

Filed: January 22, 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. IPR2023-01416

U.S. Patent No. 6,947,477

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

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I. INTRODUCTION

Petitioners submitted a Petition to institute *inter partes* review (“IPR”) of U.S. Patent No. 6,947,477 (“the ’477 patent”) (Ex. 1001), challenging claims 1-20 (the “Challenged Claims”). General Access Solutions, Ltd. (“Patent Owner”) requests that the Board decline to institute because Petitioner has failed to allege that the prior art discloses every element of the Challenged Claims, and so cannot have a reasonable likelihood of prevailing on the merits.

First, claim [1.C]—from which Challenged Claims 2-16 also depend—recites (1) “a profile parameter storage device ***coupled*** to said profile parameter determiner.” Despite this claim language, Petitioners never assert in any Ground that the prior art discloses—through anticipation or obviousness—a “profile parameter storage device” that is ***coupled*** to a “profile parameter determiner.” Instead, Petitioners ignore the relationship between these two components altogether. This directly contravenes black letter law: Petitioners must provide an ***understandable explanation of the element-by-element specifics of the patentability challenges***. In this case, Petitioners completely miss an element, and so they cannot meet their burden of proving that the ’477 patent is invalid over the prior art. And for claim 16 and its dependent claims, Petitioners rely solely on their analysis for claim 1 without any further analysis whatsoever, and so incorporate

the deficiencies of their claim 1 analysis into their challenge to claim 16 and its dependent claims.

Second, for Grounds 1 and 2, even if Petitioners *had* alleged that the asserted Genossar prior art reference discloses (1) “a profile parameter storage device *coupled* to said profile parameter determiner,” Genossar demonstrates that the relevant storage devices are not *coupled* to the alleged profile parameter determiner, but are instead *part of* that alleged determiner. This contradicts both the explicit language of the Challenged Claims, and also the law presuming that separately listed claim elements are distinct components.

Third, for Grounds 1 and 2, the Genossar prior art reference contradicts Petitioners’ allegation that Genossar discloses that the “profile parameter storage device for storing values representative of the at least one signal-related parameter *and* the at least one channel-related parameter” as claim [1.C] also recites. Specifically, Genossar teaches that the alleged signal-related parameter and channel-related parameter are stored in *separate devices*, such that there is not a single “profile parameter storage device” that stores both alleged parameters as claim [1.C]—whose analysis is again carried forward through all claims—recites.

Fourth, for Ground 2, Petitioners relied on Genossar in combination with WiMAX, which is not prior art. It is Petitioners’ burden to prove that WiMAX—which is labeled as a “potential draft standard document” produced by an IEEE

Working Group—was publicly accessible before the '477 patent's critical date. Despite carrying this burden, Petitioners put forth zero evidence that members of the interested public would have known about this potential draft standard document, much less how to gain access to the document. Instead, Petitioners point first to the copyright date on the document, despite the fact that a copyright date is both hearsay and sheds virtually no light on whether the document was publicly accessible prior to" the critical date. Next, Petitioners point to members of the Working Group who were part of drafting the document, despite the fact that it is black letter law that a "work is not publicly accessible if the only people who know how to find it are the ones who created it.

Finally, for Grounds 3-5, Petitioners rely on the doctrine of inherency for the recited "profile parameter storage device" recited by all Challenged Claims. But in doing so, Petitioners ignore that anticipation requires the disclosure of all claim elements—even those disclosed inherently—to be arranged as in the Challenged Claims. Petitioners never even try to show this, instead only arguing that a "profile parameter storage device" is inherent in the asserted Barratt '470 prior art reference, rather than alleging that a "profile parameter storage device" must "always and necessarily" be both present and arranged as in the Challenged Claims. In so arguing, Petitioners ignore that the Challenged Claims additionally require that this device is additionally (1) "*coupled* to said profile parameter

determiner and (2) “for storing values representative of the at least one signal-related parameter *and* the at least one channel-related parameter.” And Petitioners’ own evidence —the Genossar reference—demonstrates that a “profile parameter storage device” is *not* inherently arranged as in the Challenged Claims. The alleged “profile parameter storage device” in Genossar is contained within the alleged “profile parameter determiner,” it is not coupled to it as required by Claim element [1.c].

Accordingly, Patent Owner requests that the Board deny institution on all Challenged Claims of the ’477 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 ’477 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 ’477 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 '477 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.

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.

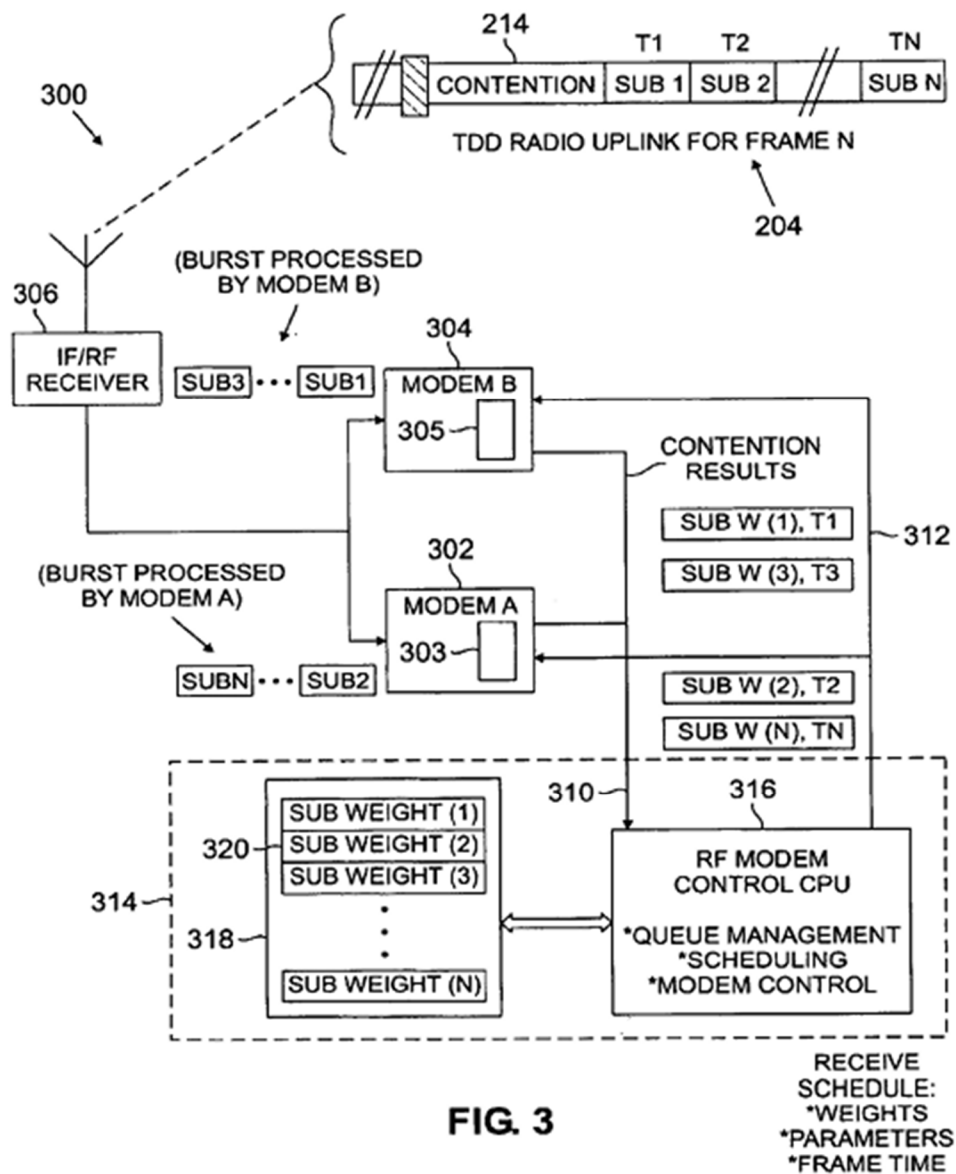
Paul Struhsaker and his colleagues at Raze applied for, and were granted, several fundamental patents related to wireless communications. Most notably for present purposes, on April 20, 2001, a patent application was filed on behalf of Mr.

Struhsaker and Mr. Russell McKown, which ultimately led to the issuance of U.S. the '477 patent on September 20, 2005.

The '477 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 5:44-48.) In addition, the patent recognized “a need for an apparatus to compensate for distortion introduced upon data signals transmitted on a wireless communication channel. (*Id.* at 5:48-50.) Further, because “the base stations of a FWA [fixed wireless access] system must be able to quickly and accurately [] operate upon data bursts received from a potentially large number of subscribers, the '477 patent recognized a need for “an increase in speed and accuracy by which the data bursts can be operated upon by the base stations, or other infrastructure.” (*Id.* at 5:51-57.)

To address these needs, the claims of the '477 patent are directed to an “apparatus and associated method by which to operate upon bursts data signals received at a receiving station, such as a base station of a fixed wireless access system” in order to increase “the speed and accuracy by which bursts of burst data signals are operated upon, when received at the receiving station.” (*Id.* at 5:60-67.)

Figure 3 from the '477 patent, copied below, “illustrates a functional block diagram of a portion of an embodiment of the present invention.” (*Id.* at 7:34-37.)



In Figure 3, modems 302 and 304 are coupled to receive uplink signals sent to the base station by different subscriber stations, and IF/RF receive circuitry 306 passes uplink signals to the modems. (*Id.* at 9:67-10:5.) Circuitry 306 down-converts in frequency uplink signals received from receive circuitry, and then the

down-converted signals, shown as bursts sub3 . . . sub1 and subn . . . sub2 are operated upon by modems 304 and 302, respectively. (*Id.* at 10:5-9.) Additionally, controller 314 creates and maintains profiles, and stores these profiles in memory such as memory device 318. (*Id.* at 10:18-19.)

“Characteristics of data bursts and the channels by which the data bursts are received are stored in memory as signal and channel profiles at the receiving station.” (*Id.* at 6:1-3.) “When a burst of data is provided to a demodulator, a profile associated with the channel upon which the burst is communicated to the base station and utilized in the demodulation of the burst of data.” (*Id.* at 6:19-22.) Then, “[a]s the burst of data is demodulated, the values of the profile associated with the channel upon which the data burst is communicated are updated as appropriate. The updated profile is stored to be retrieved thereafter, when subsequent data bursts are received at the base station and demodulated.” (*Id.* at 22-27.)

“Because changes in the channel condition typically vary at a rate much slower than the rate of data transmission of the uplink data signals, the update rates at which the values of the profiles need to be applied to the modems are a mere fraction of the data transmission rates.” (*Id.* at 10:38-42.) In this way, “[i]mproved uplink capacity of data signals sent by the subscriber stations is possible,” and “better compensation is made to counteract the effects of distortion of the data

signals communicated during operation of a communication system” implementing the claimed invention. (*Id.* at 6:35-42.)

IV. CHALLENGED CLAIMS

Petitioner challenges claims 1-20 of the '477 patent, of which claims 1 and 16 are independent. Exemplary claim 1 recites:

Profile-creating apparatus for creating at least a first profile associated with transmission upon at least a first channel of at least a first burst-data Signal transmitted in bursts to a receiving station, said profile-creating apparatus

comprising:

a profile parameter determiner coupled to receive an indication of an initial burst of the first burst data signal transmitted upon the first channel to the receiving station, said profile parameter determiner for determining a value of at least one signal-related parameter and at least one channel-related parameter, wherein the signal-related and channel-related parameters are collectively representative of communication of the first burst data signal over the first channel to the receiving station; and

a profile parameter storage device coupled to said profile parameter determiner, said profile parameter storage device for storing values representative of the at least one signal-related parameter and the at least one channel-related parameter determined by said profile parameter determiner, the values stored at said profile parameter storage device to be used to facilitate receive operations performed at the receiving station on subsequent bursts of the first burst data signal.

(*Id.* at 12:63-13:18)

V. CLAIM CONSTRUCTION

No claim construction is necessary to deny institution because General Access’s arguments for denial do not hinge on any disputed issues of claim interpretation. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

VI. 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).

VII. ARGUMENT

A. **Grounds 1 and 2—All Challenged Claims: The Petition Fails to Show that Genossar Discloses “a Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner,” and “Said Profile Parameter Storage Device for Storing Values Representative of the at Least One Signal Related-Parameter and the at Least One Channel-Related Parameter” as Recited in Claim [1.C].**

1. **The Petition Fails to Allege that Genossar Discloses a “Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].**

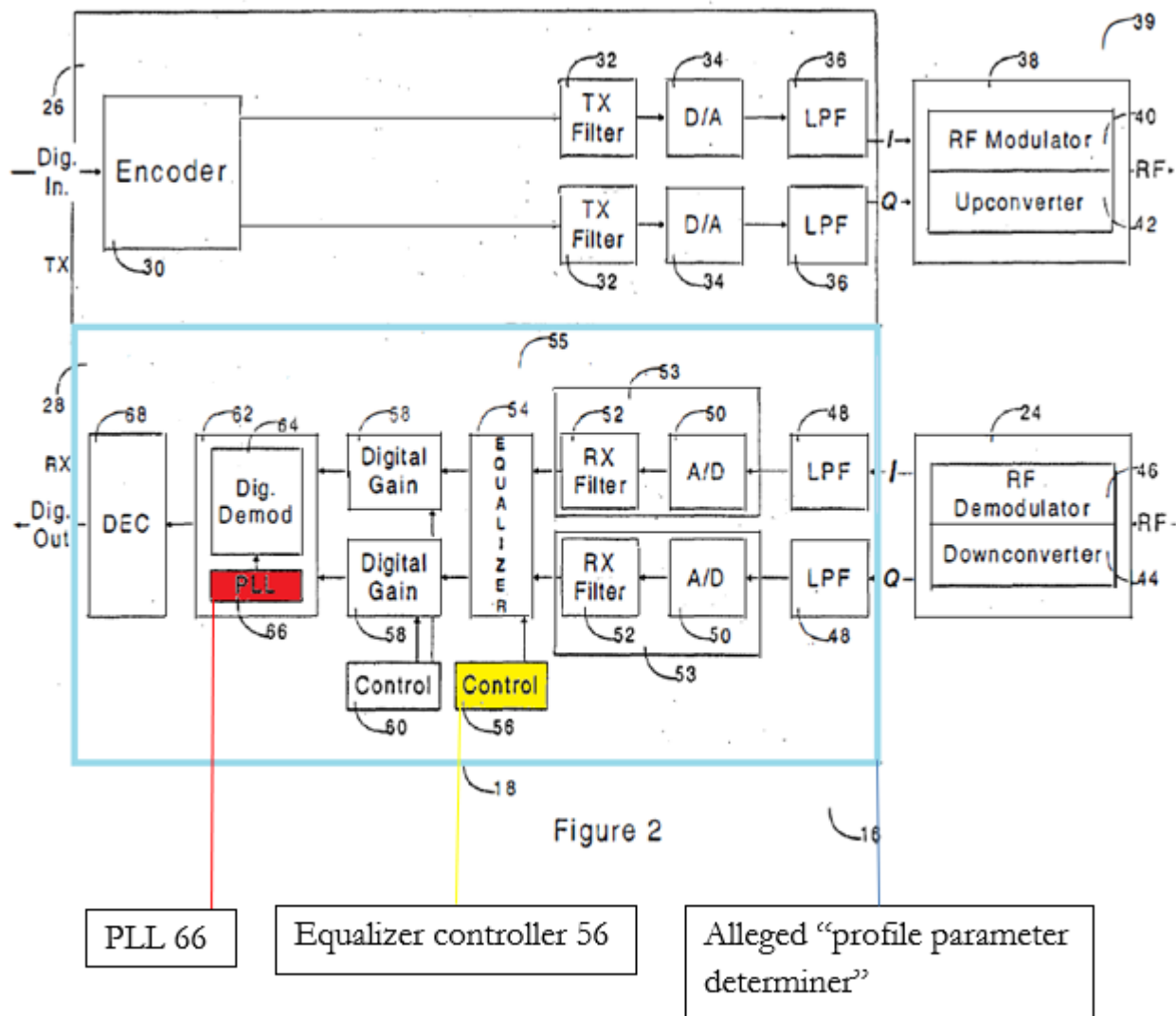
Claim [1.C] recites “a profile parameter storage device coupled to said profile parameter determiner, said profile parameter storage device for storing values representative of the at least one signal-related parameter and the at least one channel-related parameter determined by said profile parameter determiner.” (Ex. 1001 at 13:10-15.) Petitioners devote only the following seven lines of text to claim element [1.C]:

Genossar discloses Claim [1.C]. Ex. 1003, ¶77. Genossar teaches that the determined parameter values including “the equalizer coefficients can be *stored* for each terminal station 14 separately, and then reused when that terminal station 14 is transmitting again.” Ex. 1005, 11:22-65. Genossar expressly teaches that these determined parameter values can be stored in the “stored memory” (i.e., profile parameter storage device) of the base station. *Id.*, 13:37-45, 18:41-67. Thus, Genossar discloses Claim [1.C]. Ex. 1003, ¶77; *see also* Ex. 1011, 20-21.

(Petition at 20.) In their cursory attempt, Petitioners do not make any allegation whatsoever that Genossar anticipates a “profile parameter storage device *coupled* to said profile parameter” as claim element [1.C] recites. Petitioners were required to make this allegation as part of their anticipation analysis both because “coupled” is explicitly part of the language of claim [1.C], and because a “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.

Indeed, Petitioners do not even identify where within the base station—other than generally in its “stored memory” (not pictured in Genossar’s Figure 2, below)—they allege the claimed “profile parameter storage device” is located. (*See*, Petition at 20.) Consequently, the word “couple” does not appear at all in Petitioners’ scant discussion of claim element [1.C], much less with respect to the alleged “profile parameter storage device” and the alleged “profile parameter determiner”—which Petitioners allege to be the receive portion 28 outlined in blue in Genossar’s Figure 2, below. (Petition at 17, 20.) Rather, Petitioners do not provide any discussion at all regarding the relationship between Genossar’s alleged “profile parameter determiner” and Genossar’s alleged “profile parameter storage device.” (Petition at 17, 20.)



(Ex. 1005 at Figure 2 (annotated).)

Because Petitioners failed to allege that Genossar anticipates “a profile parameter storage device coupled to said profile parameter determiner,” all of Petitioners’ Ground 1 arguments fail. *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); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim . . . [T]he expedited nature of IPRs bring[s] with it an obligation for petitioners to make their case in their petition to institute. While the Board’s requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.”). Further, because Petitioners were required to allege how Genossar allegedly anticipates the “profile parameter storage device coupled to said profile parameter determiner” in their Petition, Petitioners cannot cure this failure in any subsequent briefing. *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“Given these ‘strict...requirements,’ the Board is not permitted to “to cure the petition’s deficiencies in its subsequent briefing to the Board.”).

Since claims 2-15 depend from claim 1, Petitioners’ Ground 1 challenge fails for each of these claims as well. Further, because Petitioners rely only on their claim [1.C] analysis for claim [16.B] and its dependent claims—without providing any additional analysis whatsoever—Petitioners incorporate the failings of its claim 1 challenge into claim 16. For this reason, Petitioners’ Ground 1 challenge must fail as to claim 16 and its dependent claims as well. (Petition at 26.) *See*

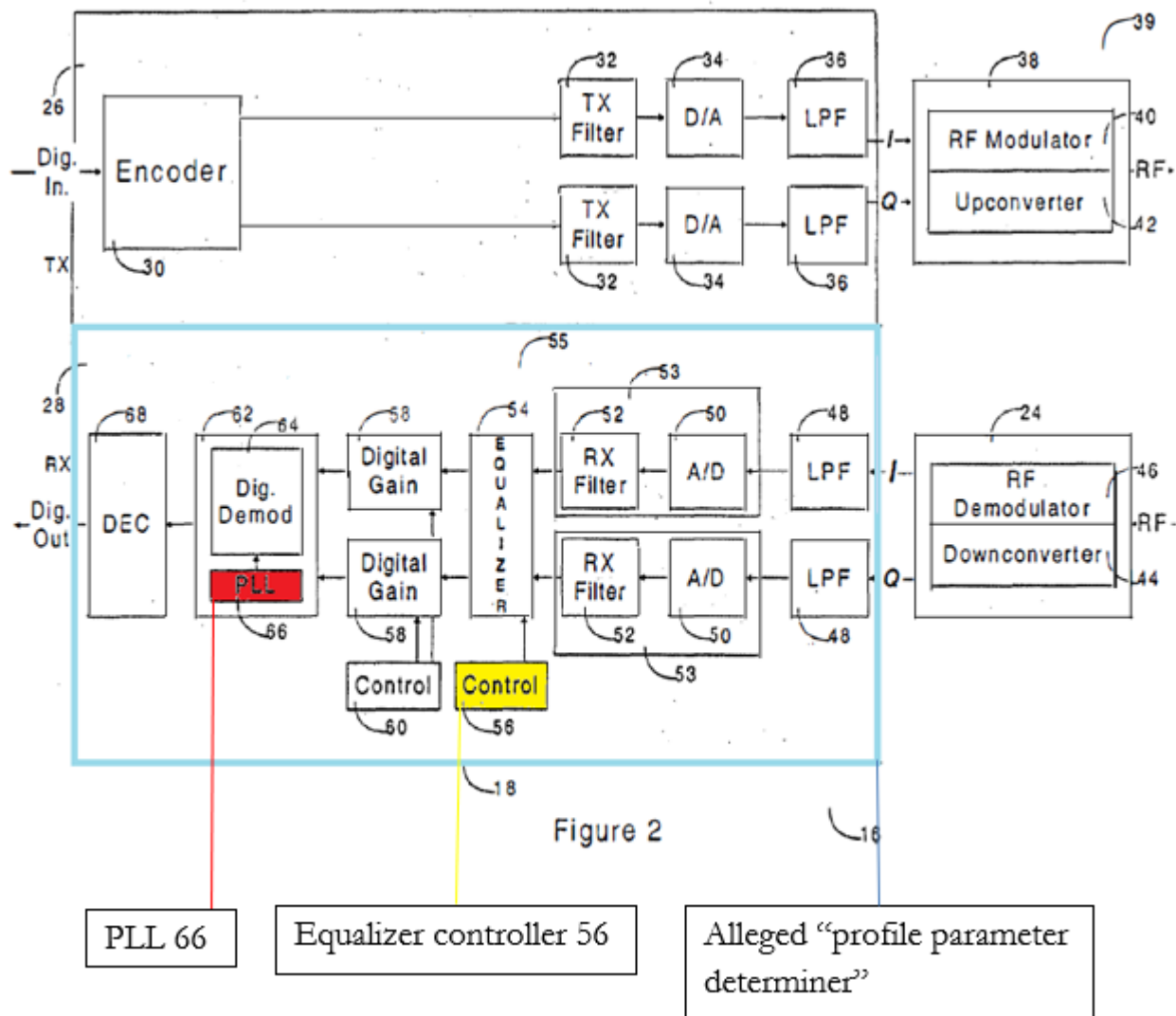
Netflix, Inc. v. DivX, LLC, 84 F.4th 1371, 1377, 1379 (Fed. Cir. 2023) (“[T]he Board should also not have to decode a petition to locate additional arguments beyond the ones clearly made. A petitioner may not rely on a vague, generic, and/or meandering petition and later fault the Board for failing to understand what the petition really meant.” (quoting *Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 713 (Fed. Cir. 2021) (“It is not the Board’s job to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments. Arguments in a petition must be made with particularity, not opacity...”))).)

Petitioners’ Ground 2 challenge fails for these same reasons. Specifically, Ground 2 only includes challenges to claims depending from claims 1 and 16, and Petitioners rely solely on their Ground 1 analysis for the claims 1 and 16 portions of the dependent claims the Petition challenges in Ground 2. (Petition at 28-40.) Thus, because Petitioners do not remedy their analysis for claims 1 or 16 in their Ground 2 challenge, Petitioners’ challenge fails as to all claims for Grounds 1 and 2. *See Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1309 (Fed. Cir. 2017). (“Section 312 sets forth the various statutory requirements to which each petition challenging the validity of a patent must conform before the PTO may institute an inter partes review. The petition must identify, ‘in writing and with particularity, each claim

challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim....”).

2. The Petition’s Allegations are Inconsistent with Genossar Disclosing “a Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].

Even if Petitioners had alleged that Genossar anticipates “a profile parameter storage device coupled to said profile parameter determiner” as claim [1.C] recites, Petitioners’ challenge would still fail because Genossar does not store the profile parameters, as alleged by Petitioners, in “a profile parameter storage device” coupled to Petitioners’ alleged “profile parameter determiner.” Specifically, as discussed above, Petitioners allege that Genossar’s “profile parameter determiner” is the receive portion 28 outlined in blue in Genossar’s Figure 2, below. (Petition at 17, 20.)



(Ex. 1005 at Figure 2 (annotated).)

But elsewhere in the Petition, in its discussion of claim element [1.B], the Petition alleges that Genossar discloses determining equalizer coefficients that correspond to the "channel-related parameter" recited in claim element [1.C]. (Petition at 19.) And with respect to claim element [1.A], Petitioners acknowledge that "Genossar teaches that equalizer controller 56 [highlighted in yellow in Figure 2, above], forming part of the receive portion 28 (as shown in [blue in] Figure 2),

‘stores the values for the equalizer coefficients and then reuses these values as an initial estimate when a new signal is received’ from the same terminal station.” (Petition at 17-18 (emphasis added).) Thus, for Genossar to disclose a “profile parameter storage device for storing values representative of the at least one . . . channel-related parameter determined by said profile parameter” as claim [1.C] recites, this “profile parameter storage device” would have to be equalizer controller 56 (yellow). Because Genossar teaches that its equalizer controller 56—which “stores the values for the equalizer coefficients”—form[s] part of the receive portion 28, this equalizer controller 56 cannot be “coupled” to the receive portion 28, as it is already “part of the receive portion 28.” (Petition at 17.)

Further, identifying receive portion 28 as the “profile parameter determiner” while receive portion 28 encompasses the “profile parameter storage device”—at least with respect to an alleged channel-related parameter—also runs afoul of the Federal Circuit’s “presumption that those components are distinct” because Claim [1.C] lists these elements separately. *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1382 (Fed. Cir. 2022).

3. Genossar Does Not Disclose a “Profile Parameter Storage Device for Storing Values Representative of the at Least One Signal Related-Parameter and the at Least One Channel-Related Parameter” as Recited in Claim [1.C].

Petitioners’ challenge additionally fails as to both Grounds 1 and 2 because Genossar does not disclose a “profile parameter storage device for storing values

representative of the at least one signal related-parameter *and* the at least one channel-related parameter” as claim [1.C] recites. The Petition alleges with respect to element [1.B] that the “at least one signal-related parameter” is the “carrier frequency offset,” and the at least one-channel related parameter is the “equalizer coefficient[.]” (Petition at 19.) And, although the Petition alleges for element [1.A] that Genossar stores the equalizer coefficients in equalizer controller 56, the Petition fails to mention that Genossar’s “carrier frequency offset” is *not* also stored in equalizer controller 56. (Petition at 17-18, *see id.* at 20.) Rather, Genossar discloses that “PLL 66 [highlighted in red in Figure 2, above] at base station modem 18 does *store and reuse the values for carrier frequency offset*” (Ex. 1005 at 11:62-64 (emphasis added).)

Thus, according to Genossar, the alleged signal-related parameter and channel-related parameter are not stored in the same storage device. Rather, the Petition’s alleged signal-related parameter is both stored and reused in Genossar’s PLL 66, and the Petition’s alleged channel-related parameter is both stored and reused in Genossar’s equalizer controller 56. (Petition at 17-18; Ex. 1005 at 11:62-64.) Accordingly, Genossar does not disclose a “profile parameter storage device for storing values representative of the at least one signal related-parameter *and* the at least one channel-related parameter” as claim [1.C] recites. For this additional reason, Petitioners’ Grounds 1 and 2 challenges fail as to all Challenged Claims.

B. Ground 2—All Claims: WiMAX is Not Prior Art.

For Ground 2, Petitioners combine Genossar with WiMAX for additional limitations of dependent claims 2, 10-12, 14, and 18. (Petition at 2.) However, Petitioners have failed to establish that WiMAX qualifies as prior art. *See Elec. Frontier Foundation v. Personal Audio, LLC*, IPR2014-00070, Paper 21 at 20–24 (PTAB Apr. 18, 2014) (petitioner bears the burden of proving that a reference is a printed publication).

1. The Copyright Stamp on the WiMAX Potential Draft Standard Does Not Demonstrate Public Accessibility.

Petitioners rely on the fact that “WiMAX includes a 2000 Copyright stamp.” (Petition at 10.) But the Board has previously determined in *In-Depth Geophysical*—which has been designated as informative—that a copyright date alone “sheds virtually no light on whether the document was publicly accessible prior to” the critical date. *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00849, Paper 14, at 10-11 (PTAB Sept. 6, 2019) (informative as to Section I.E addressing public accessibility); *see Microsoft Corp. v. Corel Software, LLC*, IPR2016-01300, Paper 13 at 10 (PTAB Jan. 4, 2017) (denying institution where petitioner failed to make threshold showing that its asserted references were prior art printed publications, and holding that although a copyright notice “may be evidence of the date of a reference,” crucially, it “sheds virtually no light on whether the document was publicly accessible as of that date.”).

Here, as in *In-Depth Geophysical*, the WiMAX potential draft standard document “does not bear, and Petitioners do not point to, any other indicia such as express publication dates, libraries, journal numbers, or International Standard Book Number (“ISBN”) codes, or Library of Congress Control Number (“LCCN”) that the Board previously has held are indicia of public availability.” *Id.* By contrast, WiMAX contains a *placeholder* ISBN ending in “xxx-x SH xxxxx,” a note that the document is “an unapproved Task Group document being circulated for comment,” and a statement that “[n]o part of this publication may be reproduced in any form, in any electronic retrieval system or otherwise, without the prior written permission of the publisher,” as shown below:

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(Ex. 1006 at 1.)

Further, the copyright date on the face of the WiMAX potential draft standard document is hearsay, and so inadmissible to prove that the document was, in fact, publicly accessible as of that date. Specifically, because the Federal Rules of Evidence are applicable in *inter partes* reviews, “copyright ‘dates imprinted on documents are hearsay when offered to prove the truth of the matter asserted.’”

Standard Innovation Corp. v. Lelo, Inc., IPR2014-00148, Paper 41 at 17, (PTAB

Apr. 23, 2015). As such, any copyright date printed on the WiMAX potential draft standard document cannot be relied on to establish its purported publication date. *See Apple Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 14 at 6 (PTAB Aug. 12, 2015) (“[T]he stamped date on the face of [the reference] is a hearsay statement [and] the archive date cannot establish when, if ever, [it] became publicly available.”); *Laird Techs. Inc. v. A.K. Stamping Co. Inc.*, IPR2017-02038, Paper 6 at 10 (PTAB Mar. 14, 2018) (“We acknowledge that the cover page of Laird includes a date reading ‘April 1, 2010.’ . . . However, the date, is a hearsay statement”) (citation omitted); *ServiceNow, Inc. v. Hewlett-Packard Co.*, IPR2015-00716, Paper 13 at 16-17 (PTAB Aug. 26, 2015) (“To the extent that Petitioner relies on the date on the face of each exhibit and the indications of availability of these references for download . . . for the truth of that information, and considering that Petitioner has not established that any hearsay exception or exclusion applies, we agree [that the statements are inadmissible hearsay] . . . “We are not persuaded that the presence of a copyright notice, without more, is sufficient evidence of public accessibility as of a particular date.”) (citation omitted) (citing *LG Electronics, Inc. v. Advanced Micro Devices, Inc.*, IPR2015-00329, Paper 13 at 10–13 (PTAB July 10, 2015)).

2. **Petitioners Have Failed to Show that a Potential Draft IEEE Standard Document Would Have Been Publicly Accessible Prior to the Critical Date of the '477 Patent**

Petitioners additionally rely on the assertion that “IEEE draft standards such as WiMAX were and are available to the public and area easily searchable through libraries and other IEEE resources.” (Petition at 10.) This argument is both incorrect and irrelevant.

First, that the WiMAX potential draft standard document may currently be “easily searchable through libraries and other IEEE resources” as Petitioners assert—without supporting evidence—is irrelevant to whether the document was publicly accessible before the critical date of the '477 patent.

Second, Petitioners’ characterization of WiMAX as publicly accessible as an “IEEE draft standard[],” is inaccurate, at best. Rather, WiMAX’s abstract states: “This document is FOR COMMENT as a potential DRAFT standard,” as shown below.

Abstract: This document is FOR COMMENT as a potential DRAFT standard for medium-access and physical layer components that meet the functional requirements of a point-to-multipoint Broadband Wireless Access (BWA) system as defined by the IEEE 802.16 Working Group. Detailed logical, electrical, and signal processing specifications are presented that enable the production of interoperable equipment.

(Ex. 1006 at 1 (highlighting added).) Petitioners have provided no evidence of the public accessibility of *potential* draft IEEE standards.

Third, Petitioners have provided no evidence from anyone with knowledge of the IEEE 802.16 Working Group, how it stores its potential draft standards, and

how a member of the interested public could find out about any potential draft standards, much less gain access to those potential draft standards.

In a case with considerably more evidence than Petitioners have provided, the Board denied institution because the Petitioner had failed to prove that a draft standard from the IEEE 802.11 Working Group was a printed publication. Specifically, in *Samsung*, a declaration establishing that the draft standard “was available to all members of the 802.11 Working Group’s email list,” and “discussed and distributed at an 802.11 Working Group meeting”—the Board found insufficient evidence of public accessibility because of an absence of “any assertions or evidence in support of the availability of Draft Standard to individuals other than members of the 802.11 Working Group and those who already knew about Draft Standard or the July 8-12 meeting of the 802.11 Working Group.” *Samsung Elecs. Co. Ltd. v. Rembrandt Wireless Techs., LP*, IPR2014-00514, Paper 18 at 7 (PTAB Sept. 9, 2014) (citation omitted).

Here, Petitioners provide no evidence that anyone other than a member of the 802.16 Working Group would have known about or received a copy of the WiMAX potential draft standard. By contrast, Petitioners assert that “an interested POSITA would have been aware of and purposefully sought out IEEE documents because of the organization’s importance in developing standards for telecommunications.” (Petition at 11, n. 2.) Noticeably missing, however, is any

evidence that the IEEE 802.16 Working Group publicized the existence of the WiMAX potential draft standard beyond the Working Group such that any member of the interested public would have been aware of it known to request it. *See Samsung*, IPR2014-00514, Paper 18 at 7-8 (declining institution because of a lack of “sufficient argument or evidence that any individual who was not already a member of, or otherwise aware of, the 802.11 Working Group would have known about Draft Standard such that he or she would have known to request a copy or ask to be added to an email list for access to the document.”).

Finally, Petitioners’ notation of a handful of “industry members who directly worked on and facilitated the production of the draft standard” is irrelevant to public accessibility. (Petition at 11, n. 2.) Indeed, it is black letter law that “[a] work is not publicly accessible if the only people who know how to find it are the ones who created it.” *Samsung Elecs. Co., Ltd. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1371-72 (Fed. Cir. 2019).

Because Petitioners have failed to meet their burden to show that members of the interested public outside of the IEEE 802.16 Working Group would have known about, and known how to request the WiMAX potential draft standard, Petitioners’ Ground 2 challenge must be denied.

C. Grounds 3-5—All Claims: The Petition Fails to Allege that Barratt '470 Discloses a “Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].

As discussed above, claim [1.C] recites “a profile parameter storage device coupled to said profile parameter determiner, said profile parameter storage device for storing values representative of the at least one signal-related parameter and the at least one channel-related parameter determined by said profile parameter determiner.” (Ex. 1001 at 13:10-15.) As in Grounds 1-2, in Ground 3, Petitioner once again fails to allege that the prior art—Barratt '470 on this occasion—discloses “a profile parameter storage device *coupled* to said profile parameter determiner,” and that this alleged “profile parameter storage device” is “for storing values representative of the at least one signal-related parameter *and* the at least one channel-related parameter.” (Petition at 47-48.)

Instead, Petitioners acknowledge that Barratt does not disclose the claimed “profile parameter storage device,” and so Petitioners must rely on inherency to meet each element required of the “profile parameter storage device.” But despite claim [1.C] reciting not just the existence of a “profile parameter storage device,” but that this device must additionally be (1) “*coupled* to said profile parameter determiner, (2) “for storing values representative of the at least one signal-related parameter *and* the at least one channel-related parameter,” the Petition merely asserts that “Barratt '470 discloses that the base station **necessarily** includes a

“profile parameter storage device” for *storing* these parameter values *from one frame to next* for each signal of interest.” (Petition at 48) (bold added).) But simply having a profile parameter storage device is not enough.

Petitioners’ argument falls well short of what the doctrine of inherency requires. Even if Barratt ’470 necessarily includes a “profile parameter storage device” as the Petition alleges, it is ***not*** the case that Barratt ’470 ***necessarily*** includes a “profile parameter storage device ***arranged in the same manner*** recited in claim [1.C]: (1) “coupled” to a profile parameter determiner, and (2) storing both the alleged signal-related parameter and channel-related parameter. *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 “profile parameter storage device” arranged in the same manner recited in claim [1.C].

For example, the Petition argues that “Barratt ’470 discloses that for each signal of interest ‘the method involves a recursive loop repeated every frame.’” (Petition at 47-48 (citing Ex. 1006 at 16:32-17:7 (discussing normal mode processing).) As the Petition alleges with respect to claim [1.D], Barratt ’470 illustrates this processing through Figure 6, reproduced below. In the context of Figure 6, Petitioners allege that w_{r0} is the claimed “channel-related parameter” and the frequency offset and time alignment are the claimed “signal-related parameters.” (Petition at 44-46.) However, while Figure 6 illustrates utilizing “ w_{r0} from SYNCH mode or from previous frame,” and subsequently correcting this initial copy signal using the “[f]req. offset & time alignment from previous frame or SYNCH mode,” Figure 6 provides no disclosure as to where the “ w_{r0} from SYNCH mode or from previous frame,” and “[f]req. offset & time alignment from previous frame or SYNCH mode” are stored. (See Ex. 1007 at Fig. 6.)

Consequently, Figure 6 provides no disclosure regarding whether the “ w_{r0} from SYNCH mode or from previous frame,” and “[f]req. offset & time alignment from previous frame or SYNCH mode” are stored separately, or in a single “profile parameter storage device for storing values representative of the at least one signal-related parameter *and* the at least one channel-related parameter” as claim [1.C] recites. (See *id.*) Nor does Figure 6 (or anywhere else in Barratt ’470) provide any disclosure regarding whether the device(s) storing the “ w_{r0} from SYNCH mode or

from previous frame,” and “[f]req. offset & time alignment from previous frame or SYNCH mode” are “coupled” to the “profile parameter determiner”—which Petitioners have alleged is the Slot 0 processor 117.0. (See Petition at 42, 47-48.)

Ex. 1007, Fig. 6 (annotated)

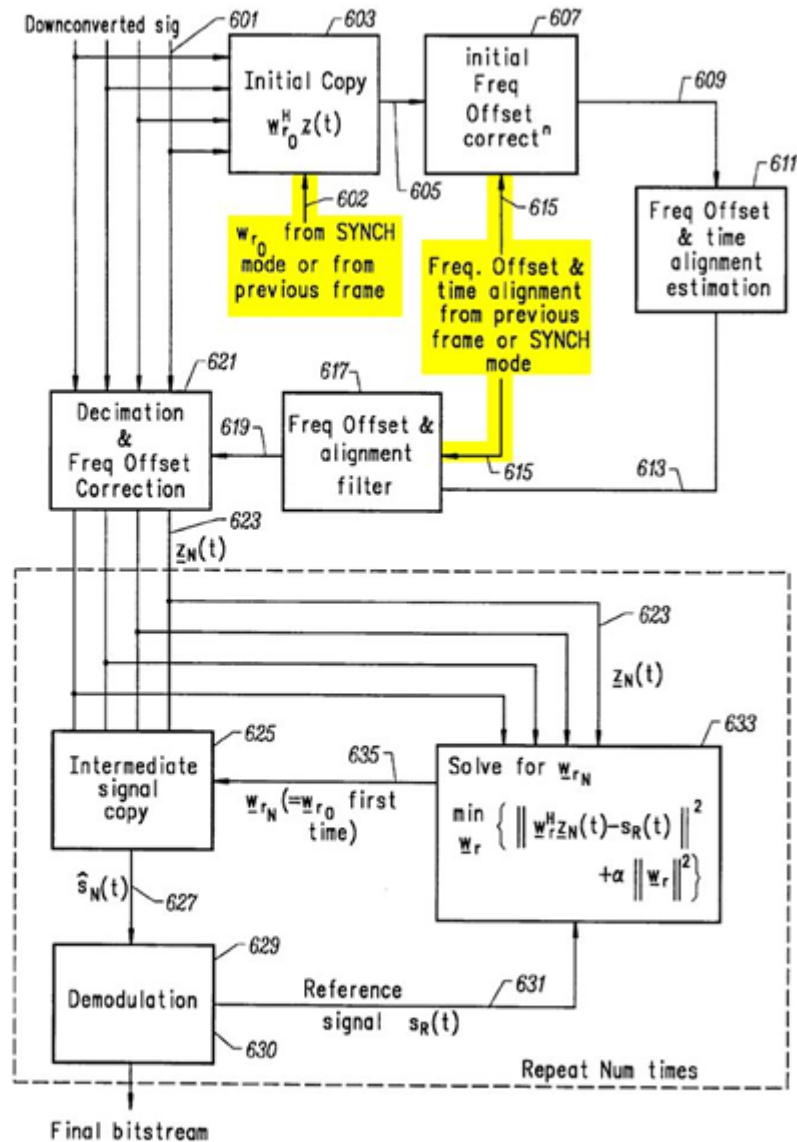


FIG. 6

(Petition at 49.)

Moreover, Petitioners' own evidence in Genossar affirms that a "profile parameter storage device" arranged in the same manner as recited in claim [1.C] need not be necessarily present. For example, Barratt '470 could store the " w_{r0} from SYNCH mode or from previous frame," and "[f]req. offset & time alignment from previous frame or SYNCH mode" in two separate storage devices, just as in Genossar, as detailed in Section VII.A.3., above. Additionally, Barratt '470 could store the " w_{r0} from SYNCH mode or from previous frame," and "[f]req. offset & time alignment from previous frame or SYNCH mode" inside of the Slot 0 processor 117.0 that Petitioners have alleged is Barratt '470's "profile parameter determiner," such that the storage device(s) (1) cannot be "coupled to said profile parameter determiner" as claim [1.C] recites, and (2) do not disclose distinct "profile parameter determiner" and "profile parameter storage device" components as the law requires, and as discusses in detail in Section VII.A.2., above. *See Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) ("Where a claim lists elements separately, 'the clear implication of the claim language' is that those elements are 'distinct component[s]' of the patented invention." *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (quoting *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288 (Fed. Cir. 2004))).

Genossar’s disclosure is just one example that refute Petitioners’ inherency argument, and for this reason Petitioner’s inherency argument, which must meet the “necessarily includes,” 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.”).

Thus, because Barratt ’470 does not necessarily include a “profile parameter storage device” that is (1) “***coupled*** to said profile parameter determiner and (2) “for storing values representative of the at least one signal-related parameter ***and*** the at least one channel-related parameter,” as claim [1.C] recites, Petitioners have failed to meet their burden of showing inherency for the claimed “profile parameter storage device” arranged in the same way as in claim [1.C]. *See Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1377–78 (Fed. Cir. 2002) (“In arguing inherent disclosure of the [profile parameter storage device] limitation in the [’477] patent, [Petitioner] bears an evidentiary burden to establish that the limitation was necessarily present.”). Further, because Petitioners rely on their

claim [1.C] and 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.)

Further, because Petitioners were required—but failed—to allege how Barratt '470 allegedly anticipates the “profile parameter storage device coupled to said profile parameter determiner” and the “profile parameter storage device for storing values representative of the at least one signal-related parameter and the at least one channel-related parameter” in their Petition, Petitioners' argument necessarily fails. *See In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (The PTO's authority is “not so broad that it allows the PTO to raise, address, and decide unpatentability theories never presented by the petitioner and not supported by record evidence.”); *Wasica Fin. GmbH*, 853 F.3d at 1286 (Petitioner may not “cure the petition's deficiencies in its subsequent briefing to the Board.”).

Since claims 2-15 depend from claim 1, and because Petitioners rely only on their claim [1.C] analysis for claim [16.B] and its dependent claims, Petitioners' Ground 3 challenge must fail as to all claims. (Petition at 58.) Petitioners' Grounds 4-5 challenges fails for these same reasons. Specifically, Grounds 4-5 only include challenges to claims depending from claims 1 and 16, and Petitioners rely solely on their Ground 3 analysis for the claims 1 and 16 portions of the dependent claims

the Petition challenges in Grounds 4-5. (Petition at 59-68.) Thus, Petitioners' challenge fails as to all claims for Grounds 3-5.

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 '477 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 69.)

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. 1013 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.

VIII. CONCLUSION

For the reasons discussed above, Petitioners fail to meet its burden of demonstrating a reasonable likelihood that claims 1-20 are invalid. Therefore, Patent Owner respectfully requests the Board deny Petitioners’ request for *Inter Partes* Review of U.S. Patent No. 6,947,477.

Dated: January 22, 2024

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 7,208 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: January 22, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioner 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 January 22, 2024 at the following addresses of record:

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