

Filed: February 16, 2024

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

SUR-REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF AUTHORITIES

Cases

<i>BlephEx, LLC v. Myco Indus., Inc.</i> , 24 F.4th 1391 (Fed. Cir. 2022)	5
<i>CommScope Techs. LLC v. Dali Wireless, Inc.</i> , IPR2022-01242 (PTAB Feb. 27, 2023) (Paper 23)	1
<i>Corephotonics, Ltd. v. Apple Inc.</i> , 84 F.4th 990 (Fed. Cir. 2023)	4
<i>Ecolochem, Inc. v. Southern California Edison Co.</i> , 227 F.3d 1361 (Fed. Cir. 2000).....	5
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016).....	2
<i>Samsung Electronics Co., Ltd. v. MyPort, Inc.</i> , IPR2023-00023 (PTAB Apr. 24, 2023) (Paper 21)	2
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 593 F.3d 1325 (Fed. Cir. 2010).....	3

Despite requesting from the Board “leave to address considerations under *Fintiv*” (Ex. 2002 at 1), Petitioners do not mention *Fintiv* factors 1-5. Instead, the Reply responds to the “merits” (factor 6) only, even when “PTAB panels [are] to only consider compelling merits if they first determined that *Fintiv* factors 1-5 favored a discretionary denial.” *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (PTAB Feb. 27, 2023) (precedential). As Patent Owner argued in its POPR, and as Petitioners explicitly requested the opportunity to do and have now failed for the second time—*Fintiv* factors favor discretionary denial at least because Petitioners have not requested a stay in the district court litigation, and because a Final Written Decision in this IPR would not be expected until several months after trial in the district court. (POPR at 38-39.)

By focusing on *Fintiv* factor 6 alone, Petitioners have essentially converted their Reply to the merits, even though they did not request a Reply on the merits from the Board. For this reason, the second and third paragraphs of the Reply should be struck. (*See* Reply at 1-2.) Indeed, in a similar circumstance, the Board refused to “consider such unauthorized arguments”:

As a preliminary matter, we agree that Petitioner’s arguments regarding the merits of its challenges are outside the authorized scope of the Preliminary Reply. In our communication authorizing the additional briefing, we instructed the parties that “[t]he [Preliminary] Reply is limited . . . to addressing the *Fintiv* issues identified by

Petitioner below.” Petitioner identified those issues as “Patent Owner’s positions on Fintiv factors 1-4 and 6, and Patent Owner’s ‘additional considerations’ related to Fintiv.” **Petitioner’s arguments regarding the merits of its challenges exceed the allowed scope for the Preliminary Reply**, and we therefore do not consider such unauthorized arguments.

Samsung Electronics Co., Ltd. v. MyPort, Inc., IPR2023-00023, Paper 21 at 18-19 (PTAB Apr. 24, 2023) (citation omitted) (emphasis added). The Board does not typically permit a petitioner to file a preliminary reply to argue the challenges’ merits. As the Federal Circuit has explained, “the expedited nature of IPRs bring[s] with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Unless there is a change in the law, unforeseeable subsequent development, or similar extraordinary circumstances, Petitioners should not get extra merits briefing.

Nonetheless, Petitioners’ merits arguments fail. With respect to Ground 1, Petitioners blatantly mischaracterizes Patent Owner’s argument. Specifically, Petitioners assert that “Patent Owner attacks Ground 1 of the Petition by arguing that a controller would not be present in the Barratt ’470 base station.” (Preliminary Reply at 1.) Not so. Instead, Patent Owner argued that the “Petition does not show that Barratt ’470 inherently discloses a controller *arranged in the*

same manner as in claim element” [1.2], [1.4], [4.2], [4.3], or [4.5]. (POPR at 18, 26.) Petitioners additionally make much of the fact that “Patent Owner does not assert that a base station would not necessarily comprise a controller,” but ignores that it is *Petitioner’s burden*. Inherency is well settled—Petitioners must show not only that the prior art necessarily requires a controller, but also that it would necessarily include a controller *arranged in the same manner* as in the Challenged Claims—a burden that Petitioners have utterly failed to meet, as explained in detail in the POPR. (See POPR at 17-30.) 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.”).

With respect to Grounds 4 and 5, Petitioners misstate the contents of the Petition. Specifically, Petitioners argue that “the Petition establishes that Figure 4 by itself discloses each and every element of claim 1.” (Reply at 2.) Not so. For example, for claim element [1.2], the Petition cites only to Uhlik’s description of Figure 3 for its assertion that because Uhlik discloses “‘weights’ and other location-related parameter estimates [that] are passed to a ‘source tracker’ whose function ‘is to keep track of the positions of each of the transmitters as a function of time,’ Uhlik must for some reason “disclose[] that the host processor (i.e., ‘controller’) is coupled to each timeslot processor (i.e., ‘demodulator’) in a

feedback arrangement for processing additional, subsequent bursts received from the same subscriber station” as claim element [1.2] recites. (Petition at 54 (citing Ex. 1005, 4:61-5:13).) While the Petition also contains a citation for this claim element, the citation merely states: “*see also id.*, 6:19-58,” (Petition at 54). This portion of Uhlik does not contain any description of using weights in a feedback arrangement as claim element [1.2] recites—nor does the Petition contain any explanation of the relevance of this “*see also*” citation, as required. *See Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001–02 (Fed. Cir. 2023) (“The IPR petition[] must provide an ***understandable explanation of the element-by-element specifics of the patentability challenges***, including the identification of particular portions of prior art on which the petitioner is relying.”) (emphasis added). Notably, Petitioners’ Reply does not dispute Patent Owner’s assertion that reliance on Figure 3 would be an improper combination of embodiments. (*See* Reply at 1-2.) Because the Petition *does* rely on Figure 3 for its alleged disclosure of claim element [1.2], the Petition’s arguments must fail. (*See* POPR at 30-38.)

Petitioners further argue that their combination of Figures 1 and 4 in their anticipation analysis is proper because “Figure 1 shows a general ‘architecture’ in which the disclosed spatial processing (SDMA) techniques can be used in combination with *any* such conventional multiple access scheme (*e.g.*, FDMA,

TDMA, and/or CDMA), such as the scheme illustrated in Figure 4.” (Reply at 2 (citing Petition at 56-57).)

Petitioners’ argument fails on the facts and the law. On the facts, Petitioners’ citation to the Petition at 56-57 is part of the analysis of claim element [1.3] *only*—and so does not rationalize Petitioners’ combination of the different embodiments with respect to claim elements 1 [pre] or [1.2] as discussed in the POPR. (POPR at 31-32.) With respect to the law, “it is not enough that the prior art reference includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention to show anticipation.” *BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1400 (Fed. Cir. 2022) (cleaned up). Because Uhlik never discloses combining Figure 1 with Figure 4, and indeed discloses Figure 4 as an *alternative* embodiment to Figure 1 that does not contain Figure 1’s SDMAP, Petitioners’ reliance on a combination of Figures 1 and 4 is fatal to its anticipation analysis. (See POPR at 32-34.) See, e.g., *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.”)).

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), 42.105, I certify that I caused to be served on the counsel for Petitioners a true and correct copy of the foregoing Sur-Reply to Patent Owner's Preliminary Response, by electronic means on February 16, 2024 at the following addresses of record:

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