same length and with the same ability to submit additional evidence in rebuttal (e.g., Topic #2). While looming Institution Decision deadlines make it impossible to give Patent Owner the same amount of time to address Petitioner's new arguments and evidence, Petitioner asks for 15 business days to prepare sur-replies on these four topics in the event the Board grants Petitioner's request(s).

Petitioner's proposed reply topics are:

1. **PO's *Fintiv* arguments:** Common across all 10 IPRs (Group A, Group B, and Group C)

Petitioner's Position: Petitioner seeks authorization to file a response to Patent Owner's ("PO's") *Fintiv* argument and to document *Sotera* stipulations to be offered by Dell and Lenovo, the Real-Parties in Interest to Petitioner, in the co-pending District Court litigations. Petitioner seeks 3-pages to address Issue 1. Petitioner does not oppose a Sur-Reply of equal length.

PO's Position: Patent Owner does not oppose a Reply on this discretionary topic, so long as

the Board grants Patent Owner a Sur-Reply of the same length to be filed seven business days after Petitioner files its Replies.

2. **Public Availability of WWiSE proposal:** Common across 9 IPRS (all Group A and Group B IPRS, IPR2023-01145 from Group C)

Petitioner's Position: Petitioner seeks authorization to address PO's argument in the preliminary response that the WWiSE proposal does not qualify as a printed publication. Petitioner could not have foreseen that, for example, PO would ignore Federal Circuit and PTAB decisions establishing that submissions to IEEE and similar standards bodies qualify as prior art, and would assert that a skilled person would not have taken steps to locate the WWiSE IEEE proposal submission. Petitioner further seeks authorization to file a supplemental declaration of Jim Lansford on public availability in accordance with the Federal Circuit case *Valve Corp. v. Ironburg Inventions Ltd*, 8 F.4th 1364, 1370 fn.6 (Fed. Cir. 2021) ("A petitioner may provide evidence of public accessibility of a reference after the petition stage if the patent owner raises a challenge to public accessibility"). *See also, M & K Holdings, Inc. v. Samsung Elecs. Co., Ltd.*, 985 F.3d 1376 (Fed. Cir. 2021). Petitioner seeks 4-pages to address Issue 2. Petitioner does not oppose a Sur-Reply of equal length.

PO's position: See above summary. In addition, the WWiSE proposal is not an IEEE article or the like (as Petitioner apparently suggests above for the first time), and Petitioner's inapposite case law does not address supplementing the Petition while still in the "petition stage" with new evidence (*another* declaration from Jim Lansford) and new argument that could have and should have been included in its Petitions.

3. **Mischaracterizations of Motivation to Combine:** Common across 9 IPRS (all Group A and Group B IPRS, IPR2023-01145 from Group C)

Petitioner's Position: Petitioner further seeks authorization to address PO's arguments that a POSITA would not have been motivated to combine Hansen and WWiSE as proposed because, for example, a receiver would be unable to properly receive PPDUs, the 802.11n standard did not adopt extended range functionality, and other techniques existed to extend range. Petitioner could not have foreseen that PO would use the majority of its Preliminary Response (approximately 10,000 words (over 70% of Petitioner's **total** word allocation **for the entire petition**) for the Group A IPRS and approximately 8,000 words for Group B IPRS and Group C, IPR2023-001145) attacking Petitioner's motivation to combine and would in its arguments mischaracterize receiver operation, for example, ignoring the well-known process of blind decoding implemented in receivers and would ignore the fact that the 802.11ax standard PO alleges to infringe these claims **did** adopt extended range capability despite PO's criticism. If not addressed, PO's mischaracterizations and omissions present a risk of misleading the Board, severely prejudicing Petitioner. Petitioner seeks 5-pages to address Issue 3. Petitioner does not oppose a Sur-Reply of equal length.

PO's position: See above summary.

For Group C, IPR2023-01146, Petitioner seeks authorization to respond to the following two issues unique to this IPR:

4. **Inconsistent Claim Construction Positions:**

Petitioner's Position: Petitioner seeks authorization to address PO's claim construction positions in the POPR which are inconsistent with positions taken in the district court. Good cause therefore exists to grant Petitioner's request because if not identified, Patent Owner's inconsistent statements present the risk of allowing Patent Owner to twist its patent one way to avoid invalidity at the PTAB and another way to find infringement in the District Court, severely prejudicing Petitioner. *See Amazon.com, Inc. v. Barnesandnoble.com*, 239 F.3d 1343, 1351 (Fed. Cir. 2001).

PO's position: See above summary.

5. **Mischaracterization of Prior Art References:**

Petitioner's Position: Petitioner seeks authorization to address PO's mischaracterization of the prior art references that (i) attempts to conflate the process of FFT demodulation with the process of packet decoding in the receive pipeline when a POSITA would understand that these are two distinct operations, and (ii) attempts to conflate the process of detecting the repeated header fields with the process of decoding the repeated header fields. If not addressed, PO's mischaracterizations and omissions present a risk of misleading the Board, severely prejudicing Petitioner.

Petitioner seeks 5-pages total to address both Issues #4 and #5. Petitioner does not oppose a Sur-Reply of equal length.

PO's position: See above summary.

For ease of the Board, Petitioner summarizes its request on a per-IPR basis below.

GROUP A: IPR2023-01135 to IPR2023-01140

GROUP B: IPR2023-01143 and IPR2023-01144

GROUP C: IPR2023-01145

- Issue 1: *Fintiv* Reply
- Issue 2: Public Availability of WWiSE Proposal
- Issue 3: Motivation to Combine

Petitioner requests a total of 12-pages (3 for Issue 1, 4 for Issue 2, and 5 for Issue 3), due 5 business days after authorization for each Reply. Petitioner does not oppose a Sur-Reply of 12-pages, due 7 business days after Petitioner's filing.

GROUP C: IPR2023-00146

- Issue 1: *Fintiv* Reply

- Issue 4: Inconsistent Claim Construction Positions
- Issue 5: Mischaracterization of Prior Art References

Petitioner requests a total of 8-pages (3 for Issue 1, 5 for Issues 4 and 5), due 5 business days after authorization for each Reply. Petitioner does not oppose a Sur-Reply of 8-pages, due 7 business days after Petitioner's filing.

Regards-
Lori A. Gordon
Counsel for Petitioner

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