

Filed: March 14, 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

SUR-REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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As detailed in the POPR, claim [1.C] recites “a profile parameter storage device coupled to said profile parameter determiner,” but Petitioners simply failed to allege that Genossar’s purported profile parameter storage device is coupled to Genossar’s purported profile parameter determiner. (POPR, 11-17.) On Reply, Petitioners improperly argue for the first time that “because Genossar discloses *storing* the parameters after *determining* the parameters, the component that determines the parameters is coupled to the component the stores the parameters for later use, otherwise, such storage would not/could not occur.” (Reply, 3.) Petitioners additionally argue that the “determining components would inherently be coupled to the storing components,” and that “an understanding of one skilled in the art is []sufficient] to establish that these components are coupled to one another.” (Reply, 3-4.) But this argument is wholly missing from the seven lines that Petitioners devoted to this claim element in the Petition—which fail to mention coupling, inherency, or the understanding of a POSA. (*See* Petition, 20.)

Rather, Petitioners’ new inherency argument is one that Petitioners were required, by statute, to make in their Petition. *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) (“Shifting arguments in this fashion is foreclosed by statute, [Federal Circuit] precedent, and Board guidelines.” (citing 35 U.S.C. § 312(a)(3) (requiring petitions to identify “with particularity...the grounds on which the challenge to each claim is based”)));

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.”)). “Petitioners may not use reply briefs to cure deficiencies in their petitions.” *Intuitive Surgical, Inc. v. Ethicon LLC*, No. 2020-1480, 2022 WL 421189, at *4 (Fed. Cir. Feb. 11, 2022) (citing *Wasica*, 853 F.3d at 1286 (the Board is not permitted to “to cure the petition’s deficiencies in its subsequent briefing to the Board”))).

To obfuscate Petitioners’ wholesale failure to make a required argument in their Petition, Petitioners argue that “Patent Owner’s own infringement contentions contradict its argument.” (Reply, 3.) But nothing Patent Owner has ever said is relevant to the fact that Petitioners failed to make *any* allegation in their Petition to satisfy their *prima facie* case as to the alleged obviousness of claim [1.C].

Notwithstanding Petitioners’ failure to even allege a *prima facie* case in their Petition, Patent Owner additionally pointed out in its POPR that *even if* Petitioners had alleged that Genossar anticipates claim [1.C], Petitioners’ allegations that

Genossar’s equalizer controller 56 both “stored the values for the equalizer coefficients” and *forms part of* the receive portion 28 precludes equalizer controller 56 from being “coupled” to receive portion 28, which Petitioners alleged to be the “profile parameter storage device.” (See POPR, 17-19.) See *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1382 (Fed. Cir. 2022) (Where a claim lists elements separately, there is a “presumption that those components are distinct.”).

Petitioners skip over this argument entirely, instead mistakenly asserting that Patent Owner’s third claim [1.C] argument is incorrect because “[N]owhere do Genossar or the Petition state that the channel-related parameters (e.g., equalizer coefficients) must be stored *within* equalizer controller 56...” (Reply, 1-2.) Not so. In fact, the Petition specifically alleges: “Genossar teaches that equalizer controller 56, forming part of the receive portion 28 (as shown in Figure 2), ‘stores the values for the equalizer coefficients...” (Petition, 17-18.) Petitioners go on to additionally argue that Genossar does not teach “that the signal-related parameters (e.g., carrier frequency offset) must be stored *within* PLL 66. (Reply, 2.) Again, Genossar belies Petitioners’ argument, explicitly stating that “PLL 66 at base station model 18 does store and reuse the values for carrier frequency offset.” (Ex. 1005, 11:62-64.) Thus, the text of the Petition and Genossar prove that Petitioners’ arguments are demonstrably false.

Finally, on Reply, in response to Patent Owner’s third claim [1.C] argument that Genossar’s “alleged signal-related parameter and channel-related parameter are not stored in the same storage device” (POPR, 20), Petitioners state that they “do not, and would not, argue that the parameters in Genossar are necessarily stored in separate devices.” (Reply, 2.) And yet Petitioners also rely on Patent Owner’s infringement contentions for the proposition that the “profile parameter storage device” *need not* be a singular component. (Reply, 2-3.)

Petitioners’ failure to take a position as to whether or not the claimed parameters may be stored in separate devices is insufficient to meet the requirement in 37 C.F.R. § 42.104(b)(3) that a petition must explain “[h]ow the challenged claim is to be construed.” This is because “[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), which require that Petitioner “indicate that it agrees with, proposes, or adopts the constructions attributed to Patent Owner.” *IBM Corp. v. Groupon, Inc.*, IPR2017-01452, Paper 7 at 10 (PTAB Dec. 5, 2017) (denying institution); *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) (denying institution where Petitioner did not “indicat[e], 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 because the Petition “refers to Patent Owner’s proffered construction” but “merely does not dispute that this construction may be appropriate without endorsing or supporting the construction.” (cleaned up)).

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 the case here as well, and so for this additional reason, the Petition should be denied.

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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 March 14, 2024 at the following addresses of record:

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