

Filed: June 4, 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 OPPOSITION TO PETITIONERS' MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

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A. Petitioners’ Supplemental Information Improperly Seeks to Respond to the POPR and the Institution Decision.

The Board should deny Petitioners’ Motion to Submit Supplemental Information (“Motion”), because it is solely offered to refine and bolster arguments Petitioners could have made in their Petition. But “the Board has warned that ‘[s]upplemental information,’ under 37 C.F.R. § 42.123, ‘is not intended to provide a petitioner an advantageous ‘wait-and-see’ opportunity to use a patent owner’s preliminary response and our decision on institution in order to refine or bolster petitioner’s position.’” *Hunter’s Manufacturing Co., Inc. v. Ravin Crossbows, LLC*, IPR2023-00407, Paper 32 at 5-6 (PTAB Feb. 15, 2024) (“*Hunter’s*”) (quoting *Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14 at 3–4 (PTAB Jan. 23, 2018)) (collecting cases and citing *Am. Well Corp. v. TelaDocHealth, Inc.*, IPR2021-00748, Paper 23 at 6-7 (PTAB Feb. 28, 2022) (“*Am. Well*”) (collecting cases) (“the Board has denied [motions under 37 C.F.R. § 42.123] where the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision.”); *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21 at 3 (PTAB Sept. 10, 2018) (“*Merck*”) (“The provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a preliminary response.”)).

As Petitioners admit, their Motion is solely directed to responding to the POPR and the Institution Decision. Specifically, Petitioners' Motion states: "the supplemental information presented here responds to the challenges by Patent Owner" (Motion at 4) and "Patent Owner challenged the accessibility of WiMAX in its Preliminary Response." (Motion at 1.) The Motion further asserts: "Patent Owner has challenged whether WiMAX was publicly accessible before January 19, 2001, and thus, qualifies as prior art under § 102(a)." (Motion at 3.)¹ Further, the Supplemental Information states: "I understand from Counsel that the Board requested additional clarification as to the public availability of WiMAX. To further establish WiMAX's position as prior art, this declaration discusses additional patents and patent applications that reference or incorporate WiMAX that were filed prior to the '477 Patent's alleged priority date." (EX1035, ¶11.)²

Where a petitioner "seeks to provide arguments via the supplemental declaration for issues addressed by Patent Owner in its Preliminary Response or by [the Board] in the Decision on Institution," the Board "views [the supplemental declaration] as unwarranted." *Triller, Inc. v. TikTok Pte. Ltd.*, IPR2022-00180, Paper 18, 3-4 (PTAB Aug. 25, 2022). Because this is exactly what Petitioners seek to do here, the Supplemental Information is unwarranted and should be disallowed.

¹ In support, the Motion cites *Cisco Systems, Inc.* at IPR2018-0144, Paper 14 at 3 (Motion at 3.) PO can find no such citation.

² PO can find no such request for clarification in the Board's ID.

Id. at 6; *see Pac. Mkt. Int'l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 3 (PTAB Dec. 2, 2014) (“[A] petitioner should not expect § 42.123 to present a ‘wait-and-see’ opportunity to supplement a petition after initial comments or arguments have been laid out by a patent owner”).

While “at least in some instances, [a] fine line exists between bolstering a petition and supplementing it,” Petitioners’ attempt to cabin its Motion into the “supplementing” category fails. *See Hunter’s* at 10 (denying Motion “in view of the Board’s admonitions against proposed supplementation that responds directly to a patent owner’s preliminary response or a decision instituting an IPR”).

Petitioners allege that their “supplemental information is consistent with the type of evidence the Board has allowed to address public accessibility.” (Motion at 4.) But Petitioners’ citations are exclusively to cases allowing librarian declarations. (*See id.*) Here, Petitioners submitted a failed librarian declaration with the Petition, and so now attempt to submit a supplemental declaration from their technical expert, as well as from an individual cited in their technical expert’s original declaration. (*See id.*) This falls on the impermissible “bolstering” side of the line.

B. The Supplemental Information Was Available to Petitioners at the Time the Petition was Filed.

“The Board may take into account under 37 C.F.R. § 42.123(a) whether the supplemental information was reasonably available to the Petitioner at the time the Petition was filed.” *Hunter’s* at 6 (denying Motion where Supplemental

Information was available at the time of Petition’s filing) (quoting *Merck* at 4 (citing *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443 (Fed. Cir. 2015))); (citing *ClearOne, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 32 at 8 (PTAB Nov. 6, 2019) (“We find that the circumstances presented here, namely, that Petitioner could have submitted the supplemental information with the Petition and Petitioner has not provided sufficient explanation for not doing so, warrants denying Petitioner’s Motion.”); *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01510, Paper 37 at 3 (PTAB May 26, 2015).

Here, Petitioners offer no explanation why they were unable to submit the Supplemental Information with the Petition. (*See Motion.*) Nor could they. The Supplemental van der Weide Declaration is from Petitioners’ expert who submitted a declaration with the Petition, and is based on patent applications available before Petitioners filed the Petition. (EX.1035, ¶¶13-23.) Additionally, the Supplemental Eklund Declaration is from an individual who the original van der Weide Declaration named “as an industry member who directly worked on and facilitated the production of the draft standard and identified him as someone with further knowledge of its importance and public accessibility.” (Motion at 4.) Despite alleging that Eklund had such knowledge, Petitioners adopted the forbidden “wait-and-see” approach, and did not include a declaration from him in their Petition.

C. Patent Owner Would be Prejudiced if the Motion is Granted.

Finally, Petitioners fail to establish good cause as to why they should be allowed to submit two additional declarations, including a supplemental declaration from their technical expert, to backfill deficiencies in the Petition. Merely addressing the procedural standard for a motion to submit supplemental information is insufficient. *Triller* at 1-2. This does not mean the Board “must grant the motion.” *Id.* at 3. “Rather, timeliness and relevancy provide additional requirements that must be construed within the overarching context of the PTAB’s regulations governing IPR and general trial proceedings.” *Id.* at 2-3 (citing *Redline Detection, LLC*, 811 F.3d at 446). Indeed, the Board must “consider how supplemental information fits within the context of inter partes reviews.” *Triller* at 3. As in *Triller*, in the present circumstances, the Motion should be denied. *See id.* at 4-5. Specifically, Petitioners allege that they have given PO “nearly two months before the [POR] deadline of July 8, 2024” to respond to the Supplemental Information. (Motion at 5.) Not so. PO first received the Supplemental Information on May 24 (not nearly two months before its July 8 POR deadline), must depose both of Petitioners’ declarants by June 28, and must notice those depositions, including that of Ekland who resides in Finland—no later than 10 days after filing this Opposition. *See* 37 C.F.R. §42.53(d). This is insufficient time for PO to respond to the Supplemental Information if the Board were to grant the motion.

Dated: June 4, 2024

Respectfully Submitted,

/Sarah E. Spires/

Sarah E. Spires (Reg. No. 61,501)

SKIERMONT DERBY LLP

1601 Elm St., Ste. 4400

Dallas, Texas 75201

P: 214-978-6600/F: 214-978-6601

Counsel for Patent Owner

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 Opposition to Petitioners' Motion to Submit Supplemental Information, by electronic means on June 4, 2024 at the following addresses of record:

John D. Haynes (Reg. No. 44,754)
ALSTON & BIRD LLP
John.Haynes@alston.com

Wesley C. Achey (Reg. No. 56,487)
ALSTON & BIRD LLP
Wes.Achey@alston.com

Steve McNiff (Reg. No. 53,305)
ALSTON & BIRD LLP
Steve.Mcniff@alston.com

Michael C. Deane (Reg. No. 70,389)
ALSTON & BIRD LLP
Michael.Deane@alston.com

Christopher TL Douglas (Reg. No. 56,950)
ALSTON & BIRD LLP
Christopher.Douglas@alston.com

Dated: June 4, 2024

Respectfully submitted,

/Sarah E. Spires/

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