

Filed: December 28, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION, ERICSSON INC., AND

T-MOBILE USA, INC.,

PETITIONERS,

V.

GENERAL ACCESS SOLUTIONS, LTD.,

PATENT OWNER.

Case No. IPR2023-01415

U.S. Patent No. 7,099,383

PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

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I. INTRODUCTION

On September 22, 2023, Petitioners submitted a Petition to institute *inter partes* review (“IPR”) of U.S. Patent No. 7,099,383 (“the ’383 patent”) (Ex. 1001), challenging claims 1-17 (the “Challenged Claims”). General Access Solutions, Ltd. (“Patent Owner”) requests that the Board decline to institute IPR because Petitioner ignores the applicable law in its analysis and fails to make the required showing that it has a reasonable likelihood of prevailing on the merits.

First, 37 C.F.R. § 42.104(b)(3) requires a petition to explain “[h]ow the challenged claim is to be construed.” Petitioners ignore this statutory requirement, and instead rely on implied constructions from Patent Owner’s infringement contentions in the related District Court matter—a practice the Board has repeatedly rejected.

Second, Petitioners rely on the doctrine of inherency for the recited “controller” and controller that “comprises a memory portion” elements of the Challenged Claims. But in doing so, Petitioners ignore that inherency requires the claim element must “*always and necessarily*” be present. Petitioners even tacitly acknowledge this isn’t true for the controller that “comprises the memory portion.” Petitioners additionally ignore that the law of anticipation requires the disclosure of *all* claim elements—even those disclosed inherently—to be arranged as in the Challenged Claims. Petitioner never even tries to show this, instead only arguing

that a controller is inherent in the prior art, rather than alleging that a controller must “always and necessarily” be both present and *arranged as in the Challenged Claims*.

Third, Petitioners argue anticipation based on multiple separate embodiments within the prior art, ignoring clear Federal Circuit precedent that does not allow claim elements to be cherry-picked from different embodiments to meet the claim.

Accordingly, Patent Owner requests that the Board deny institution on all Challenged Claims of the ’383 patent.

II. LEVEL OF ORDINARY SKILL

For purposes of this Preliminary Response only, Patent Owner does not dispute the Petitioners’ definition of a person of ordinary skill in the art. (Petition at 5.)

III. OVERVIEW OF THE ’383 INVENTION

In 1999-2000, a Plano-based start-up company known as WestEnd Broadband, Inc. worked on research and development of next generation wireless communications networks. Mr. Paul Struhsaker, one of the founders of WestEnd Broadband and an inventor of the ’383 patent, had years of experience in Signals Intelligence in the U.S. Navy and National Security Agency. Mr. Struhsaker

understood and appreciated the possibilities that wireless communications networks offered, as well as the challenges they would need to overcome.

When the '383 patent was filed in 2001, cellular networks were used primarily for voice communications. However, during his work at WestEnd Broadband, Mr. Struhsaker foresaw the future challenges that wireless communications networks would face, such as the ever-increasing demands for bandwidth, speed, and throughput, specifically for data.

At WestEnd Broadband, Mr. Struhsaker developed a number of technologies in the area of wireless communications. One of the technologies Mr. Struhsaker worked to incorporate into wireless networks was “beamforming”—specifically the use of advanced antenna arrays to generate focused beams of radio-frequency energy in a desired direction. In particular, Mr. Struhsaker sought to use beamforming in conjunction with Time Division Duplexing (“TDD”) to extend the range, speed, quality, and throughput of cellular wireless networks.

In 2000-2001, WestEnd Broadband changed its name to Raze Technologies, Inc. Raze continued to pioneer the development of wireless telecommunications equipment, sometimes referred to as “4G” networks, which would accommodate broadband data services (along with voice) with better speed, throughput, reliability, and quality. In 2000-2002, Raze successfully designed, developed, built, and tested what were at the time highly-advanced 4G wireless networks in Texas.

Prototype systems were field tested in Decatur, Texas, and Raze presented its equipment and capabilities to wireless carriers pursuant to non-disclosure agreements.

Paul Struhsaker and his colleagues at Raze applied for, and were granted, several fundamental patents related to wireless communications. Most notably for present purposes, on April 20, 2001, a patent application was filed on behalf of Mr. Struhsaker and Mr. Russell McKown, which ultimately led to the issuance of U.S. the '383 patent on August 29, 2006.

The '383 patent recognized that there were many needs in the field of communication network access systems, including “for broadband access equipment that can be readily and inexpensively deployed in large domestic and international markets that are not currently served by wired or wireless broadband access technology.” (Ex. 1001 at 5:46-50.) In addition, the patent recognized “a need for an apparatus to increase the communication capacity of the communication system.” (*Id.* at 5:50-52.) Further, because the available “broadband access equipment includes base stations which have RF (radio frequency) modems capable of modulating and demodulating data signals communicated between the base stations and subscriber stations,” and “[a] large number of subscriber stations are generally capable of communicating with a single base station,” the '383 patent recognized a need for “the RF modems [to] be

capable of communicating with the subscriber stations in manners which permit quick, and accurate, receive operations to be performed upon signals transmitted thereto by the subscriber stations.” (*Id.* at 5:53-63.) Finally, the ’383 patent recognized a need for “increased speed and accuracy of receive operations to be performed upon the signals transmitted to a base station of a [fixed wireless access] system.” (*Id.* at 5:64-67.)

To address these needs, the claims of the ’383 patent are directed to an apparatus and method for acting upon data signals received at a base station. Figure 1 from the ’383 patent, shown below, provides an exemplary fixed wireless access network according to one embodiment of the invention:

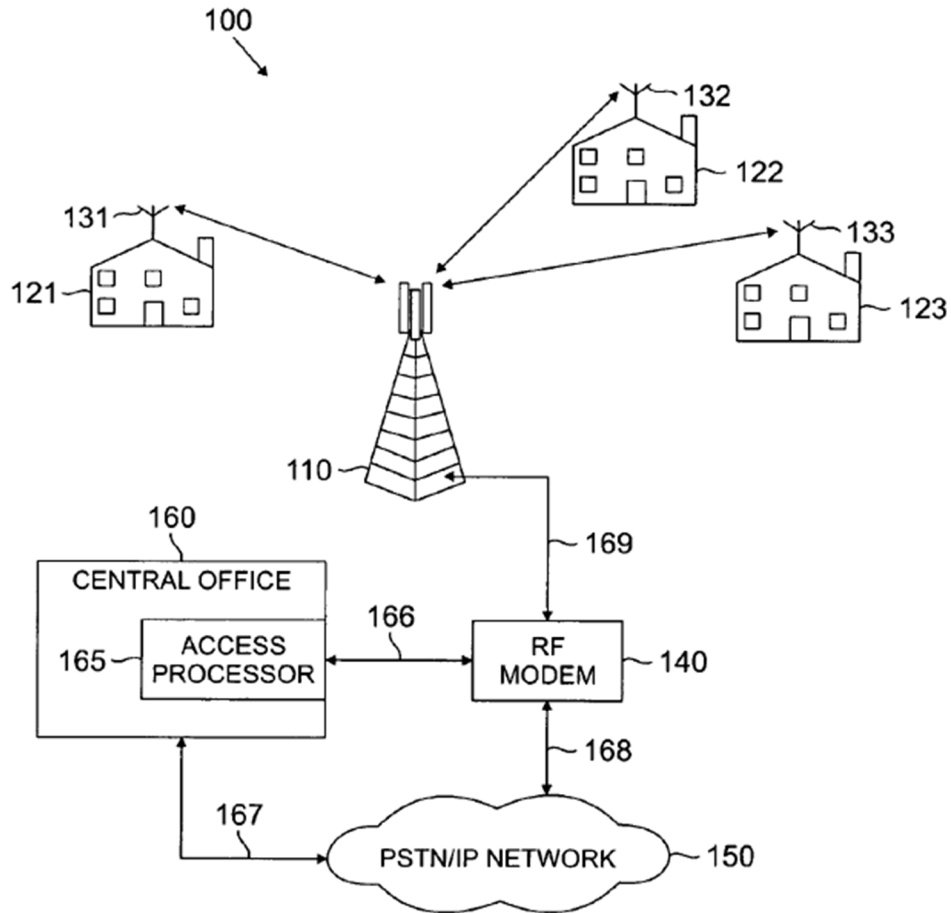


FIG. 1

In Figure 1, a transceiver base station (110) receives forward channel (downlink) signals from the external network 150 and transmits these signals to subscriber premises 121-123, and also transmits the reverse channel (uplink) signals from the subscriber premises to the external network. Figure 3, shown below, selectively couples modem 302 and modem 304 to receive uplink signals sent by different subscriber stations to the base station. (*Id.* at 10:34-39.) And Figure 3's Control CPU—which is an example of the “controller” element of the Challenged

Claims— performs “queue management, scheduling operations, as well as []
 exert[s] control over operation of modems 302 and 304.” (*Id.* at 10:52-54.)

“Profiles (not shown) are created and maintained by controller 314 in a memory,
 such as memory device 318. The profiles include values which represent channel
 characteristics upon which uplink signals are transmitted as well as characteristics
 of the uplink signals.” (*Id.* at 10:55-59.)

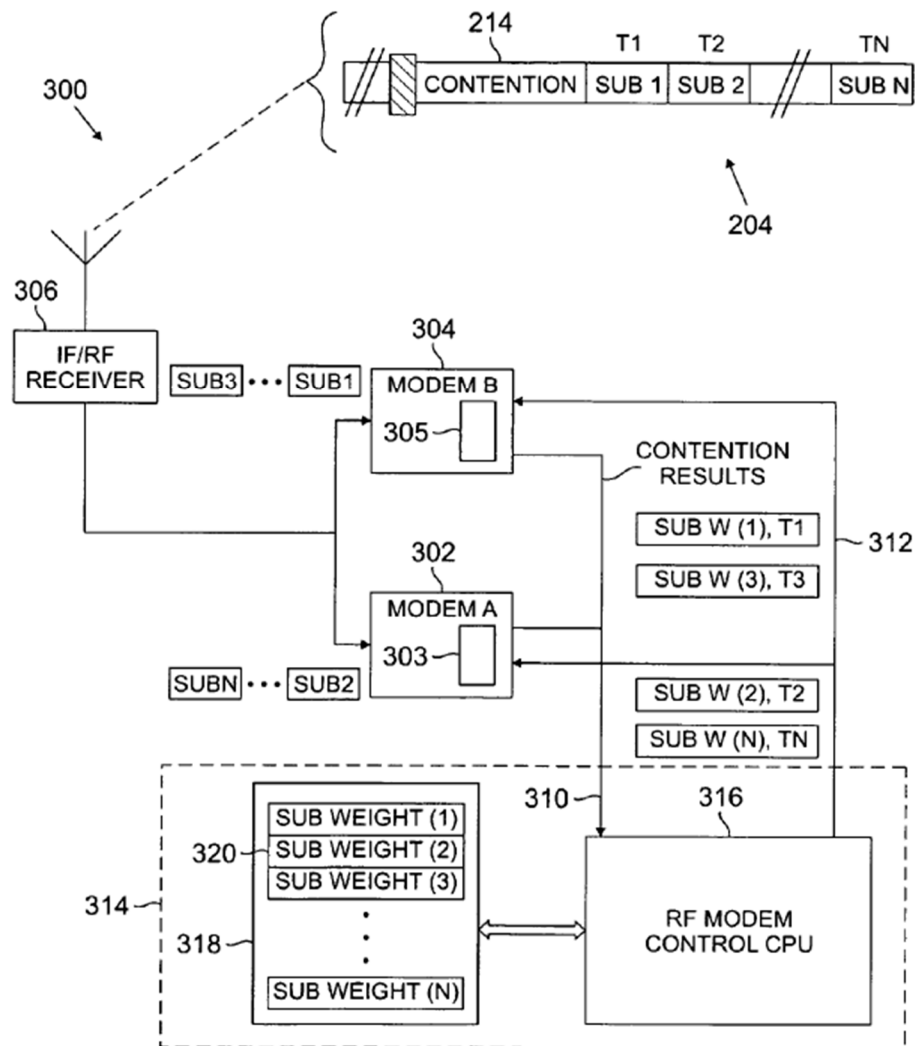


FIG. 3

The '383 patented invention further recognized that, to achieve its stated goals, a base station may utilize “two separate modems . . . to demodulate separate bursts of uplink data signals. By utilizing at least two separate modems, alternating ones of the modems are utilized to demodulate successive bursts of data. During a time period in which a demodulator is not being utilized to operate upon a data burst, values associated with another channel upon which a subsequent data burst is expected to be transmitted is applied to the unused modem. Thereby, when the subsequent burst of data is received at the base station[,] the modem is primed to operate upon the burst of the uplink data signal.” (*Id.* at 12:1-11.) In this way, the invention of the '383 patent significantly improves the quality of communications and increases throughput rates and capacity of wireless communication networks.

IV. CHALLENGED CLAIMS

Petitioner challenges claims 1-17 of the '383 Patent, of which claims 1, 4, 5, and 16 are independent. Claim 1 is included below, as an example.

Claim 1 recites:

An apparatus for a communication station operable in a wireless communication system at least to receive first and second data signals successively transmitted thereto by a first Subscriber station and a second Subscriber station, respectively, within a plurality of subscriber stations, the apparatus comprising:

a first demodulator selectably coupled to receive the first data signals transmitted to the communication station;

at least a second demodulator also selectably coupled to receive the second data signals transmitted to the communication station; and

a controller, coupled to the first demodulator and to the at least second demodulator in a feedback arrangement, the controller alternately selecting the first data signals for application to the first demodulator and the second data signals for application to the second demodulator,

wherein the at least the second subscriber station comprises a plurality of subscriber stations and wherein the controller selectively applies the first and second data signals to the first and second demodulators according to a selected pattern by alternately coupling the first demodulator and the second demodulator to receive, selectably, the first and at least second data signals communicated by alternating ones of the plurality of subscriber stations.

(Ex. 1001 at 12:46-67.)

V. STANDARD FOR GRANTING *INTER PARTES* REVIEW

A petition for IPR may only be granted when “the information presented in the petition...shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(c). Petitioner has the burden of proof to

show that the statutory threshold is satisfied. (*See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012).)

IPR institution is discretionary. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review ...”) (emphasis omitted). “In exercising that discretion, [the Board is] guided by the statutory requirement, in promulgating regulations for *inter partes* review, to consider the effect of any regulations on ‘the efficient administration of the Office [and] the ability of the Office to timely complete proceedings,’ 35 U.S.C. § 316(b), as well as the requirement to construe the PTAB’s rules to ‘secure the just, speedy, and inexpensive resolution of every proceeding,’ 37 C.F.R. § 42.1(b).”

For example, “the Board may consider the number of claims and grounds that meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a).” *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 42 (PTAB Jan. 24, 2019) (Informative).

VI. ARGUMENT

A. The Petition Should Be Denied Because Petitioner Failed to Set Forth How the Challenged Claims Are to Be Construed as 37 C.F.R. § 42.104(b)(3) Requires.

Under 37 C.F.R. § 42.104(b)(3), a petition must explain “[h]ow the challenged claim is to be construed.” And the Patent Trial and Appeal Board

Consolidated Trial Practice Guide (“CTPG”) further provides that “[i]f a petitioner believes that a claim term requires an express construction, the petitioner *must* include a statement identifying a proposed construction of the particular term *and where the intrinsic and/or extrinsic evidence supports that meaning.*” (CTPG at 44 (emphasis added).) The Board has warned Petitioners that claim construction is often required to determine the scope of a patent’s claim, and “[i]f the scope of the claims cannot be determined without undue speculation, as is the case here, the differences between the claimed invention and the prior art cannot be ascertained. In other words, ‘[w]ithout ascertaining the proper claim scope, we cannot conduct a necessary factual inquiry for determining obviousness—ascertaining differences between the claimed subject matter and the prior art.’” *Live Power Intelligence Company NA, LLC v. Genscape Intangible Holding, Inc.*, IPR2019-00169, Paper 7 at 13-14 (PTAB June 7, 2019) (quoting *BlackBerry Corp. v. MobileMedia Ideas, LLC*, IPR2013-00036, Paper 65 at 19–20 (PTAB Mar. 7, 2014) (citing *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) and denying institution on the basis that that “the prior art grounds of unpatentability must fall, pro forma, because they are based on speculative assumption as to the meaning of the claims”)).); *see Kathrein USA, Inc. and T-Mobile US, Inc. v. Fractus S.A.*, IPR2019-00952, Paper 21 at 21-22 (PTAB Oct. 25, 2019) (similar, denying institution); *HTC Corp. and HTC*

America, Inc. v. U.S. Philips Corp., IPR2017-00856, Paper 7 at 8-9 (PTAB Aug. 18, 2017) (similar, denying institution).

Here, the Petition states that “[a]n explanation of how the claims of the ’383 Patent should be construed is provided below in Section V.B.iv.” (Petition at 2.) However, there is no Section V.B.iv. in the Petition, nor an explanation of how Petitioners believe the claims of the ’383 patent should be construed. Instead, in a different section of the Petition, Petitioners merely state that “[u]nless otherwise specified, the terms should receive their respective plain an ordinary meaning as understood by a person of ordinary skill in the art...” (*Id.* at 6.) And nowhere else do Petitioners even mention claim construction, much less provide a proposed construction for any term of the ’383 patent. Nonetheless, without offering any constructions whatsoever, the Petition repeatedly cites to Patent Owner’s infringement contentions from a related district court proceeding to set forth what Petitioner then intuitively Patent Owner’s constructions for claim terms would be. First, Petitioner does not know what Patent Owner’s claim construction is for any term, but more importantly Petitioner bears the burden of providing the Board with its construction for this proceeding. The Board has repeatedly declined to institute Petitions that flout this rule, holding that “[m]erely stating Patent Owner’s contentions from a district court proceeding is not sufficient” to meet the

requirements of 37 C.F.R. § 42.104(b)(3). *IBM Corp. v. Groupon, Inc.*, IPR2017-01452, Paper 7 at 10 (PTAB Dec. 5, 2017) (denying institution).

Rather, the Board has held that to rely on “constructions advanced by Patent Owner in the related litigation,” fails “to provide a sufficient statement of how the challenged claims are to be construed as required by 37 C.F.R. § 42.104(b)(3),” Petitioner must “indicate that it agrees with, proposes, or adopts the constructions attributed to Patent Owner.” *Carefusion Corp. v. Baxter Int’l, Inc.*, IPR2016-01456, Paper 9 at 7 (PTAB Feb. 6, 2017) (denying institution) (citing *Toyota Motor Corp. v. Blitzsafe Texas, LLC*, IPR2016-00422, Paper 12 at 26-27 (PTAB July 6, 2016) (holding that “[t]he ‘construction’ referred to by 37 C.F.R. § 42.104(b)(3) is ... one that Petitioner believes is the correct construction under applicable law and should apply in the involved proceeding” and so denying institution because “Petitioner does not take ownership of the district court’s constructions by indicating, in some way, that it agrees with, proposes, or adopts the construction of this district court.”)); *see Hologic, Inc. v. Enzo Life Sciences, Inc.*, IPR2018-00019, Paper 21 at 4-7 (PTAB Nov. 28, 2018) (institution denied where Petitioner relied on Patent Owner’s claim construction positions before the District Court but did not agree with, propose, or adopt those constructions); *Eiko Global, LLC v. Blackbird Tech LLC d/b/a Blackbird Technologies*, IPR2017-00980, Paper 16 at 35-36 (PTAB Sept. 1, 2017) (denying institution “based on the

Petition’s failure to comply with 37 C.F.R. § 42.104(b)(3)(b)(4)” where the Petition “refers to Patent Owner’s proffered construction” and “merely does not dispute that this construction may be appropriate without endorsing or supporting the construction.” (cleaned up)).

Here, rather than setting forth how the challenged claims are to be construed as required under 37 C.F.R. § 42.104(b)(3), the Petition avoids taking any position. Instead, the Petition relies on the Patent Owner’s apparent interpretation of various claim terms in its infringement contentions before the District Court (Ex. 1008)—notably without indicating “that it agrees with, proposes, or adopts the constructions attributed to Patent Owner” as required in *Carefusion*, *Toyota*, and *Hologic*—cited above. As just a few examples, the Petition states on “time directions”:

With respect to “time directions,” the ’383 Patent does not expressly define what this term allegedly means. Ex. 1001; Ex. 1003, ¶103. In fact, “time directions” appears nowhere in the patent outside this claim element. Ex. 1001; Ex. 1003, ¶103. However, ***Patent Owner’s related contentions interpret the concept of “time directions” broadly*** to cover “direction measurements [that] can be used to determine the settings for transmitting in the direction of a subscriber and/or to focus reception of an uplink burst from a subscriber.” Ex. 1008, 44; Ex. 1003, ¶103. Such techniques are disclosed in Barratt ’470.

(Petition at 45 (emphasis added).) Second, with respect to the “times of arrival,” the Petition again argues that “[i]n its related contentions, Patent Owner contends “[the accused] base stations determine timing-advance values for each UE.” Ex. 1008, 44 (emphasis added); Ex. 1003, ¶138. In the same way, Uhlik discloses determining such “timing-advance” values.” (Petition at 62 (emphasis added).)

As additional examples, in its claim 1 anticipation analysis for Grounds 1 and 4 (which Petitioners rely on not only for all claims depending from claim 1, but also for claims 4 (Petition at 63), 16 (Petition at 42, 74) and 17 (Petition at 43, 74)), Petitioners argue anticipation of Claim 1’s recited “according to a selected pattern” by citing to various different disclosures in the prior art, and then arguing:

This is also consistent with the Patent Owner’s position in its related infringement contentions, which states that “[the accused base stations utilize uplink scheduling to determine the selected pattern with which the controller selectively applies the first and second data signals to the first and second demodulators.[”]

(Petition at 26, 59 (citing Ex. 1008 at 27) (emphasis added).) Similarly, Petitioners argue anticipation of Claim 6’s “channel-related parameter” by arguing that “[i]n its related infringement contentions, Patent Owner contends that this limitation is met because “[accused] eNodeB calculates and stores parameters related to *equalization weighting*, antenna parameters (including but not limited to beamforming), etc.” (Petition at 31 (citing Ex. 1008 at 71).) And with respect to

claim 13’s recited “antenna combining parameters,” Petitioners further base their anticipation argument on the prior art’s alleged similarity to Patent Owner’s infringement contentions, rather than to the Challenged Claims, arguing:

This is also consistent with Patent Owner’s position in its related infringement contentions. Ex. 1008, 94 (contending limitation met because “[accused] base stations include a plurality of antenna transducers which are used in antenna combining techniques *such as beamforming* (including both transmit and receive beamforming) and MIMO.”) (emphasis added).”

(Petition at 72 (bold added).)

The Petition relies on citations to Patent Owner’s infringement contentions no less than 68 times for its challenge to all Challenged Claims, and for all Grounds. (*See* Petition, *passim*.) The Board has previously characterized a situation such as this one, where a “Petitioner’s articulation of its patentability arguments [is] in terms of Patent Owner’s ‘apparent constructions,’” as “invit[ing] us to review Patent Owner’s preliminary contentions made in another forum and to speculate as to what Petitioner understands to be Patent Owner’s construction in that other forum.” *Lyft, Inc. v. Quartz Auto Techs., LLC*, IPR2020-01450, Paper 7 at 12-14 (PTAB Mar. 4, 2021) (denying institution). In *Lyft*, the Board further found that “by effectively asserting that a particular limitation is satisfied because it allegedly would fall within the opposing party’s infringement contentions—

many of Petitioner’s arguments are mere conclusory assertions and we are left unable to discern any basis for those arguments.” *Id.* This is exactly the case here as well, as shown in the examples above.

Because “[i]t is incumbent on Petitioner to set out its patentability contentions in a readily discernable way that does not require [the Board] to speculate,” the Board here, as it has done numerous times before, should “decline to speculate as to how Petitioner contends the challenged claims should be construed” and deny institution. *Id.* (citing 37 C.F.R. 42.104(b)(3) (“The petition must set forth a statement of the precise relief requested for each claim challenged including [h]ow the challenged claim is to be construed.”) (cleaned up)); *see Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01548, Paper 9 at 9-11 (PTAB Mar. 1, 2019) (denying institution because where the “petition is based on the claim constructions urged by Patent Owner in the related district court litigation” as these allegations “fail[] to identify how the challenged claims are to be construed and applied to the prior art” such that “the Petition fails to comply with 37 C.F.R. § 42.104(b)(3).”).

B. The Petition Should Be Denied Because the Barratt ’470 Grounds Fail to Disclose a Controller or a Controller that Comprises a Memory Portion.

Challenged Claims 1-15 each recite “a controller” arranged in a particular way. For example, claim 1 recites “*a controller*, coupled to the first demodulator

and to the at least second demodulator in a feedback arrangement, *the controller* alternately selecting the first data signals for application to the first demodulator and the second data signals for application to the second demodulator...wherein *the controller* selectively applies the first and second data signals to the first and second demodulators according to a selected pattern by alternately coupling the first demodulator and the second demodulator to receive, selectably, the first and at least second data signals communicated by alternating ones of the plurality of subscriber stations.” (Ex. 1001 at 12:57-13:3 (emphasis added).) Despite the numerous requirements for the claimed controller, Petitioners acknowledge that Barratt ’470 does not disclose a controller, such that Petitioners must rely on inherency to meet each element required of the claimed controller. (Petition at 20.)

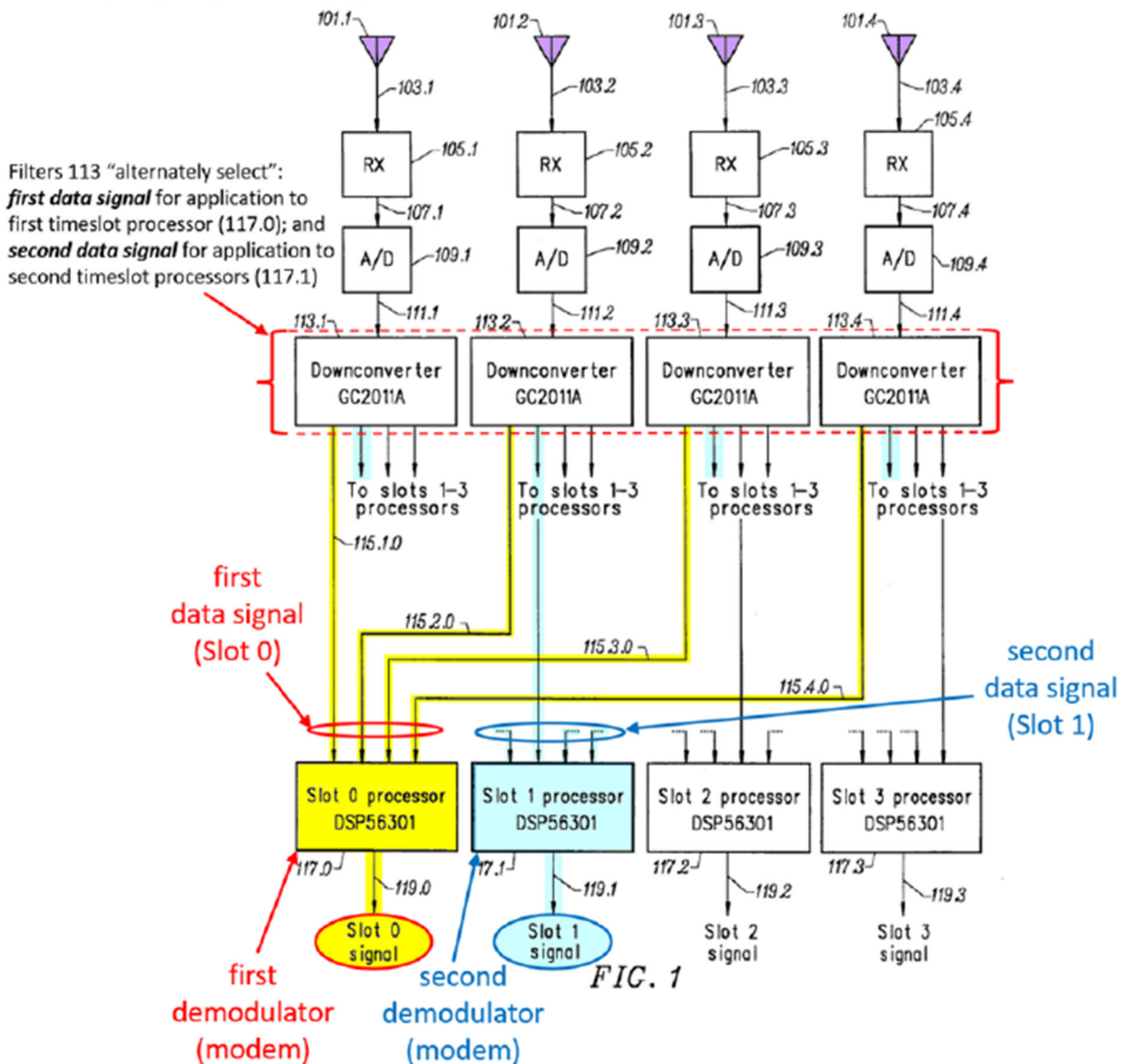
1. The Petition does not show that Barratt ’470 inherently discloses a controller arranged in the same manner as in claim element [1.2] and [4.2].

Petitioner contends for claim elements [1.2] and [4.2]: “*a controller*, coupled to the first demodulator and to the at least second demodulator in a feedback arrangement, *the controller* alternately selecting the first data signals for application to the first demodulator and the second data signals for application to the second demodulator,” and then argue that “[t]he base stations disclosed in Barratt ’470 *necessarily* include a controller (e.g., processing unit) for controlling the operation and performance of these steps.” (Petition at 20, 44.) (emphasis

added) This argument falls well short of what the doctrine of inherency requires. While it may be the case that Barratt '470 might include a controller, it is *not* the case that Barratt '470 *necessarily* includes a controller *arranged in the same manner* recited in the Challenged Claims. *See Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (“The concept of ‘*inherent disclosure*’ *does not alter* the requirement that *all elements must be disclosed* in an anticipatory reference *in the same way as they are arranged or combined in the claim*. Anticipation by *inherent disclosure* is appropriate only when the reference discloses prior art that *must necessarily include the unstated limitation*.”). Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (cleaned up) (emphasis added).) On that specific issue, the Petition is devoid of any evidence at all that Barratt '470 *necessarily* includes a controller *arranged in the same manner* recited in the Challenged Claims.

For example, the Petition argues that “annotated Figure 1 (reproduced below) illustrates how a controller in the base station uses filter devices 113 (during each frame) to alternately select the first data signals received during Slot 0 for application to the *first* DSP 117.0 and the second data signals received during Slot 1 for application to the *second* DSP 117.1

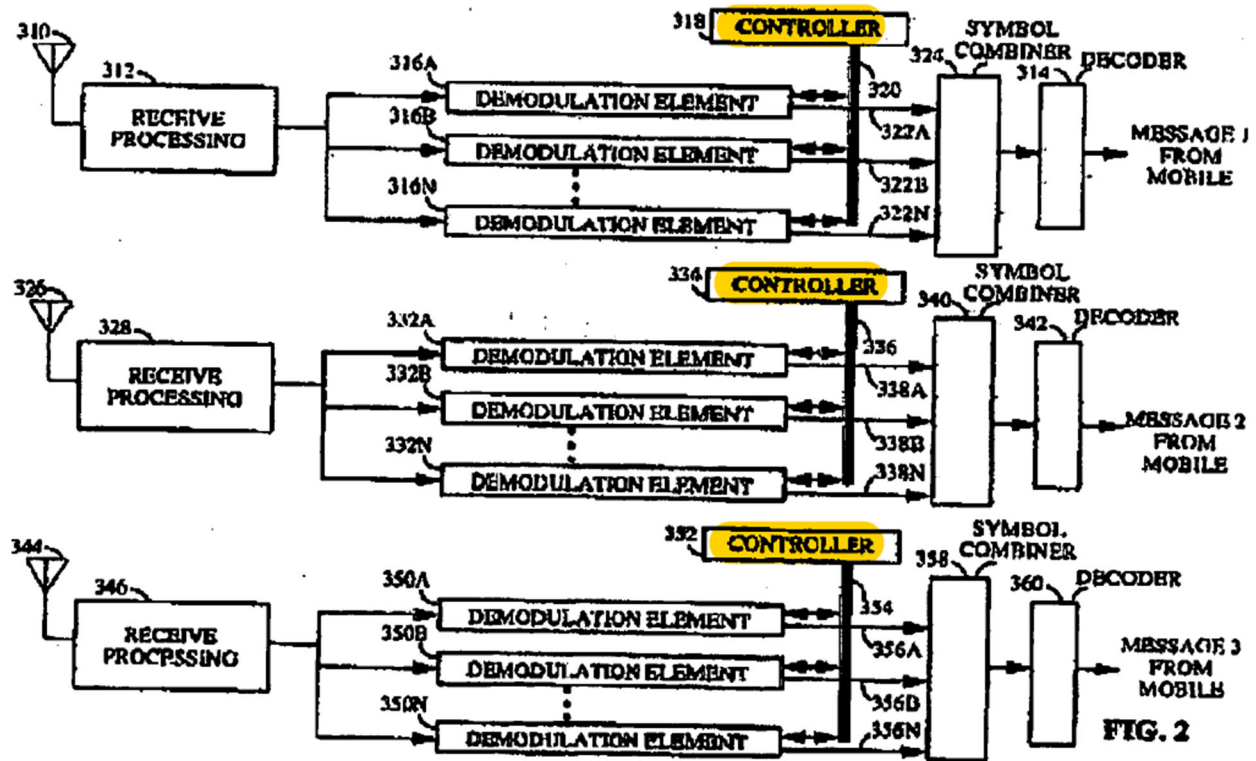
Ex. 1006, Fig. 1 (annotated)



(Petition at 20-21, 44). Not so. Barratt '470's Figure 1 does not show any controller(s), and Petitioners have provided no evidence. Indeed, it is crystal clear from Petitioners' expert's declaration, with an unsupported *ipse dixit* pronouncement, that the controller is not **actually** present but according to the expert is **necessarily** operating in Barratt '470's Figure 1 in the manner recited by

the Challenged Claims. (Ex. 1003 at ¶ 62 (“The base stations disclosed in Barratt ’470 necessarily include a controller ... because processors (e.g., digital signal processors 117) require controller supervision.”).) *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (PTAB Feb. 10, 2023) (Precedential) (Director affirming denial of institution based on disregard of Petitioner’s expert declaration that “merely offered conclusory assertions without underlying factual support and repeated, *verbatim*, Petitioner’s conclusory arguments.”).

Petitioner’s own evidence affirms that a controller need not be necessarily present. Barratt ’470’s Figure 1 could operate instead with different antennas each operating under the control of separate controllers, as shown in the prior art reference that Applicants successfully distinguished their claim from during prosecution:



(Ex. 1002 at 355 (highlighting added).) Specifically, during prosecution, Applicants distinguished *Gilhousen*'s Figure 2, above, stating that "during operation...the three different antennas 310, 326, and 344 depicted in Figure 2 of *Gilhousen et al* each operate, ***under the control of separate controllers 318, 334, and 352***, respectively, on a message (Message 1, Message 2 and Message 3, respectively) from different mobile units." (Ex. 1002 at 355 (bold and italics added).) Thus, it is possible that Barratt '470's Figure 1, like *Gilhousen*'s Figure 2, also operates using multiple controllers, rather than utilizing "***a controller***, coupled to the first demodulator and to the at least second demodulator in a feedback arrangement, ***the controller*** alternately selecting the first data signals for

application to the first demodulator and the second data signals for application to the second demodulator” as claimed.

Gilhousen’s Figure 2 is just one of likely many examples that refute Petitioners’ inherency argument, and for this reason such an argument must fail. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (reversing the Board’s finding of inherency for ignoring the “critical principles” that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,’” and that inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). As yet another example, it is further possible that Barratt ’470’s Figure 1 might instead utilize multiple controllers in the manner shown in Uhlik’s Figure 3, below. Rather than a *single* controller configured to perform all recited requirements for the controller claimed in the Challenged Patents, Uhlik discloses:

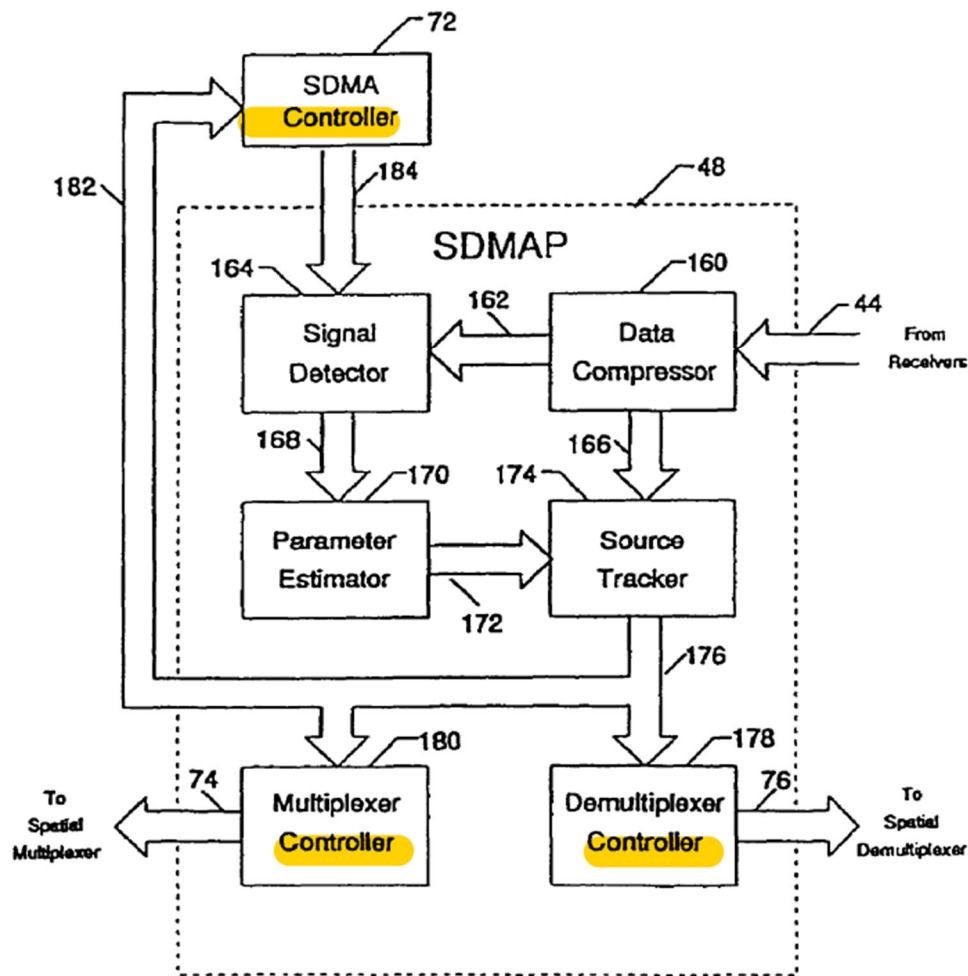


FIG. 3

(Ex. 1005, Fig. 3 (highlighting added).)

Instead of trying to demonstrate the requirements of inherency and providing evidence beyond bald statements that include the language “necessarily,” the Petition alleges—again without supporting evidence—that “as illustrated in annotated Figure 6 (reproduced below), Barratt ’470 also discloses how the controller in the base station operates each of the DSPs “in a feedback arrangement” that involves maintaining and updating various parameter values (e.g., frequency offset) *from one frame to the next.*”

Ex. 1006, Fig. 6 (annotated)

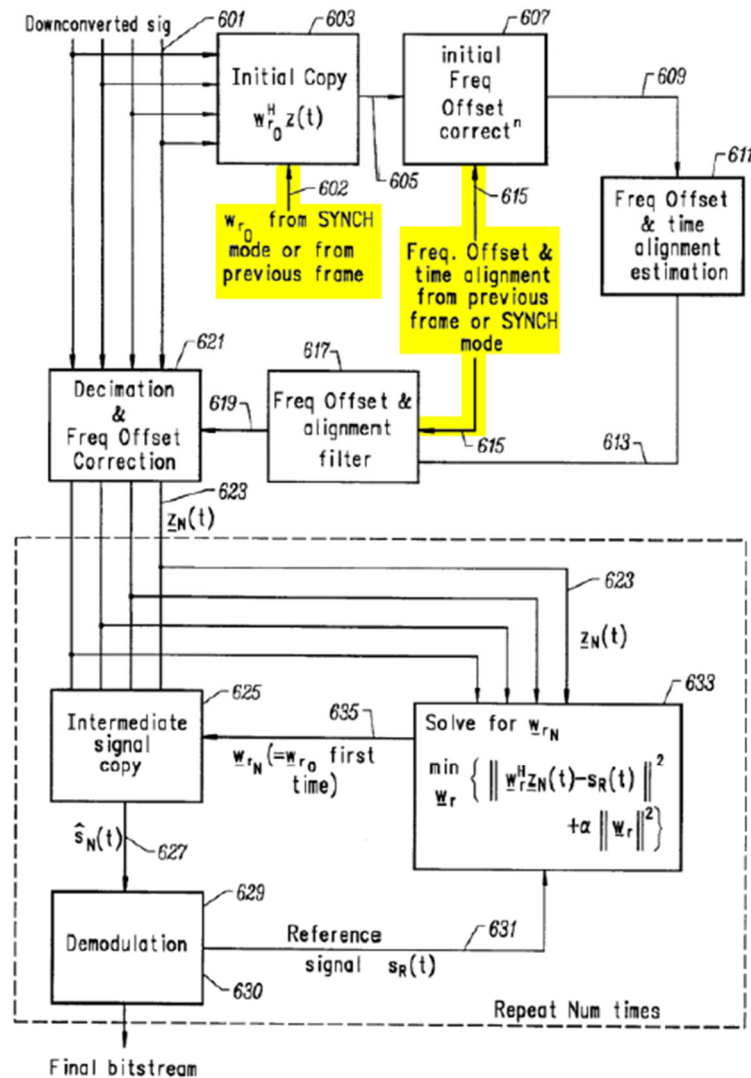


FIG. 6

(Petition at 21-22, 44.) But once again, Barratt '470's Figure 6 does not show any controller(s), and Petitioners have provided no actual evidence. Petitioners' unsupported evidence from their expert that a controller is *necessarily* operating in Barratt '470's Figure 6 in the manner recited by the Challenged Claims is not enough. See *Xerox*, IPR2022-00624, Paper 12 at 5. Just as stated above and as shown in two examples using Petitioners' submitted evidence, it is possible that

Barratt '470's Figure 6 could operate any alleged "feedback arrangement" under the control of separate controllers, as shown in *Gilhousen's* Figure 2 and Uhlik's Figure 3, above.

Thus, because Barratt '470 does not *necessarily* include "*a controller*, coupled to the first demodulator and to the at least second demodulator in a feedback arrangement, *the controller* alternately selecting the first data signals for application to the first demodulator and the second data signals for application to the second demodulator" as claims 1 and 4 recite, Petitioners have failed to meet their burden of showing inherency for the claim controller arranged in the same way as in claims 1 and 4. *See Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1377–78 (Fed. Cir. 2002) ("In arguing inherent disclosure of the [controller] limitation in the ['383] patent, [Petitioner] bears an evidentiary burden to establish that the limitation was necessarily present."). Further, because Petitioners rely on their claim [1.2] and [4.2] analysis for each claim depending from claim 1, as well as for claim 16, Petitioners' challenges must fail for these additional claims.

(Petition at 42.)

2. The Petition does not allege that Barratt '470 inherently discloses a controller arranged in the same manner as in claim element [1.4], [4.3], or [4.5].

Claim elements [1.4] and [4.5] recite "wherein *the controller* selectively applies the first and second data signals to the first and second demodulators

according to a selected pattern by alternately coupling the first demodulator and the second demodulator to receive, selectably, the first and at least second data signals communicated by alternating ones of the plurality of subscriber stations.” (Ex. 1001 at 12:63-13:3, 13:38-45.) But the only time the Petition even mentions a controller is in quoting Patent Owner’s infringement contentions:

This is also consistent with the Patent Owner’s position in its related infringement contentions, which states that “[the accused] base stations utilize uplink scheduling to determine the selected pattern with which the **controller** selectively applies the first and second data signals to the first and second demodulators. Ex. 1008, 27.

(Petition at 26 (emphasis added), 46.) Ex. 2008 is Patent Owner’s Infringement Contentions. Needless to say, Petitioners cannot show Barratt’s disclosure of a controller arranged in the same manner as recited in claims [1.4] and [4.5] by citation to an unrelated controller discussed in Patent Owner’s infringement contentions. This sleight of hand demonstrates the Petition is lacking. In fact, the Petition does not even allege that Barratt ’470 discloses a controller—even inherently—arranged in the same manner as recited in claims [1.4] and [4.5]. The Petition’s claims 1 and 4 challenges must fail. *See Therasense, Inc.*, 593 F.3d at 1332 (“The concept of ‘inherent disclosure’ does not alter the requirement that all elements must be disclosed in an anticipatory reference in the same way as they are arranged or combined in the claim.”). Further, because Petitioners rely on their

claim [1.4] analysis for each claim depending from claim 1, as well as for claim 17, Petitioners' challenges must fail for these additional claims. (Petition at 44.)

Moreover, claim [4.3] recites "wherein the first and at least second data signals transmitted to the communication station by the first and at least second subscriber stations are transmitted in bursts of selected time durations and wherein *the controller* further determines times of arrival and time directions of the bursts which form the data signals." (Ex. 1001 at 13:31-36 (emphasis added).) But once again, the Petition's analysis of this claim element does not even mention the controller, much less allege that Barratt '470 discloses a controller arranged in the same way as recited in claim [4.3]. (Petition at 44-46.) For this additional reason, Petitioners' challenge must fail for claim 4.

3. The Petition does not allege that Barratt '470 inherently discloses either a controller or a controller that comprises a memory portion arranged in the same manner as in claim 5.

Claim element [5.2] recites "a controller, coupled to the first demodulator and to the at least second demodulator in a feedback arrangement, the controller alternately selecting the first data signal for application to the first demodulator and the second data signal for application to the second demodulator." (Ex. 1001 at 13:57-61.) For this claim element, Petitioners rely on their analysis for claim element [1.2], and so Petitioners' claim 5 challenge fails for the reasons discussed above in Section VI.B.1.

In addition, claim element [5.3] recites “wherein the controller further comprises a memory portion, the controller further for maintaining profiles associated with each of the first and at least second data signals transmitted upon first and at least second channels, respectively, the profiles stored at the memory portion of the controller.” (Ex. 1001 at 13:62-67.) Despite these claim limitations, the only time that Petitioners even mention the claimed “controller” or “memory portion” is to allege that “Barratt ’470 discloses base stations that necessarily comprise ‘memory portions,’ which may be included within the base station’s ‘controller’ *or other parts of the base station.*” (Petition at 29-30 (emphasis added).) But as discussed above, this analysis does not establish that the controller is *necessarily* arranged as recited in claim [5.3]. Even worse, despite relying on inherency for Barratt ’470’s “memory portion,” Petitioners *admit* that this alleged “memory portion” *is not necessarily* “included within the base station’s ‘controller’” as recited in claim [5.3] since Petitioners acknowledge that a “memory portion” “may be included” in “other parts of the base station” other than “within the base station’s ‘controller’.” (Petition, 29.) *See Cont’l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268–69 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). For this additional reason, Petitioners’ challenge to claim 5 must fail. Further,

because Petitioners rely on their claim [5.3] analysis for each claim depending from claim 5, as well as for claim 16, Petitioners' challenges must fail for these additional claims. (Petition at 42.)

C. The Petition Should Be Denied Because it Impermissibly Relies on Disclosures from Separate Embodiments in Uhlik that are Not Arranged or Combined in the Same Way as in the Challenged Claims.

The Federal Circuit has repeatedly held that “[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, “unless a reference discloses within the four corners of the document not only all of the limitations claimed but *also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN*, 545 F.3d at 1371 (emphasis added).

For these reasons, the Federal Circuit has repeatedly held that for anticipation, “it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow

combine to achieve the claimed invention.” *Id.* (citing *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (“The prior art reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” (cleaned up))); *see, e.g., Net MoneyIN*, 545 F.3d at 1370-1371 (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984) (“Because the district court had treated the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning, we reversed.” (quotation omitted)) and *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000) (finding no anticipation where, “although the reference taught all elements of the claim, it did not contain a discussion suggesting or linking hydrazine with the mixed bed in the figure, and thus did not show the invention arranged as in the claim.”)).

Here, for all Grounds based on Uhlik, the Petition attempts to combine embodiments in its anticipation arguments in the same manner that the Federal Circuit has rejected. Specifically, in detailing Uhlik’s alleged disclosure of claim 1, Petitioners rely on Uhlik’s Figures 1, 3, and 4, as well as their respective descriptions. (*See* Petition at 50-51 (relying on **Figure 1** and the description of

Figure 4 for claim element 1 [pre]); Petition at 51-53 (relying on **Figure 4** and its description for claim elements [1.1.1] and [1.1.2]); Petition at 53-55 (relying on **Figure 4** and the descriptions of **Figures 1 and 3** for claim element [1.2]); Petition at 55-57 (relying on **Figure 1** and its descriptions for claim element [1.3]); Petition at 57-59 (relying on **Figure 4** and its descriptions for claim element [1.4]).)

According to Uhlik, Figures 1 and 3 are part of the same embodiment. Specifically, Uhlik describes Figure 1 as “a diagram illustrating an exemplary architecture of a wireless communication system according to one embodiment of the present invention,” with Figure 3 “show[ing] a breakdown of a Spatial Division Multiple Access signal processor (SDMAP) 48,” which is included in Figure 1. (Ex. 1005 at 2:21-23, 3:53-54.) The interaction between Uhlik’s Figures 1 and 3 can be seen through the highlighting below:

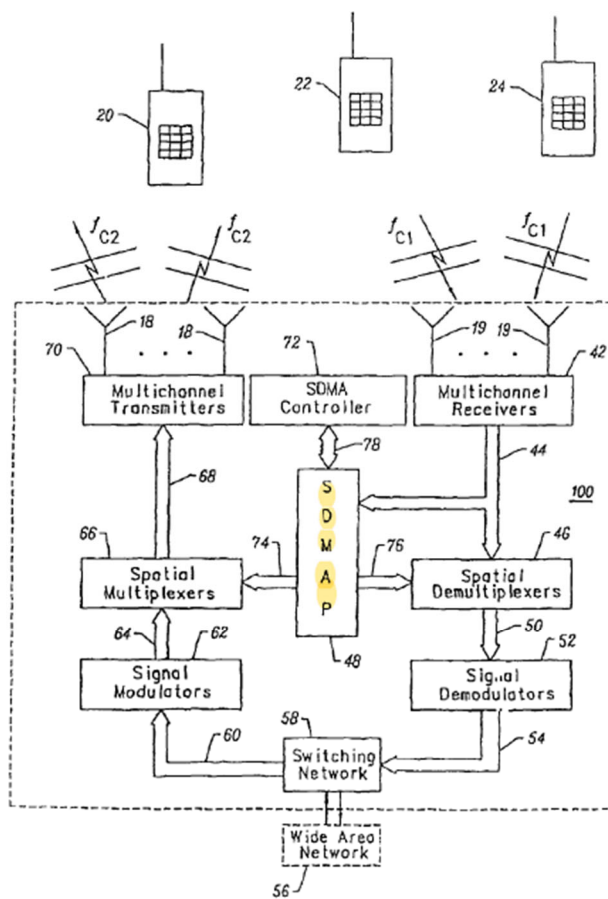


FIG. 1

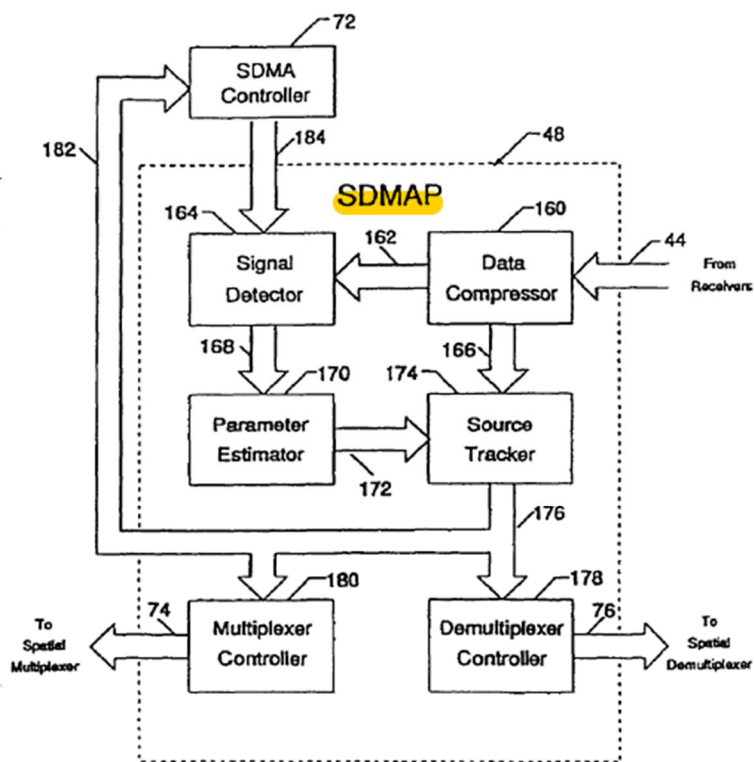


FIG. 3

By contrast, Uhlik describes Figure 4 as “an *alternative embodiment* of a wireless communications system suitable for implementing the present invention.” (Ex. 1005 at 5:22-24.) And as seen below, unlike Uhlik’s Figures 1 and 3, Uhlik’s alternative embodiment shown in its Figure 4, below, does not contain the Spatial Division Multiple Access signal processor (SDMAP) that is shown in Figures 1 and 3:

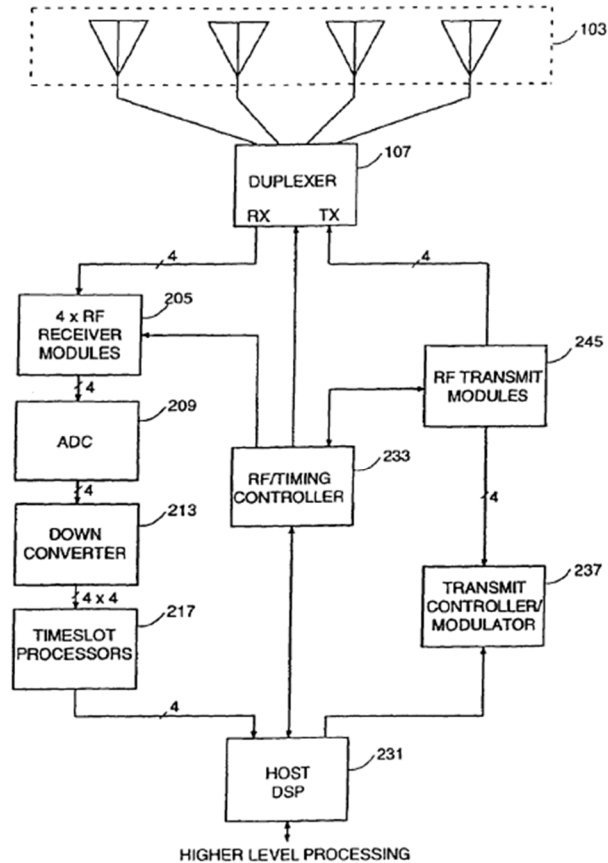


Figure 4

For this reason, the Petition cannot rely on Figure 4 for some claim elements and Figures 1 and/or 3 for other claim elements for anticipation. This is particularly the case for claim element [1.2]. For that element, Petitioners relied on Uhlik’s description of “spatial multiplexing and demultiplexing weights”—contained in Uhlik’s description of the SDMAP of Figure 1—as well as using these weights “to keep track of the positions of each of the transmitters as a function of time”—contained in Uhlik’s description of Figure 3’s SDMAP—as allegedly disclosing the “feedback arrangement” recited in claim element [1.2]. (Petition, 54 (citing Ex. 1005, 3:1-27 (“The SDMA processor (SDMPA) 48 produces and

maintains spatial signatures for each subscriber station for each conventional channel, calculates spatial multiplexing and demultiplexing weights...”), 4:61-5:13 (describing Figure 3).) By contrast, for claim elements 1 [pre], [1.1.1], [1.1.2] and [1.4], Petitioners rely in Uhlik’s disclosures of its Figure 4 “alternative embodiment.” (See Petition at 50-51 (relying on the description of **Figure 4** for claim element 1 [pre]); Petition at 51-53 (relying on **Figure 4** and its description for claim elements [1.1.1] and [1.1.2]); Petition at 53-55 (relying on **Figure 4** for claim element [1.2]); Petition at 57-59 (relying on **Figure 4** and its descriptions for claim element [1.4]).)

Because Petitioners rely on the disclosures of the SDMAP in Figures 1 and 3, but also on the disclosures of the alternative embodiment shown in Figure 4—which does not contain an SDMAP—Petitioners’ anticipation challenge to claim 1 relies on disclosures from Uhlik that are not “arranged or combined in the same way as in the claim,” and so must fail. *See Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1361 (Fed. Cir. 2012) (“For a prior art reference to anticipate a claim, it must disclose all of the limitations of the claim, ‘arranged or combined in the same way as in the claim.’ For example, in *Net MoneyIN*, this court held that an ‘Internet payment system’ was not anticipated by a prior art reference that disclosed all the components of the invention, because the reference disclosed two separate payment protocols, each of which contained only a subset

of the components claimed in the patent at issue.” (quoting *Net MoneyIN*, 545 F.3d at 1370.)) Further, because Petitioners rely on their claim [1.2] analysis for each claim depending from claim 1, as well as for claims 4, 5 (and all claims depending from claim 5), and 16 (and all claims depending from claim 16), Petitioners’ challenges must fail for these additional claims. (Petition at 61, 63.)

Although Petitioners’ challenge to claims 11-12 and 14-15 (which all depend from claim 5) is based on an obviousness challenge to Uhlik, rather than one based on anticipation, Petitioners rely solely on their anticipation arguments for claim 5—for the claim 5 elements from which claims 11-12 and 14-15 depend. Thus, Petitioners have not argued that it would have been obvious for a POSA to combine Uhlik’s Figures 1 and 3 with its Figure 4, and it is too late to make this argument now. *See Live Power Intelligence Company NA*, IPR2019-00169, Paper 7 at 13-14 (“Our role is not to remedy the deficiencies in Petitions that fall short.”) (citing *Sirona Dental Sys. GMBH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018) (because “the petitioner’s contentions, not the Director’s discretion, define the scope, it would thus not be proper for the Board to deviate from the grounds in the petition and raise its own obviousness theory instituting a different inter partes review” (quoting *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356–57 (2018) (cleaned up)); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (IPRs are “a system that is predicated on a petition followed

by a trial in which the petitioner bears the burden of proof. Given that framework, we find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”).

It is worth noting that “a reference can anticipate a claim even if it does not expressly spell out all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would at once envisage the claimed arrangement or combination.” *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068 (Fed. Cir. 2017) (cleaned up) (affirming the Board’s finding of no anticipation). However, in order to make such a showing, Petitioners would have needed to present evidence in their Petition that a POSA would have “at once envisage[d] the combination of Uhlik’s Figures 1 and 3 with Uhlik’s alternative embodiment depicted in Figure 4, and Petitioners have not made any such allegation, much less the required evidentiary showing. (See Petition at 50-59.) *BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1400–01 (Fed. Cir. 2022) (rejecting anticipation argument “premised on [Plaintiff’s] assertion that [the prior art]’s Figures 2 and 3 depict the same embodiment” and that even if they did not, the “highly skilled ordinary artisan here would ‘at once envisage’ the claimed combination” because “a substantial question of validity cannot be manufactured

through mere supposition about what an artisan with highly advanced skill in the [] field might do.”).

D. The Board Should Deny Institution Under *Fintiv*, 35 U.S.C. § 314(d)

Discretionary denial is compelling under the *Fintiv* analysis pursuant to 35 U.S.C. § 314(d). The *Fintiv* factors are:

- (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
- (3) investment in the parallel proceeding by the court and the parties;
- (4) overlap between issues raised in the petition and in the parallel proceeding;
- (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and,
- (6) other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple, Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential). These factors weigh in favor of denying institution.

First, General Access has asserted the ’383 Patent against Nokia and Ericsson, and T-Mobile in litigation pending in the United States District Court for

the Eastern District of Texas, *General Access Solutions Ltd. v. T-Mobile US, Inc. et al.*, Case No. 2:23-cv-00158-JRG-RSP (the “Related Litigation”). There is little chance that the district court will stay the case in the event that the Board institutes because the Related Litigation will be tried and reduced to a final judgment before any Final Written Decision. Additionally, as Petitioners acknowledge, they have not requested a stay. (Petition at 79.)

Second, the five-year average median time from filing to trial in the Eastern District of Texas is nineteen months (*see* Ex. 2001 at 2) and the Complaint was filed in April 2023, leading to an assumed trial date of November 2024. Consistent with that general estimate, the district court has set a trial date for January 2025. (Ex. 1009 at 1.) If institution is granted in this IPR, a Final Written Decision would not be expected until March 2025, which is approximately two to four months after trial. This factor weighs in favor of denial. *See Roku, Inc. v. IOENGINE, LLC*, IPR2022-01551, Paper 11 at 10-11 (PTAB May 5, 2023); *Samsung Electronics Co., Ltd. v. California Institute of Technology*, IPR2023-00133, Paper 10 at 14 (PTAB May 4, 2023).

Third, Petitioners present no *Sotera* stipulation with their Petition, and instead relies on “compelling merits” for institution. (Petition at 81); *cf. Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (Precedential in relevant part). But, as detailed above, there are no

“compelling merits” because Petitioners’ asserted grounds for invalidity are particularly weak. Under these circumstances, interests of judicial economy warrant denial of institution.

VII. CONCLUSION

For the reasons discussed above, Petitioners fail to meet their burden of demonstrating a reasonable likelihood that claims 1-17 are invalid. Therefore, Patent Owner respectfully requests the Board deny Petitioners’ request for *Inter Partes* Review of U.S. Patent No. 7,099,383.

Dated: December 28, 2023

Respectfully Submitted,

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CERTIFICATE OF WORD COUNT

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the Microsoft Office word count for the foregoing Patent Owner's Preliminary Response Under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, excluding the table of contents, table of authorities, certificate of word count, and certificate of service, totals 7,520 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: December 28, 2023

Respectfully Submitted,

/Sarah E. Spires/

Sarah E. Spires (Reg. No. 61,501)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioners a true and correct copy of the foregoing Patent Owner's Preliminary Response Under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, by electronic means on December 28, 2023 at the following addresses of record:

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