

Filed: November 26, 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 SUR-REPLY TO PETITIONERS' REPLY

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	2
A.	Grounds 1-2: Petitioners Have Not Established that Genossar Discloses a “Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].....	2
B.	Grounds 1-2: Petitioners Have Not Established that Genossar Discloses 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].	12
C.	Grounds 3-5: Petitioners Have Not Established that Barratt ’470 Discloses a “Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].....	14
D.	Ground 5: The Petition Fails to Explain How it Consistently Maps the Same Parameters in Claims 16 and 18 Over Barratt ’470 and PHS.....	21
E.	Ground 2: Petitioners Have Not Established that WiMAX is Prior Art.....	22
III.	CONCLUSION.....	25

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Motorola, Inc.</i> , 757 F.3d 1286 (Fed. Cir. 2014)	6
<i>Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP</i> , 616 F.3d 1249 (Fed. Cir. 2010)	6
<i>Corephotonics, Ltd. v. Apple Inc.</i> , 84 F.4th 990 (Fed. Cir. 2023)	3, 18, 19
<i>Cutsforth, Inc. v. MotivePower, Inc.</i> , 643 F. App'x 1008 (Fed. Cir. 2016)	5, 6
<i>Google LLC v. EcoFactor, Inc.</i> , 92 F.4th 1049 (Fed. Cir. 2024)	7
<i>In re Cuozzo Speed Techs., LLC</i> , 793 F.3d 1268 (Fed. Cir. 2015)	7
<i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	15, 21
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	3, 14, 16, 19, 20
<i>Live Power Intelligence Co. NA, LLC v. Genscape Intangible Holding, Inc.</i> , IPR2019-00169 (PTAB June 7, 2019) (Paper 7)	9
<i>Merck & Co., Inc. v. Teva Pharms. USA, Inc.</i> , 395 F.3d 1364 (Fed. Cir. 2005)	6
<i>Netflix, Inc. v. DivX, LLC</i> , 84 F.4th 1371 (Fed. Cir. 2023)	2, 4, 18
<i>PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC</i> , 815 F.3d 747 (Fed. Cir. 2016)	10
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018)	10

<i>SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.</i> , 983 F.3d 1367 (Fed. Cir. 2021)	10
<i>Sirona Dental Sys. GmbH v. Institut Straumann AG</i> , 892 F.3d 1349 (Fed. Cir. 2018)	9
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 593 F.3d 1325 (Fed. Cir. 2010)	17
<i>Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.</i> , 853 F.3d 1272 (Fed. Cir. 2017)	14
Statutes	
35 U.S.C. § 312(a)(3)	2, 16
37 C.F.R. § 42.104(b)(2)	7
37 CFR § 42.104(b)(4)	2
Other Authorities	
Consolidated Trial Practice Guide (November 2019)	19

I. INTRODUCTION

Petitioners' Reply attempts to convince the Board to throw out the rulebook and invalidate the Challenged Claims of the '477 patent despite Petitioners having repeatedly failed to meet their burden of proving invalidity. This is most evident by the opening paragraph of Petitioners' Reply, which brazenly faults General Access for setting "forth **straw man arguments based on the allegation** not that the '477 [p]atent is valid, but **merely that Petition did not establish invalidity.**" (Reply, 1.) But of course, the law places the burden of establishing invalidity squarely on Petitioners, and Petitioners' attempt to rid themselves of this burden cannot be made in good faith. Nor can Petitioners' reliance in their Reply on the Supplemental Evidence that the Board *denied Petitioners' previous motion* to submit—without even acknowledging the Board's prior denial.

Rather, having failed to even allege in the Petition that the prior art discloses every element of the Challenged Claims—such as "a profile parameter device coupled to said profile parameter determiner"—Petitioners now represent to the Board that the Institution Decision misunderstood the Petition—despite Petitioners' prior representations to the contrary. Petitioners also repeatedly attempt to make these omitted allegations (which still fail) for the first time on Reply, in contravention of their statutory obligation to make their prima facie case in their Petition. Petitioners' failure to follow the law and prior orders of the Board

cannot be countenanced. General Access therefore respectfully requests that the Board confirm the patentability of the '477 patent's Challenged Claims.

II. ARGUMENT

A. Grounds 1-2: Petitioners Have Not Established 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,” and as the Institution Decision noted, the Petition failed to allege that Genossar discloses this claim element. (ID, 24.) Petitioners cite *Netflix* on Reply to argue that a “holistic” review of the Petition “confirms that Genossar anticipates this element.” (Reply, 13.) However, the *Netflix* Court explicitly denounced what Petitioners urge the Board to do here, holding that “[w]hile the Board should review a petition holistically, **it is not obligated 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 argument.” *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1379 (Fed. Cir. 2023) (quotation omitted)¹. And no amount of “holistic” review can absolve Petitioners of the statutory requirement that “[t]he petition must specify where **each element of the claim is found in the prior art** patents or printed publications relied upon.” (37 CFR § 42.104(b)(4); 35 U.S.C. § 312(a)(3).)

¹ All emphases added unless otherwise noted.

Petitioners then argue that “[t]o the extent the Institution Decision agreed with Patent Owner regarding this limitation, that argument was based on the above-discussed overly narrow construction of the term ‘coupled to’ which excluded components which joined within each other (e.g., Institution Decision at 24.).” (Reply, 13.) Petitioners’ arguments fail for numerous reasons.

First, Petitioners cannot blame the Institution Decision’s findings on any interpretation of the term “coupled to,” when the Petition failed to allege in any way that Genossar discloses a “profile parameter storage device” that is “coupled to said profile parameter determiner.” Indeed, in contravention of the law requiring Petitioners to provide an *understandable explanation of the element-by-element specifics of the patentability challenges*, the Petition did not even contain the words “coupled to” in its analysis of claim [1.C]. *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.”); *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.").

Second, Petitioners attempt to remedy the Petition's incurable deficiencies by, for the first time on Reply, pointing to other portions of the Petition to argue that "Petitioners' original Petition stated that 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," which is "clearly relevant to the 'coupled to' limitation, as shown by the citation to them in the Institution Decision." (Reply, 14 (quotation omitted); *see* Reply, 18.) Not only does this argument fail to adhere to the Federal Circuit's pronouncement in *Netflix* that the Board "is not obligated 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 argument," this argument is also belied by Petitioners' previous arguments. *Netflix*, 84 F.4th at 1379 (quotation omitted). Specifically, in their Reply to the POPR, Petitioners argued that "[n]owhere do Genossar or the Petition state that the channel-related parameters (e.g., equalizer coefficients) must be stored *within* equalizer controller 56." (Paper 10 at 1-2.) Thus, Petitioners' arguments on Reply cannot be reconciled with their previous arguments, which make clear that, in their view, the Petition did not rely on Genossar's storage of the channel-related

parameters within equalizer controller 56. Nor did the Petition rely upon Petitioners' new allegations that PLL 66 constitutes part of the "parameter storage device." (*See Reply*, 18.)

Third, even if Petitioners had alleged in the Petition—as they improperly attempt to argue on Reply—that the profile parameter storage device is coupled to the profile parameter determiner (alleged to be receive portion 28) by virtue of being a sub-component of receive portion 28—Petitioners' argument still would have failed. Specifically, Petitioners' argument that "coupled to" means "joined or connected in any way" does not remedy the Petition's failure as this argument does not change the fact that a component cannot be "coupled to" itself.

Indeed, the Federal Circuit has held that "[i]t goes beyond the plain meaning of 'coupled' to say that a sub-component (e.g., an engine in a car) is 'coupled to' the component as a whole (e.g., the car)." *Cutsforth, Inc. v. MotivePower, Inc.*, 643 F. App'x 1008, 1012–13 (Fed. Cir. 2016) (reversing the Board's holding that "a 'brush catch' may be a sub-component of the 'beam' and still be considered to be 'coupled to the beam'"). Yet this is exactly what Petitioners' argument requires. While Petitioners attempt to disguise this by arguing that "[t]he 'coupled to' language does not preclude an arrangement in which the profile parameter storage device is joined within the profile parameter determiner," Petitioners' argument does not require that two components of the profile parameter determiner are

“joined within the profile parameter determiner.” Rather, for Petitioners’ argument to succeed (if it had been made in the Petition, as required), a sub-component of the profile parameter determiner (the alleged profile parameter storage device) would have to be joined to the profile parameter determiner of which it is a part. As the Federal Circuit agreed in *Cutsforth*, this would “render[] the phrase ‘coupled to’ meaningless.” *Id.* at 1012. The same is true here.

Fourth, claims that recite separate elements (i.e., “profile parameter storage device,” “profile parameter determiner”), relating to one another in a specific way (i.e., “coupled to”), must be construed in such a way as to maintain those relationships. *See, e.g., Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1305 (Fed. Cir. 2014) (rejecting proposed construction that “reads [a term] out of the claim”); *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (finding error in district court construction that “did not require a spring means that was a distinct structural element” from another claimed element); *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”). Petitioners attempt to argue this point, citing *Google v. EcoFactor* for the proposition that “[t]here is no ‘*per se* rule that separately listed claim elements are distinct components.” (Reply, 10.) However, Petitioners ignore that, two sentences later, the Federal Circuit in *Google v.*

EcoFactor held: “Rather, we have explained that there is a ‘presumption’ that separately listed claim limitations may indicate separate and distinct physical structure, but that presumption may always be rebutted in the context of a particular patent.” *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049, 1058 (Fed. Cir. 2024). Given this presumption, paired with the fact that Petitions are required to address any claim terms that require construction, Petitioners must have rebutted this presumption, if at all, in the Petition. *See* 37 C.F.R. § 42.104(b)(2).

Thus, these tenets of claim construction govern the phrase “profile parameter storage device coupled to said profile parameter determiner.” The phrase “coupled to” therefore describes a relationship between distinct structures. It is not synonymous with “is part of” or “includes,” or other phrases that might address how a single structure has discernible parts. The “profile parameter storage device” and “profile parameter determiner” must be “coupled” to one another, and so they must be distinct physical structures. Unless these two elements are physically distinct, the claim’s requirement of “coupling” has no meaning. *See In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1280 (Fed. Cir. 2015) (“[I]t would be illogical to regard one unit as being ‘attached’ to itself.” (quotation omitted)).

Fifth, Petitioners argue that, in the context of the ’477 patent, “coupled to” can reference either “two components” or “a functional relationship,” where “the profile parameter is ‘coupled’ to receive,” or coupled for the purpose of receiving,”

such that “‘coupled to’ is not limited to a specific, direct, physical relationship.” (Reply, 5.) But this argument is a straw man, as General Access has never argued that “coupled to” means having “a specific, direct, physical relationship.” Rather, General Access has argued, just as the Federal Circuit has confirmed, that a sub-component of a structure cannot be “coupled to” the structure. If this were the case, as Petitioners argue, there could be no requirement of the “functional relationship” that Petitioners argue “coupled to” represents, since under Petitioners’ proposed definition, every sub-component of the whole structure would by definition be “coupled to that structure,” regardless of whether any functional relationship existed between the structure and its sub-component.

Sixth, Petitioners’ argument that “Patent Owner’s own expert agrees” that “coupled to” “does not necessarily exclude components which are joined with each other” is misleading, and so also fails. Specifically, General Access’s expert—Dr. Madisetti—never agreed to anything of the sort, stating instead that he had not formed an opinion as to whether “the profile storage device [can] be a subcomponent of the profile parameter determiner” because the Petition did not provide an allegation that the profile parameter storage device is coupled to the profile parameter determiner in order for him to be able to form an opinion as to whether he agreed with those allegations. (EX1038, 15:2-18:17.)

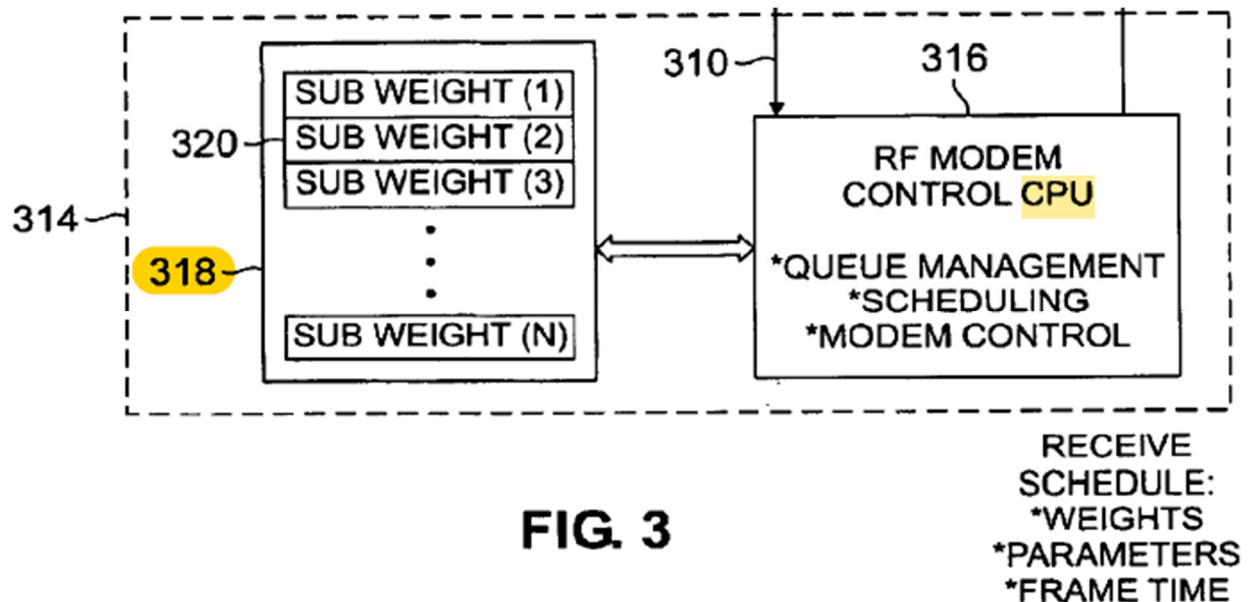
Similarly, while Petitioners fault Dr. Madisetti for failing to render opinions on allegations that the Petition never made, they feign ignorance as to how he could render opinions on whether two components were “coupled to” each other in the District Court proceeding. (*See Reply*, 9.) The difference between Dr. Madisetti’s two opinions is simple—in the District Court proceeding, the alleged components and their coupling had been identified for him to render an opinion upon, whereas here, the Petition did not provide the necessary identification. It is not Dr. Madisetti’s nor General Access’s burden to speculate as to all of the ways in which Petitioner might have attempted to allege that Genossar discloses the coupling recited in the Challenged Claims, because it was Petitioners’ burden to provide this allegation in the Petition. Absent such an allegation, there was nothing upon which Dr. Madisetti was able to render an opinion prior to being presented with previously undisclosed hypotheticals at his deposition. *See Live Power Intelligence Co. NA, LLC v. Genscape Intangible Holding, Inc.*, IPR2019-00169, Paper 7 at 13-14 (PTAB June 7, 2019) (“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*, 584 U.S. 357, 365–66 (2018) (cleaned up)).

Finally, Petitioners argue that a claim construction that does not allow a sub-component of a whole structure to be “coupled to” the whole structure “would exclude the example set forth in Figure 3 and 6:50-62 of the ’477 [p]atent specification.” (Reply, 8.) This is both irrelevant and incorrect. Petitioners’ argument is irrelevant because they acknowledge that “in discussion of Figure 4[,] the patent specifies that a sub-component within the controller 314, the control CPU”—not the controller 314 itself as Petitioners argue—“is operable to form a profile parameter determiner and updater.” (Reply, 8.) Because the ’477 patent clearly discloses an embodiment that matches the plain meaning of “coupled to,” according to the Federal Circuit, there is no basis to depart from this plain meaning. See *SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1379–80 (Fed. Cir. 2021) (holding that a construction “would not ‘contradict the specification’ where “[i]t simply leaves out some alternative embodiments.”); *PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016) (rejecting the proposition that “each and every claim ought to be interpreted to cover each and every embodiment”).

In addition to being irrelevant, Petitioners’ argument is also incorrect because it ignores the language of the ’477 patent specification. Specifically, the

'477 patent explicitly states: “The controller 314 is here again shown to include the **memory device 318** and the **control CPU 316**. Here, the **control CPU is operable to form a profile parameter determiner** and updater, and the **memory here forms a profile storage device.**” (EX1001, 11:9-13.)



(EX1001, Figure 3 (excerpted, annotated).) Thus, according to the '477 patent specification, in Figure 3, above, the control CPU 316 is the profile parameter determiner, and this is coupled to the profile storage device, 318, via the double arrow shown in figure 3, above.

Despite the explicit description in the '477 patent of control CPU 316 as the claimed “profile parameter determiner,” Petitioners insist—without citation to evidence—that “it is the overall controller 314 of Figure 3 which performs the claimed steps of receiving and determining. (Reply, 8.) Not so. Rather, in its description of Figure 3, the '477 patent states that receiving is done by CPU 316:

“The **modems** are shown to be functionally **coupled to controller 316** via lines 310, **for receiving contention results**, and 312 for **passing parameters**, frame times and weight values **for the modems to apply to the received signals**. **Controller 314 includes control CPU 316** and memory device 318.” (EX1001, 10:9-14.)

In sum, Petitioners failed to allege their prima facie case in their Petition, and by failing to allege that Genossar discloses every element of claim 1 and its dependent claims, Petitioners’ challenge to these claims in Grounds 1 and 2 must fail. But even under Petitioners’ argument—impermissibly submitted for the first time on Reply under the guise of response to a claim construction argument of a component that Petitioners failed to allege in the first place—Petitioners’ challenge still fails. For in this argument, Petitioner for the first time on Reply maps the “profile parameter storage device” as a sub-component of the alleged “profile parameter determiner,” such that the two cannot be “coupled to” each other, as claim [1.C] recites.

B. Grounds 1-2: Petitioners Have Not Established that Genossar Discloses 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 argue—based solely on a related District Court case that is still ongoing—that “[t]he plain and ordinary meaning” of the recited “profile parameter

storage device for storing values representative of the at least one signal-related parameter and the at least one channel-related parameter” “does not require the signal-related parameter and channel-related parameter be stored together in a single memory component.” (Reply, 10-11.) Petitioners misunderstand General Access’s argument. Petitioners failed to meet their burden with respect to this claim element because they did not even identify where within the base station—other than generally in its “stored memory”—they allege the claimed “profile parameter storage device” is located. (*See*, Petition at 20.) Certainly, had Petitioners identified such a storage device within Genossar, that device could have had multiple components. However, Petitioners failed to make even this barest allegation, which the Board recognized in its Institution Decision. (ID, 24.) In the absence of an identification of a profile parameter storage device in Genossar, General Access—on its own—looked to Genossar to determine where such a device might exist. And in doing so, General Access was unable to identify any profile parameter storage device separate from the alleged “profile parameter determiner” that “stor[es] values representative of the at least one signal-related parameter and the at least one channel-related parameter” as claim 1 recites. For these additional reasons, Petitioners Genossar-based challenge to claim 1 and its dependent claims must fail.

C. Grounds 3-5: Petitioners Have Not Established that Barratt '470 Discloses a “Profile Parameter Storage Device Coupled to Said Profile Parameter Determiner” as Recited in Claim [1.C].

On Reply, Petitioners attempt to re-write the Petition to include allegations of “coupling” fatally missing from the Petition. Curiously, Petitioners now argue that “Patent Owner’s position with respect to Barratt ’470 misunderstands the nature of Petitioners’ articulated inherency argument.” (Reply, 15.) Petitioners’ revisionist history is belied by the fact that Petitioners requested and received permission to file a 5-page reply to the POPR, and despite only using 2 lines of their granted 5th page, Petitioners have not articulated this “misunderstanding” until now. “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute,” such that Petitioners cannot “cure the petition’s deficiencies in its subsequent briefing to the Board.” *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (quoting *Intelligent Bio-Sys.*, 821 F.3d at 1369.) Below is a comparison of what Petitioners wrote in their Petition, and what they now represent to the Board—for the first time on Reply—that they “meant” when they wrote the Petition.:

What the Petition Says	What Petitioners Say they “Meant”
“Thus, Barratt ’470 discloses that the base station necessarily includes a “profile parameter storage device” for	Thus, Barratt ’470 discloses that the base station necessarily includes a profile parameter storage device

storing these parameter values from one frame to next for each signal of interest, as required by Claim [1.C].” (Petition at 48.)	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.
--	--

(Reply, 15.)

Even if Petitioners’ “misunderstood” argument was believable (it is not), it would still be irrelevant, as Petitioners cannot satisfy their burden of demonstrating that Barratt ’470 discloses a “profile parameter storage device coupled to said profile parameter determiner” with such conclusory allegations. *See In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.”). Because Petitioner did not “articulate specific reasoning, based on evidence of record,” why the base station necessarily includes not only a profile parameter storage device, but also a

profile parameter storage device that is coupled to the profile parameter determiner as claim 1 recites, Petitioners' challenge based on Barratt '470 must fail.

Next, Petitioners attempt to save their challenge by arguing a new claim construction for the first time on Reply. (Reply, 19.) This belated claim construction argument, however, is irrelevant. Petitioners argue that "[a] proper construction of [profile parameter storage device] encompasses storage in any location or combination of locations, so long as the parameters stored therein are available to the profile parameter determiner by a functional coupling." (*Id.*) This construction, however, does nothing to save Petitioners' challenge, as it does not relieve Petitioner of the burden of identifying the profile parameter storage device within Barratt '470's base station—which the Institution Decision held that Petitioners failed to do. (ID, 41.) *See Intelligent Bio-Sys.*, 821 F.3d at 1369 ("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.'") (quoting 35 U.S.C. § 312(a)(3)).

Further, Petitioners are simply incorrect in alleging that the base station necessarily includes both a profile parameter storage device and that this profile parameter storage device is necessarily coupled to the profile parameter determiner. This is because "[a]nticipation by inherent disclosure is appropriate

only when the reference discloses prior art that must necessarily include the unstated limitation.” *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (“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).) However, as Petitioners have acknowledged, one possible scenario is that Barratt ’470’s alleged profile parameter storage device is a subcomponent of the alleged profile parameter determiner, such that the two cannot be “coupled to” each other, as discussed in Section II.A., above. In another scenario, the profile parameters are stored in the cloud, and not on the claimed profile-creating apparatus. Because either scenario is possible, it is not the case that Barratt ’470 necessarily (and thus inherently) anticipates a “profile parameter storage device coupled to said profile parameter determiner” as claim 1 recites.

Recognizing the Petition’s fatal omissions, Petitioners impermissibly attempt to resuscitate their Challenges based on Barratt ’470 by pointing to a brief mention of the component DSP 117—not in the Petition—but in the Petitioners’ expert declaration. (Reply, 16 (citing EX1003 ¶135), 19.) This does not save Petitioners’ challenge for at least four reasons.

First, this citation appears in the Petition’s analysis of claim element [1.A], not [1.cC], and so is not relevant to whether Barratt ’470 discloses a “profile

parameter storage device coupled to said profile parameter determiner,” as this element is not recited in claim [1.A]. *See Netflix*, 84 F.4th at 1379 (the Board “is not obligated 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 argument.” (quotation omitted).)

Second, Petitioners’ expert’s unrelated mention of DSP 117 with respect to claim [1.A] still did not identify the memory components within DSP 117 as being the “profile parameter storage device” recited in claim [1.C], much less explain how these memory components were allegedly “coupled to” the profile parameter determiner—which Petitioner also alleges as being DSP 117. *See Corephotonics*, 84 F.4th at 1001–02 (“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.”).

Third, again recognizing the Petition’s fatal omissions, Petitioners include in their Reply a Hail Mary attempt at salvaging the Petition’s challenges, and impermissibly include in their Reply for the first time allegations that DSP 117 is a DSP56301, with memory components that “would have ‘maintained’ the at-issue values and were ‘coupled to’ the other components of the DSP56301 in that they were joined within that device.” (Reply, 16-18 (citing EX1039, ¶¶26-29; EX1042,

55-6).) *See Corephotonics*, 84 F.4th at 1002 (“[T]he Board is not permitted to entertain ‘[s]hifting arguments’ but must, instead, reject any ‘entirely new theory of *prima facie* obviousness absent from the petition,’ if the petitioner attempts to inject such a theory into the proceeding post-petition.”) (quotation omitted).

This is the epitome of impermissible new evidence submitted on Reply for the purpose of establishing the *prima facie* case Petitioners were required to have made in the Petition. *See* U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide, 73-75 (Nov. 2019) (“**Petitioner may not submit new evidence or argument in reply** that it could have presented earlier, e.g. **to make out a *prima facie* case of unpatentability**. ... Examples of **indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case** for the patentability or unpatentability of an original or proposed substitute claim, such as newly raised rationale to combine the prior art references that was not expressed in the petition. *See Intelligent Bio-Sys.*, 821 F.3d at 1369–70 (holding that the Board did not err in refusing the reply brief as improper under 37 C.F.R. § 42.23(b) because petitioner relied on an entirely new rationale to explain why one of skill in the art would have combined the references at issue). It is also **improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to “gap-fill” by teaching a claim element**

that was not present in the prior art presented with the petition.”). As such, the Board should not consider this evidence and General Access requests that it be stricken from the record and from the Reply. *See Intelligent Bio-Sys.*, 821 F.3d at 1369 (“Once the Board identifies new issues presented for the first time in reply, neither this court nor the Board must parse the reply brief to determine which, if any, parts of that brief are responsive and which are improper. As the Board noted, ‘it will not attempt to sort proper from improper portions of the reply.’” (quotation omitted).)

Fourth, even accepting Petitioners’ impermissible new identification of the memory components within DSP 117 as being the “profile parameter storage device” recited in claim [1.C], Petitioners still cannot demonstrate that these memory components within DSP 117 are “coupled to [the] profile parameter determiner.” This is because these DSP 117 memory components are subcomponents of what Petitioners have alleged as the profile parameter determiner (DSP 117), such that the two cannot be “coupled to” each other, as discussed in Section II.A., above.

Because the Petition failed to allege that Barratt ’470 discloses a “profile parameter storage device coupled to said profile parameter determiner,” and Petitioner cannot remedy this defect in its prima facie case with new evidence and allegations on Reply, or otherwise, Petitioners’ claim 1 challenge based on Barratt

'470 must fail. *See In re Magnum Oil Tools*, 829 F.3d at 1381 (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.”).

D. Ground 5: The Petition Fails to Explain How it Consistently Maps the Same Parameters in Claims 16 and 18 Over Barratt '470 and PHS.

On Reply, Petitioners attempt to explain why the parameters they rely on in claim 2 are allegedly channel-related and signal-related. (Reply, 21-22.) However, this is not the deficiency that the Board noted in its Institution Decision, where the Board held:

[D]ependent claim 18 refers to the same signal-related and channel-related parameters recited in independent method claim 16. In its mapping of those parameters for the independent claims, Petitioner contends that “Barratt '470 discloses “determining at least one signal-related parameter (*e.g.*, *frequency offset*, *time alignment*, *etc.*)” and “determining a value of at least one channel-related parameter (*e.g.*, *antenna weights*).” Pet. 46. For dependent claim 18, Petitioner does not refer explicitly to those same parameters. *See id.* at 68 (relying on the contentions made for claim 2); *id.* at 67 (Petitioner contending, for claim 2, that “the initial burst is used by the base station to determine the at least one parameter for the first burst data signal, including the ‘*frequency*’ and ‘*timeslot*’ of the SCH channel and other parameters

described in the PHS standard.’’). Petitioner has not explained adequately how it consistently maps the same parameters in both independent claim 16 and its dependent claim 18.

(ID, 46-47.)

Thus, Petitioners’ explanation as to why the parameters it relies on in claim 2, and also for claim 18, are allegedly channel-related and signal related is irrelevant. Because “[D]ependent claim 18 refers to the **same signal-related and channel-related parameters** recited in independent method claim 16,” the relevant question is whether the parameters Petitioners rely upon for claims 2 and 18 are the same as those Petitioners rely upon for claim 16—upon which claim 18 depends. Petitioners’ Reply confirms that these parameters are not, in fact, the same. (ID, 46; *see*, Reply, 21-22.) Thus, Petitioners’ Ground 5 challenge fails for claim 18.

E. Ground 2: Petitioners Have Not Established that WiMAX is Prior Art.

The most appalling aspect of Petitioners’ Reply is their reliance on Supplemental Evidence that the Board denied Petitioners permission to submit, without ever even acknowledging the fact that the Board issued this denial. (*See* Reply, 2-3, 22-24.) Specifically, in denying Petitioners’ motion to submit these Supplemental Exhibits previously, the Board held:

[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood

that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

The Petition in this case failed to identify adequate evidence to meet the threshold showing at the institution stage. The Petition begins with the conclusory assertion that the reference “was published in September 2000 and qualifies as prior art” and characterizes it as a “draft standard[.]” Pet. 10. As mentioned above, the Petition relies on a purported copyright date and Dr. van der Weide’s testimony where he was instructed to assume to be correct Petitioner’s conclusory assertion regarding the reference’s status as a prior art publication and where he discusses the accessibility of *draft* standards. *See id.*; EX1003 ¶54. The Petition failed to address adequately the document’s self-identification as a *potential* draft standard or the existence of inconsistent dates on the first page. *See* Pet. 10–11; *cf.* Mot. 1 (Petitioner continuing to characterize the reference as a “Draft Standard” without acknowledging the “potential” modifier).

Petitioner admittedly now seeks to respond to the Preliminary Response through the submission of supplemental evidence. *See, e.g.*, Mot. 4 (“[T]he supplemental information presented here responds to the challenges by Patent Owner.”). This is not a situation where a petitioner met the threshold showing of public accessibility but there remained a potential dispute on that issue that might be resolved via supplemental information. Rather, Petitioner here failed to satisfy that threshold burden and now seeks to make a showing after institution

and after Patent Owner and our Institution Decision discussed problems with Petitioner's initial case.

As mentioned above, the Petition identified Mr. Eklund as someone purportedly having "direct knowledge of the importance and availability of the WiMAX draft standard to other relevant, interested POSITAs." *Id.* at 11 n.2. However, Petitioner did not file, with the Petition, the declaration from Mr. Eklund that it seeks now to submit as supplement information. Rather, Petitioner chose to rely on a declaration of a witness who was instructed to assume that the WiMAX reference was published in September 2000 and qualifies as prior art—the very things that are at issue. *See* EX1003 ¶54. Petitioner now seeks to file declarations from both witnesses along with purportedly supporting evidence. Petitioner does not explain adequately why it did not, at the time of the Petition, come forward with the supplemental information and present related arguments to which Patent Owner could have responded in the Preliminary Response. We agree with Patent Owner that Petitioner took a wait-and-see approach and now is attempting to improperly bolster the Petition after institution.

(Paper 18, 7-9.)

Because the Board has already denied Petitioners' Motion to submit Supplemental Exhibits 1017-1035 as supplemental information, Petitioners' reliance on those same Exhibits in Reply should be stricken, at the very least.

(Paper 18, 10.)

III. CONCLUSION

For each of the above reasons, as well as those detailed in the POR, General Access respectfully requests that the Board confirm that the Challenged Claims of the '477 patent are patentable.

Dated: November 26, 2024

Respectfully submitted,

/Sarah E. Spires/

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

SKIERMONT DERBY LLP

1601 Elm Street, Suite 4400

Dallas, Texas 75201

Tel: (214) 978-6600

Fax: (214) 978-6601

sspires@skiermontderby.com

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the Microsoft Office word count for the foregoing Patent Owner's Sur-Reply under 37 C.F.R. § 42.23, excluding the table of contents, table of authorities, claim listing, certificate of word count, and certificate of service, totals 5,571 words, which is less than the 5,600 words allowed under 37 C.F.R. § 42.24(c)(1).

Dated: November 26, 2024

/Sarah E. Spires/
Sarah E. Spires (Reg. No. 61,501)
SKIERMONT DERBY LLP
1601 Elm Street, Suite 4400
Dallas, Texas 75201
Tel: (214) 978-6600
Fax: (214) 978-6601
sspires@skiermontderby.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Sur-Reply was served on November 26, 2024, by delivering a copy via electronic mail to the attorneys of record for the Petitioners as follows:

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: November 26, 2024

Respectfully Submitted,

/Sarah E. Spires/

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