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Subject: RE: IPR2023-01393 (714 patent) - Request to file pre-institution reply to Patent Owner's Preliminary Response (POPR)

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Your Honors,

Petitioner's email is improperly argumentative and serves as an impermissible *de facto* Reply on the merits submitted without Board authorization. The Board should strike the email without further consideration.

Nevertheless, Petitioner's assertions confirm that no further briefing is warranted. Petitioner seeks a second bite at the apple with new arguments that Petitioner could have and should have—but did not—raise in the Petition, a fact further evidenced by Petitioner's request for **ten pages** of additional briefing on the merits.

Topic (1): Petitioner mischaracterizes the POPR as introducing a “narrow” and “unforeseeable” claim construction requiring the “wherein” clause of claim 13(d) and 32(d) to “simultaneously transmit and receive overlapping data packets.” But the term “data packets” is not found anywhere in the POPR, and it was **Petitioner** that asserted the “wherein” clauses of these claims require “simultaneous” transmission and reception. *See, e.g.*, Petition at 7, 24-25 (Morikawa allegedly teaches FDD which allegedly allows “simultaneous transmission and reception”), 46 (Serizawa teaches “simultaneous transmission and reception...”); *see also id.* 38-39, 58-59 (relying on claims 1 and 13 disclosures for claims 31 and 32). It was therefore entirely foreseeable that Patent Owner would dispute the prior art under **Petitioner's** implicit claim interpretation. Petitioner, after all, bears the burden of proposing a construction and arguing that the claims are unpatentable under that construction. In any event, “[d]etermining the proper meaning of disputed claim terms” is a “routine function[] of the Board” that does not justify further briefing. *Unified Patents, LLC v. Robocast, Inc.*, IPR2022-01125, Paper 10 at 2 (Nov. 9, 2022).

Topic (2): Petitioner seeks to insert new theories of unpatentability into this proceeding under the guise of addressing Morikawa's “sequence of request-response events” discussed in the POPR and by Dr. Haas. The Petition did not mention these disclosures at all, much less contend that they somehow taught any particular claim elements. Petitioner cannot submit new unpatentability theories based on these disclosures now. Further, and despite Petitioner's arguments to the contrary, Dr. Wicker's testimony in another proceeding about the “request-response events” is consistent with Dr. Haas's testimony in this one (and the express disclosure of Morikawa)—namely that Morikawa's “request-response” means the transmission/reception occur sequentially. In any event, any alleged discrepancy is irrelevant here, where the issue is whether Petitioner carried its statutory burden in the Petition. *E.g.*, *BASF v. Ingevity*, PGR2020-00037, Paper 9 at 3-4 (July 22, 2020) (alleged contradiction by expert in different venue not good cause for Reply to POPR).

Topic (3): Petitioner again seeks to insert new theories of unpatentability based on the Topic 2 disclosure in Morikawa and another disclosure in Serizawa about one frequency “following” the other (neither of which were cited or relied upon in the Petition) under the guise of addressing alleged mischaracterizations of these passages. Again, the issue here is where Petitioner met its burden in the Petition, and it is too late to submit new theories based on these passages. Further, the Board is well-equipped to evaluate the art and detect any mischaracterizations—and will find there were none in the POPR.

Accordingly, no further briefing is necessary on the merits of the Petition. To the extent the Board disagrees and grants Petitioner’s request for a reply, Patent Owner respectfully requests a surreply of the same length.

Respectfully,

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