Filed on behalf of: AX Wireless, LLC

Entered: November 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

AX WIRELESS,
Patent Owner.

Case IPR2023-01140
Patent 10,917,272

PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING STATEMENT

TABLE OF CONTENTS

I. Introduction....1

II. Background....1

III. More Than One Petition Is Unwarranted....2

IV. Conclusion....5

TABLE OF AUTHORITIES

Page(s)

CASES

Apple Inc. v. Koss Corp.,
IPR2021-00679, Paper 14 (Oct. 12, 2021) 3

Fitbit, Inc. v. Koninklijke Phillips N.V.,
IPR2020-00772, Paper 14 (Oct. 19, 2020) 3

SolarEdge Techs. Ltd. v. SMA Solar Tech., AG.,
IPR2020-00966, Paper 9 (Jan. 11, 2021).....1, 2

STATUTES

35 U.S.C. § 314(a) 3

REGULATIONS

37 C.F.R. § 1.16(i) 1

37 C.F.R. § 42.15(a)(1).....4

37 C.F.R. § 42.15(a)(3).....1, 4

I. Introduction

This is not the "rare" case where two petitions might be justified. Consolidated Trial Practice Guide (Nov. 2019) ("CTPG") at 59. Petitioner challenges just 14 claims—with seven of those claims being nearly identical to the other seven. *See* AXW-2024 (comparing the two sets of seven challenged claims). Indeed, petitioners pay the minimum IPR fee to challenge up to *twenty* claims, and often pay additional fees to challenge even more claims—all in a single petition. *See* 37 C.F.R. §§ 1.16(i), 42.15(a)(3).

And even in those cases where more than 20 claims are challenged, petitioners nearly always require just one petition. The Board explains that "multiple petitions by a petitioner are not necessary in the *vast majority* of cases." CTPG at 59 (emphasis added). And here, Petitioner challenged only 14 claims—two sets of seven nearly identical claims, and identifies no material differences between those two claim sets or any other viable justification for expanding its arguments across two separate petitions.

II. Background

Absent exceptional circumstances, only one petition should be filed against a single patent. *SolarEdge Techs. Ltd. v. SMA Solar Tech., AG.*, IPR2020-00966, Paper 9 at 10 (Jan. 11, 2021). Indeed, the Board's Practice Guide recognizes that two petitions "are not necessary in the *vast majority* of cases. To date, a substantial

majority of patents have been challenged with a single petition." CTPG at 59 (emphasis added).

The Practice Guide continues: two petitions *may* be justified "when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. In such cases two petitions by a petitioner *may* be needed, although *this should be rare*." *Id.* (emphases added). Neither of those conditions are satisfied here, and even if they were, this is not the rare case where two petitions are needed.

Rather, these mine-run IPRs challenge just fourteen claims—two nearly identical groups of just *seven* claims each. *See* AXW-2024 (claim comparison generated using Microsoft Word). Both challenged independent claims (and thus their dependent claims) recite a computer-readable storage medium with instructions executed in a transceiver, which is a device that transmits and receives. *Id*. The only difference is that independent claim 1 recites generating and transmitting certain packets, while independent claim 11 recites receiving and demodulating those same packets. *Id*. Petitioner does not allege that this is a material difference.

III. More Than One Petition Is Unwarranted

A Petitioner filing two petitions must provide the following:

> (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and

> (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

CTPG at 59-60. Here, Petitioner ranked this Petition (-01140) second, and the other (-01139) first. Paper 3 (Ranking Statement) at 3. At most, the Board should institute only the first-ranked petition.

As for item (2) above, Petitioner failed to identify any specific material differences between its Petitions. Petitioner primarily argues instead that Patent Owner asserted "a large number of claims in litigation" and that Patent Owner might "attempt to assert additional claims at some future date." Paper 3 at 2.

Petitioner, however, challenged only the 14 asserted claims, no more and no less. Any hypothetical "additional [asserted] claims" are not challenged and therefore cannot provide any justification for the second petition. And contrary to Petitioner's unsupported assertion, fourteen is not a large number of claims—petitioners routinely challenge more than 14 claims in a single petition. *Apple Inc. v. Koss Corp.*, IPR2021-00679, Paper 14 at 12 (Oct. 12, 2021) ("The Board routinely receives petitions challenging more than 18 claims."); *Fitbit, Inc. v. Koninklijke Phillips N.V.*, IPR2020-00772, Paper 14 at 26 & n.8 (Oct. 19, 2020) (In fiscal year 2019, there were about 16 challenged claims per challenged patent.). Indeed, the

basic filing fee for an *inter partes* review contemplates challenging up to 20 claims. *See* 37 C.F.R. § 42.15(a)(1), (3).

Petitioner also fails to provide the required explanation of the differences between the petitions and why they are material. Petitioner repeatedly asserts that it is challenging "unique claim set[s]," that "[t]here are no overlapping claims in these petitions," and "[t]herefore, the petitions present materially different challenges, each to a unique subset of '272 patent claims." Paper 3 at 1-2.

Petitioner, however, never explains any differences. It cannot. The two subsets of challenged claims are nearly identical: both recite computer-readable media executed in a transceiver. The only difference is that the transceiver transmits the packets in one subset of seven claims, and receives the same packets in the other. *See* AXW-2024 (comparing the claims). For good reason, Petitioner does *not* argue that transmitting vs. receiving packets is a material difference. The majority of the dispute between the parties relates to the format/content of those packets—there is no dispute that the prior art transceivers transmitted and received packets of some sort. *See generally* Patent Owner's Preliminary Responses.

Even worse, Petitioner contends in both petitions that transmission vs. reception is *not* a material difference. In its second ground adding the Choi reference, Petitioner argues in both petitions that it would have been obvious "to implement such repetition [in the packets] in the *transmission or reception*" portions

of the transceiver. -01139 Pet. at 74, -01140 Pet. at 68 (emphasis added). In both petitions, Petitioner discusses only the "transmission chain" in any detail, adding a conclusory "[b]ecause the order of transmission is the same as the order of reception" before its conclusion that "Hansen, July 2005 WWiSE, and Choi" disclose the "demodulating" step when receiving the packets for the exact same reasons they disclose the "generating" step when transmitting the packets. *Compare* -01139 Pet. at 70-78 *with* -01140 Pet. at 64-72.

In short, Petitioner failed to provide any viable justification for requiring two petitions to challenge essentially just *seven* unique patent claims with immaterial differences.

IV. Conclusion

If it institutes at all, the Board should institute only the first-ranked petition.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 17th day of November, 2023, a true and correct copy of the foregoing **Patent Owner's Response to Petitioner's Ranking Statement** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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