

Filed on behalf of: AX Wireless, LLC

Entered: January 22, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

AX Wireless, LLC,
Patent Owner.

Case IPR2023-01146
Patent No. 11,212,146

**PATENT OWNER'S SUR-REPLY
IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

Exhibit List

Exhibit	Description
2001	Declaration of Zygmunt Haas, Ph.D. (“Haas” or “AXW-2001”)
2002	<i>Curriculum Vitae</i> of Zygmunt Haas, Ph.D. (“AXW-2002”)
2003	U.S. Patent Application Publication No. 2012/0170625 (“2012 Publication” or “AXW-2003”)
2004	International Patent Application No. PCT/US2010/046088 (“2010 Application” or “AXW-2004”)
2005 - 2016	RESERVED
2017	Third Amended Docket Control Order, <i>AX Wireless LLC v. Dell Inc.</i> , No. 2:22-cv-00277 (E.D. Tex. Oct. 23, 2023), ECF No. 136 (“AXW-2017”)
2018	Third Amended Docket Control Order, <i>AX Wireless LLC v. Lenovo Grp. Ltd.</i> , No. 2:22-cv-00280 (E.D. Tex. Oct. 31, 2023), ECF No. 130 (“AXW-2018”)
2019	RESERVED
2020	<i>Time to Milestones – Judge Robert W. Schroeder, III: Case Filing Date: On or After Jan. 1, 2008</i> , Docket Navigator (“AXW-2020”)
2021	Civil Docket, <i>AX Wireless LLC v. Dell Inc.</i> , No. 2:22-cv-00277 (E.D. Tex.) (through Dec. 7, 2023) (“AXW-2021”)
2022	Civil Docket, <i>AX Wireless LLC v. Lenovo Grp. Ltd.</i> , No. 2:22-cv-00280 (E.D. Tex.) (through Dec. 7, 2023) (“AXW-2022”)

Exhibit	Description
2023	Defendants' P.R. 3-3 Invalidity Contentions and Ineligibility Contentions, <i>AX Wireless LLC v. Dell Inc. & HP Inc.</i> , Nos. 2:22-cv-00277, 2:22-cv-00279 (E.D. Tex. Jan. 23, 2023 [served]) ("AXW-2023")
2024-2030	RESERVED
2031	[Proposed] Fourth Amended Docket Control Order, <i>AX Wireless LLC v. Dell Inc.</i> , No. 2:22-cv-00277 (E.D. Tex. Dec. 1, 2023), ECF No. 153-1 ("AXW-2031")
2032	Memorandum Order Denying Dell's Motion to Transfer, <i>AX Wireless LLC v. Dell Inc.</i> , No. 2:22-cv-00277 (E.D. Tex. Nov. 12, 2023), ECF No. 142 ("AXW-2032")
2033	Docket Control Order, <i>AX Wireless LLC v. Acer Inc.</i> , No. 2:23-cv-00041-JRG-RSP (E.D. Tex. Oct. 13, 2023), ECF No. 35 ("AXW-2033")
2034	Defendant Acer Inc.'s Initial Disclosures Pursuant to Paragraphs 1 and 3 of the Discovery Order, <i>AX Wireless LLC v. Acer Inc.</i> , No. 2:23-cv-00041-JRG-RSP (E.D. Tex. Oct. 19, 2023) ("AXW-2034")
2035	Defendant's P.R. 3-3 Invalidity Contentions and Ineligibility Contentions, <i>AX Wireless LLC v. Acer Inc.</i> , No. 2:23-cv-00041-JRG-RSP (E.D. Tex. Nov. 30, 2023) ("AXW-2035")
2036	Defendant HP Inc.'s Rule 72(a) Objections to Order Denying Motion to Transfer to the Northern District of California, <i>AX Wireless LLC v. HP Inc.</i> , No. 2:22-cv-00279-JRG-RSP (E.D. Tex. Dec. 21, 2023), ECF No. 101 ("AXW-2036")

Exhibit	Description
2037	Fourth Amended Docket Control Order, <i>AX Wireless LLC v. Dell Inc.</i> , No. 2:22-cv-00277-RWS-RSP (E.D. Tex. Jan. 2, 2024), ECF No. 161 (“AXW-2037”)
2038	Third Amended Docket Control Order, <i>AX Wireless LLC v. HP Inc.</i> , No. 2:22-cv-00279-JRG-RSP (E.D. Tex. Jan. 2, 2024), ECF No. 102 (“AXW-2038”)

I. Intel Failed To Show Institution Is Warranted Despite Fintiv

Petitioner Intel, of course, bears the burden of showing that institution is warranted. It has not done so. With respect to *Fintiv*, Intel offers *Sotera* stipulations from admitted RPIs Dell and Lenovo. Reply 1. Those stipulations do not solve Intel's *Fintiv* problem. The Director's *Fintiv* Memorandum explains that "if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution." *Fintiv* Memo at 7. But the petition still includes the same grounds that will be presented in district court, despite the stipulations, at least because admitted RPI Dell and HP submitted joint invalidity contentions in their closely linked cases with the same grounds presented in this IPR. *See* AXW-2023. Intel does not contend that HP—which will go to trial in June 2024, *see* AXW-2038—is bound in any way by Dell's stipulation.

The Director's *Fintiv* memorandum does not directly address this situation. It is instead directed to the situation where the petitioner (rather than a collection of RPIs and privies) is the defendant in the one parallel court proceeding (rather than multiple related proceedings), and the petitioner (rather than its RPIs and privies) submits a stipulation. *See* *Fintiv* Memo at 7. Here, Intel supplies HP, just as it supplies Dell and Lenovo. *See* AXW-2036 at -005 (Intel supplies HP). In addition, Acer has now submitted its invalidity contentions, and it, too, include the same

grounds as the Petition. AXW-2035 at -039-041. Intel also supplies Acer, and Acer will go to trial before, but closer to, the Board's final written decision date. AXW-2033 (setting a January 2025 trial date); AXW-2034 at -003 (admitting Intel is Acer's supplier).

Intel never explains why the closely linked HP case (or Acer's case for that matter) do not raise the same "concerns of inefficiency and the possibility of conflicting decisions" as the Dell and Lenovo trials. *Fintiv* Memo at 7 (quoting *Fintiv* at 12). Intel insinuates that HP (and Acer) are *not* privies or RPIs in a cryptic footnote citing the original *Fintiv* decision (Reply 1 n.1), but carefully avoids stating so in a transparent attempt to avoid its routine discovery obligations. As the relevant supplier to all four litigants, Intel's silence is telling. Intel cannot sidestep its burden as petitioner and subvert the Board's *Fintiv* guidance in this manner.

Indeed, Intel tacitly recognizes that its stipulations are not enough in these particular circumstances, expanding on its conclusory "compelling merits" allegation. Reply 3; Pet. 77-78. But as PO explained in its Preliminary Response, the merits of the Petition are weak because Intel failed to show that either the Huang or Sun references are prior art. *See* POPR at 8-25. It thus makes no sense for Intel to (again) point to Huang and Sun—references that post-dated the '146 patent by years—to argue that PO "co-opted the concept of different packet formats and repeated header fields from ITU-T G.hn submissions." Reply 2-3.

Intel does not even allege in its Petition that the '146 patent lacks sufficient written description support in the priority application for either the claimed packet formats and header repetition. And although Intel attempts to rehabilitate its Petition as it relates to construction of the “distinguishing” limitation, that too fails as explained below.

And to be sure, the invalidity portions of the Lenovo and the closely linked Dell and HP cases are well underway despite any recent schedule adjustments—*Markman* briefing and argument are complete, fact discovery is or will be complete, and expert discovery is well underway will soon be complete. POPR 57, AXW-2037 (Dell's expert discovery complete on March 13, 2024 per the current schedule); AXW-2038 (HP's expert discovery also complete on March 13); AXW- 2018 (Lenovo's still-current schedule). Under these facts, the Board should exercise its discretion to deny institution under *Fintiv* and § 314(a) for the reasons set forth herein and in the POPR.

II. Intel's Attempt To Rehabilitate Its Written Description Challenge Fails

Intel's Reply brief recasts its meritless claim construction argument related to the “distinguishing” limitation as purely a written description challenge. *See* Pet. 9-19. But there is no credible dispute that Intel's written description position was based on its purported construction of the “distinguishing” limitation to exclude detecting repeated headers by “decoding the packet to obtain the value of D.” Pet.

16-17 (arguing that “detecting a repeated header field” excludes any process that “requires decoding”); *id.* at 18 (attempting to distinguish “detecting” from “decoding” under the “principle of claim differentiation”). Now, after reviewing the POPR, Intel is forced to concede that the plain language of the claims covers distinguishing packet types by “detecting ... a second header field which repeats the first header field” by decoding value for D. Reply 4 (“Petitioner is ***not arguing*** that written description support is missing because the explicit decode-to-learn-‘D’ embodiments fall outside the reach of the claims.” (emphasis added)).

That should end of the inquiry. The Board should find that the chain of priority dating back to the '909 Provisional (INTEL-1008) is intact because there is no dispute that the ancestral application of the '146 patent supports detecting repeated headers based on embodiment in which the value of “D” is decoded from the packet. *See* POPR at 18-25. Contrary to Intel’s allegations, there is nothing inconsistent about Patent Owner’s (PO) position in district court: PO ***expressly relied*** on disclosures of detecting header repetition by decoding packets without knowing the value of “D” a priori in response to the RPIs indefiniteness arguments. INTEL-1018 at 15-16 (citing INTEL-1001 at 2:61-64). Moreover, the claim construction briefing ***did not*** involve written description issues, period. So Intel’s position that PO is somehow taking inconsistent positions before the district court and the Board holds no water.

Intel then pivots away from the Petition to argue that there must be an explicit disclosure of an embodiment in the ancestral applications in which a receiver “detect[s] the presence or absence of a repeated header field without the transmitter explicitly sending a ‘D’ value for the receiver to decode.” Reply 4. But “that a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment.” *Medtronic, Inc. v. Teleflex Innovations S.à.r.l.*, 69 F.4th 1341, 1354 (Fed. Cir. 2023) (cleaned up) (internal citation omitted). There is no requirement that every embodiment of a claim be explicitly described in a priority application for that claim to have written description support. *Hynix Semiconductor Inc. v. Rambus Inc.*, 645 F.3d 1336, 1352 (Fed. Cir. 2011) (“[T]here is no categorical rule that a species cannot suffice to claim the genus.”). And to succeed on its argument, Intel would have had to show in the Petition (but did not) that the disclosure of the decoding embodiment in the ’909 provisional was so “critical” or “important” that it served to narrow the claims. *See In re Glob. IP Holdings LLC*, 927 F.3d 1373, 1377 (Fed. Cir. 2019) (for a disclosed species to narrow the claims requires a showing of “criticality or importance” of the “unclaimed limitation [in the species] to the invention.”) (internal citation omitted). Intel points to nothing—no traversed prior art or remarks by the applicant that would support finding the unclaimed “decoding” of the “D” value critically affects claim scope. *Id.*; *In re Peters*, 723 F.2d 891, 893-84

(Fed. Cir. 1983). Intel instead relies on dictum in a concurring opinion in *X2Y* that “did not affect the result affirmed by th[e] court” and that simply stands for the proposition that “entitlement to priority cannot be decided without first construing the asserted claims.” *X2Y Attenuators, LLC v. Int’l Trade Comm’n*, 757 F.3d 1358, 1365 (Fed. Cir. 2014). *X2Y* thus undermines Intel’s argument that the Board need not engage in claim construction before deciding the written description issue. Regardless, Intel now concedes that the claims encompass “decoding” a value of D as a way of distinguishing between packet types, which confirms that the ’909 provisional includes sufficient written description support for the claims. Reply 4.

For the above reasons, Intel has not shown a reasonable likelihood of success on the merits of its Petition and Institution should thus be denied.

Respectfully submitted,

Dated: January 22, 2024

By: /S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)
giri.pathmanaban@lw.com
Latham & Watkins LLP
300 Colorado Street, Suite 2400
Austin, TX 78701-3295
Telephone: 737.910.7300
Fax: 737.910.7301

Counsel for Patent Owner
AX Wireless, LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 22nd day of January, 2024, a true and correct copy of the foregoing **Patent Owner's Sur-Reply in Support of Patent Owner's Preliminary Response and all Exhibits** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

Lori A. Gordon (Reg. No. 50,633)
Perkins Coie LLP
700 Thirteenth St. NW, Suite 800
Washington, DC 20005
Gordon-ptab@perkinscoie.com
Tel.: 202.661.5883
Fax: 202.624.9543

Jonathan R. Carter (Reg. No. 75,145)
Perkins Coie LLP
1155 Avenue of the Americas, 22nd Floor
New York, New York 10036
Carter-ptab@perkinscoie.com
Tel.: 212.261.6826
Fax: 212.977.1649

Matthew W. Hindman (Reg. No. 57,396)
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304-1212
Hindman-ptab@perkinscoie.com
Tel.: 650.838.4300
Fax: 650.838.4350

By: / S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)
giri.pathmanaban@lw.com

Latham & Watkins LLP
300 Colorado Street, Suite 2400
Austin, TX 78701-3295
Telephone: 737.910.7300
Fax: 737.910.7301

Counsel for Patent Owner
AX Wireless, LLC