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Paper 8
Date: January 4, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

AX WIRELESS, LLC
Patent Owner.

IPR2023-01135 (Patent 9,973,361 B2)
IPR2023-01136 (Patent 10,079,707 B1)
IPR2023-01137 (Patent 10,291,449 B2)
IPR2023-01138 (Patent 10,554,459 B2)
IPR2023-01139 (Patent 10,917,272 B2)
IPR2023-01140 (Patent 10,917,272 B2)
IPR2023-01143 (Patent 9,854,262 B2)
IPR2023-01144 (Patent 9,614,566 B2)
IPR2023-01145 (Patent 11,212,146 B2)
IPR2023-01146 (Patent 11,212,146 B2)[1]

Before KRISTEN L. DROESCH, TERRENCE W. McMILLIN, JOHN D. HAMANN, and MICHAEL T. CYGAN, *Administrative Patent Judges*.[2]

McMILLIN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

[1] This Order applies to each of the listed proceedings. The parties are not authorized to use this form of caption without prior authorization from the Board.

[2] This is not an expanded panel. The named judges are from the three judge panels assigned to the cases that are the subject of this Order.

IPR2023-01135 (Patent 9,973,361 B2); IPR2023-01136 (Patent 10,079,707 B1); IPR2023-01137 (Patent 10,291,449 B2); IPR2023-01138 (Patent 10,554,459 B2); IPR2023-01139 (Patent 10,917,272 B2); IPR2023-01140 (Patent 10,917,272 B2); IPR2023-01143 (Patent 9,854,262 B2); IPR2023-01144 (Patent 9,614,566 B2); IPR2023-01145 (Patent 11,212,146 B2); IPR2023-01146 (Patent 11,212,146 B2)

INTRODUCTION

On Wednesday, December 27, 2023, the parties sent a joint email to the Board requesting authorization for pre-institution briefing. The joint email has been entered into the record for these proceedings as Exhibit 3001. For the reasons discussed below, the request is partially granted and partially denied.

DISCUSSION

Petitioner requests further briefing on five different topics. Patent Owner does not oppose further briefing on the issue of discretionary denial based on 35 U.S.C. § 314(a) and the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at 2–3 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*")). Patent Owner opposes further briefing on the remaining topics.

With regard to the first topic which the parties refer to as Patent Owner's *Fintiv* arguments, the parties indicate that this topic is common to all ten IPRs listed in the caption. Petitioner's position on this topic is:

> Petitioner seeks authorization to file a response to Patent Owner's ("PO's") *Fintiv* argument and to document *Sotera [Sotera Wireless, Inc. v. Masimo Corporation*, IPR202-01019, Paper 12, 13–14 (PTAB Dec. 1, 2020) (precedential as to §II.A.)] 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.

Patent Owner's position on this topic is, "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."

We believe that it is important to get Petitioner's *Sotera* stipulation into the record of these proceedings. The importance of *Sotera* stipulations to the *Fintiv* analysis and discretionary denial is discussed in the USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation ("Guidance Memo"), 7–8 (June 21, 2022).[3] The Guidance Memo provides that, "the PTAB will not discretionarily deny institution of an IPR or PGR in view of the district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition." *Id.* at 7. We, therefore, grant the joint request for further briefing on this topic. Petitioner is authorized to file a reply to the preliminary response addressing this issue that is 3-pages in length and Patent Owner is authorized to file a sur-reply addressing this issue that is 3-pages in length in each of the above-captioned ten proceedings.

The second, third, and fifth topics that Petitioner requests further briefing on are: "Public Availability of WWiSE proposal;" "Mischaracterizations of Motivation to Combine;" and "Mischaracterization

[3] Available at: https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf)>

of Prior Art References." Patent Owner opposes further briefing on these topics.

With regard to the "Public Availability of WWiSE proposal," this topic relates to whether a reference relied on by Petitioner in nine of the above-captioned proceedings (IPR2023-01135, IPR2023-01136, IPR2023-01137, IPR2023-01138, IPR2023-01139, IPR2023-01140, IPR2023-01143, IPR2023-01144, IPR2023-01145) constitutes prior art and, specifically, whether the reference was publicly accessible. *See Acceleration Bay, LLC v. Activision Blizzard Inc..*, 908 F.3d 765, 772 (Fed. Cir. 2018) ("A reference is considered publicly accessible if it was 'disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.'"). We do not believe that further briefing on this issue is necessary or appropriate, because both parties have already been afforded the opportunity to address this issue in the petitions and preliminary responses filed in these IPRs.

Petitioner also seeks leave to file a further supplemental declaration on this topic. However, in each of the affected IPRs, Petitioner has already filed a lengthy declaration including a number of evidentiary appendices (1124 pages long). Petitioner appears to have anticipated the issue of whether this reference qualifies as prior art and has submitted arguments and evidence on this topic in each of the affected IPRs. We agree with Patent Owner that the proposed "new evidence . . . and new argument . . . could have and should have been included in [the] Petitions." No further briefing on this topic is authorized.

With regard to "Mischaracterizations of Motivation to Combine," and "Mischaracterization of Prior Art References," we also do not believe that further briefing is appropriate. If, as Petitioner argues, Patent Owner has mischaracterized its arguments and evidence, the Board should be able to discern any mischaracterizations in its analysis of the sufficiency of the arguments and evidence of both parties in determining whether to institute *inter partes* review. It is unfortunately all too frequent for one party to mischaracterize the arguments and evidence of the other party and the Board is well-equipped to spot and handle any potential mischaracterizations. No further briefing on these topics is authorized.

With regard to the last topic, "Inconsistent Claim Construction Positions," we authorize further briefing in IPR2023-01146. The Petitioner's position on this topic states:

> 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).

Patent Owner opposes Petitioner's request for further briefing on this topic but does not specifically address this topic. If, as alleged by Patent Owner, Petitioner has taken inconsistent positions on claim construction, we would

like to know the specifics so that they can be considered in determining whether to institute *inter partes* review.

It is unclear how many pages Petitioner requests on this topic. Petitioner requests a total of 5-pages on this and another topic. If a reply is granted, Patent Owner requests a sur-reply of equal length. We authorize 3-pages of additional briefing on this topic in IPR2023-01146.

In considering whether to allow the requested briefing, one of the issues we have considered is whether the Petitioner's request for further briefing was timely and our ability to issue our decisions on institution within the three month statutory deadline. Petitioner's request comes more than a month after the preliminary responses were filed in seven of these proceedings on November 17, 2023. We have authorized limited briefing on the topic (*Fintiv* and *Sotera* stipulations) where we believe it is essential to have a complete record to consider on institution and on a topic (inconsistent claim construction) that we do not believe Petitioner could have anticipated and addressed in its petition in IPR2023-01146. The time limits on institution decisions in IPRs do not favor the other briefing requested in the email from the parties.

ORDER

Accordingly, it is ordered that in each of IPR2023-01135, IPR2023-01136, IPR2023-01137, IPR2023-01138, IPR2023-01139, IPR2023-01140, IPR2023-01143, IPR2023-01144, IPR2023-01145, and IPR2023-01146, Petitioner is authorized to file a 3-page reply no later than within 5 business days of this Order and Patent Owner is authorized to filed a 3-page sur-reply

no later than 7 business days limited to the topic of a *Sotera* stipulation and discretionary denial; and

it is further ordered that in IPR2023-01146, Petitioner is authorized to address the topic of "Inconsistent Claim Construction Positions" in an additional 3-page section of its reply and Patent Owner is authorized to address this same topic in an additional 3-page section of its sur-reply.

IPR2023-01135 (Patent 9,973,361 B2); IPR2023-01136 (Patent 10,079,707 B1); IPR2023-01137 (Patent 10,291,449 B2); IPR2023-01138 (Patent 10,554,459 B2); IPR2023-01139 (Patent 10,917,272 B2); IPR2023-01140 (Patent 10,917,272 B2); IPR2023-01143 (Patent 9,854,262 B2); IPR2023-01144 (Patent 9,614,566 B2); IPR2023-01145 (Patent 11,212,146 B2); IPR2023-01146 (Patent 11,212,146 B2)

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